



**LAWRENCE N. GINSBERG  
ENDOCARE, INC.  
201 TECHNOLOGY DRIVE  
IRVINE CA 92618**

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OCT 19 2007

**OFFICE OF PETITIONS**

**DECISION ON PETITIONS**

In re Application of  
Sanford D. Damasco et al  
Application No. 10/700,326  
Filed: November 3, 2003  
Atty Docket No. ENDO108-C1-CP2CP

This is a decision on the petitions filed October 5, 2007, to (1) amend under 37 CFR 1.48(a) the inventive entity by the addition of Jawahar M. Ali, David J. Battles, Paul W. Mikus, and Jay J. Eum as joint inventors, (2) to waive under the provisions of 37 CFR 1.183 that part of 37 CFR 1.48(a)(2) which requires a statement from the person being added, (3) to accept under 37 CFR 1.47(a), as authorized by 37 CFR 1.48(a)(3), the declaration, which lacks the signature of the inventor being added as required by 37 CFR 1.63, and (4) to withdraw this application from issue under 37 CFR 1.313(c)(2).

The petitions are **GRANTED**.

**DISCUSSION OF PETITION UNDER 37 CFR 1.313(c)(2)**

Petitioner requests that this application be withdrawn from issue in order to amend the inventorship in this case. A Request for Continued Examination (RCE) under 37 CFR 1.114 was filed concurrently with the petition to withdraw from issue.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on August 6, 2007 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.<sup>1</sup>***

<sup>1</sup> The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Part B – Fee(s) Transmittal Form must be completed and timely submitted to avoid abandonment.

**DISCUSSION OF REQUEST UNDER 37 CFR 1.48(a)**

In those instances wherein a request under 37 CFR 1.48(a) and a petition under 37 CFR 1.47 have both been filed in an application, the Office of Petitions may first issue a decision on the request under 37 CFR 1.48(a) so as to determine the appropriate oath or declaration under 37 CFR 1.63 required for the petition under 37 CFR 1.47. In those situations where, as here, an inventor to be added refuses to submit a statement supporting the addition or such party cannot be reached, waiver under 37 CFR 1.183 of the requirement for a statement from that party would be appropriate upon a showing of such refusal or inability to reach the inventor. Every existing assignee of the original named inventors must give its consent to the requested correction.

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b)).

The request under 37 CFR 1.48(a) to add inventors Jawahar A. Ali, David J. Battles, Paul W. Mikus and Jay J. Eum has been found that, through error and without deceptive intent, the application improperly set forth the inventorship. Accordingly, this application has been amended to include the aforementioned inventors.

It is noted that a statement and declaration were received on October 9, 2007 by previously non-signing inventor Jawahar A. Ali.

**DISCUSSION OF PEITION UNDER 37 CFR 1.47(a)**

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after

having been presented with the application papers (specification, claims and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee set forth in § 1.17(g); and

(4) a statement of the last known address of the non-signing inventor.

The petition complies with the above requirements. Further, the evidence submitted in support of the petition under 37 CFR 1.47(a) is sufficient to establish that non-signing inventor David J. Battles, one of the inventors being added under the provisions of 37 CFR 1.48(a), did not respond to a request to execute the oath or declaration (or assignment) after having been presented with a copy of the application papers as filed.

The application papers have been reviewed and found to be in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

#### **DISCUSSION OF PEITION UNDER 37 CFR 1.183**

On very infrequent occasions, the requirements of 37 CFR 1.48(a)(2) have been waived upon the filing of a request and the fee set forth in § 1.17(f) for a petition under 37 CFR 1.183 (along with the request and fee under 37 CFR 1.48(a)) to permit the filing of a statement by less than all the parties required to submit a statement. In re Cooper, 230 USPQ 638, 639 (Dep. Assist. Comm'r Pat. 1986). However, such a waiver will not be considered unless the facts of record unequivocally support the correction sought. In re Hardee, 223 USPQ 1122, 1123 (Comm'r Pat. 1984). In essence, petitioner must show that the inability to obtain the statement from David J. Battles is, notwithstanding the exercise of reasonable care and diligence, due to circumstances beyond his control.

Under the circumstances recounted in the petition, justice would be served by suspending the requirements of 37 CFR 1.48(a)(2) for a statement by non-signing inventor David J. Battles. Accordingly, the requirement for a statement under 37 CFR 1.48(a)(2) by non-signing inventor David J. Battles is waived under the provisions of 37 CFR 1.183.

A Corrected Filing Receipt which sets forth the inventorship of this application accompanies this decision on petition.

Telephone inquiries should be directed to Frances Hicks at (571) 272-3218.

This application is being referred to Technology Center AU 3737 for processing of the request for continued examination under 37 CFR 1.114.

A handwritten signature in black ink, appearing to read "Brian Hearn", with a stylized flourish at the end.

Brian Hearn  
Petitions Examiner  
Office of Petitions

ATTACHMENT: Corrected Filing Receipt



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Table with 6 columns: APPLICATION NUMBER, FILING or 371(c) DATE, GRP ART UNIT, FIL FEE REC'D, ATTY.DOCKET.NO, TOT CLAIMS, IND CLAIMS. Row 1: 10/700,326, 11/03/2003, 3737, 885, ENDO108-C1-CP2CP, 35, 2

CONFIRMATION NO. 5138

CORRECTED FILING RECEIPT



33746
LAWRENCE N. GINSBERG
ENDOCARE, INC.
201 TECHNOLOGY DRIVE
IRVINE, CA 92618

Date Mailed: 10/18/2007

Receipt is acknowledged of this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Filing Receipt Corrections. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections

Applicant(s)

- Sanford D. Damasco, Irvine, CA;
Thach Duong, Tustin, CA;
Jawahar M. Ali, Lake Forest, CA;
David J. Battles, Santa Barbara, CA;
Paul W. Mikus, Trabuco Canyon, CA;
Jay J. Eum, Irvine, CA;

Power of Attorney: The patent practitioners associated with Customer Number 33746

Domestic Priority data as claimed by applicant

This application is a CIP of 10/307,036 11/27/2002 PAT 6,643,535
which is a CIP of 09/957,306 09/20/2001 PAT 6,544,176
which is a CON of 09/699,938 10/30/2000 PAT 6,485,422
which is a CON of 09/318,710 05/26/1999 PAT 6,139,544

Foreign Applications

If Required, Foreign Filing License Granted: 02/11/2004

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US 10/700,326

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

\*\* SMALL ENTITY \*\*

**Title**

COMPUTER GUIDED ABLATION OF TISSUE USING INTEGRATED ABLATIVE/TEMPERATURE SENSING DEVICES

**Preliminary Class**

600

**PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES**

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

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

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

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

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

**LICENSE FOR FOREIGN FILING UNDER**

**Title 35, United States Code, Section 184**

**Title 37, Code of Federal Regulations, 5.11 & 5.15**

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).



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DAVID J. BATTLES  
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OCT 19 2007

**OFFICE OF PETITIONS**

In re Application of  
Stanford D. Damasco; Thach Duong; Jawahar M. Ali; David J. Battles; Paul W.  
Mikus; and Jay J. Eum  
Application No. 10/700,326  
Filed: November 3, 2003  
For: COMPUTER GUIDED ABLATION OF TISSUE USING INTEGRATED  
ABLATIVE/TEMPERATURE SENSING DEVICES

Dear Mr. Battles:

You are named as a joint inventor in the above-identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3218. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1 (800) 972-6382 (outside the Washington, DC area).

Frances Hicks  
Petitions Examiner  
Office of Petitions

cc:

Lawrence N. Ginsberg  
ENDOCARE, INC.  
201 Technology Drive  
Irvine, CA 92618



Appl. No. 10/700,326  
Statement Under Rule 48

Appl. No. : 10/700,326  
Applicant : DAMASCO ET AL  
Filed : 11/03/2003  
Title : COMPUTER GUIDED ABLATION OF TISSUE USING INTEGRATED  
ABLATIVE/TEMPERATURE SENSING DEVICES  
  
TC/A.U. : 3737  
Examiner : KHOLDEBARIN, IMAN K  
  
Docket No. : ENDO108-C1-CP2CP  
Customer No. : 33746  
Confirm. No. : 5138

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**STATEMENT UNDER RULE 48**

Sir/Madam:

I, **JAWAHAR M. ALI** hereby declare that:

I was not listed as an inventor during the original filing of the above identified continuation in part patent application (Serial No. 10/700,326). This error in inventorship occurred without deceptive intention on my part.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

  
\_\_\_\_\_  
**JAWAHAR M. ALI**  
Applicant/Inventor  
26541 Rancho Parkway S.  
Lake Forest, CA 92630

10/4/07  
\_\_\_\_\_  
Date