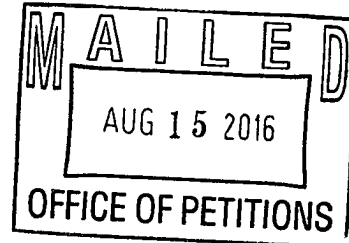




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Inventors: Nader Asghari-Kamrani et al :
Application No. 12/210,926 :
Filing Date: September 15, 2008 :
Attorney Docket No. PL2891174 :

Decision on Petitions

This is a decision on the petition under 37 C.F.R. §§ 1.78(c) and 1.78(e) filed February 22, 2016, *as supplemented on* August 8, 2016. This is also a decision on the petition to expedite under 37 C.F.R. § 1.182 filed on August 8, 2016.

The petition under 37 C.F.R. §§ 1.78(c) and 1.78(e) is **dismissed**.

The petition under 37 C.F.R. § 1.182 is **granted**.

Background

The instant application was filed on September 15, 2008. The specification includes the following three priority claims:

- (1) This application is a continuation of Application No. 11/239,046;
- (2) Application No. 11/239,046 claims the benefit of Application No. 60/615,603;
and
- (3) This application is a continuation of Application No. 09/940,635.

The third priority claim set forth above is improper because this application was filed after the date that Application No. 09/940,635 issued as a patent.

The papers filed September 15, 2008, include a paper giving a power of attorney to the practitioners associated with Customer No. 63670 ("Law Firm 1")

The Office issued a filing receipt including the three priority claims on October 1, 2008.

A paper giving a power of attorney to practitioners associated with Customer No. 23504 ("Law Firm 2") was filed on September 8, 2009.

A paper giving a power of attorney to practitioners associated with Customer No. 58293 (“Law Firm 3”) was filed on May 14, 2010.

This application issued as a patent on September 11, 2012.

The specification portion of the patent includes all three priority claims in the original specification.

The front page of the patent does not include the priority claim in the specification indicating this application is a continuation of Application No. 09/940,635. Instead, the front page states Application No. 11/239,046 is a continuation of Application No. 09/940,635.

A paper giving a power of attorney to practitioners associated with Customer No. 105857 (“Law Firm 4”) was filed on December 17, 2015.

A petition under 37 C.F.R. § 1.78 was filed on February 22, 2016.

A second petition under 37 C.F.R. § 1.78, a petition to expedite, a request for a certificate of correction, and an application data sheet (“ADS”) were filed on August 8, 2016.¹ The second petition indicates the petition is intended to replace the first petition.

The ADS includes the following six priority claims:

- (1) This application is a continuation-in-part (“CIP”) of Application No. 11/239,046;
- (2) Application No. 11/239,046 claims the benefit of Application No. 60/615,603;
- (3) Application No. 11/239,046 is a CIP of Application No. 09/940,635;
- (4) This application is a CIP of Application No. 11/333,400;
- (5) Application No. 11/333,400 is a CIP of Application No. 09/940,635; and
- (6) Application No. 11/333,400 claims the benefit of Application No. 60/650,137.

Discussion

A petition under 37 C.F.R. §§ 1.78(c) and 1.78(e) must be accompanied by:

- (1) The reference required by 35 U.S.C. § 119(e) and 37 C.F.R. § 1.78(a)(3) to the prior filed provisional application(s) and required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(d)(2) to the nonprovisional application(s);
- (2) The petition fee set forth in 37 C.F.R. § 1.17(m); and
- (3) A statement that the entire delay between the date the claim were due under 37 C.F.R. §§ 1.78(a)(4) and 1.78(d)(3) and the date the claim were filed was unintentional.²

¹ The \$200 fee for the petition to expedite and the \$100 fee for the request for a corrected filing receipt have been charged to Deposit Account No. 50-5922.

² With respect to the statement of delay, the Office “may require additional information where there is a question whether the delay was unintentional.” 37 C.F.R. § 1.78(e)(3).

The Reference Submitted with the Petition under 37 C.F.R. § 1.78 is Unacceptable.

This application was filed prior to September 16, 2012. As a result, the required reference can be submitted as part of an ADS and/or as part of amendment to the beginning of the specification.

The petition filed February 22, 2016, is not accompanied by an ADS or an amendment.

The papers filed August 8, 2016, include an ADS. The papers do not include an amendment.

The reference in the ADS is unacceptable because the ADS is improper.

37 C.F.R. § 1.76(c)(2) states,

An application data sheet providing corrected or updated information ... must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed.

The ADS fails to properly identify the changes made to the priority information of record. Therefore, the ADS is improper.

A renewed petition may be filed. The renewed petition must include an amendment adding the required reference to the beginning of the specification and/or a new ADS.

As a courtesy, the Office notes an ADS taking the following form would be acceptable:

- (1) The ADS lists the original three priority claims followed by the six priority claims in the ADS filed on August 8, 2016;
- (2) The information for the first three priority claims is stricken-through; and
- (3) The information for the remaining six priority claims is underlined.

The Information in the Requested Certificate of Correction is Inconsistent with the Priority Information in the ADS.

The requested certificate of correction seeks to make corrections to the beginning of the specification. The changes to the specification in the requested certificate of correction are inconsistent with the priority information in the ADS. Specifically, the changes to the specification set forth in the requested certificate of correction fail to include the third priority claim in the ADS. The third priority claim in the ADS consists of language indicating Application 11/239,046 is a CIP of Application No. 09/940,635.

Any renewed petition filed in response to this decision should include a request for a certificate of correction including priority information consistent with the reference submitted with the renewed petition.

Although not required, the Office recommends the phrase “with a priority of” in the specification be replaced with the phrase “claims the benefit of” in order to clarify the relationship between Application No. 11/239,046 and Application No. 60/615,603 in the specification

An Additional Problem in the Requested Certificate of Correction.

Paragraph (63) on the front page of the issue patent includes priority information involving priority claims under 35 U.S.C. § 120.

Paragraph (64) on the front page of the issue patent includes priority information involving a priority claim under 35 U.S.C. § 119(e) to Application No. 60/615,603.

The requested certificate of correction seeks to make several changes to paragraph (63), which include the addition of information pertaining to a priority claim to Application No. 60/650,137.

The requested certificate of correction does not seek to make any changes to paragraph (64).

The additional priority information pertaining to Application No. 60/650,137 should be included in paragraph (64), not paragraph (63), of the front page of the patent.

Statement of Unintentional Delay

The petition seeks to add priority claims under 35 U.S.C. § 119(e) and § 120. Therefore, the petition is being treated as a petition under 37 C.F.R. §§ 1.78(c) and 1.78(e).

A petition under 37 C.F.R. §§ 1.78(c) and 1.78(e) must include a statement that the entire delay between the date each of the claims was due under 37 C.F.R. §§ 1.78(a)(4) or 1.78(d)(3) and the date each of the claims was filed was unintentional.

The petition states, “the entire delay between the date the benefit claim was due under pre-AIA 37 C.F.R. 1.78(a)(2)(ii) and the benefit claims [was] filed was unintentional.”³ As a result of the format of the petition and other facts, the extent to which the statement of delay is intended to apply to the third priority claim in the ADS is unclear.

The petition does not include a statement of delay addressing the delay in the submission of the priority claim under 35 U.S.C. § 119(e).

Any renewed petition filed in response to this decision should state, “The entire delay between the date each of the claims was due under 37 C.F.R. §§ 1.78(a)(4) or 1.78(d)(3) and the date each of the claims was filed was unintentional.”

The Office notes the entire delay in the submission of the fourth, fifth, and sixth priority claims in the ADS was not unintentional if Law Firm 1, Law Firm 2, or Law Firm 3 made the choice not to file any of the claims at any point when handling prosecution of the application. *At least one*

³ The time period set forth in 37 C.F.R. § 1.78(d)(3) is the same as the time period formerly set forth in 37 C.F.R. § 1.78(a)(2)(ii).

of the prior law firms was aware of the existence of both the instant application and Application No. 11/333,400. Specifically, a power of attorney to Law Firm 3 was filed on the same date in the instant application and in Application No. 11/333,400.

Conclusion

In view of the prior discussion, the petition is dismissed.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.⁴ Document Code "PET.OP" should be used if the request is filed electronically.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries regarding this communication should be directed to Attorney Advisor Steven Brantley at (571) 272-3203.



Charles Steven Brantley
Attorney Advisor
Office of Petitions

⁴ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.