

# Exhibit 45

appear in the application transmittal letter (or the specification, rather than only in the specification). The inclusion of this incorporation by reference of the prior application(s) was necessary in these applications to permit applicant to amend the continuation or divisional application to include subject matter in the prior application(s) without the need for a petition. See also the subsection above regarding "Incorporation by Reference." If the continuation or divisional application filed prior to September 21, 2004 under 37 CFR 1.53(b) does not include the incorporation by reference statement in the application papers (in the specification or in the transmittal letter) as originally filed and applicant has not been informed of the omitted items, the application should be returned to OIPE for mailing of a "Notice of Omitted Item(s)." For applications filed on or after September 21, 2004, see 37 CFR 1.57(a) and MPEP § 201.17.

### 201.06(d) 37 CFR 1.53(d) Continued Prosecution Application (CPA) Practice [R-5]

37 CFR 1.53. Application number, filing date, and completion of application.

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#### (d) Application filing requirements - Continued prosecution (nonprovisional) application.

(1) A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under this paragraph, provided that:

- (i) The application is for a design patent;
- (ii) The prior nonprovisional application is a design application that is complete as defined by § 1.51(b); and
- (iii) The application under this paragraph is filed before the earliest of:

(A) Payment of the issue fee on the prior application, unless a petition under § 1.313(c) is granted in the prior application;

(B) Abandonment of the prior application; or

(C) Termination of proceedings on the prior application.

(2) The filing date of a continued prosecution application is the date on which a request on a separate paper for an application under this paragraph is filed. An application filed under this paragraph:

- (i) Must identify the prior application;

(ii) Discloses and claims only subject matter disclosed in the prior application;

(iii) Names as inventors the same inventors named in the prior application on the date the application under this paragraph was filed, except as provided in paragraph (d)(4) of this section;

(iv) Includes the request for an application under this paragraph, will utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute the new application, and will be assigned the application number of the prior application for identification purposes; and

(v) Is a request to expressly abandon the prior application as of the filing date of the request for an application under this paragraph.

(3) The filing fee, search fee, and examination fee for a continued prosecution application filed under this paragraph are the basic filing fee as set forth in § 1.16(b), the search fee as set forth in § 1.16 (l), and the examination fee as set forth in § 1.16(p).

(4) An application filed under this paragraph may be filed by fewer than all the inventors named in the prior application, provided that the request for an application under this paragraph when filed is accompanied by a statement requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed in the new application. No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of correction of inventorship under § 1.48.

(5) Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

(6) The filing of a continued prosecution application under this paragraph will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public, who is entitled under the provisions of § 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of this paragraph, may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket.

(7) A request for an application under this paragraph is the specific reference required by 35 U.S.C. 120 to every application assigned the application number identified in such request. No amendment in an application under this paragraph may delete this specific reference to any prior application.

(8) In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability:

- (i) Title of invention;
- (ii) Name of applicant(s); and
- (iii) Correspondence address.

(9) \*\*See § 1.103(b) for requesting a limited suspension of action in an application filed under this paragraph.

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## **I. CPA PRACTICE HAS BEEN ELIMINATED AS TO UTILITY AND PLANT APPLICATIONS**

Effective July 14, 2003, continued prosecution application (CPA) practice has been eliminated as to utility and plant applications. Applicants who wish to continue examination of the same claimed invention after the prosecution of a utility or plant application is closed should consider filing a request for continued examination (RCE) under 37 CFR 1.114. For more information on RCE practice, see MPEP § 706.07(h). Applicants who wish to file a continuation, divisional, or continuation-in-part application should file an application under 37 CFR 1.53(b). See MPEP § 201.06(c). CPAs filed prior to July 14, 2003 will continue to be processed and examined under the procedures set forth in prior 37 CFR 1.53(d). Any request for a CPA filed on or after July 14, 2003 in a utility or plant application is improper, regardless of the filing date of the utility or plant application in which the CPA is filed.

The Office will not convert an improper CPA into an application under 37 CFR 1.53(b) unless the applicant shows that there are extenuating circumstances that warrant the burdensome process of such conversion.

If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the Technology Center (TC) who will reprocess the CPA and correct the application records as appropriate.

### **A. Applications Filed on or After June 8, 1995**

If a utility or plant application has a filing date on or after June 8, 1995, an improper CPA filed on or after July 14, 2003 will be treated as a request for continued examination (RCE) under 37 CFR 1.114. See MPEP § 706.07(h) and form paragraph 7.42.15. If the improper CPA does not satisfy the requirements of 37

CFR 1.114 (e.g., the request lacks a submission or the fee under 37 CFR 1.17(e), or the prosecution of the application is not closed), the Office will treat the improper CPA as an improper RCE, and the time period set in the last Office action (or notice) will continue to run. The Office will send the applicant a Notice of Improper Request for Continued Examination (RCE), PTO-2051. If the time period for reply to the last Office action (or notice) has expired, the application is abandoned and the applicant must file a petition under 37 CFR 1.137 and the required petition fee to revive the abandoned application. Unless prosecution in the application was not closed, the petition must be accompanied by a submission as defined by 37 CFR 1.114(c) and the fee set forth in 37 CFR 1.17(e), unless previously filed. If the last Office action is a notice of allowance, the issue fee must also be paid at the time of filing the petition to revive. If prosecution in the application was not closed, the petition must be accompanied by a reply to the non-final Office action.

Applicants cannot, as a matter of right, obtain continued examination on claims that are independent and distinct from the invention previously claimed (i.e., applicants cannot switch inventions when filing an RCE). See 37 CFR 1.145. Therefore, if applicants file a request for a divisional CPA on or after July 14, 2003 and the request satisfies all the requirements in 37 CFR 1.114 (e.g., the request is accompanied by the fee as set forth in 37 CFR 1.17(e) and a submission), the Office will treat the improper divisional CPA as a proper RCE. However, any amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention will be treated as nonresponsive. See MPEP § 821.03. Any newly submitted claims that are directed to an invention distinct from and independent of the invention previously claimed will be withdrawn from consideration. Applicants should be notified by using form paragraph 8.26 or 8.27.

### **B. Applications Filed Before June 8, 1995**

If a utility or plant application has a filing date before June 8, 1995, the Office cannot treat an improper CPA filed on or after July 14, 2003 as an RCE because RCE practice does not apply to applications filed before June 8, 1995. The Office will notify the applicant of the improper CPA by mailing a

Notice of Improper CPA (or FWC) Filing For Utility or Plant Applications Filed Before June 8, 1995, PTO-2011 (Rev. 7/03 or later). The time period for reply set in the last Office action (or notice) will continue to run. Applicant may file a continuing application under 37 CFR 1.53(b). If the time period for reply has expired, the application is abandoned. If the application in which the improper CPA is filed is abandoned when a continuing application is filed, applicant would need to file a petition under 37 CFR 37 CFR 1.137 to revive the prior application to establish copendency with the continuing application under 37 CFR 1.53(b).

## **II. FILING AND INITIAL PROCESSING OF CPAs FOR DESIGN APPLICATIONS**

### **A. In General**

In addition to the provisions of 37 CFR 1.53(b), a continuation or divisional (but not a continuation-in-part) application may be filed under 37 CFR 1.53(d) if the prior application is a design application that is complete as defined by 37 CFR 1.51(b). A continuation or divisional application filed under 37 CFR 1.53(d) is called a “Continued Prosecution Application” or “CPA.” A CPA has a number of advantages compared to a continuation or divisional application filed under 37 CFR 1.53(b). For example, the papers required to be filed in the U.S. Patent and Trademark Office in order to secure a filing date under 37 CFR 1.53(d) are minimal compared to 37 CFR 1.53(b). In addition, the Office will not normally issue a new filing receipt for a CPA. See 37 CFR 1.54(b). The time delay between the filing date and the first Office action should be less for a CPA than for an application filed under 37 CFR 1.53(b). For examination priority purposes only, the USPTO will treat continuation CPAs as if they were “amended” applications (as of the CPA filing date) and not as “new” applications. This treatment is limited to CPAs in which the prior application has an Office action issued by the examiner. If no Office action has been issued in the prior application, the CPA will be treated, for examination purposes, like a “new” application unless a petition to make special under 37 CFR 1.102 or a request for expedited examination under 37 CFR 1.155 is filed in the CPA. As “amended” applications generally have a shorter time frame for being acted on by examiners

than “new” applications, the treatment of a CPA as an “amended” application will result in a first Office action being mailed in the CPA much sooner than if it had been filed as a continuation application under 37 CFR 1.53(b) (or under former 37 CFR 1.60 or 1.62). Therefore, applicants are strongly encouraged to file any preliminary amendment in a CPA at the time the CPA is filed. See 37 CFR 1.115 and MPEP § 714.03(a).

A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 CFR 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 CFR 1.53(b). If applicant wants the USPTO to disregard a previously filed request for a CPA filed in a design application (and not recognize its inherent request to expressly abandon the prior application) and to treat the paper as the filing of an application under 37 CFR 1.53(b), the applicant must file a petition under 37 CFR 1.182. A request to expressly abandon an application is not effective until the abandonment is acknowledged, including the express abandonment of the prior application of a CPA that occurs by operation of 37 CFR 1.53(d)(2)(v). The express abandonment of the prior application is acknowledged and becomes effective upon processing and entry of the CPA into the file of the prior application. Thus, such a petition under 37 CFR 1.182 should be filed expeditiously since the petition will not be granted once the request for a CPA has been entered into the prior application (and the inherent request to expressly abandon the prior application has been acknowledged). If the request for a CPA has been entered into the prior application by the time the petition under 37 CFR 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied. It is noted, however, that if the applicant intended to file a second application (either a continuation or a divisional) without abandoning the prior application, applicant can still achieve that result without loss of the benefit of the original filing date by: (A) continuing the prosecution of the original application via the CPA; and (B) filing a new continuation/divisional under 37 CFR 1.53(b) claiming benefit of the CPA and its parent applications under 35 U.S.C. 120 during the pendency of the CPA.

Since no new matter may be introduced in a CPA, the procedure set forth in 37 CFR 1.53(d) is not available for filing a continuation-in-part application. All continuation-in-part applications must be filed under 37 CFR 1.53(b) and a newly executed oath or declaration is required.

Under the CPA procedure, the continuation or divisional application will utilize the file wrapper and contents of the prior nonprovisional application, including the specification, drawings and oath or declaration from the prior nonprovisional application, and will be assigned the same application number as the prior nonprovisional application. Any changes to the continuation or divisional application desired when filing the CPA must be made in the form of an amendment to the prior application as it existed prior to filing the CPA, see 37 CFR 1.53(d)(5). Any new specification filed with the CPA request will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with 37 CFR 1.125. However, the applicant must comply with the requirements of 37 CFR 1.125(b) before the substitute specification will be entered into the CPA. Since 37 CFR 1.125(b) requires that a substitute specification be accompanied by, *inter alia*, a statement that the substitute specification includes no new matter, any substitute specification containing new matter will be denied entry by the examiner. Any preliminary amendment to the written description and claims, other than a substitute specification, filed with a CPA request will ordinarily be entered. Any new matter which is entered, however, will be required to be canceled pursuant to 35 U.S.C. 132 from the descriptive portion of the specification. Further, any claim(s) which relies upon such new matter for support will be rejected under 35 U.S.C. 112, first paragraph. See MPEP § 2163.06. In the event that a substitute specification or preliminary amendment containing new matter was filed with a request for a CPA, applicant may file a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file, and be accorded the status as a separate application by being placed in a new file wrapper and assigned a new application number, with the new application being accorded a filing date as of the date the request for a CPA and substitute specification/preliminary amendment were filed. Of course, a request

for a CPA is not improper simply because the request is accompanied by a substitute specification or preliminary amendment containing new matter. Thus, an applicant will not be entitled to a refund of the filing fee paid in a proper CPA as a result of the granting of a petition under 37 CFR 1.182 requesting that the substitute specification or preliminary amendment be removed from the CPA application file.

A CPA may be based on a prior CPA so long as the prior CPA is complete under 37 CFR 1.51(b) and is a design application. There is no other limit to the number of CPAs that may be filed in a chain of continuing applications. However, only one CPA may be pending at one time based on the same prior nonprovisional application.

Under 37 CFR 1.53(d), the specification, claims, and drawings, and any amendments entered in the prior nonprovisional application are used in the CPA. A new basic filing fee, search fee, and examination fee are required in accordance with 35 U.S.C. 41 and 37 CFR 1.16. No search and examination fees are required for a CPA filed before December 8, 2004. The only other statutory requirement under 35 U.S.C. 111(a) is a signed oath or declaration. Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under the statute and rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration will be considered to be the oath or declaration of the CPA.

The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter.

If application papers for a design application are in any way designated as a CPA filing under 37 CFR 1.53(d) (e.g., contain a reference to 37 CFR 1.53(d), CPA, or continued prosecution application), the application papers will be treated by the Office as a CPA filed under 37 CFR 1.53(d), even if the application papers also contain other inconsistent designations (e.g., if the papers are also designated as an applica-

tion filed under 37 CFR 1.53(b) or include a reference to a “continuation-in-part CPA”). If application papers for a utility or plant application are in any way designated as a CPA filing under 37 CFR 1.53(d), the application papers will be treated as a request for continued examination (RCE) under 37 CFR 1.114. See I. CPA PRACTICE HAS BEEN ELIMINATED AS TO UTILITY AND PLANT APPLICATIONS, above.

### **B. Conditions for Filing a CPA**

A continuation or divisional application may be filed under 37 CFR 1.53(d), if the prior nonprovisional application is a design application that is complete as defined by 37 CFR 1.51(b). The term “prior nonprovisional application” in 37 CFR 1.53(d)(1) means the nonprovisional application immediately prior to the CPA. A complete application as defined by 37 CFR 1.51(b) must contain, *inter alia*, the appropriate filing fee (including the basic filing fee, search fee, and examination fee) and a signed oath or declaration under 37 CFR 1.63.

In addition, a continuation or divisional application filed under 37 CFR 1.53(d) must be filed before the earliest of: (A) payment of the issue fee on the prior application, unless a petition under 37 CFR 1.313(c) is granted in the prior application; (B) abandonment of the prior application; or (C) termination of proceedings on the prior application.

Note that request for continued examination (RCE) practice under 37 CFR 1.114 is not available in design applications. Any improper RCE filed in a design application will not be treated as a CPA. An improper RCE filed in a design application will not toll the running of any time period for reply.

### **C. Initial Processing**

A CPA request will be initially processed by the TC assigned the prior application. The TC will verify that (A) the prior application is a design application, (B) the correct application number of the prior nonprovisional application is identified in the request, (C) the request is properly signed, (D) the prior nonprovisional application was pending on, and that the issue fee has not been paid in the prior nonprovisional application on or prior to, the filing date of the CPA request, (E) the prior nonprovisional application was complete under 37 CFR 1.51(b) (e.g., the filing fee has been paid and a signed oath or declaration under

37 CFR 1.63 has been filed in the prior application), and (F) the proper filing fee has been paid in the CPA. If one or more other conditions for filing a CPA have not been satisfied or the proper basic filing fee, search fee, and examination fee have not been paid, the applicant will be so notified and no examination will be made in the CPA until the filing error has been corrected or the proper fees have been submitted. See 37 CFR 1.53(h). If an examiner discovers that an improper or incomplete CPA has been processed as a proper CPA in error, the examiner should immediately notify a supervisory applications examiner (SAE) or other technical support staff within the TC who will reprocess the CPA and correct the application records.

### **D. Incorrect Patent Application Number Identified**

A request for a CPA must identify the prior nonprovisional application (37 CFR 1.53(d)(2)(i)) by application number (series code and serial number) or by serial number and filing date. Where a paper requesting a CPA is filed which does not properly identify the prior nonprovisional application number, the TC should attempt to identify the proper application number by reference to other identifying information provided in the CPA papers, e.g., name of the inventor, filing date, title of the invention, and attorney’s docket number of the prior application. If the TC is able to identify the correct application number of the prior application, the correct application number should be entered in red ink on the paper requesting the CPA and the entry should be dated and initialed. For Image File Wrapper (IFW) processing, see IFW Manual. If the TC is unable to identify the application number of the prior application and the party submitting the CPA papers is a registered practitioner, the practitioner may be requested by telephone to supply a letter signed by the practitioner providing the correct application number. If all attempts to obtain the correct application number are unsuccessful, the paper requesting the CPA should be returned by the TC to the sender where a return address is available. The returned CPA request must be accompanied by a cover letter which will indicate to the sender that if the returned CPA request is resubmitted to the U.S. Patent and Trademark Office with the correct application number within two weeks of the mail date on the cover letter, the original date of receipt of the CPA request will be