

T-366 P.002/004 F-086

MRD 12/21/2000

01-02-2001

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APPENDIX B



DOCKET NO. 791_037

Form PTQ 1595

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PATENTS ONLY

U.S. Department of Commerce

To the Honorable Commissioner of Patents and Trademarks, Please record the attached original documents on hand thereof.

1. Name of conveying party(ies)

Yukihisa Takeuchi, Takao Ohnishi and
Koji Kimura

2. Name and address of receiving party(ies):

Name: NGK Insulators, Ltd.
Address: 2-56, Suda-cho, Mizuho-ku,
Nagoya-City, Aichi-Pref., 467-8530
JAPAN

Additional name(s) of conveying parties attached ☒ No

3. Nature of Conveyance:

<input checked="" type="checkbox"/> Assignment	<input type="checkbox"/> Merger
<input type="checkbox"/> Security Agreement	<input type="checkbox"/> Change of Name
<input type="checkbox"/> Other _____	

Additional name(s) attached? ☒ No

Execution Date February 18, 1999

4. Application number(s) or patent number(s)

If this document is being filed together with a **NEW APPLICATION**, the execution date of this application is _____

A. Patent Application No.(s)

B. Patent No.(s)

09/242,642 filed December 28, 1998

Additional Numbers attached? ☒ No

5. Name and address of party to whom correspondence concerning this document should be mailed:

Name: Stephen P. Burt

Address: BURN & BROWN
P.O. Box 7068
Syracuse, NY 13261-7068
Telephone: (315) 233-8300
Facsimile: (315) 233-8320

6. Total number of application and patents involved: 1

7. Total fee (37 CFR 3.4) \$40.00

- ✓ Enclosed
- ✓ Authorized to charge any deficiency or credit any over payment to Deposit Account No. 50-1446.

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8. **Statement and Signature:**

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Stephen P. Burr
Reg. No. 32,970

December 21, 2000

Date _____

Total Number of Pages Comprising Cover Sheet 3

OMB NO 0651-0011(EXP. 4/94)

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98P00706
WA-0442 US

ASSIGNMENT

(1-8) Insert Name(s) of Inventor(s)

(1)	<u>Yukihisa Takeuchi</u>	(5)	_____
(2)	<u>Takao Ohnishi</u>	(6)	_____
(3)	<u>Koji Kimura</u>	(7)	_____
(4)	_____	(8)	_____

In consideration of the sum of dollar (\$1.00) and other good and valuable consideration paid to each of the undersigned, the undersigned agree(s) to assign, and hereby does assign, transfer and set over to

(9) Insert name of Assignee (9) NGK Insulators, Ltd.

(10) Insert address of Assignee (10) 2-56, Suda-cho, Mizuho-ku, Nagoya-City, Aichi-Pref., 467 JAPAN ⁻⁸⁵³⁰

(hereinafter designated as the Assignee) the entire right, title and interest for the United States, its territories, dependencies and possessions, in the invention, and all applications for patent and any Letters Patent which may be granted therefor, known as

(11) Insert Identification of Invention, such as Title, Case Number or Foreign Application Number (11) PIEZO-ELECTRIC/ELECTROSTRICTIVE DEVICE
(Case No. 791_037 (WA-0442 US))

for which the undersigned have executed an application for patent in the United States of America

(12) Insert Date of Signing of Application (12) on _____ 09/24/2,642 8993 12/21/00

(13) Alternative identification (13) U.S. Application(s) Serial Number(s) 09/214,110 for filed application(s) filed December 28, 1998

1) The undersigned agree(s) to execute all papers necessary in connection with the application and any continuing or divisional applications thereof and also to execute separate assignments in connection with such applications as the Assignee may deem necessary or expedient.

2) The undersigned agree(s) to execute all papers necessary in connection with any interference which may be declared concerning this application or continuation or division thereof and to cooperate with the Assignee in every way possible in obtaining evidence and going forward with such interference.

3) The undersigned agree(s) to execute all papers and documents and perform any act which may be necessary in connection with claims or provisions of the International Convention for Protection of Industrial Property or similar agreements.

4) The undersigned agree(s) to perform all affirmative acts which may be necessary to obtain a grant of a valid United States patent to the Assignee.

5) The undersigned hereby authorize(s) and request(s) the Commissioner of Patents to issue any and all Letters Patents of the United States resulting from said application or any divisions or continuing applications thereof to the said Assignee, as Assignee of the entire interest, and hereby covenants that he has (they have) full right to convey the entire interest herein assigned, and that he has (they have) not executed and will not execute, any agreement in conflict herewith.

PA-0442-48

16) The undersigned hereby grant(s) Stephen P. Burr, of WALL MARJAMA BILINSKI & BURR the power to insert on this assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office recordation of this document.

In witness whereof, executed by the undersigned on the date(s) opposite the undersigned name(s).

Date February 18, 1999 Signature Yukihisa Takeuchi (SEAL)
Yukihisa Takeuchi

Date February 18, 1999 Signature Takao Ohnishi (SEAL)
Takao Ohnishi

Date February 18, 1999 Signature Koji Kimura (SEAL)
Koji Kimura

Date _____ Signature _____ (SEAL)

Date _____ Signature _____ (SEAL)

Date _____ Signature _____ (SEAL)

Date _____ Signature _____ (SEAL)

Date _____ Signature _____ (SEAL)

This assignment should preferably be signed before: (a) a Notary Public if within the U.S.A. or (b) a U.S. Consul if outside the U.S.A. If neither, then it should be signed before at least two witnesses who also sign here:

Date _____ Witness _____

Date _____ Witness _____



17 DEC 1999

Patent and Trademark Office

Patent Cooperation Treaty
Legal OfficeAddress: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

William P. Burr
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In re Application of
TAKEUCHI et al
Application No.: 09/214,110
PCT No.: PCT/JP98/03971
Int. Filing Date: 04 September 1998
Priority Date: 08 September 1997
Attorney's Docket No.: 791-037
For: PIEZO-ELECTRIC DEVICE

:
: DECISION ON
:
: RENEWED PETITION
:
: UNDER 37 CFR 1.182
:
:

This decision is in response to applicants' "RENEWED PETITION TO GRANT FILING DATE ...RENEWED PETITION TO THE COMMISSIONER UNDER 37 C.F.R. §§1.181-1.183" filed 09 December 1999.

BACKGROUND

On 04 September 1998, applicants filed international application PCT/JP98/03971, which claimed priority of an earlier Japanese application filed 08 September 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 18 March 1999. A Demand for international preliminary examination, in which the United States was elected, was not filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 08 May 1999.

On 28 December 1998, applicants filed a "Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning a Filing under 35 U.S.C. 371" (Form PTO-1390) for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1) and a description claims and drawings in the Japanese language. The Transmittal Letter indicated that the Japanese text was a copy of the international application. The papers were identified with attorney's docket number 791-037 and were assigned US application number 09/214,110. On 09 March 1999, applicants filed a transmittal letter entitled, "COMPLETION OF FILING REQUIREMENTS FOR INTERNATIONAL APPLICATION ENTERING NATIONAL STAGE IN U.S. DESIGNATED OFFICE (DO/US) UNDER 35 U.S.C. 371" which indicated "submitted herewith, is a English translation of the non-English language international applications as originally filed." A purported English translation of the international

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application, the processing fee for filing the English translation later than 20 months from the priority date as required by 37 CFR 1.492(f), an executed declaration, and the surcharge for filing the oath or declaration later than 20 months from the priority date as required by 37 CFR 1.492(e) were filed on the same date.

On 05 May 1999, applicants filed a Transmittal Letter To The United States Designated/Elected Office (DO/EO/US) Concerning a filing under 35 U.S.C. 371 (Form PTO-1390) for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application as required by 35 U.S.C. 371(c)(2) and a declaration as required by 35 U.S.C. 371(c)(4). The papers were identified with attorney's docket number 791-050.

On 20 July 1999, a communication was mailed to applicants informing them that only one national stage application per international application could be filed and that all the papers had been placed in the present application file.

On 05 August 1999, applicants filed a petition requesting that the papers filed on 28 December 1998 be treated as a filing under 35 U.S.C. 111 and the papers filed on 05 May 1999 be treated as the national stage of international application PCT/JP98/039771.

On 17 September 1999, applicants' petition was dismissed because there was no indication in the papers filed on 28 December 1999 that the papers were to be treated as a national application.

On 20 September 1999, applicants filed a request for reconsideration, a request for expedited handling and a renewed petition under 37 C.F.R. §§1.181-1.183" filed, requesting reconsideration of the decision dated 17 September 1999. The petition once again requested that the papers filed on 05 May 1999 be removed from the present file, acceptance of the papers filed on December 28, 1998 as a proper § 111 National Patent Application and acceptance of the papers filed on 05 May 1999 as the national stage of international application PCT/JP98/03971.

On 03 December 1999, applicants' petition to accept the papers filed on December 28, 1998 as a proper § 111 National Patent Application was again dismissed since there was a clear indication in the papers filed on December 28, 1999 that the papers were being filed under the provision of 35 U.S.C. 371.

DISCUSSION

Applicants have argued that "much of the subject matter disclosed in the December 28, 1998 application appears for the first time anywhere in the world in that application" [page 3 of the

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petition] and "that application contains substantial additional subject matter that is not disclosed in the international application as filed" [page 2, of the petition]. A comparison of the published international application and the December 28, 1998 application reveals the following differences.

	papers filed December 28, 1998	published international application
description	26 pages	32 pages
claims	45 claims (pages 27-31)	28 claims (pages 33-37)
drawings	11 pages (19 figures)	19 pages (25 figures)

Because the papers filed December 28, 1998 and the published international application are both in Japanese, the original texts cannot immediately be compared. However, applicant filed on 09 March 1999 an English translation of the papers filed December 28, 1998 and on 05 May 1999 an English translation of the published international application. It is clear from comparing the number of claims, the drawings, and reading the two translations that while the two specifications are drawn to the same type of device, due to the many differences in the two specifications the December 28, 1998 papers are not a translation of the published international application.

Applicant further has argued that "Applicants must rely upon the December 28, 1998 filing date to preserve their rights in several foreign countries, all of which observe absolute novelty requirements. If the December 28, 1998 filing date is not granted, applicants will be forced to surrender substantial foreign patent rights due to disclosures that were made after December 28, 1998 and prior to the filing of patent applications in those foreign countries." [page 3 of petition]

In effect, applicant is requesting a waiver under 37 CFR 1.183 of 37 CFR 1.494(f) which states, "The documents and fees submitted under paragraphs (b) and (c) of this section must be clearly identified as a submission to enter the national stage under 37 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111."

37 CFR 1.183, states, "In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h)."

In this instance, applicants clearly indicated that the papers filed on 28 December 1998 were submitted under 35 U.S.C. 371. However, the present situation constitutes an extraordinary situation where justice requires waiver of the rule to prevent the substantial loss of patent

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rights in foreign countries. In addition, applicants have offered "to concede, with respect to the December 28, 1998 application, any priority claim to the '971 International Application." [page 4, of the petition]. Inasmuch as the papers filed on December 28, 1998 met the requirements for an application under 35 U.S.C. 111(a), applicants' offer is accepted and the papers filed on 28 December 1998 will be removed from this application and those papers will be treated as a US application under 35 U.S.C. 111(a) with a filing date of 28 December 1998 without the right to priority to international application PCT/JP98/03971. The papers filed on 28 December 1998 have been assigned US application number 09/242,642. This loss of priority applies to any continuation application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to US application number 09/242,642. Any continuing application filed from US application number 09/242,642 must contain a copy of this decision.

CONCLUSION

For the limited circumstances discussed above, applicant's petition is GRANTED.

Application number 09/214,110 will remain as the national stage of PCT/JP98/03971.

The papers filed on December 28, 1998, March 9, 1999 and the information disclosure statement filed on March 19, 1999 have been removed from the present application filed, placed in a separate file, assigned a US application number 09/242,642 and will be entitled to an filing date of December 28, 1998. A copy of this decision has been placed in application 09/242,642.

Application 09/242,642 will be forwarded to the Office of Initial Patent Examining for processing as an application under 35 U.S.C. 111(a) having a filing date of December 28, 1998.



Charles A. Pearson
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patents Policy and Projects