

Subject: RE: Notice Forwarding Certified List
From: "Abraham, Kyra" <Kyra.Abraham@USPTO.GOV>
Date: Tue, 21 Nov 2006 16:57:46 -0500
To: "Jed Margolin" <jm@jmargolin.com>

Mr Margolin

I will attempt to answer each of your questions below. Please note that IFW is not the only database used in the PTO. The Patent Application Locating and Monitoring (PALM) database is also used internally by the PTO and is used in conjunction with IFW when compiling the Certified List for the Court. This database has separate entries from those in IFW therefore the Certified List will differ from IFW. Also, the Certified List is a listing of the complete contents of the file wrapper and every document regardless of whether it is relevant to the appeal or not is included in the list. Also, You will need to contact our office by phone or submit a written letter listing exactly what documents you are planning to designate for the record, the below e-mail while useful is not considered contacting our office for the designation of materials. If you have any further questions regarding the Certified list please do not hesitate to contact me. If you have any questions regarding designating the record or any other aspects of the appeal, please contact Mr. whealan directly. Thank you.

-----Original Message-----

From: Jed Margolin [mailto:jm@jmargolin.com]
Sent: Tuesday, November 21, 2006 12:40 PM
To: Abraham, Kyra
Subject: Notice Forwarding Certified List

Ms. Abraham.

In CAFC Appeal 2007-1056 (Application 09/947,801 ***Distributed Computing System***), I received the ***Notice Forwarding Certified List*** on November 20, 2006. There are some problems with it.

1. The cover letter suggests that either I have Counsel or I am Counsel. I don't and I'm not. I am a Pro Se Appellant. If Mr. Whealan insists that only Counsel contact him to arrange for designating the record, he should be informed that I have no intention of retaining Counsel in order to designate the record and I will inform the Court that he refuses to discuss designating the record with me.

[Abraham, Kyra] The Notice forwarding the Certified list is a form letter sent with every cert list pro se or not, it is commonly understood that a pro se would contact the named attorney just the same as counsel, so you are to contact the office about designating the record just as we discussed during our phone conversation the other day. Pro se appeals are handled in the exact same way as appeals with designated counsel in our office.

2. The certified list contains at least one document that is ambiguous and others that are irrelevant.

The Certified List is composed of every document in the file wrapper and not just certain documents regardless of whether or not they are relevant to the appeal.

In chronological order:

09/06/2001 APPLICATION FILED

There are a number of documents in the IFW having that date. Are they all considered the Application?

[Abraham, Kyra] The Certified List is in part composed of documents from IFW however what is listed in IFW will differ from the cert list since IFW lists different sections of a document separately whereas the Cert List will list the complete document i.e. the application is one document which comprises the claims, abstract etc. which in IFW will have separate entries;

10/05/2001 CORRESPONDENCE ADDRESS CHANGE

There is no such document in the IFW. The only time I changed the correspondence address was when I moved in late 2005. I did this by changing the address associated with my Customer Number. There is no document in the IFW for this.

[Abraham, Kyra] An entry was made into the PTO's PALM database for a correspondence address change, however a review of the documents in IFW indicates that this document was entered in error and I will submit an amended Certified List to the Court removing this document from the record

In any event, how is this relevant to the prosecution history of the case?

[Abraham, Kyra] This has already been explained above, the Certified List is composed of every document in the file wrapper regardless of whether they are relevant to the appeal or not.

09/06/2001 INFORMATION DISCLOSURE STATEMENT (IDS) FILED

09/06/2001 NONPUBLICATION REQUEST

OK, but since these documents are listed separately from **09/06/2001 APPLICATION FILED** then that entry is ambiguous.

[Abraham, Kyra] The IDS is considered a separate document from the application and is therefore listed separately on the Certified List

12/09/2004 MISCELLANEOUS INCOMING LETTER

In the Fall of 2004 this application disappeared from my customer number. After a series of telephone calls it was discovered that the Patent Office had mistakenly transferred it to another customer number, one belonging to the law firm of McGinn & Gibb, who have never represented me on this or any other matter. I contacted them and they filed this letter

informing the Patent Office of this.

[Abraham, Kyra] The Miscellaneous Incoming Letter is from McGinn & Gibb informing the PTO that their law firm did not represent you, this letter is part of the complete file wrapper and is part of the record regardless of whether it is relevant to the appeal or not and belongs on the Cert. List

How is this relevant to the prosecution history of this case other than to show that the Patent Office makes mistakes?

01/26/2005 ***NON-FINAL ACTION***
04/21/2005 ***RESPONSE AFTER NON-FINAL ACTION***
06/15/2005 ***MAIL FINAL REJECTION (PTOL - 326)***
08/04/2005 ***RESCIND NONPUBLICATION REQUEST FOR PRE GRANT PUBLICATION***

OK.

08/12/2005 ***MISCELLANEOUS INCOMING -TELEPHONE INTERVIEW SUMMARY***
08/12/2005 ***INFORMALRESPONSE TO OFFICE ACTION***

The Informal Response to Office Action was filed as part of the Telephone Interview Summary for 8/5/2005 because the Examiner had refused to enter it into the Record. It was not recorded as a separate document. If you wish to treat it as a separate document, then fine.

[Abraham, Kyra] This entry will be amended on the corrected Cert List I file with the Court to one entry - Misc. Incoming Letter

08/19/2005 ***MISCELLANEOUS INCOMING-TELEPHONE INTERVIEW SUMMARY***
08/25/2005 ***MISCELLANEOUS INCOMING-TELEPHONE INTERVIEW SUMMARY***
08/29/2005 ***MAIL EXAMINER INTERVIEW SUMMARY (PTOL -413)***

OK.

08/30/2005 ***MAIL EXAMINER INTERVIEW SUMMARY (PTOL-413)***

This is very bad.

There are two entries in the IFW for 08/30/2005.

One is for a telephone conversation I had on August 23, 2005 with SPE Rupal Dharia to schedule a telephone interview for August 25, 2005.

The other is the Examiner's Summary for the Telephone Interview held on August 25, 2005.

The first document is irrelevant. The second is material. There is no way to distinguish the two in this Certified List.

[Abraham, Kyra] As you can see in the Certified List there is an entry for 8/29/05 this is for the 8/23 interview and an entry for 8/30/05 which is for the 8/25 interview. Both documents are part of the file and are therefore relevant as they are part of the record as explained above.

The remaining entries appear to be correct and relevant.

<i>09/06/2005</i>	<i>NOTICE OF APPEAL FILED</i>
<i>09/06/2005</i>	<i>PRE-APPEAL BRIEF REQUEST FOR REVIEW</i>
<i>10/26/2005</i>	<i>APPEALS CONF. PROCEED TO BPAI,</i>
<i>10/27/2005</i>	<i>NOTICE OF PANEL DECISION FROM PRE-APPEAL BRIEF REVIEW</i>
<i>11/17/2005</i>	<i>APPEAL BRIEF FILED</i>
<i>01/20/2006</i>	<i>EXAMINER'S ANSWER TO APPEAL BRIEF</i>
<i>01/24/2006</i>	<i>MAIL EXAMINER'S ANSWER</i>
<i>03/16/2006</i>	<i>REPLY BRIEF FILED</i>
<i>05/17/2006</i>	<i>ASSIGNMENT OF APPEAL NUMBER</i>
<i>08/24/2006</i>	<i>BPAI DECISION - EXAMINER AFFIRMED</i>
<i>10/06/2006</i>	<i>APPEAL TO COURT OF APPEALS</i>
<i>10/12/2006</i>	<i>MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)</i>

As far as the Designated List is concerned, I have uploaded my proposed Appendix (updated to reflect the Docket Number) to my server.

www.jmargolin.com/uspto/jm_propap.pdf Proposed Appendix PDF 9 MByte
self-contained

www.jmargolin.com/uspto/jm_propap_index.htm Proposed Appendix html 8
KByte with active online links to references

www.jmargolin.com/uspto/jm_propap.zip Proposed Appendix zip 8 MBytes

unzip to folder
click on ***jm_propap_index.htm***
contains references with active local links

Mr. Whealan should consider this my Designated List. If he wants me to add to it he should contact me, assuming he is willing to talk to a Pro Se Appellant.

And, finally, I am planning on filing a Corresponding Brief on Compact Disc under CAFC Rule 32(e). If you have any objections to this, let me know.

Jed Margolin
Appellant Pro Se
775-847-7845