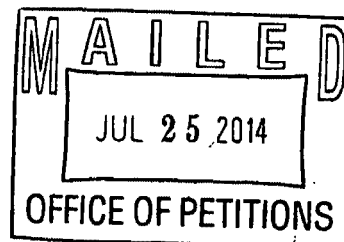




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*Ex Parte* Reexamination Proceeding : **DECISION GRANTING PETITION**  
Control No.: 90/013,017 : **TO ACCEPT UNINTENTIONALLY**  
Filed: October 7, 2013 : **DELAYED PRIORITY CLAIM UNDER 37**  
For: U.S. Patent No. 7,058,822 : **C.F.R. § 1.78(e)**

This is a decision on the March 6, 2014, 2014 patent owner petition entitled "PETITION TO ACCEPT UNINTENTIONALLY DELAYED PRIORITY CLAIM UNDER 37 C.F.R. § 1.78". The petition will be treated under 37 CFR § 1.78(e).

The petition is before the Office of Patent Legal Administration for consideration.

The March 6, 2014 patent owner petition is **granted**.

#### RELEVANT BACKGROUND

1. On June 6, 2006, United States Patent No. 7,058,822 B2 was issued to Finjan Software, Ltd. (Finjan, Inc.).
2. On October 7, 2013, a request for ex parte reexamination of U.S. Patent No. 7,058,822 B2 was filed, and was assigned Reexamination Control No. 90/013,017.
3. On March 6, 2014, patent owner filed a petition to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the concurrently filed amendment.

## DECISION

As stated in MPEP 2258 (IV)(E), a patent owner may correct the failure to adequately claim (in the application for the patent reexamined) benefit under 35 U.S.C. 120 of an earlier filed copending U.S. patent application. For a patent to be reexamined which matured from a utility or plant application filed on or after November 29, 2000, the patent owner must file a grantable petition for an unintentionally delayed priority claim under 37 CFR 1.78(e).

A petition for acceptance of a claim for late priority under 37 CFR § 1.78(e) is applicable to those applications filed after the expiration of the period specified in 37 CFR § 1.78(d)(3). In addition, the petition under 37 CFR § 1.78(e) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR § 1.78(d)(2) of the prior-filed application;
- (2) the petition fee set forth in § 1.17(m); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(d)(3) and the date the claim was filed was unintentional. The Director may require additional where there is a question whether the delay was unintentional.

37 CFR § 1.78(e) requires a statement that the entire delay between the date the claim was due under 37 CFR § 1.78(d)(3) and the date the claim was filed was unintentional. Since the statement appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR § 1.78(d)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

All the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. § 120 is accepted as being unintentionally delayed.

**The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR § 1.78(e) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed applications. In order for this application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and under 1.78 must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.**

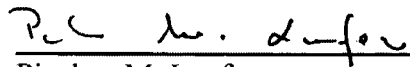
A corrected Filing Receipt, which includes the priority claim to the prior-filed applications, accompanies this decision on petition.

**CONCLUSION**

The petition under 37 CFR § 1.78(e) is **granted**.

Any questions concerning this matter may be directed to Petitions Attorney Shirene Willis Brantley at (571) 272-3230. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 3992 for consideration by the examiner of the claim under 35 U.S.C. § 120 of the prior-filed nonprovisional applications.



Pinchus M. Laufer  
Senior Legal Advisor  
Office of Patent Legal Administration

July 24, 2014

ATTACHMENT : Corrected Filing Receipt