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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
90/014,795	07/06/2021	10329653	2189.006	2652

69082 7590 03/28/2022
ULMER & BERNE, LLP
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312 Walnut Street
SUITE 1400
CINCINNATI, OH 45202

EXAMINER

VINCENT, SEAN E

ART UNIT	PAPER NUMBER
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3991

MAIL DATE	DELIVERY MODE
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03/28/2022

PAPER

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.



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***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/014,795 .

PATENT UNDER REEXAMINATION 10329653 .

ART UNIT 3991 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Notice of Intent to Issue Ex Parte Reexamination Certificate	Control No. 90/014,795	Patent Under Reexamination 10329653	
	Examiner SEAN E VINCENT	Art Unit 3991	AIA Status Yes

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

1. ☒ Prosecution on the merits is (or remains) closed in this *ex parte* reexamination proceeding. This proceeding is subject to reopening at the initiative of the Office or upon petition. *Cf.* 37 CFR 1.313(a). A Certificate will be issued in view of
 - (a) ☒ Patent owner's communication(s) filed: 21 February 2022.
 - (b) ☐ Patent owner's failure to file an appropriate timely response to the Office action mailed: ____.
 - (c) ☐ Patent owner's failure to timely file an Appeal Brief (37 CFR 41.31).
 - (d) ☐ The decision on appeal by the ☐ Board of Patent Appeals and Interferences ☐ Court dated ____
 - (e) ☐ Other: ____.
2. The Reexamination Certificate will indicate the following:
 - (a) Change in the Specification: ☒ Yes ☐ No
 - (b) Change in the Drawing(s): ☐ Yes ☒ No
 - (c) Status of the Claim(s):
 - (1) Patent claim(s) confirmed: 1-5,7-9,11,25-33,35-50,52-62,64,66 and 70-76.
 - (2) Patent claim(s) amended (including dependent on amended claim(s)): 12-16,18-21,23-24,34,67 and 69
 - (3) Patent claim(s) canceled: none.
 - (4) Newly presented claim(s) patentable: 79-126.
 - (5) Newly presented canceled claims: ____.
 - (6) Patent claim(s) ☐ previously ☐ currently disclaimed: ____
 - (7) Patent claim(s) not subject to reexamination: 6,10,17,22,51,63,65,68 and 77-78.
3. ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on ____.
4. ☒ Note the attached statement of reasons for patentability and/or confirmation. Any comments considered necessary by patent owner regarding reasons for patentability and/or confirmation must be submitted promptly to avoid processing delays. Such submission(s) should be labeled: "Comments On Statement of Reasons for Patentability and/or Confirmation."
5. ☐ Note attached NOTICE OF REFERENCES CITED (PTO-892).
6. ☒ Note attached LIST OF REFERENCES CITED (PTO/SB/08 or PTO/SB/08 substitute).
7. ☐ The drawing correction request filed on ____ is: ☐ approved ☐ disapproved.
8. ☐ Acknowledgment is made of the priority claim under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the certified copies have
 - ☐ been received.
 - ☐ not been received.
 - ☐ been filed in Application No. ____.
 - ☐ been filed in reexamination Control No. ____.
 - ☐ been received by the International Bureau in PCT Application No. ____.

* Certified copies not received: ____.

9. ☐ Note attached Examiner's Amendment.
10. ☐ Note attached Interview Summary (PTO-474).
11. ☐ Other: ____.

All correspondence relating to this reexamination proceeding should be directed to the **Central Reexamination Unit** at the mail, FAX, or hand-carry addresses given at the end of this Office action.

/Sean E Vincent/ & /Timothy J. Kugel/ Patent Reexam Specialists, Art Unit 3991	
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cc: Requester (if third party requester)

STATEMENT OF REASONS FOR PATENTABILITY AND/OR CONFIRMATION

The following is an examiner's statement of reasons for patentability and/or confirmation of the claims found patentable in this reexamination proceeding: Xiao is the closest prior art and it fails to teach a magnesium alloy that includes in situ galvanically-active intermetallic phases or intermetallic particles to enable controlled dissolution of the magnesium alloy as claimed. The phases of Xiao taught to be involved in galvanic activity contain aluminum instead of the secondary/additive materials required by the claims. There is no suggestion from Xiao to substitute copper, nickel, iron or cobalt for the aluminum in the galvanically-active intermetallic.

Any comments considered necessary by PATENT OWNER regarding the above statement must be submitted promptly to avoid processing delays. Such submission by the patent owner should be labeled: "Comments on Statement of Reasons for Patentability and/or Confirmation" and will be placed in the reexamination file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN E VINCENT whose telephone number is (571)272-1194. The examiner can normally be reached 8:00am to 4:30pm.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jean C Witz can be reached on 571-272-0927. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of published or unpublished applications may be obtained from Patent Center. Unpublished application information in Patent Center is available to registered users. To file and manage patent submissions in Patent Center, visit: <https://patentcenter.uspto.gov>. Visit <https://www.uspto.gov/patents/apply/patent-center> for more information about Patent Center and <https://www.uspto.gov/patents/docx> for information about filing in DOCX format. For additional questions, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sean E Vincent/
Patent Reexam Specialist, Art Unit 3991

Conferees:

/Timothy J. Kugel/
Patent Reexam Specialist, Art Unit 3991

/Jean C. Witz/
Supervisory Patent Reexam Specialist, Art Unit 39913.