

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/GB 00/03725

Patent document cited in search report		Publication date	Patent family member(s)		Publication date
WO 0056834	A	28-09-2000	NONE		
EP 0539952	A	05-05-1993	JP 2568774	B	08-01-1997
			JP 5117643	A	14-05-1993
			DE 69207346	D	15-02-1996
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EP 0811670	A	10-12-1997	JP 2869038	B	10-03-1999
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			CA 2244420	A	04-06-1998
			CN 1214719	A	21-04-1999
			WO 9823703	A	04-06-1998

Electronic Acknowledgement Receipt

EFS ID:	1509941
Application Number:	10937736
International Application Number:	
Confirmation Number:	1006
Title of Invention:	Refrigerant with lubricating oil for replacement of R22 refrigerant
First Named Inventor/Applicant Name:	Kenneth M. Ponder
Customer Number:	24504
Filer:	Todd Deveau./Laurie Delesandro
Filer Authorized By:	Todd Deveau.
Attorney Docket Number:	821920-1030
Receipt Date:	12-FEB-2007
Filing Date:	08-SEP-2004
Time Stamp:	17:20:56
Application Type:	Utility

Payment information:

Submitted with Payment	no
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File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (if appl.)
1		00484052.pdf	393900	yes	9

	Multipart Description/PDF files in .zip description				
	Document Description		Start	End	
	Amendment After Final		1	1	
	Claims		2	6	
	Applicant Arguments/Remarks Made in an Amendment		7	9	
Warnings:					
Information:					
2	Examination support document	00484049.pdf	892503	no	8
Warnings:					
Information:					
3	Examination support document	00484050.pdf	393487	no	4
Warnings:					
Information:					
4	Information Disclosure Statement (IDS) Filed	00483773.pdf	679640	no	4
Warnings:					
Information:					
5	Foreign Reference	00483766.pdf	290499	no	8
Warnings:					
Information:					
6	Foreign Reference	00483761.pdf	566276	no	35
Warnings:					
Information:					
7	NPL Documents	00484061.pdf	892497	no	8
Warnings:					
Information:					
8	NPL Documents	00484062.pdf	393487	no	4
Warnings:					

Information:	
Total Files Size (in bytes):	4502289
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.	

Document code: WFEE

United States Patent and Trademark Office
Sales Receipt for Accounting Date: 03/02/2007

MMCGEE1	SALE	#00000001	Mailroom Dt:	02/12/2007	200778	10937736
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PATENT APPLICATION FEE DETERMINATION RECORD						Application or Filing Number 18/937,136				
Substitute for Form PTO-875										
APPLICATION AS FILED – PART I										
(Column 1)		(Column 2)		SMALL ENTITY		OR	OTHER THAN SMALL ENTITY			
FOR	NUMBER FILED	NUMBER EXTRA		RATE (\$)	FEE (\$)		RATE (\$)	FEE (\$)		
BASIC FEE (37 CFR 1.16(a), (b), or (c))										
SEARCH FEE (37 CFR 1.16(k), (i), or (m))										
EXAMINATION FEE (37 CFR 1.16(o), (p), or (q))										
TOTAL CLAIMS (37 CFR 1.16(i))		minus 20 =	*	X	=	OR	X	=		
INDEPENDENT CLAIMS (37 CFR 1.16(h))		minus 3 =	*	X	=		X	=		
APPLICATION SIZE FEE (37 CFR 1.16(s))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).									
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(j))										
				TOTAL			TOTAL			
* If the difference in column 1 is less than zero, enter "0" in column 2.										
APPLICATION AS AMENDED – PART II										
(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY		OR	OTHER THAN SMALL ENTITY	
AMENDMENT A		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)		RATE (\$)	ADDITIONAL FEE (\$)
	Total (37 CFR 1.16(i))	*	26	Minus	**	43	=	OR	X	=
	Independent (37 CFR 1.16(h))	*	3	Minus	***	5	=	OR	X	=
	Application Size Fee (37 CFR 1.16(s))							OR		
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	
AMENDMENT B		CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)		RATE (\$)	ADDITIONAL FEE (\$)
	Total (37 CFR 1.16(i))	*		Minus	**		=	OR	X	=
	Independent (37 CFR 1.16(h))	*		Minus	***		=	OR	X	=
	Application Size Fee (37 CFR 1.16(s))							OR		
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(j))							OR		
						TOTAL ADD'L FEE		OR	TOTAL ADD'L FEE	
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3. ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20". *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3". The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.										

This collection of information is required by 37 CFR 1.16. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/937,736	09/08/2004	Kenneth M. Ponder	821920-1030	1006

24504 7590 03/06/2007
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

HARDEE, JOHN R

ART UNIT	PAPER NUMBER
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1751

MAIL DATE	DELIVERY MODE
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03/06/2007

PAPER

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

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/937,736	PONDER ET AL.	
	Examiner	Art Unit	
	John R. Hardee	1751	

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

THE REPLY FILED 12 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: applicant's arguments are not persuasive. (See below).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.



John R. Hardee
Primary Examiner
Art Unit: 1751

Continuation of 13. Other: Applicant argues that Roberts teaches away from removing or eliminating butane. This is not persuasive because a compositions consisting essentially, as recited, of about 40% of pentafluoroethane and about 55% of tetrafluoroethane could still comprise appreciable amounts, far above 2.3%, of butane. Furthermore, removal or elimination of butane is not required to arrive at a composition, motivated by the prior art, which falls within the scope of applicant's claims. Applicant further argues that Roberts does not disclose the packaging of refrigerant and lubricant as claimed, prior to installation in refrigeration equipment. This is not persuasive because the disclosed lubricants are disclosed as fully miscible with the refrigerants, implying that determination of miscibility prior to charging the apparatus is customary and, by implication, prudent. Applicant's arguments regarding ASHRAE standards are well taken, but not persuasive because the IDS, submitted after final rejection and without a 197(e) statement, was not considered.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Docket No.: 821920-1030

PONDER, K., et al.,

Art Unit: 1751

Serial No.: 10/937,736

Examiner: John R. Hardee

Filing Date: September 8, 2004

Confirmation No.: 1006

For: Refrigerant with Lubricating Oil for Replacement of R-22 Refrigerant

RESPONSE AND REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Final Office Action, Paper No./Mail Date 20061207, from Examiner John R. Hardee of Art Unit 1751, mailed December 11, 2006, has been received and carefully reviewed. Applicants respectfully request reconsideration and withdrawal of the rejections presented in the Office Action in view of the following remarks and amendment. No new matter and, thus, no new issues are presented.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that any extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Docket No.: 821920-1030

PONDER, K., et al.,

Art Unit: 1751

Serial No.: 10/937,736

Examiner: John R. Hardee

Filing Date: September 8, 2004

Confirmation No.: 1006

For: **Refrigerant with Lubricating Oil for Replacement of R-22 Refrigerant**

RESPONSE TO ADVISORY ACTION AND REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Advisory Action, Paper No./Mail Date 20070304, from Examiner John R. Hardee of Art Unit 1751, mailed March 6, 2007, has been received and carefully reviewed. Applicants respectfully request reconsideration and withdrawal of the rejections presented in the Final Office Action mailed December 11, 2006, as further clarified in the Advisory Action, in view of the following remarks. No new matter and, thus, no new issues are presented.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that any extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

IN THE CLAIMS

Please amend the claims to read as follows wherein changes in a claim are shown by double brackets for deleted matter and underlining for added matter:

1. (Previously presented) In an apparatus designed for use with chlorodifluoromethane refrigerant, the improvement comprising substituting the chlorodifluoromethane with a substitute blend refrigerant containing a lubricant, said substitute refrigerant consisting essentially of:
about 40% to about 45% by weight pentafluoroethane;
about 55% to about 60% by weight tetrafluoroethane; and
said substitute refrigerant packaged with about 0.5% up to about 20% by weight of the refrigerant with a lubricating oil that is soluble in chlorodifluoromethane, pentafluoroethane and tetrafluoroethane

wherein the lubricating oil is selected from the group consisting of napthenic based lubricants, paraffinic based lubricants, and mixtures thereof, mineral oil, polyol ester, synthetic alkyl aromatic lubricants, synthetic alkyl aromatic lubricants mixed with mineral oil, and synthetic alkyl aromatic lubricants mixed with polyol ester.

2. (Original) The invention according to Claim 1, the lubricating oil having the following components:

65-88% hydrotreated light napthenic distillate, and
10-20% solvent refined light napthenic distillate petroleum.

3. (Original) The invention according to claim 1 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 40% by weight to said tetrafluoroethane present in an amount of about 60% by weight.

4. (Original) The invention according to claim 1 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 42% by weight to said tetrafluoroethane present in an amount of about 58% by weight.

5. (Original) The invention according to claim 1 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 45% by weight to said tetrafluoroethane present in an amount of about 55% by weight.

6. (Previously presented) A method for refilling an apparatus designed for use with chlorodifluoromethane refrigerant, the method comprising:

(1) supplying a substitute refrigerant under pressure, in a cylinder can fitted with an outlet compatible with a chlorodifluoromethane recharging manifold of the apparatus; and

(2) adding to said apparatus via the manifold a substitute refrigerant for chlorodifluoromethane, said substitute refrigerant consisting essentially of:

about 40% to about 45% by weight pentafluoroethane;

about 55% to about 60% by weight tetrafluoroethane; and

said substitute refrigerant packaged with about 0.5% up to about 20% by weight of the refrigerant of a lubricating oil that is soluble in chlorodifluoromethane, pentafluoroethane and tetrafluoroethane

wherein the lubricating oil is selected from the group consisting of naphthenic based lubricants, paraffinic based lubricants, and mixtures thereof, mineral oil, polyol ester, synthetic alkyl aromatic lubricants, synthetic alkyl aromatic lubricants mixed with mineral oil, and synthetic alkyl aromatic lubricants mixed with polyol ester.

7. (Previously presented) The method according to claim 6, the lubricating oil having the following components:

65-85% hydrotreated light naphthenic distillate, and

10-20% solvent refined light naphthenic distillate petroleum.

8. (Previously presented) The method according to claim 6 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 40% by weight to said tetrafluoroethane present in an amount of about 60% by weight.

9. (Previously presented) The method according to claim 6 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 42% by weight to said tetrafluoroethane present in an amount of about 58% by weight.

10. (Previously presented) The method according to claim 6 wherein in the substitute refrigerant said pentafluoroethane is present in the ratio of about 45% by weight to said tetrafluoroethane present in an amount of about 55% by weight.

11. – 20. (Cancelled)

21. (Previously presented) A refrigerant consisting essentially of:
about 40% to about 45% by weight pentafluoroethane;
about 55% to about 60% by weight tetrafluoroethane;
said refrigerant packaged with about 0.5% up to about 20% by weight of the refrigerant of a lubricating oil that is soluble in chlorodifluoromethane, pentafluoroethane and tetrafluoroethane
wherein the lubricating oil is selected from the group consisting of naphthenic based lubricants, paraffinic based lubricants, and mixtures thereof, mineral oil, polyol ester, synthetic alkyl aromatic lubricants, synthetic alkyl aromatic lubricants mixed with mineral oil, and synthetic alkyl aromatic lubricants mixed with polyol ester.

22. (Original) The invention according to claim 21, the lubricating oil having the following components:

65-85% hydrotreated light naphthenic distillate, and
10-20% solvent refined light naphthenic distillate petroleum.

23. (Original) A refrigerant according to claim 21 wherein said pentafluoroethane is present in the ratio of about 40% by weight to said tetrafluoroethane present in an amount of about 60% by weight.

24. (Original) A refrigerant according to claim 21 wherein said pentafluoroethane is present in the ratio of about 45% by weight to said tetrafluoroethane present in an amount of about 55% by weight with a naphthenic lubricant.

25. (Original) A refrigerant according to claim 21 wherein said pentafluoroethane is present in the ratio of about 40% by weight to said

tetrafluoroethane present in an amount of about 60% by weight with a napthenic lubricant.

26. (Cancelled)

27. (Previously presented) The refrigerant according to claim 21, wherein the lubricating oil further includes an acrylic polymer or a corrosion inhibitor or both.

28. (Cancelled)

29. (Previously presented) The refrigerant according to claim 21, wherein the lubricating oil is an alkylbenzene-based lubricating oil.

30. (Previously presented) The invention according to claim 1, wherein the apparatus is selected from the group consisting of refrigeration equipment, air-conditioning equipment, and HVAC equipment.

31. (Previously presented) The invention according to claim 1, wherein the lubricating oil includes an additive selected from the group consisting of acrylic polymer, a corrosion inhibitor and mixtures thereof.

32. (Cancelled)

33. (Previously presented) The invention according to claim 1, wherein the lubricating oil is an alkylbenzene-based lubricating oil.

34. (Previously presented) The method according to claim 6, wherein the apparatus is selected from the group consisting of refrigeration equipment, air-conditioning equipment, and HVAC equipment.

35. (Previously presented) The method according to claim 6, wherein the lubricating oil includes an additive selected from the group consisting of acrylic polymer, a corrosion inhibitor and mixtures thereof.

36. (Cancelled)

37. (Previously presented) The method according to claim 6, wherein the lubricating oil is an alkylbenzene-based lubricating oil.

38. (Previously presented) The invention according to claim 1, wherein the tetrafluoroethane is 1,1,1,2-tetrafluoroethane.

39. (Previously presented) The method of claim 6, wherein the tetrafluoroethane is 1,1,1,2-tetrafluoroethane.

40. (Previously presented) The invention of claim 21, wherein the tetrafluoroethane is 1,1,1,2-tetrafluoroethane.

REMARKS

Claims 1-10, 21-25, 27, 29-31, 33-35 and 37-40 are presently pending in the above application.

The claims stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Roberts (US 6,428,720). Roberts was first cited in the Final Office Action mailed December 11, 2007. Applicants submitted their Response and Request for Reconsideration on February 12, 2007 providing their arguments showing that the present claims are allowable over Roberts. The present Advisory Action was issued in reply. Applicants respectfully request reconsideration of Final Office Action, as clarified by the Advisory Action, and allowance of the present claims.

The Advisory Action submits that Applicants' argument that the Roberts reference teaches away from removing or eliminating butane from the composition disclosed in Roberts is not persuasive on the position that the compositions of Applicants' claims "could still comprise appreciable amounts, far above 2.3%, of butane." Applicants respectfully submit that this position in the Advisory Action is not supported by the present record.

The Advisory Action fails to address Applicants' point presented in their prior Response and Request for Reconsideration filed February 12, 2007 that the presence of butane in Applicants' claimed composition, or the absence of butane from the composition disclosed in Roberts, would materially effect the basic and novel properties of the respective refrigerant compositions. As noted in Applicants' prior Response, Roberts teaches the performance of its composition "deteriorates as the concentration of butane is decreased down to 2.3% by weight." This shows that the inclusion of butane in Applicants' claimed composition would materially effect its basic and novel properties. Similarly, in converse, this same statement shows that the elimination of butane from Roberts' composition would materially effect its basic and novel properties. In contradiction to this teaching away from Applicants' claimed composition by Roberts, the Advisory Action makes the unsupported statement that Applicants' claimed composition "could still comprise appreciable amounts, far above 2.3%, of butane." The Advisory Action makes this statement without explaining how such hypothetical modification of Applicants' claimed composition to include butane to meet the teaching of Roberts would not materially effect the basic and novel properties of Applicants' claimed composition when Roberts states it would. Furthermore, the Advisory Action fails to cite to any evidence, in particular a reference, to rebut Roberts' teaching away.

The Advisory Action makes the additional unsupported statement that “removal or elimination of butane is not required to arrive at a composition, motivated by the prior art, which falls within the scope of applicants’ claims.” The Advisory Action, however, fails to explain how Applicants’ claimed composition is motivated by prior art that teaches the presence of butane is critical and materially effects the performance of the refrigerant composition taught by Roberts.

Applicants further respectfully take issue with the statement in the Advisory Action concerning Applicants’ claimed packaging of lubricant with the recited refrigerant gases prior to installation in refrigeration equipment. The Advisory Action comments that Applicants’ argument on this issue is not persuasive “because the disclosed lubricants are disclosed as fully miscible with the refrigerants.” Applicants respectfully submit that this characterization of Roberts is incorrect. No citation is provided in the Advisory Action, such as by column and line, to where Roberts teaches that the disclosed lubricants are “fully miscible” with the refrigerants. Applicants cannot find anywhere in Roberts where there is such a teaching. Instead Roberts simply states that: “the compositions of the present invention are highly compatible with the mineral oil lubricants which have been conventionally used with CFC refrigerants. Accordingly, the compositions of the present invention can be used with mineral oil and alkyl benzene lubricants...” (See column 3, line 49 – column 4, line 2). This does not support the statement that the disclosed lubricants are “fully miscible” with the refrigerants and does not provide a teaching of Applicants’ claimed composition directed to certain refrigerant gases packaged with certain lubricants prior to installation in refrigeration equipment. (See, also, Roberts, column 6, lines 54-57: “The equipment used consisted of Danfoss SC12BXT2 air cooled condensing unit with the original mineral oil lubricant and a sight glass fitted to the compressor shell to enable the oil level [in the compressor] to be checked.”).

Lastly, the Advisory Action comments that Applicants’ arguments regarding ASHRAE standards are well taken, but are not persuasive because the IDS, submitted after final rejection and without a 197 (e) statement, was not considered.” Applicants respectfully submit the failure to consider the ASHRAE standards is in error and is based on an incorrect reading of Section 1.97. Section 1.97(c) mandates that the ASHRAE standards be considered in this case. Section 1.97(c) states that a statement under 1.97(e) is not necessary for the IDS and, in particular the ASHRAE standards, to be considered. Section 1.97(c) specifically states:

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under §1.113, a notice of allowance under §1.311, or an action that otherwise closes the prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in §1.17(p).

(Emphasis added).

Accordingly, Section 1.97 (c) mandates that Applicants' IDS, and thus the ASHRAE standards, be considered. Section 1.97 (c) only requires that either a Statement under 1.97 (e) or the fee set forth in Section 1.17 (p) is submitted. In this case, the fee was submitted. Applicant checked the box on the IDS for the "Fee set forth in 37 CFR 1.17 (p) has been submitted herewith." Applicants further provided multiple authorizations to charge its deposit account for any fees required. To be further clear about Applicants' payment of this fee and authorization for payment, Applicants submit herewith a fee payment form itemizing the payment of this fee.

In view of the further comments above, in conjunction with those presented in Applicants' Response and Request for Reconsideration filed February 12, 2007 which Response is incorporated herein by reference as if fully set forth, Applicants respectfully request reconsideration of the Final Office Action as clarified by the Advisory Action. If, in view of the above information, the Examiner still considers, contrary to the evidence discussed above, that the presence of butane would not materially effect the basic and novel properties of Applicants' claimed refrigerant composition, and conversely that the elimination of butane from the composition taught by Roberts would not materially effect Roberts' composition, Applicants respectfully request that the Examiner provide evidence to support such position in the form of a citation to a particular passage in a reference.

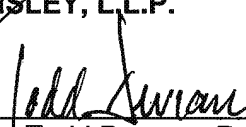
CONCLUSION

In view of the foregoing, favorable reconsideration and allowance of the present application and pending claims is hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at 770-933-9500.

The Commissioner is authorized to charge Deposit Account 20-0778 for any deficiencies or credit any over payments.

Respectfully Submitted,

**THOMAS KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

By: 

Todd Deveau, Reg. No. 29,526

100 Galleria Parkway, Suite 1750
Atlanta, Georgia 30339-5948
(770) 933-9500

Docket No. 821920-1030

FEE TRANSMITTAL

For FY 2006

Complete if Known

Application Number	10/937,736
Filing Date	09/08/2004
First Named Inventor	Ponder, K., et al.
Examiner Name	Hardee, J.
Art Unit	1751
Attorney Docket No.	821920-1030

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$180.00)

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 20-0778 Deposit Account Name: Thomas, Kayden, Horstemeyer Risley, L.L.P.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	Filing Fees		Search Fees		Examination Fees		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee (\$)	Small Entity Fee(\$)	Fee (\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESSIVE CLAIM FEES

Fee Description

Each claim over 20 (including Reissues)

Each independent claim over 3 (including Reissues)

Multiple dependent claims

Fee (\$)	Small Entity Fee(\$)
	Fee(\$)
50	25
200	100
360	180

Total Claims Extra Claims Fee (\$) Fee Paid (\$)

-20 or HP =

HP = highest number of total claims paid for, if great than 20

Multiple Dependent Claims
Fee (\$) Fee Paid (\$)

Indep. Claims Extra Claims Fee (\$) Fee Paid (\$)

-3 or HP =

HP = highest number of total claims paid for, if great than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 USC 41(a)(1)(G) and 37 CFR 1.16(s)

<u>Total Sheets</u>	<u>Extra Sheets</u>	<u>Number of each additional 50 or fraction thereof</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
-100 =	/50=	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other: Fee Set Forth in 37 CFR 1.17(p) Submission of an Information Disclosure Statement

Fee Paid (\$)

180.00

SUBMITTED BY

Complete (if applicable)

Signature

Registration No. 29,526

Telephone Number
770-933-9500

Name: (Print/Type)

Todd Deveau

Date: 03/12/2007

FEE TRANSMITTAL

For FY 2006

Complete if Known

Application Number	10/937,736
Filing Date	09/08/2004
First Named Inventor	Ponder, K., et al.
Examiner Name	Hardee, J.
Art Unit	1751
Attorney Docket No.	821920-1030

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$180.00)

METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify):

☒ Deposit Account Deposit Account Number: 20-0778 Deposit Account Name: Thomas, Kayden, Horstemeyer Risley, L.L.P.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) ☒ Credit any overpayments

under 37 CFR 1.16 and 1.17

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	Filing Fees		Search Fees		Examination Fees		Fees Paid (\$)
	Fee (\$)	Small Entity Fee(\$)	Fee (\$)	Small Entity Fee(\$)	Fee (\$)	Small Entity Fee(\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESSIVE CLAIM FEES

<u>Fee Description</u>				<u>Fee (\$)</u>	<u>Fee(\$)</u>
Each claim over 20 (including Reissues)				50	25
Each independent claim over 3 (including Reissues)				200	100
Multiple dependent claims				360	180
<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
-20 or HP =				<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>

HP = highest number of total claims paid for, if great than 20

Indep. Claims	Extra Claims	Fee (\$)	Fee Paid (\$)
---------------	--------------	----------	---------------

-3 or HP =

HP = highest number of total claims paid for, if great than 3

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 USC 41(a)(1)(G) and 37 CFR 1.16(s)

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
-100 =	/50=	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

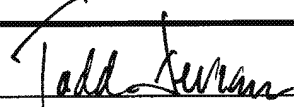
Other: Fee Set Forth in 37 CFR 1.17(p) Submission of an Information Disclosure Statement

Fee Paid (\$)

180.00

SUBMITTED BY

Complete (if applicable)

Signature		Registration No. 29,526	Telephone Number 770-933-9500
Name: (Print/Type)	Todd Deveau	Date:	03/12/2007

Electronic Patent Application Fee Transmittal

Application Number:	10937736			
Filing Date:	08-Sep-2004			
Title of Invention:	Refrigerant with lubricating oil for replacement of R22 refrigerant			
First Named Inventor/Applicant Name:	Kenneth M. Ponder			
Filer:	Todd Deveau./Laurie Delesandro			
Attorney Docket Number:	821920-1030			
Filed as Large Entity				
Utility Filing Fees				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Submission- Information Disclosure Stmt	1806	1	180	180
Total in USD (\$)				180

Electronic Acknowledgement Receipt	
EFS ID:	1585106
Application Number:	10937736
International Application Number:	
Confirmation Number:	1006
Title of Invention:	Refrigerant with lubricating oil for replacement of R22 refrigerant
First Named Inventor/Applicant Name:	Kenneth M. Ponder
Customer Number:	24504
Filer:	Todd Deveau./Laurie Delesandro
Filer Authorized By:	Todd Deveau.
Attorney Docket Number:	821920-1030
Receipt Date:	12-MAR-2007
Filing Date:	08-SEP-2004
Time Stamp:	17:43:12
Application Type:	Utility

Payment information:

Submitted with Payment	yes
Payment was successfully received in RAM	\$ 180
RAM confirmation Number	937
Deposit Account	200778
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: Charge any Additional Fees required under 37 C.F.R. Section 1.16 and 1.17	

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (if appl.)				
1		00495311.pdf	380476	yes	10				
	Multipart Description/PDF files in .zip description								
	Document Description		Start	End					
	Amendment After Final		1	1					
	Claims		2	6					
	Applicant Arguments/Remarks Made in an Amendment		7	10					
Warnings:									
Information:									
2	Miscellaneous Incoming Letter	00495318.pdf	58958	no	1				
Warnings:									
Information:									
3	Fee Worksheet (PTO-06)	fee-info.pdf	8183	no	2				
Warnings:									
Information:									
Total Files Size (in bytes):			447617						
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.									

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PATENT APPLICATION FEE DETERMINATION RECORD						Application No. <u>10/437,736</u>			
Substitute for Form PTO-875									
APPLICATION AS FILED - PART I									
(Column 1)		(Column 2)		SMALL ENTITY		OR OTHER THAN SMALL ENTITY			
FOR	NUMBER FILED	NUMBER EXTRA	RATE (\$)	FEE (\$)	RATE (\$)	FEE (\$)			
BASIC FEE (37 CFR 1.16(a), (b), or (c))									
SEARCH FEE (37 CFR 1.16(a), (f), or (m))									
EXAMINATION FEE (37 CFR 1.16(a), (p), or (q))									
TOTAL CLAIMS (37 CFR 1.16(f))	minus 20 =	*	X	=	X	=	OR		
INDEPENDENT CLAIMS (37 CFR 1.16(h))	minus 3 =	*	X	=	X	=			
APPLICATION SIZE FEE (37 CFR 1.16(e))	If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).								
MULTIPLE DEPENDENT CLAIM PRESENT (37 CFR 1.16(i))									
* If the difference in column 1 is less than zero, enter "0" in column 2.									
APPLICATION AS AMENDED - PART II									
(Column 1)		(Column 2)		(Column 3)		SMALL ENTITY		OR OTHER THAN SMALL ENTITY	
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)		
	Total (37 CFR 1.150(i))	26	Minus	43	=	X	=	OR	X
	Independent (37 CFR 1.150(i))	3	Minus	5	=	X	=	OR	X
	Application Size Fee (37 CFR 1.16(e))								
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(i))								
TOTAL		TOTAL ADD'L FEE		TOTAL		TOTAL ADD'L FEE			
3-12-07									
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE (\$)	ADDITIONAL FEE (\$)	RATE (\$)	ADDITIONAL FEE (\$)		
	Total (37 CFR 1.150(i))	SAME	Minus	=	X	=	OR	X	
	Independent (37 CFR 1.150(i))	=	Minus	=	X	=	OR	X	
	Application Size Fee (37 CFR 1.16(e))								
	FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM (37 CFR 1.16(i))								
TOTAL		TOTAL ADD'L FEE		TOTAL		TOTAL ADD'L FEE			
* If the entry in column 1 is less than the entry in column 2, write "0" in column 3. ** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20". *** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3". The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.									

This collection of information is required by 37 CFR 1.18. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



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 NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/937,736	09/08/2004	Kenneth M. Ponder	821920-1030	1006

24504 7590 03/27/2007
THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

HARDEE, JOHN R

ART UNIT	PAPER NUMBER
----------	--------------

1751

MAIL DATE	DELIVERY MODE
-----------	---------------

03/27/2007

PAPER

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

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/937,736

Applicant(s)

PONDER ET AL.

Examiner

John R. Hardee

Art Unit

1751

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

THE REPLY FILED 12 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.



John R. Hardee
Primary Examiner
Art Unit: 1751

Continuation of 11. does NOT place the application in condition for allowance because: If applicant believes that the compositions of Roberts will not act as refrigerants, thereby failing the "basic and novel" test, applicant should demonstrate such via timely filed affidavit. The Office lacks the facilities to determine such. Granted US patents are assumed to be valid and enabled. Applicant's compositions, containing, at a minimum, about 40% of pentafluoroethane and about 55% of tetrafluoroethane can contain substantial amounts of other refrigerants, such as butane. Elimination of butane is not required for a prior art composition to meet the claim limitations. Regarding "fully miscible", the proper phrase should have been "highly compatible". Regarding the IDS, it was filed two months after the final rejection.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Docket No.: 821920-1030

PONDER, K., et al.,

Art Unit: 1751

Serial No.: 10/937,736

Examiner: John R. Hardee

Filing Date: September 8, 2004

Confirmation No.: 1006

For: Refrigerant with Lubricating Oil for Replacement of R-22 Refrigerant

RESPONSE TO ADVISORY ACTION AND REQUEST FOR RECONSIDERATION

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

The Advisory Action, Paper No./Mail Date 20070304, from Examiner John R. Hardee of Art Unit 1751, mailed March 6, 2007, has been received and carefully reviewed. Applicants respectfully request reconsideration and withdrawal of the rejections presented in the Final Office Action mailed December 11, 2006, as further clarified in the Advisory Action, in view of the following remarks. No new matter and, thus, no new issues are presented.

AUTHORIZATION TO DEBIT ACCOUNT

It is not believed that any extensions of time or fees are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to deposit account no. 20-0778.

DO NOT ENTER
HCA 3/26/07

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

821930-1030

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office thru EFS Web

on 04/11/2007

Signature



Typed or printed name

Laurie Delesandro

Application Number

10/937,736

Filed

09/08/2004

First Named Inventor

Ponder, et al.

Art Unit

1751

Examiner

Hardee, J.R.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the



applicant/inventor.



assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)



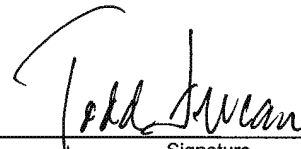
attorney or agent of record.

Registration number 29,526



attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Todd Deveau

Typed or printed name

770-933-9500

Telephone number

04/11/2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required; see below*.



*Total of forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF
PATENT APPEALS AND INTERFERENCES**

In Re Application of:	)	Docket No.: 821920-1030
	)	
Ponder, et al.	)	Group Art Unit: 1751
	)	
Serial No.: 10/937,736	)	Examiner: Hardee, J.R.
	)	
Filed: September 8, 2004	)	Confirmation No. 1006
	)	
For: Refrigerant With Lubricating Oil	)	
For Replacement of R-22 Refrigerant	)	

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits the following remarks in support of its Request for a Pre-Appeal Brief Conference.

REMARKS

This is an appeal from the Final Office Action mailed December 11, 2006, Paper No. 20061207, as clarified by the Advisory Actions mailed March 6 and March 27, 2007. Claims 1-10, 21-25, 27, 29-31, 33-35 and 37-40 are pending. No claims are allowed. All of the claims are entered and finally rejected. Claims 1, 6, and 21 are independent claims. The remaining claims depend upon one of each of the independent claims.

Applicant submits there are clear errors in the final rejection of the pending claims and the basis of the rejection is insufficient to provide a prima facie rejection of the claims. The following language of claim 1 is exemplary. Independent claims 6 and 21 have similar language:

“said substitute refrigerant mixture consisting essentially of:

about 40% to about 45% by weight pentafluoroethane; and

about 55% to about 60% by weight tetrafluoroethane;

said substitute refrigerant packaged with about 0.5% up to about 20% by weight of the refrigerant with a lubricating oil that is soluble in chlorodifluoromethane, pentafluoroethane and tetrafluoroethane

wherein the lubricating oil is selected from the group consisting of naphthenic based lubricants, paraffinic based lubricants, and mixtures thereof, mineral oil, polyol ester, synthetic alkyl aromatic lubricants, synthetic alkyl aromatic lubricants mixed with mineral oil, and synthetic alkyl aromatic lubricants mixed with polyol ester.”

The Final Office Action mailed December 11, 2006 rejects the claims on a single ground. It argues that “Roberts discloses compositions that comprise 40-55% by weight of R125 [pentafluoroethane] and 35-60% by weight of R134a [tetrafluoroethane] (col. 3, lines 13-24)”. The Office Action further comments: “Small amounts of butane refrigerant are also present, but its presence is not ruled out by applicant’s use of “consisting essentially” scope. Suitable lubricants include mineral oil and alkylbenzenes, including naphthenic and paraffinic oils, as well as polyol esters (col. 4, lines 1+). While amounts of these lubricants are not disclosed, determination of the lubrication-effective amount of a disclosed lubricant amounts to ordinary experimentation.”

Applicant submitted a Response and Request for Reconsideration to the Final Office Action in which Applicant argued: 1) Roberts, itself, teaches away from Applicant’s claimed substitute refrigerant composition, teaching the inclusion of butane and showing that the amount of butane materially affects the basic and novel properties of the composition; 2) Roberts does not teach packaging any lubricant with refrigerant gases, as claimed, to form a substitute refrigerant

for installation into refrigerating or cooling apparatus; and 3) in further support point (1) above Applicant submitted an IDS including ASHRAE Standards showing the presence or absence of butane, as well as other refrigerant gases, is considered to materially affect the basic and novel properties of a refrigerant composition. These arguments are provided in greater detail below.

An Advisory Action was mailed March 6, 2007 sustaining the rejection, and commenting "the arguments regarding ASHRAE Standards are well taken, but not persuasive" because the IDS was submitted without a 197(e) statement and was not considered. It also dismissed Applicant's second argument above concerning a lubricant, stating: "This is not persuasive because the disclosed lubricants are disclosed as fully miscible with the refrigerants, implying that determination of miscibility prior to charging the apparatus is customary and, by implication, prudent." The Advisory Action thus acknowledges that Roberts does not teach a substitute refrigerant in which a lubricant is packaged with the claimed refrigerant gases prior to charging the refrigerant into the apparatus.

Applicant submitted a Response to Advisory Action and Request for Reconsideration reiterating its arguments. A second Advisory Action was mailed March 27, 2007 sustaining the rejection commenting: "Applicant's compositions, containing, at a minimum, about 40% of pentafluoroethane and about 55% of tetrafluoroethane can contain substantial amounts of other refrigerants, such as butane...Regarding the IDS, it was submitted after the final rejection." (emphasis added).

Applicant respectfully disagrees with the statement that "small amounts of butane refrigerant are also present [in Roberts], but its presence is not ruled out by Applicant's use of "consisting essentially" scope." The phrase "consisting essentially of" has been construed by the Federal Circuit to mean that "the invention necessarily includes the listed ingredients and is open to unlisted ingredients that do not materially affect the basic and novel properties of the invention." See *PPG Industries v. Guardian Industries Corp.*, 48 U.S.P.Q.2d, 1351, 1354 (Fed. Cir. 1998). Roberts teaches: "Generally the performance of the composition deteriorates as the concentration of butane is decreased down to 2.3% by weight. Similarly, for a given butane content, the performance characteristics of the composition deteriorate as the concentration of R125 is increased." (emphasis added). This shows that the inclusion of butane in Applicants' claimed composition would materially effect its basic and novel properties. Similarly, in converse, this same statement shows that the elimination of butane from Roberts' composition would materially effect its basic and novel properties. In contradiction to this teaching away from Applicants' claimed composition by Roberts, the first Advisory Action makes the

unsupported statement that Applicants' claimed composition "could still comprise appreciable amounts, far above 2.3%, of butane." The second Advisory Action goes further stating "Applicant's compositions can contain substantial amounts of other refrigerants, such as butane." (emphasis added). The Advisory Actions make these unsupported, and unsupportable, statements without explaining how such hypothetical modification of Applicants' claimed composition to include butane to meet the teaching of Roberts would not materially effect the basic and novel properties of Applicants' claimed composition when Roberts states it would. Furthermore, the Advisory Actions fail to cite to any evidence, in particular a reference, to rebut Roberts' teaching away.

Applicants further respectfully take issue with the statement in the Advisory Action concerning Applicants' claimed packaging of a lubricant with the recited refrigerant gases prior to installation in refrigeration equipment. The first Advisory Action comments that Applicants' argument on this issue is not persuasive "because the disclosed lubricants are disclosed as fully miscible with the refrigerants." The second Advisory Action backtracks applying the phrase "highly compatible" instead of "fully miscible." Applicants respectfully submit that these characterizations of Roberts are incorrect. Roberts simply states that: "the compositions of the present invention are highly compatible with the mineral oil lubricants which have been conventionally used with CFC refrigerants. Accordingly, the compositions of the present invention can be used with mineral oil and alkyl benzene lubricants..." (See column 3, line 49 – column 4, line 2). This does not provide a teaching of Applicants' claimed composition directed to certain refrigerant gases packaged with certain lubricant(s) prior to charging in refrigeration equipment. (See, also, Roberts, column 6, lines 54-57: "The equipment used consisted of Danfoss SC12BXT2 air cooled condensing unit with the original mineral oil lubricant and a sight glass fitted to the compressor shell to enable the oil level [in the compressor] to be checked. "). The Actions seem to be taking the position that the lubricant becomes "packaged" with the refrigerant gases after the refrigerant gases are charged into the equipment. This misreads the claims, however, that define a substitute refrigerant packaged with lubricant for charging into the equipment. Additionally, even if charging refrigerant gas without a lubricant can be considered to result in refrigerant gases packaged with a lubricant after charging, there is no teaching that such charging would or should result in about 0.5% up to about 20% lubricating oil by weight of the refrigerant as claimed.

Lastly, the first Advisory Action comments that Applicants' arguments regarding ASHRAE standards are well taken, but are not persuasive because the IDS, submitted after

final rejection and without a 197 (e) statement, was not considered.” Applicants respectfully submit the failure to consider the ASHRAE standards is in error and is based on an incorrect reading of Section 1.97. Section 1.97(c) mandates that the ASHRAE standards be considered in this case. Section 1.97(c) states that a statement under 1.97(e) is not necessary for the IDS, in particular the ASHRAE standards, to be considered. Section 1.97(c) specifically states:

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under §1.113, a notice of allowance under §1.311, or an action that otherwise closes the prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in §1.17(p).

(Emphasis added).

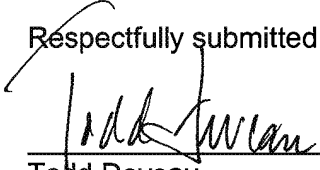
Accordingly, Section 1.97(c) mandates that Applicants’ IDS, and thus the ASHRAE standards, be considered. The IDS was submitted before any [one] of a notice of allowance or an action that otherwise closes prosecution. Section 1.97(c) does not refer to an IDS submitted “after” any of the listed three actions. Additionally, Section 1.97(c) only requires that either a Statement under 1.97 (e) or the fee set forth in Section 1.17 (p) is submitted. In this case, the fee was submitted.

CONCLUSION

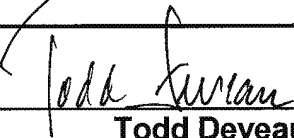
Based upon the foregoing discussion, Applicants respectfully request that the final rejection of Claims 1, 21-25, 27, 29-31, 33-35 and 37-40 be overruled and withdrawn by the Board and that the application be allowed to issue as a patent with said claims. Any additional fee that may be due or required is authorized to be charged to our Deposit Account No. 20-0778.

Respectfully submitted,

By:


Todd Deveau
Registration No. 29,526

THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.
100 Galleria Parkway, Suite 1750
Atlanta, Georgia 30339
(770) 933-9500

PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a) FY 2005 <i>(Fees pursuant to the Consolidated Appropriations act, 2005 (H.R. 4818).)</i>		Docket No. 821920-1030	
Application Number: 10/937,736		Filed: 09/08/2004	
For: Refrigerant with Lubricating Oil for Replacement of R22 Refrigerant			
Art Unit: 1751		Examiner: Hardee	
This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.			
The requested extension and fee are as follows (check time period desired and enter the appropriate fee below):			
	<u>Fees</u>	<u>Small Entity</u> <u>Fees</u>	
☒ One month (37 CFR 1.17(a)(1))	\$120	\$60	\$60
☐ Two months (37 CFR 1.17(a)(2))	\$450	\$225	\$
☐ Three months (37 CFR 1.17(a)(3))	\$1020	\$510	\$
☐ Four months (37 CFR 1.17(a)(4))	\$1590	\$795	\$
☐ Five months (37 CFR 1.17(a)(5))	\$2160	\$1080	\$
☒ Applicant claims small entity status. See 37 CFR 1.27			
☐ A check in the amount of the fee is enclosed.			
☐ Payment by credit card. Form PTO-2038 is attached.			
☒ The Director has already been authorized to charge fees in this application to a Deposit Account.			
☒ The Commissioner is hereby authorized to charge any deficiencies in fees which may be required, or credit any overpayment to Deposit Account No. 20-0778.			
WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.			
I am the			
☐ applicant/inventor.			
☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/96).			
☒ attorney or agent of record. Registration Number: 29,526			
☐ attorney or agent under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34:			
 Todd Deveau		<u>04/11/2007</u> Date <u>770-933-9500</u> Telephone Number	

The collection of information is required by CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 USC 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 6 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, US Patent and Trademark Office, US Department of Commerce, PO Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, PO Box 1450 Alexandria, VA 22313-1450.

Electronic Patent Application Fee Transmittal

Application Number:	10937736			
Filing Date:	08-Sep-2004			
Title of Invention:	Refrigerant with lubricating oil for replacement of R22 refrigerant			
First Named Inventor/Applicant Name:	Kenneth M. Ponder			
Filer:	Todd Deveau./Laurie Delesandro			
Attorney Docket Number:	821920-1030			
Filed as Small Entity				
Utility Filing Fees				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Notice of appeal	2401	1	250	250
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Extension - 1 month with \$0 paid	2251	1	60	60
Miscellaneous:				
Total in USD (\$)				310

Electronic Acknowledgement Receipt

EFS ID:	1675152
Application Number:	10937736
International Application Number:	
Confirmation Number:	1006
Title of Invention:	Refrigerant with lubricating oil for replacement of R22 refrigerant
First Named Inventor/Applicant Name:	Kenneth M. Ponder
Customer Number:	24504
Filer:	Todd Deveau./Laurie Delesandro
Filer Authorized By:	Todd Deveau.
Attorney Docket Number:	821920-1030
Receipt Date:	11-APR-2007
Filing Date:	08-SEP-2004
Time Stamp:	19:20:00
Application Type:	Utility

Payment information:

Submitted with Payment	yes
Payment was successfully received in RAM	\$310
RAM confirmation Number	1131
Deposit Account	200778

The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows:
Charge any Additional Fees required under 37 C.F.R. Section 1.16 and 1.17

File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (if appl.)
1	Notice of Appeal Filed	00510708.pdf	63937	no	1
Warnings:					
Information:					
2	Pre-Brief Conference request	00510709.pdf	62111	no	1
Warnings:					
Information:					
3	Pre-Brief Conference request	00510710.pdf	252147	no	5
Warnings:					
Information:					
4	Extension of Time	00510707.pdf	57114	no	1
Warnings:					
Information:					
5	Fee Worksheet (PTO-06)	fee-info.pdf	8317	no	2
Warnings:					
Information:					
Total Files Size (in bytes):			443626		
This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503. <u>New Applications Under 35 U.S.C. 111</u> If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application. <u>National Stage of an International Application under 35 U.S.C. 371</u> If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course. <u>New International Application Filed with the USPTO as a Receiving Office</u> If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.					

**NOTICE OF APPEAL FROM THE EXAMINER TO
THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Docket No. (Optional):
821920-1030

I hereby certify that this correspondence is being filed with the
United States Patent and Trademark Office through EFS-Web on

April 11, 2007


Signature – Laurie Delesandro

In re Application of
Ponder, K., et al.

Application Number

10/937,736

Filed

09/08/2004

For

Refrigerant With Lubricating Oil for Replacment of
R22 Refrigerant

Group Art Unit

1751

Examiner

John R. Hardee

Applicant hereby **appeals** to the Board of Patent Appeals and interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b))

\$ 500.00

☒ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is \$ 250.00
reduced by half, and the resulting fee is:

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.
I have enclosed a duplicate copy of this sheet.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment to
Deposit Account No. 20-0778.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

**Warning: Information on this form may become public. Credit card information should not be
included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

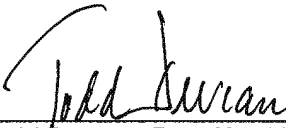
☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR
3.73(b)

Is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

☐ Attorney or agent acting under 37 CFR 1.34(a).
Registration No. if acting under 37 CFR 1.34(a)


Todd Deveau, Reg. No. 29,526

11 April 2007
Date

Note: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit
multiple forms if more than one signature is required, see below*.

☐ *Total of forms are submitted.

This collection of information is required by 37 CFR 1.213(a). The information is used by the public to request that an application not be published under 35
U.S.C. 122(b) (and the PTO to process that request). Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12
minutes to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this
form should be sent to the Chief Information Officer, Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR
COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



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 NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/937,736	09/08/2004	Kenneth M. Ponder	821920-1030	1006
24504 7590 04/23/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948				
			EXAMINER HARDEE, JOHN R	
			ART UNIT 1751	PAPER NUMBER
			MAIL DATE 04/23/2007	DELIVERY MODE PAPER

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

Application Number 	Application/Control No. 10/937,736 John R. Hardee	Applicant(s)/Patent under Reexamination PONDER ET AL. Art Unit 1751
Document Code - AP.PRE.DEC		

Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 4-11-07.

1. ☐ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate.
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☐ Other:

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☒ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☒ The panel has determined the status of the claim(s) is as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-10, 21-25, 27, 29-31, 33-35, 37-40.

Claim(s) withdrawn from consideration: _____

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Douglas McGinty

(2) Greg Mills

(3) John R. Hardee

(4) [Signature]



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 NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/937,736	09/08/2004	Kenneth M. Ponder	821920-1030	1006
24504 7590 08/10/2007 THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP 100 GALLERIA PARKWAY, NW STE 1750 ATLANTA, GA 30339-5948			EXAMINER HARDEE, JOHN R	
			ART UNIT 1751	PAPER NUMBER
			MAIL DATE 08/10/2007	DELIVERY MODE 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.

Interview Summary	Application No.	Applicant(s)	
	10/937,736	PONDER ET AL.	
	Examiner	Art Unit	
	John R. Hardee	1751	

All participants (applicant, applicant's representative, PTO personnel):

(1) John R. Hardee. (3) _____

(2) Atty. Deveau. (4) _____

Date of Interview: 02 August 2007.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____

Claim(s) discussed: _____

Identification of prior art discussed: _____

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Discussed possible amendments to overcome prior art. Such amendments and submission of IDS would require RCE.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiner's Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

REQUEST FOR CONTINUED EXAMINATION(RCE)TRANSMITTAL (Submitted Only via EFS-Web)

Application Number	10937736	Filing Date	2004-09-08	Docket Number (if applicable)	821920-1030	Art Unit	1751
First Named Inventor	Ponder, K., et al.			Examiner Name	John R. Hardee		

This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.

Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. The Instruction Sheet for this form is located at WWW.USPTO.GOV

SUBMISSION REQUIRED UNDER 37 CFR 1.114

Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

☐ Other _____

☒ Enclosed

☐ Amendment/Reply

☐ Information Disclosure Statement (IDS)

☐ Affidavit(s)/ Declaration(s)

☒ Other

Preliminary Amendment and Information Disclosure Statement

MISCELLANEOUS

☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of months _____
(Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

☐ Other _____

FEES

The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

☒ The Director is hereby authorized to charge any underpayment of fees, or credit any overpayments, to Deposit Account No 200778

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED

☒ Patent Practitioner Signature

☐ Applicant Signature

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Signature of Registered U.S. Patent Practitioner

Signature	/todd deveau/	Date (YYYY-MM-DD)	2007-08-13
Name	Todd Deveau	Registration Number	29526

This collection of information is required by 37 CFR 1.114. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.