

Practical Patent Practice Webinar Series Episode 02

Docketing Formalities, Restrictions, Non-Final Office Actions

4-Episode Webinar Series

Episode 01 – Docketing and Docketing Management for US Initial Filing (Provisionals & Regular /Apps) Due/Bar Dates, Paris Convention & PCT Deadlines
Thursday, April 1st, 2021 at 12:00 PM CT

Episode 02 – Docketing Formalities, Restrictions, Non-Final Office Actions, PCT Actions
Thursday, June 3rd, 2021 at 10:00 AM CT

Episode 03 – Docketing Final Office Actions, Appeals, Continuations, Allowances

Thursday, August 5th, 2021 at 12:00 PM CT

Episode 04 – Docketing Post Issuance Deadlines: Certificates of Correction, Reissues, Patent Term Adjustment Verification, Maintenance Fees
Thursday, October 7th, 2021 at 12:00 PM CT

Before We Get Started...



Recording

A link to the recording and slides will be emailed to all registrants.



Questions

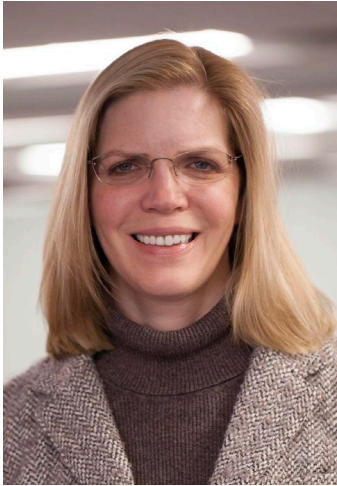
Type questions in the Q&A feature at any time, and we will address them during a Q&A session at the end of the webinar.



Social

Follow us on LinkedIn or go to SLW Institute on slwip.com and BlackHillsIP.com to see upcoming and on demand webinars.

Today's Presenters...



Ann McCrackin

President, Black Hills IP
Patent Attorney
Professor of Law



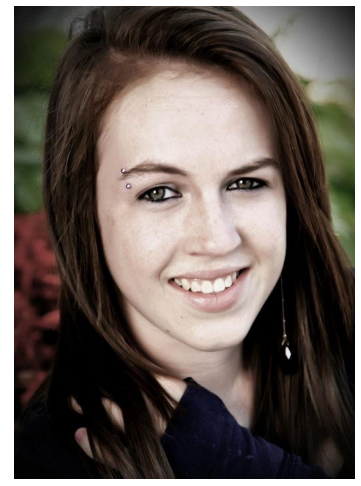
Zhakalazky Carrion

Docketing Manager
Schwegman, Lundberg &
Woessner



Adam Reece

IP Automation Specialist
Lead
Black Hills IP



Amanda Loushin

IP Automation Specialist
Black Hills IP

Polling Question

What is your primary role in your organization?

- Docketer
- Paralegal
- Attorney
- Manager/Administrator
- IT
- Other

Polling Question

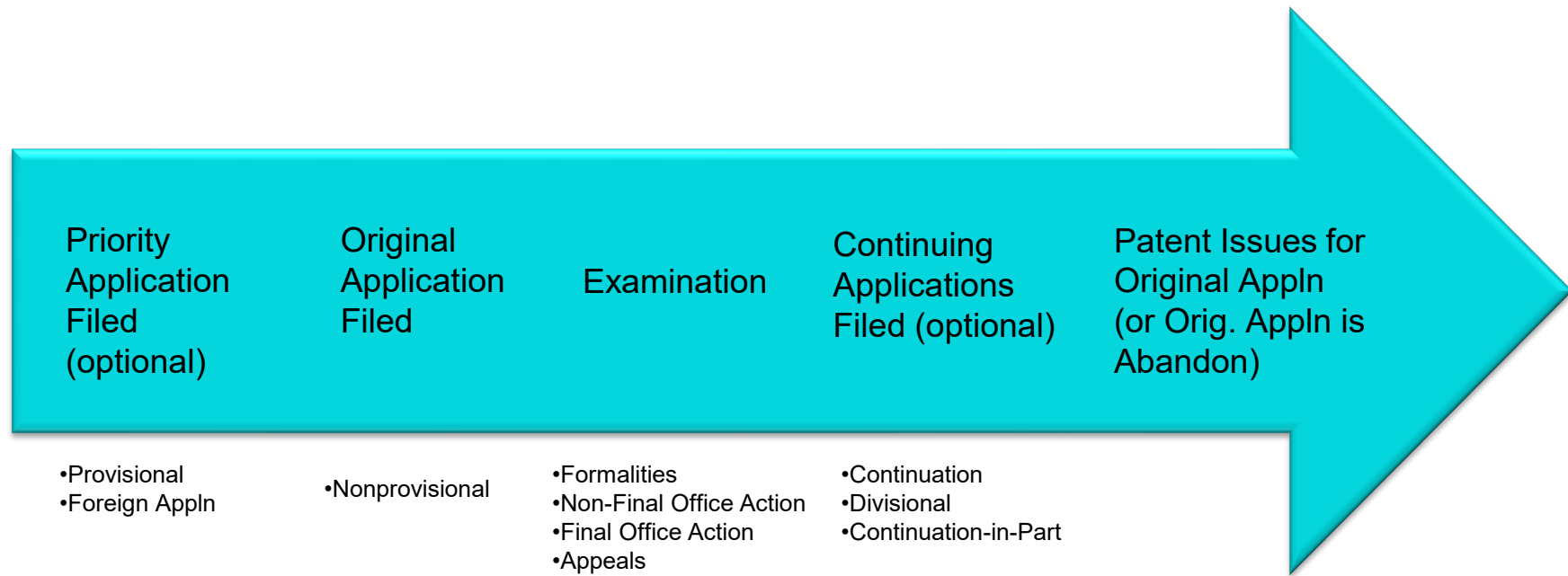
What is the primary docketing system that you use?

- Anaqua
- AppColl
- CPI
- FoundationIP
- Inprotech
- IPFolio
- IP Manager
- Memotech
- Patricia
- Other

Program Objectives

1. Identify common PTO documents including nonfinal office actions and other pre-examination notifications
2. Understand what deadlines need to be docketed
3. Recognize common manual docketing errors
4. Illustrate how automated docketing and verification can avoid these errors

Overview of a Patent Prosecution Process for a US Patent Application



Episode Overview


1. Official Filing Receipts / Notices of Publication
2. Formalities
3. Office Actions

Official Filing Receipts and Notices of Publications



"Easy like Sunday Morning"

- Easy by The Commodores



UNITED STATES PATENT AND TRADEMARK OFFICE


UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP PART UNIT	FE. FEE REC'D	ATTY. DOCKET NO.	TOT CLAIMS	IND CLAIMS
12/345,678	05/17/2021	2621	495		10	5

21186

CONFIRMATION NO. 8958

FILING RECEIPT



0000000123027048

Date Mailed: 05/25/2021

Receipt is acknowledged of this non-provisional utility patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF FIRST INVENTOR, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection.

Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please submit a written request for a corrected Filing Receipt, including a properly marked-up ADS showing the changes with strike-through for deletions and underlining for additions. If you received a "Notice to File Missing Parts" or other Notice requiring a response for this application, please submit any request for correction to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections provided that the request is grantable.

Inventor(s)
Otto Docket, Minneapolis, MN;

Applicant(s)
Otto Docket, Minneapolis, MN;

Power of Attorney: None

Domestic Priority data as claimed by applicant
This application is a CIP of 12/345,678 09/15/2020

Foreign Applications for which priority is claimed (You may be eligible to benefit from the **Patent Prosecution Highway** program at the USPTO. Please see <http://www.uspto.gov> for more information.) - None.
Foreign application information must be provided in an Application Data Sheet in order to constitute a claim to foreign priority. See 37 CFR 1.55 and 1.76.

Permission to Access Application via Priority Document Exchange: Yes

Permission to Access Search Results: Yes

Applicant may provide or rescind an authorization for access using Form PTO/SB/39 or Form PTO/SB/69 as appropriate.

If Required, Foreign Filing License Granted: 05/24/2021

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is

Projected Publication Date: 03/17/2022

Non-Publication Request: No

Early Publication Request: No

**** MICRO ENTITY ****

Title
Auto-Docketing that is too legit to quit

Preliminary Class

345

Statement under 37 CFR 1.55 or 1.78 for AIA (First Inventor to File) Transition Applications: No

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.



Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4258).



		UNITED STATES PATENT AND TRADEMARK OFFICE		UNITED STATES DEPARTMENT OF COMMERCE	
				United States Patent and Trademark Office	
				Address: COMMISSIONER FOR PATENTS	
				P.O. Box 1500	
				Alexandria, Virginia 22313-1450	
				www.uspto.gov	
APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE		
21186	05/08/2019				
			CONFIRMATION NO. 7844		
			PUBLICATION NOTICE		
					
			0000000116469358		

Title:

Publication No.:US-2020-0121729-A1
Publication Date:04/23/2020

NOTICE OF PUBLICATION OF APPLICATION

The above-identified application will be electronically published as a patent application publication pursuant to 37 CFR 1.211, et seq. The patent application publication number and publication date are set forth above.

The publication may be accessed through the USPTO's publically available Searchable Databases via the Internet at www.uspto.gov. The direct link to access the publication is currently <http://www.uspto.gov/patft/>.

The publication process established by the Office does not provide for mailing a copy of the publication to applicant. A copy of the publication may be obtained from the Office upon payment of the appropriate fee set forth in 37 CFR 1.19(a)(1). Orders for copies of patent application publications are handled by the USPTO's Public Records Division. The Public Records Division can be reached by telephone at (571) 272-3150 or (800) 972-6382, by facsimile at (571) 273-3250, by mail addressed to the United States Patent and Trademark Office, Public Records Division, Alexandria, VA 22313-1450 or via the Internet.

In addition, information on the status of the application, including the mailing date of Office actions and the dates of receipt of correspondence filed in the Office, may also be accessed via the Internet through the Patent Electronic Business Center at www.uspto.gov using the public side of the Patent Application Information and Retrieval (PAIR) system. The direct link to access this status information is currently <https://portal.uspto.gov/pair/PublicPair>. Prior to publication, such status information is confidential and may only be obtained by applicant using the private side of PAIR.

Further assistance in electronically accessing the publication, or about PAIR, is available by calling the Patent Electronic Business Center at 1-866-217-9197.

Is there a deadline to docket?

Answer: No

Language from the Filing Receipt: "If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction."

Common Problems Docketing Filing Receipts & Notices of Publication

Easy to docket but time consuming to verify the data

Polling Question

Who does your US patent docketing?



- Internal Docketing Team
- Internal Paralegals
- Outside Vendor
- Outside Counsel updates my docketing system
- No internal docket
- Other

Formalities Letters



"Yeah, Time is on my side, yes it is.
Time is on my side, yes it is. "

- Time is On My Side by The Rolling Stones

 UNITED STATES PATENT AND TRADEMARK OFFICE UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov			
APPLICATION NUMBER	FILED OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
144407	05/18/2021		
CONFIRMATION NO. 1076 FORMALITIES LETTER  CC00000012598059 Date Mailed: 05/26/2021			

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Items Required To Avoid Abandonment:

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. **Applicant is given TWO MONTHS from the date of this Notice within which to file all required items below to avoid abandonment.** Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
- The application search fee must be submitted.
- The application examination fee must be submitted.
- Surcharge as set forth in 37 CFR 1.16(f) must be submitted.
The surcharge is due for any one of:
 - late submission of the basic filing fee, search fee, or examination fee,
 - late submission of inventor's oath or declaration,
 - filing an application that does not contain at least one claim on filing, or
 - submission of an application filed by reference to a previously filed application.

SUMMARY OF FEES DUE:

The fee(s) required within **TWO MONTHS** from the date of this Notice to avoid abandonment is/are itemized below. No entity status discount is in effect. If applicant is qualified for small entity status, a written assertion of small entity status must be submitted to establish small entity status. (See 37 CFR 1.27). If applicant is qualified for micro entity status, an acceptable Certification of Micro Entity Status must be submitted to establish micro entity status. (See 37 CFR 1.29 and forms PTO/SB/15A and 15B.)

- \$ **320** basic filing fee.
- \$ **160** surcharge.
- \$ **700** search fee.
- \$ **800** examination fee.
- \$(**0**) previous unapplied payment amount.
- \$ **1980** TOTAL FEE BALANCE DUE.

Replies must be received in the USPTO within the set time period or must include a proper Certificate of Mailing or Transmission under 37 CFR 1.8 with a mailing or transmission date within the set time period. For more information and a suggested format, see Form PTO/SB/92 and MPEP 512.

Replies should be mailed to:

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450



Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web, including a copy of this Notice and selecting the document description "Applicant response to Pre-Exam Formalities Notice".
<https://portal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at **(571) 272-4000** or **(571) 272-4200** or **1-888-786-0101**.

/mcgga/

 UNITED STATES PATENT AND TRADEMARK OFFICE UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov		
U.S. APPLICATION NO.	FIRST NAMED INVENTOR	ATTY. DOCKET NO.
58249		
INTERNATIONAL APPLICATION NO.		
PCT/US2019/043539		
LA FILING DATE	PRIORITY DATE	
07/25/2019	07/25/2018	
CONFIRMATION NO. 8842 371 FORMALITIES LETTER		
		

Date Mailed: 04/27/2021

Notification of Insufficiency Under 37 CFR 1.492 and/or 1.495 (DO/EO/US)

The following items have been submitted by the applicant or the International Bureau to the United States Patent and Trademark Office as a Designated / Elected Office (37 CFR 1.495).

- Indication of Small Entity Status
- Priority Document
- Copy of the International Application filed on 01/22/2021
- Copy of the International Search Report filed on 01/22/2021
- Preliminary Amendments filed on 01/22/2021
- U.S. Basic National Fees filed on 01/22/2021
- Authorize Access to Search Results filed on 01/22/2021
- Priority Documents filed on 01/22/2021
- Power of Attorney filed on 04/02/2021
- Specification filed on 01/22/2021
- Claims filed on 01/22/2021
- Abstracts filed on 01/22/2021
- Drawings filed on 01/22/2021
- Authorization to Permit Access filed on 01/22/2021
- Application Data Sheet (37 CFR 1.76) filed on 01/22/2021

The following items **MUST** be furnished within the period set forth below:

- Additional claim fees of **\$16910** as a small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due.

SUMMARY OF FEES DUE:

Total additional fees required for this application is **\$16910** for a Small Entity:

- Total additional claim fee(s) for this application is **\$16910**
 - \$8880 for 37 independent claims over 3.
 - \$7600 for 152 total claims over 20.
 - \$430 for multiple dependent claim surcharge.

Applicant is notified that the above-identified application contains the deficiencies noted below. No period for reply is set forth in this notice for correction of these deficiencies. However, if a deficiency relates to the inventor's oath or declaration, the applicant must file an oath or declaration in compliance with 37 CFR 1.63, or a substitute

statement in compliance with 37 CFR 1.64, executed by or with respect to each actual inventor no later than the expiration of the time period set in the "Notice of Allowability" to avoid abandonment. See 37 CFR 1.495(c).

- Properly executed inventor's oath or declaration for the following inventor(s) has not been submitted: **Linda L. Kinkel**

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.

<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at **1-866-217-9197** or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

INDIA L EVANS

Telephone: (571) 272-9085

Notice to File Corrected Application Papers



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371(C) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
162742	05/14/2021		

CONFIRMATION NO. 3134
FORMALITIES LETTER



0000000125764756

Date Mailed: 05/24/2021

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

An application number and filing date have been accorded to this application. **The application is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).**

The required item(s) identified below must be timely submitted to avoid abandonment:

- Replacement drawings in compliance with 37 CFR 1.84 and 37 CFR 1.121(d) are required. The drawings submitted are not acceptable because:
 - The application contains a section in the specification containing the brief description of the figures, but is missing the description of Figure(s) **6B-6I** as required by 37 CFR 1.74 and 37 CFR 1.77(b)(9). A brief description of each drawing figure presented is required to satisfy this requirement.
 - To add a brief description of a figure, a proper substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125, providing a brief description of each drawing figure presented, must be submitted. See also 37 CFR 1.77(b)(9).

Note: If applicant wishes to delete the undescribed figure, replacement sheets must be submitted to renumber the figure(s) consecutively.

Applicant is cautioned that correction of the above items may cause the specification and drawings page count to exceed 100 pages. If the specification and drawings exceed 100 pages, applicant will need to submit the required application size fee.

Replies must be received in the USPTO within the set time period or must include a proper Certificate of Mailing or Transmission under 37 CFR 1.8 with a mailing or transmission date within the set time period. For more information and a suggested format, see Form PTO/SB/92 and MPEP 512.

Replies should be mailed to:

Mail Stop Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web, including a copy of this Notice and selecting the document description "Applicant response to Pre-Exam Formalities Notice".
<https://sportal.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>



For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

Questions about the contents of this notice and the requirements it sets forth should be directed to the Office of Data Management, Application Assistance Unit, at (571) 272-4000 or (571) 272-4200 or 1-888-786-0101.

/cruga/

Requirements for Sequence Disclosure Notice

		UNITED STATES PATENT AND TRADEMARK OFFICE	
		<small>UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1518 Alexandria, Virginia 22301-1518 www.uspto.gov</small>	
U.S. APPLICATION NO.	FIRST NAMED INVENTOR	ATTY. DOCKET NO.	
21186			
		INTERNATIONAL APPLICATION NO. PCT/US2017/060917	
		LA. FILING DATE	PRIORITY DATE
		11/09/2017	11/09/2016
		CONFIRMATION NO. 7844 371 FORMALITIES LETTER	
			

Date Mailed: 05/12/2021

NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Items 1) and 2) provide general guidance related to requirements for sequence disclosures.

- 1) 37 CFR 1.821(c) requires that patent applications which contain disclosures of nucleotide and/or amino acid sequences that fall within the definitions of 37 CFR 1.821(a) must contain a "Sequence Listing", as a separate part of the disclosure, which presents the nucleotide and/or amino acid sequences and associated information using the symbols and format in accordance with the requirements of 37 CFR 1.821-1.825. This "Sequence Listing" part of the disclosure may be submitted:
 - a) via EFS-Web (see Section I.1 of the Legal Framework for EFS-Web (<https://www.uspto.gov/patents-application-process/filing-online/legal-framework-efs-web>), hereinafter "Legal Framework") as an ASCII text file, together with an incorporation-by-reference of the material in the ASCII text file in a separate paragraph of the specification identifying:
 - i) the name of the ASCII text file;
 - ii) the date of creation; and
 - iii) the size of the ASCII text file in bytes;
 - b) on compact disc(s) in duplicate according to 37 CFR 1.52(e)(1)(ii) and (4), labeled according to 37 CFR 1.52(e)(6), together with a statement that the duplicate compact discs are identical and an incorporation-by-reference of the material in the ASCII text file according to 37 CFR 1.52(e)(5) in a separate paragraph of the specification identifying:
 - i) the name of the ASCII text file;
 - ii) the date of creation; and
 - iii) the size of the ASCII text file in bytes;
 - c) via EFS-Web as a PDF (not recommended); or
 - d) on paper.
- 2) 37 CFR 1.821(e) requires that a copy of the "Sequence Listing" must also be submitted in computer readable form (CRF) in accordance with the requirements of 37 CFR 1.824.
 - a) If a "Sequence Listing" ASCII text file submitted via EFS-Web on the application filing date complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b), and applicant has not filed a "Sequence Listing" as a PDF, the text file will serve as both the "Sequence Listing" required by 37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e), and the statement of identity under the "Legal Framework" is not required.
 - b) If the "Sequence Listing" required by 37 CFR 1.821(c) is filed via EFS-Web as a PDF, then the "Legal Framework" requires submission of a statement that the "Sequence Listing" content of the PDF copy and the ASCII text file copy submitted via EFS-Web are identical.

c) If the "Sequence Listing" required by 37 CFR 1.821(c) is filed on paper or compact disc, then 37 CFR 1.821(f) requires submission of a statement that the "Sequence Listing" content of the paper or compact disc copy and the CRF are identical.

Specific deficiencies and the required response to this notice are as follows:

- Sequences appearing in the specification must be identified by sequence identifiers in accordance with 37 CFR 1.821(d). Applicant must provide a substitute specification in compliance with 37 CFR 1.121(b)(3) and 1.125 inserting the required sequence identifiers, consisting of:
 - o A copy of the previously-submitted specification, with deletions shown with strikethrough or brackets and insertions shown with underlining (marked-up version);
 - o A copy of the amended specification without markings (clean version); and
 - o A statement that the substitute specification contains no new matter.

For questions regarding compliance to these requirements, please contact:

- For Rules interpretation, call (571) 272-2510
- For CRF submission help, call (571) 272-2510
- For PatentIn software program support technical assistance, call (866) 217-9197.
- Send e-mail correspondence for PatentIn software program help to ebc@uspto.gov
- PatentIn software is available at <http://www.uspto.gov/patents/resources/tools/checker/patentinrel.jsp>

ALL OF THE ITEMS SET FORTH ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

Registered users of EFS-Web may alternatively submit their reply to this notice via EFS-Web.
<https://spat.uspto.gov/authenticate/AuthenticateUserLocalEPF.html>

For more information about EFS-Web please call the USPTO Electronic Business Center at 1-866-217-9197 or visit our website at <http://www.uspto.gov/ebc>.

If you are not using EFS-Web to submit your reply, you must include a copy of this notice.

FREDERICK SMITH

Telephone: (571) 272-8679

Formalities Letters

Is there a deadline to docket?

Answer: Yes; two months from the mailing date of the notice; extendable for 5 additional months.

Language from the document: "Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a)."

37 CFR 1.136(a)

§ 1.136 Extensions of time.

(a)

(1) If an applicant is required to reply within a nonstatutory or shortened statutory time period, applicant may extend the time period for reply up to the earlier of the expiration of any maximum period set by statute or five months after the time period set for reply, if a petition for an extension of time and the fee set in § 1.17(a) are filed, unless:

- (i) Applicant is notified otherwise in an Office action;
- (ii) The reply is a reply brief submitted pursuant to § 41.41 of this title;
- (iii) The reply is a request for an oral hearing submitted pursuant to § 41.47(a) of this title;
- (iv) The reply is to a decision by the Patent Trial and Appeal Board pursuant to § 41.50 or § 41.52 of this chapter or to § 90.3 of this chapter; or
- (v) The application is involved in a contested case (§ 41.101(a) of this title) or a derivation proceeding (§ 42.4(b) of this title).

Common Problems Docketing Formalities Letters

- Docketer enters the wrong activity / action
- Docketer enters the wrong mail date
- Docketer docket the requirement in the wrong matter

Docketing Assignments and Declarations

- Deadlines for Declarations and Assignments are “soft” deadlines with law firms or corporations each having different docketing requirements for these documents
- Best practices suggest docketing assignments and declarations for completion within two months of filing an application
- If not filed within two months, deadlines should not be removed from the docket but rolled forward until the signed documents are filed with the USPTO
- Alternative deadlines to docketing filing of Declarations and Assignments:
 - * Prior to filing PCT or foreign applications
 - * Prior to receipt of a Notice of Allowance
 - * Upon payment of the issue fee (absolute deadline)

Docketing Assignments and Declarations

- Although Assignments can be filed at any time, and Declarations are not technically due in the USPTO until payment of Issue Fee, there are many good reasons to docket and file earlier.
 - * inventors become more difficult to reach, sometimes resulting in the inability to obtain signatures at all
 - * inability to get a signed declaration could affect issuance of a US patent or loss of IP rights
 - * late filed declarations and assignments can affect prosecution of related foreign applications and priority claims

Note that while docketing instructions of your firm or client may differ, implementing consistent, automated deadlines that launch in your docketing system can eliminate wasted time, missed deadlines and possible loss of IP rights

Polling Question

How do you handle quality control ("second eye review")?

- The docketing team does a manual second eye review (one person docketing an item and a different person reviews)
- The paralegal (or other non-docketing staff) does a manual second eye review
- The attorney is responsible for a manual second eye review
- There is no official process for second eye review of docketing

Office Actions



"I have climbed the highest mountains, I have run
through the fields....
But I still haven't found what I'm looking for "

- I Still Haven't Found What I'm Looking for by U2



UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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06/19/2020

132145 7590 05/05/2021

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2613

NOTIFICATION DATE	DELIVERY MODE
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05/05/2021 ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

First Action Interview Office Action Summary	Application No.	Applicant(s)	
	Examiner JEFFERY A BRIER	Art Unit 2613	AIA (FITF) Status Yes
<i>The MAILING OR NOTIFICATION DATE of this communication appears on the cover sheet with the correspondence address.</i>			
THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE TWO MONTHS FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION.			
This time period for reply is extendable under 37 CFR 1.136(a) for only TWO additional MONTHS.			
<input type="checkbox"/> Applicant's request to not have a first-action interview is acknowledged (or the time period for reply set forth in the Pre-Interview Communication has expired and the Office did not receive any reply).			
Status			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>04/16/2021</u> and interview conducted on <u>N/A</u> . <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on ____.			
2) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims			
3) <input checked="" type="checkbox"/> Claim(s) <u>2-21</u> is/are pending in the application. 3a) Of the above claim(s) ____ is/are withdrawn from consideration.			
4) <input type="checkbox"/> Claim(s) ____ is/are allowed.			
5) <input checked="" type="checkbox"/> Claim(s) <u>2-21</u> is/are rejected.			
6) <input type="checkbox"/> Claim(s) ____ is/are objected to.			
7) <input type="checkbox"/> Claim(s) ____ are subject to restriction and/or election requirement.			
Application Papers			
8) <input type="checkbox"/> The specification is objected to by the Examiner.			
9) <input checked="" type="checkbox"/> The drawing(s) filed on <u>19 June 2020</u> is/are: a) <input type="checkbox"/> accepted or b) <input checked="" type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119			
10) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) <input type="checkbox"/> All b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. ____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).			
*See the attached detailed Office action for a list of the certified copies not received.			
Contact Information			
Examiner's Telephone Number: <u>(571)272-7656</u> Examiner's Typical Work Schedule: <u>Mon-Fri</u> Supervisor's Name: <u>Xiao M Wu</u> Supervisor's Telephone Number: <u>571-272-7761</u>			
Attachment(s)			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)		3) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: ____.	
2) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date: ____.		4) <input type="checkbox"/> Other: ____.	

First Action Interview – Office Action

First Action Interview Office Action Summary				Application No.		Applicant(s)	
				Examiner JEFFERY A BRIER		Art Unit 2613	
Notification of Rejection(s) and/or Objection(s)							
#	Claim(s)	Reference(s) (if applicable)	Rejection Statutory Basis	Brief Explanation of Rejection			
1	2,9 and 16	Ikenoue, 2011/ 0137907	35USC102(a)	"presenting an interface control element within the interface, the interface control element comprising a display of a range of values" refer to FIGs. 11-15, (continued below)			
2	3,10 and 17	Ikenoue, 2011/ 0137907	35USC102(a)	Refer to selecting user, interface of FIG. 14, and filtering illustrated in FIGs. 11-15.			
3	4,11 and 18	Ikenoue, 2011/ 0137907	35USC102(a)	Refer to FIGs. 11-15, paras 141 "or those movement histories originated from position histories recorded during a period of time designated by the user", 146, and 148"or those movement histories originated from position histories recorded during a period of time designated by the user".			
4	5-6,12-13 and 19-20	Ikenoue, 2011/ 0137907	35USC102(a)	Regarding claims 5,12,19 refer to FIGs. 11-15. Regrading claims 6,13,20 Refer to FIGs. 11-13 and 15.			
5	7-8,14-15 and 21	Ikenoue, 2011/ 0137907	35USC102(a)	Claims 7,14,21 are covered by presenting more images along the path, refer to FIGs. 11-15. Claims 8,15 are covered by FIGs. 11-13 and 15.			
Expanded Discussion/Commentary							
		Drawings The drawings are objected to because: GIS interface 700, geospatial data 702, and features 704, 706, and 708 present in paragraphs [0057], [0058], and [0059] are not in FIG. 7; operation 710 present in paragraph [0054] is not in FIG. 7; search field 710 present in paragraphs [0057] and [0059] is not in FIG. 7. This objection was also presented in the parent applications and the subsequent correcting amendment in the parent application is not present in this application.					
		Claim Interpretation Claims 2-210 have been interpreted under 35 U.S.C. 112(f) to not invoke 35 U.S.C. 112(f) claim interpretation.					
1		paras 141 "or those movement histories originated from position histories recorded during a period of time designated by the user", 146, and 148"or those movement histories originated from position histories recorded during a period of time designated by the user"; "receiving an input that selects a subset of the range of values" refer to FIG. 14, para 146 "Photos may be displayed only for the month designated by the user via the command input acknowledgement unit 12."; and (continued below)					
1		"filtering a portion of the set of data points from the presentation of the map image based on the input that selects the subset of the range of values" refer to FIGs.11-14.					
		Prior art of record and Double Patenting: Proposed amended claims overcomes Ikenoue and prior art of record, however, proposed amended claims are a broadened version of patented claims, compare proposed amended claim 2 with patented claim 1 in each of US Patents 10733778 and 10109094. Note claimed range of values corresponds to claimed constraint in 10733778 and corresponds to claimed data retrieval interval in 10109094. Thus, a terminal disclaimer is needed.					
		Attempts were made to contact Aris Gregorian at 408-278-4043 and at 612-373-6900 on 4/23/2021 and 4/29/2021, however, Aris Gregorian was unavailable and voice messages were left. Examiner Brier is available to conduct an interview in this application if needed.					
DATE: 14 March 2021			/JEFFERY A BRIER/ Primary Examiner, Art Unit 261				

First Action Interview – Office Action

Is there a deadline to docket?

Answer: Yes; 2 months from the mailing date of the notice; extendable for only an additional 2 months.

Language from the document: "THE SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE TWO MONTHS FROM THE MAILING OR NOTIFICATION DATE OF THIS COMMUNICATION. This time period for reply is extendable under 37 CFR 1.136(a) for only TWO additional MONTHS."



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
21186	10/01/2020			
	05/19/2021			

EXAMINER
FORMAN, BETTY J

ART UNIT	PAPER NUMBER
1634	

NOTIFICATION DATE	DELIVERY MODE
05/19/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SLW@blackhillsp.com
uspto@slwip.com

Office Action Summary	Application No.	Applicant(s)	
Examiner BETTY J FORMAN	Art Unit 1634	AIA (FITF) Status Yes	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(g).

Status

1) ☐ Responsive to communication(s) filed on ____.

☐ A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 1-14 is/are pending in the application.

5a) Of the above claim(s) ____ is/are withdrawn from consideration.

6) ☐ Claim(s) ____ is/are allowed.

7) ☐ Claim(s) ____ is/are rejected.

8) ☐ Claim(s) ____ is/are objected to.

9) ☒ Claim(s) 1-14 are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☐ The specification is objected to by the Examiner.

11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some** c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. ____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)

3) ☐ Interview Summary (PTO-413)

4) ☐ Other: _____

U.S. Patent and Trademark Office
PTOL-326 (Rev. 11-13)

Office Action Summary

Part of Paper No./Mail Date 20210517

Restriction Requirement

Is there a deadline to docket?

Answer: Yes; 2 months from the mailing date of the notice; extendable by 4 months.

Language from the document: "A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication."



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
73115	10/07/2020			
7590	05/04/2021			

EXAMINER	
SKIBINSKI, TOMI SWEET	

ART UNIT	PAPER NUMBER
2842	

NOTIFICATION DATE	DELIVERY MODE
05/04/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SLW@blackhillsip.com
uspto@slwip.com

Office Action Summary		Application No.	Applicant(s)	
Examiner Tomi S Skibinski		Art Unit 2842	AIA (FITF) Status Yes	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

• If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

• Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(d).

Status

1) ☒ Responsive to communication(s) filed on 07 October 2020.

☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.

4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims*

5) ☒ Claim(s) 1-20 is/are pending in the application.

5a) Of the above claim(s) _____ is/are withdrawn from consideration.

6) ☒ Claim(s) 17-20 is/are allowed.

7) ☒ Claim(s) 1-8 and 10-16 is/are rejected.

8) ☒ Claim(s) 9 is/are objected to.

9) ☐ Claim(s) _____ are subject to restriction and/or election requirement

* If any claims have been determined allowable, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office of the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/ipp/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10) ☐ The specification is objected to by the Examiner.

11) ☒ The drawing(s) filed on 07 October 2020 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

Certified copies:

a) ☐ All b) ☐ Some** c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

** See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☒ Information Disclosure Statement(s) (PTO/SB-08a and/or PTO/SB-08b)

3) ☐ Interview Summary (PTO-413)

4) ☐ Other: _____

U.S. Patent and Trademark Office

PTOL 326 (Rev. 11-13)

Office Action Summary

Part of Paper No./Mail Date 20210428

Is there a deadline to docket?

Answer: Yes; three months from the mailing date of the notice; extendable an additional 3 months

Language from the document: "A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication."

Office Action: Non-Final with Restriction Requirement



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	11/25/2019			
104326	7590	04/30/2021		
EXAMINER				
STIKLICKAS, EMILY ROSE				
ART UNIT		PAPER NUMBER		
3773				
NOTIFICATION DATE		DELIVERY MODE		
04/30/2021		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Office Action Summary	Application No.	Applicant(s)	
	Examiner	Art Unit	AIA (FITF) Status
	EMILY STIKLICKAS	3773	Yes
- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -			
Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. - Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).			
Status			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>25 November 2019</u> . <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on ____.			
2a) <input type="checkbox"/> This action is FINAL . 2b) <input checked="" type="checkbox"/> This action is non-final.			
3) <input checked="" type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on <u>12 April 2021</u> ; the restriction requirement and election have been incorporated into this action.			
4) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims*			
5) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application. 5a) Of the above claim(s) <u>9-20</u> is/are withdrawn from consideration.			
6) <input type="checkbox"/> Claim(s) ____ is/are allowed.			
7) <input checked="" type="checkbox"/> Claim(s) <u>1-8</u> is/are rejected.			
8) <input type="checkbox"/> Claim(s) ____ is/are objected to.			
9) <input type="checkbox"/> Claim(s) ____ are subject to restriction and/or election requirement			
* If any claims have been determined <u>allowable</u> , you may be eligible to benefit from the Patent Prosecution Highway program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov .			
Application Papers			
10) <input type="checkbox"/> The specification is objected to by the Examiner.			
11) <input checked="" type="checkbox"/> The drawing(s) filed on <u>25 November 2019</u> is/are: a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119			
12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). Certified copies: a) <input type="checkbox"/> All b) <input type="checkbox"/> Some** c) <input type="checkbox"/> None of the: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. ____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).			
** See the attached detailed Office action for a list of the certified copies not received.			
Attachment(s)			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 3) <input type="checkbox"/> Interview Summary (PTO-413) 2) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) Paper No(s)/Mail Date ____ Paper No(s)/Mail Date ____ 4) <input type="checkbox"/> Other: ____			

Office Action: Non-Final with Restriction Requirement

Application/Control Number: 16/694,098
Art Unit: 3773

Page 2

DETAILED ACTION

Notice of Pre-AIA or AIA Status

The present application, filed on or after March 16, 2013, is being examined under the first inventor to file provisions of the AIA.

Election/Restrictions

This application contains claims directed to the following patentably distinct species:

Species A: Figures 1A and 1B show a pedicle screw with a bottom turret that attaches via a locking mechanism.

Species B: Figures 2A-3 show a pedicle screw with a movable saddle that protrudes out the bottom of the housing.

Species C: Figures 4-7 show a pedicle screw with an attachable ball joint head and a saddle with specific ridges placed for gripping.

The species are independent or distinct because they have different functionalities and structural components. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, or a single grouping of patentably indistinct species, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-8 correspond with Species A, claims 9-15 correspond with Species B and claims 16-20 correspond with Species C.

There is a search and/or examination burden for the patentably distinct species as set forth above because at least the following reason(s) apply: Different fields of search may be

Non-Final Rejection with Restriction Requirement

Is there a deadline to docket?

Answer: Yes; three months from the mailing date of the notice; extendable an additional 3 months

Language from the document: " A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication."

Common Problems when Docketing Non-Final Rejections

- Docketer fails to docket the correct period for the initial reply (2 or 3 months)
- Docketer fails to docket the correct final deadline (4 months or 6 months)
- Docketer thinks restriction requirements still have a one-month period for reply
- Docketer fails to docket a SIDS when a NORC is included with the Office Action

Office Action: Non-Final Rejection with Final Indicated



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
49845	03/12/2018			1069
7590	04/12/2021			
EXAMINER				
KANG, TIMOTHY J				
ART UNIT				
3625				
PAPER NUMBER				
NOTIFICATION DATE				
04/12/2021				
DELIVERY MODE				
ELECTRONIC				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SLW@blackhillsip.com
USPTO@SLWIP.COM

Office Action Summary	Application No.	Applicant(s)	
	Examiner TIMOTHY J KANG	Art Unit 3625	AIA (FITF) Status Yes
Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -- A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. <ul style="list-style-type: none">Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).			
Status 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on 15 December 2020. <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on _____. 2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final. 3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action. 4) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 O.G. 213.			
Disposition of Claims* 5) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application. 5a) Of the above claim(s) ____ is/are withdrawn from consideration. 6) <input type="checkbox"/> Claim(s) ____ is/are allowed. 7) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are rejected. 8) <input type="checkbox"/> Claim(s) ____ is/are objected to. 9) <input type="checkbox"/> Claim(s) ____ are subject to restriction and/or election requirement. * If any claims have been determined allowable, you may be eligible to benefit from the Patent Prosecution Highway program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov .			
Application Papers 10) <input type="checkbox"/> The specification is objected to by the Examiner. 11) <input checked="" type="checkbox"/> The drawing(s) filed on <u>12 March 2018</u> is/are: a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119 12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). Certified copies: a) <input type="checkbox"/> All b) <input type="checkbox"/> Some** c) <input type="checkbox"/> None of the: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). ** See the attached detailed Office action for a list of the certified copies not received.			
Attachment(s) 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) 2) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b) 3) <input type="checkbox"/> Interview Summary (PTO-413) 4) <input type="checkbox"/> Other: _____ Paper No(s)/Mail Date <u>12/20/2020</u> Paper No(s)/Mail Date _____			

Office Action: Non-Final Rejection with Final Indicated

Application/Control Number:
Art Unit: 3625

Page 18

Regarding Claim 16: The combination of Bai, Barrett, and Joa discloses the limitation of claim 13 above.

The combination does not explicitly teach *transmitting a recommendation to the user account including one or more food items of a recipe stored by the system for the user account.*

However, Chen does teach *transmitting a recommendation to the user account including one or more food items of a recipe stored by the system for the user account.* Chen teaches generating recommendations to the user based on the items in stock and the recipe of the user (Chen: col. 10, ln. 18-23; see also: col. 1, ln. 36-38; col. 6, ln. 32-43).

It would have been obvious to one of ordinary skill in the art, before the effective filing date of the invention, to have included the recommendation including food items of a recipe to the invention of the combination of Bai, Barrett, and Joa. One of ordinary skill in the art would have been motivated to do so in order to communicate relevant information about the items to the user (Chen: col. 1, ln. 18-23).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIMOTHY J KANG whose telephone number is (571)272-8069. The examiner can normally be reached on Monday - Friday: 7:30 - 5:00.

Non-Final Rejection with Final Indication in the Last Paragraph

Is there a deadline to docket?

Answer: Yes; three months from the mailing date of the notice; extendable an additional 3 months

Language from the document: "A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication."

Common Problems

Docketer doesn't know if the action is final or nonfinal

Prioritized Exam



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	10/28/2020	Manus Straka		
21186	7590	05/03/2021		

EXAMINER
JP, JASON M

ART UNIT	PAPER NUMBER
3793	

NOTIFICATION DATE	DELIVERY MODE
05/03/2021	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

SLW@blackhillsip.com
uspto@slwip.com

Office Action Summary	Application No.	Applicant(s)	
	Examiner Jason Ip	Art Unit 3793	AIA (FITF) Status Yes
-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --			
Period for Reply			
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.			
<small>Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</small>			
Status			
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on 04/06/2021.			
2a) <input type="checkbox"/> A declaration(s)/affidavit(s) under 37 CFR 1.130(b) was/were filed on ____.			
2b) <input checked="" type="checkbox"/> This action is non-final.			
3) <input type="checkbox"/> An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.			
4) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.			
Disposition of Claims*			
5) <input checked="" type="checkbox"/> Claim(s) <u>1-20</u> is/are pending in the application.			
5a) Of the above claim(s) ____ is/are withdrawn from consideration.			
6) <input checked="" type="checkbox"/> Claim(s) <u>18-20</u> is/are allowed.			
7) <input checked="" type="checkbox"/> Claim(s) <u>1,7 and 9-17</u> is/are rejected.			
8) <input checked="" type="checkbox"/> Claim(s) <u>2-6 and 8</u> is/are objected to.			
9) <input type="checkbox"/> Claim(s) ____ are subject to restriction and/or election requirement			
<small>* If any claims have been determined allowable, you may be eligible to benefit from the Patent Prosecution Highway program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.</small>			
Application Papers			
10) <input type="checkbox"/> The specification is objected to by the Examiner.			
11) <input checked="" type="checkbox"/> The drawing(s) filed on <u>10/28/2020</u> is/are: a) <input checked="" type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.			
<small>Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).</small>			
Priority under 35 U.S.C. § 119			
12) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).			
Certified copies:			
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some** c) <input type="checkbox"/> None of the:			
1. <input type="checkbox"/> Certified copies of the priority documents have been received.			
2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. ____.			
3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).			
<small>** See the attached detailed Office action for a list of the certified copies not received.</small>			
Attachment(s)			
1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)			
2) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08a and/or PTO/SB/08b)			
3) <input type="checkbox"/> Interview Summary (PTO-413)			
4) <input type="checkbox"/> Other: _____			
U.S. Patent and Trademark Office PTOL-926 (Rev. 11-13)			
Office Action Summary			
Part of Paper No./Mail Date 20210424			

Non Office Action – Prioritized Exam

Is there a deadline to docket?

Answer: Yes; three months from the mailing date of the notice; Non extendable otherwise prioritized exam status will be lost

Language from the document: " A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication."

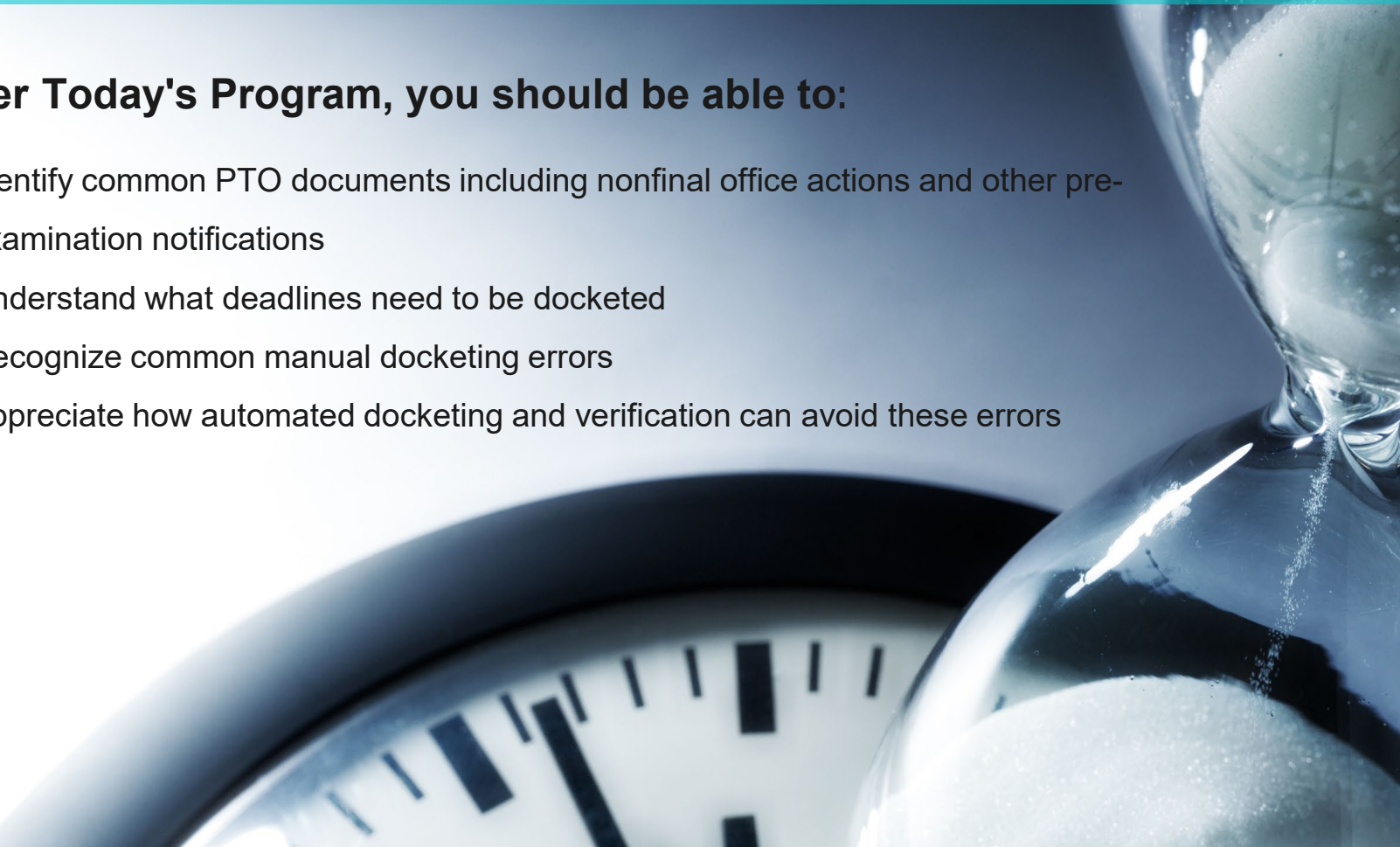
Common Problem

Docketer doesn't recognize that the matter is in prioritized exam and docket the three-month date as an extendable deadline.

Summary

After Today's Program, you should be able to:

1. Identify common PTO documents including nonfinal office actions and other pre-examination notifications
2. Understand what deadlines need to be docketed
3. Recognize common manual docketing errors
4. Appreciate how automated docketing and verification can avoid these errors



Thank you for your interest.

Questions?



4-Episode Webinar Series

Episode 01 – Docketing and Docketing Management for US Initial Filing (Provisionals & Regular /Apps) Due/Bar Dates, Paris Convention & PCT Deadlines
Thursday, April 1st, 2021 at 12:00 PM CT

Episode 02 – Docketing Formalities, Restrictions, Non-Final Office Actions, PCT Actions
Thursday, June 3rd, 2021 at 10:00 AM CT

Episode 03 – Docketing Final Office Actions, Appeals, Continuations, Allowances

Thursday, August 5th, 2021 at 12:00 PM CT

Episode 04 – Docketing Post Issuance Deadlines: Certificates of Correction, Reissues, Patent Term Adjustment Verification, Maintenance Fees
Thursday, October 7th, 2021 at 12:00 PM CT

Digital Transformation of the Legal Industry Webinar Series

Episode 01 – What is Digital Transformation for Law Practices?

Thursday, February 11th, 2021 at 12:00 PM CT

Episode 02 – SLW Digital Transformation Case Study: Overview of SLW systems, tools, data lake, processes, teams and personnel.

Thursday, March 11th, 2021 at 12:00 PM CT

Episode 03 – SLW Digital Transformation Case Study: Application Preparation – Disclosure intake and docketing, application drafting tools, production management

Thursday, April 8th, 2021 at 12:00 PM CT

Episode 04 – SLW Digital Transformation Case Study: Prosecution I – Receiving & Reporting PTO Correspondence – docketing, data/document storage, work packets, drafting and filing papers and responses; reporting to clients

Thursday, May 13th, 2021 at 12:00 PM CT

Episode 05 – SLW Digital Transformation Case Study: Prosecution II – Claim tracking, reference analysis tools and reports, prosecution landscape tools and reports, IDS management

Thursday, June 10th, 2021 at 12:00 PM CT

Episode 06 – SLW Digital Transformation Case Study: Due Diligence, Freedom to Operate Studies, Landscape Studies, Portfolio Curation, Portfolio Analytics, Landscape Analytics, Examiner and Attorney Analytics

Thursday, July 8th, 2021 at 12:00 PM CT

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