



Distinguishing Between a Strong and a Weak Claim

Ron Kaminecki MS, JD, CPL

US Patent Attorney

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FLC - Monterey, CA



FLC Members

- Own a lot of intellectual property
- Want market patents for development

Potential customers for your patents

- Will look at different aspects of the patents to determine if they can make money with them
- What do they look at?
- What can FLC members do to check their own portfolios in advance to determine the most valuable/lucrative inventions

The considerations here are used by potential customers



Basic Agenda

Dialog

Considerations between strong/weak claims

- Invention vs. prior art
- Interpretation of the invention in view of the art
- Directions based on court decisions

How can you distinguish strong/weak claims?

- Parameters within the claims
- Outside considerations
- Background

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Claims considerations

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- Claims have to be novel, useful and non-obvious, but are they money-makers?
- It may be hard to determine a strong claim, but there are parameters to check for strength
- What you think is a strong claim may be considered to be otherwise by a court or even a potential buyer or a competitor
- Have to look at the whole patent and also outside the patent to help determine a claim's strength

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Sample patent

Dialog



3,000,000

AUTOMATIC READING SYSTEM

**Kenneth R. Eldredge, Palo Alto, Calif., assignor, by
mesne assignments, to General Electric Company,
New York, N.Y., a corporation of New York**

Filed May 6, 1955, Ser. No. 506,598

21 Claims. (Cl. 340—149)

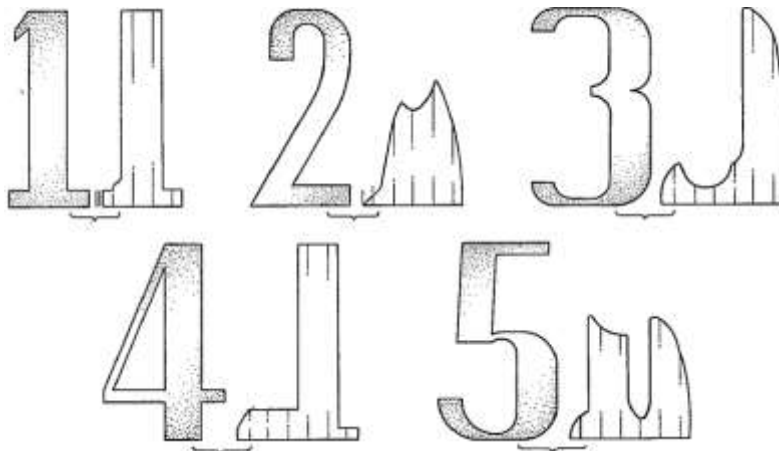
This invention relates to apparatus for reading characters in human language and providing therefrom signals representative thereof in machine language.

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Sample patent

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Sample patent




I claim:

1. A system for converting a character written in magnetic ink in human language to machine language comprising means to magnetize said character, a magnetic reading head, means to move said character under said magnetic reading head, means to obtain a signal from the output of said reading head having a wave shape characteristic of said character, a delay line, means to apply said signal to said delay line, means to detect the amplitude of said signal at several predetermined sampling points along said delay line, means to detect the maximum one of said detected signal amplitudes, means to amplify only the ones of said detected signal amplitudes which exceed a predetermined portion of said maximum detected signal amplitude to obtain a voltage pattern representative of said character.

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Sample patent considerations




- Looks like the claim covers the subject area broadly
- Has additional, more specific claims (21)
- Assume that it is legally valid (written by patent professional, examined by USPTO, etc.)
- Corresponds with the examples in the specification
- Distinct from the prior art

Substantive issues raised by ProQuest

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Claiming strategy as marketing material




- Certain considerations make a patent desirable
 - Broad coverage
 - Strength against litigation
- These same considerations are the criteria for non-obviousness and are called the Graham factors

(Graham et. al. v. John Deere Co. of Kansas City et al., 383 U.S. 1(1966))

- Commercial success
- Long felt but unsolved needs
- Failure of others to perfect such an invention

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Claiming around an exception




7. The kit according to claim 5,
 characterized in that the A[small beta,
 Greek]-mimotope consists of a peptide or
 comprises a peptide of formula wherein X1
 is an amino acid, C excepted,
 X2 is an amino acid,
 X3 is an amino acid,
 X4 is an amino acid,
 X5 is an amino acid,
 X6 is an amino acid,
 and wherein X1X2X3X4X5X6 is not DAEFRH

Substantive issues resolved by ProQuest

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Claiming around an exception




6. The method for producing an alkylated aromatic compound according to claim 1, wherein the metal component further contains at least one element selected from the group consisting of group IIB elements, group IIIA elements, group VIB elements, and group VIII elements (except nickel and cobalt).

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Glenn Seaborg's patent




3,156,523

ELEMENT 95 AND METHOD OF PRODUCING SAID ELEMENT

Glenn T. Seaborg, Chicago, Ill., assignor to the United States of America as represented by the United States Atomic Energy Commission

**No Drawing. Filed Aug. 23, 1946, Ser. No. 692,730
12 Claims. (Cl. 23—14.5)**

The present invention relates to a new transuranic element. More particularly it is concerned with the transuranic element having atomic number 95, now known as americium having the symbol Am, isotopes thereof, compositions containing the same, and methods of producing and purifying said element and compositions thereof.

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Glenn Seaborg patent

Dialog



What is claimed is:
1. Element 95.

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Glenn Seaborg patent

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What is claimed is:
1. Element 95.
2. The isotope of element 95 having the mass number 241.
3. The isotope of element 95 having the mass number 242.

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Considerations




- Very short claims, but very definitive
- Two cited references (including one to Fermi)
- Five non-patent literature cited references
- One future citation; no self-citations
- No:
 - litigation;
 - other family members; or
 - Oppositions
 - trademarks

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Drug patent




United States Patent [19]
Mills et al.

[11] **Patent Number:** 5,686,104
[45] **Date of Patent:** Nov. 11, 1997

[54] **STABLE ORAL CI-981 FORMULATION AND PROCESS OF PREPARING SAME**

Primary Examiner—Edward J. Webman
Attorney, Agent, or Firm—Michael J. Atkins

[75] **Inventors:** Nancy Mills, Mt. Arlington; Nouman A. Muhammad, Long Valley; Jay Weiss, East Brunswick; Russell U. Nesbitt, Somerville, all of N.J.

[57] **ABSTRACT**

An oral pharmaceutical composition is provided for treating hypercholesterolemia or hyperlipidemia containing an advantageous formulation for stabilizing the HMG-CoA coenzyme A inhibitor, CI-981 Hemi-Calcium, of formula (IA)

[73] **Assignee:** Warner-Lambert Company, Morris Plains, N.J.

[21] **Appl. No.:** 246,919

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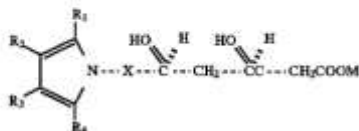
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Drug patent




What is claimed is:

1. A pharmaceutical composition for the peroral treatment of hypercholesterolemia or hyperlipidemia characterized by improved stability comprising in a mixture, a compound as active ingredient of structural formula I.



wherein X is $-\text{CH}_2-$, $-\text{CH}_2\text{CH}_2-$, $-\text{CH}_2\text{CH}_2\text{CH}_2-$ or $-\text{CH}_2\text{CH}(\text{CH}_3)-$;

R_1 is 1-naphthyl; 2-naphthyl; cyclohexyl; norbornenyl; 2-, 3-, or 4-pyridinyl; phenyl; phenyl substituted with fluorine, chlorine, bromine, hydroxyl, trifluoromethyl, alkyl of from one to four carbon atoms, alkoxy of from one to four carbon atoms, or alkanoylalkoxy of from two to eight carbon atoms;

either R_2 or R_3 is $-\text{CONR}_5\text{R}_6$ where R_5 and R_6 are independently hydrogen; alkyl of from one to six carbon atoms; 2-, 3-, or 4-pyridinyl; phenyl; phenyl substituted with fluorine, chlorine, bromine, cyano, trifluoromethyl, or carboalkoxy of from three to eight carbon atoms; and the other R_2 or R_3 is hydrogen; alkyl

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Drug patent




- 95 forward citations, including 7 self-citations
- Involved in 9 patent litigation cases
- Class code is A61K (medicaments, diagnostics)
- Has Certificate of Correction
- Maintenance fees (all three) in US and annual fees overseas have been paid
- 18 members in patent family
- No oppositions (in countries which have oppositions)
- Linked to a trademarked product
- Found in an outside source (Orange Book)

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Drug patent is Lipitor

Dialog



- Total worldwide sales of US\$12.4 billion in 2008
- Largest selling drug in the world...ever (so far)
- Expires this November 11, 2011; seventeen years from date of issue of this patent

Substantive issues resolved by ProQuest

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Drug patent is Lipitor

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- Claims were not unusual
- Markush claiming seemed adequate
- Internal data on the patent helped
- External data helped more
- Confirmed by outside sources

Substantive issues resolved by ProQuest

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Outside considerations

The Dialog logo consists of the word "Dialog" in a blue, sans-serif font, with a thin blue arc underneath it.

- Amount of opposition
- Litigation
- Citations, especially forward
 - Especially recent ones
 - Excluding self-citations
- Reexaminations
- Certificates of Correction

Substantive issues raised by Product

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Outside considerations

The Dialog logo consists of the word "Dialog" in a blue, sans-serif font, with a thin blue arc underneath it.

- Maintenance fees paid
- Reinstatement after late payment of maintenance fees
- Term shortening due to double-patenting
- Amount of time in prosecution
- Number of reassignments – and what those parties did with the patent

Substantive issues raised by Product

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Citing patents

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- Backward citations are controlled by the assignee
 - More patent citations, the more money/time spent in prosecution
 - Non-patent literature rates highly
- Forward citations, outside of self-citations, are controlled by others interested in the invention
 - Used to protect the future invention from litigation
 - Could be an improvement

Substantive issues raised by ProQuest

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Quick Check

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- Check the strength of the patent itself
- Oppositions
 - Not in US but typical overseas
 - Shows an interest by others
- Litigation
 - Enough of an interest that it is deemed enforceable
 - Indicates a desire to spend more money on the patent

Substantive issues raised by ProQuest

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Outside considerations - Inpadoc




INPADOC legal status: US 5000000 (A)

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Ethanol production by Escherichia coli strains co-expressing Zymomonas PDC and ADH genes

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Legal status of US5000000 (A) 1991-03-19:

US:	F:	35206289_A (Patent of invention)
PRS Date:		1989/05/15
PRS Code:		AS
Code Expl.:		ASSIGNMENT
NEW OWNER:		UNIVERSITY OF FLORIDA, THE, 207 TIGERT HALL, GAINE
EFFECTIVE DATE:		19890512
FURTHER INFORMATION:	ASSIGNMENT OF ASSIGNORS INTEREST;ASSIGNORS INGRAM, LONNIE O.;ALTERTHUM, FLAVIO REEL;FRAME 0050830452	

Substantive issues excluded by ProQuest

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Outside considerations - PAIR




Patent Application Information Retrieval

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09/072,274

EXTENDIBLE METHOD AND APPARATUS FOR SYNCHRONIZING FILES ON TWO DIFFERENT COMPUTER SYSTEMS

Select New Case	Application Data	Transaction History	Continuity Data	Fees	Published Documents	Address & Attorney/Agent
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Transaction History

Date	Transaction Description
07-07-2004	Correspondence Address Change
08-24-1999	Workflow - File Sent to Contractor
12-07-1999	Recordation of Patent Grant Mailed
11-26-1999	Issue Notification Mailed
10-20-1999	Issue Fee Payment Verified
07-15-1999	Mail Notice of Allowance
07-15-1999	Notice of Allowance Data Verification Completed
07-06-1999	Terminal Disclaimer Approved in TC
06-21-1999	Terminal Disclaimer Filed
06-18-1999	Information Disclosure Statement (IDS) Filed
06-18-1999	Information Disclosure Statement (IDS) Filed
06-21-1999	Date Forwarded to Examiner

Substantive issues excluded by ProQuest

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Outside considerations - articles

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HEALTH INDUSTRY | AUGUST 16, 2011

Pfizer Viagra Patent Upheld

U.S. Judge's Ruling Against Teva Preserves Market Exclusivity on Drug Into 2019

Article

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A



A

By PETER LOFTUS

A federal judge upheld a U.S. patent for Pfizer Inc.'s blockbuster anti-impotence pill Viagra, preserving Pfizer's market exclusivity on the drug into 2019.

U.S. Judge Rebecca Beach Smith ruled in federal court in Norfolk, Va., that Teva Pharmaceutical Industries Ltd.'s proposed generic version of Viagra would infringe a Pfizer patent for the drug, and that the patent is valid and enforceable.

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Other considerations

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- Reissues
- Patent family
 - Continuations
 - CIPs
 - Divisionals
 - Foreign equivalents
 - Essentially, anything extra that the applicant has to pay for

Substantive issues excluded by ProQuest.

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Other considerations  

- Litigated soon after issuance
- Forward citations very soon after publication
- Cite more prior art than non-litigated patents and are more likely to be cited by others
- However, check outside sources because the patent may be famous for reasons other than its popularity

Substantive issues raised by ProQuest 29

Freeny patent  

United States Patent [19] [11] **Patent Number:** **4,528,643**
Freeny, Jr. [45] **Date of Patent:** **Jul. 9, 1985**

[54] **SYSTEM FOR REPRODUCING INFORMATION IN MATERIAL OBJECTS AT A POINT OF SALE LOCATION**
 [75] **Inventor:** Charles C. Freeny, Jr., Fort Worth, Tex.
 [73] **Assignee:** FPDC, Inc., Oklahoma City, Okla.
 [21] **Appl. No.:** 456,730
 [22] **Filed:** Jan. 10, 1983
 [51] **Int. Cl.:** G06F 1/00
 [52] **U.S. Cl.:** 364/900
 [58] **Field of Search** ... 364/200 MS File, 900 MS File

4,217,588 8/1980 Freeny, Jr. . . .
 4,220,991 9/1980 Hamano et al. . . .
 4,232,317 11/1980 Freeny, Jr. . . .
 4,265,371 5/1981 Desai et al. . . .
 4,270,182 5/1981 Asija . . .
 4,328,544 5/1982 Baldwin et al. . . .

Primary Examiner—Raulfe B. Zache
Attorney, Agent, or Firm—Dunlap & Codding

[57] **ABSTRACT**
 The present invention contemplates a system for reproducing information in material objects at a point of sale location wherein the information to be reproduced is provided at the point of sale location from a location remote with respect to the point of sale location, an owner authorization code is provided to the point of sale location in response to receiving a request code from the point of sale location requesting to reproducing predetermined information in a material object, and the predetermined information is reproduced in a material object at the point of sale location in response to receiving a request code from the point of sale location.

[56] **References Cited**
U.S. PATENT DOCUMENTS
 3,829,833 8/1974 Freeny, Jr. . . .
 3,911,397 10/1975 Freeny, Jr. . . .
 3,924,065 12/1975 Freeny, Jr. . . .
 3,946,220 3/1976 Brobeck et al. . . .
 3,970,992 7/1976 Boothroyd et al. . . .

Substantive issues raised by ProQuest 30

Freeny patent




- Freeny was an inventor who patented an early system in which a user paid for an item online, then downloaded the item using an authorization code
- The patent was acquired by various companies that were involved in online sales

Substantive issues raised by ProQuest

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Freeny patent




I claim:

1. A method for reproducing information in material objects utilizing information manufacturing machines located at point of sale locations, comprising the steps of:

- providing from a source remotely located with respect to the information manufacturing machine the information to be reproduced to the information manufacturing machine, each information being uniquely identified by a catalog code;
- providing a request reproduction code including a catalog code uniquely identifying the information to be reproduced to the information manufacturing machine requesting to reproduce certain information identified by the catalog code in a material object;
- providing an authorization code at the information manufacturing machine authorizing the reproduction of the information identified by the catalog code included in the request reproduction codes; and
- receiving the request reproduction code and the authorization code at the information manufacturing machine and reproducing in a material object the information identified by the catalog code included in the request reproduction code in response to the authorization code authorizing such reproduction.

Substantive issues raised by ProQuest

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Freeny patent

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- Prosecution time: 911 days (~2 ½ years)
- Patents cited: 11 (5 were self-citations)
- Non-patents cited: 0
- Number of claims: 56
- Members of patent family: 6

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Freeny patent

Dialog

- Forward citations: 536
- Backward Citations: 14
- Oppositions: 0
- Litigation: 62
- Members of patent family: 6

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Freeny patent

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- Freeny could be an example likened to a *non-practicing entity* patent
- Owners sent out 75,000 mailers asking for \$5,000 license fee
- Some companies paid the fee; selective that did not were sued
- Lots of litigation, no trademarks

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Strength/Weakness of Claims

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- Places not to look
 - Don't focus on just at the claims, consider the
 - examples
 - internal and
 - external data around the patent;
 - On a PCT filing, pay no attention to the *designated* states; focus on *actual* national filings

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Published application

Dialog

(19) **United States**(12) **Patent Application Publication** (10) **Pub. No.: US 2004/0102939 A1****Ross**(43) **Pub. Date:****May 27, 2004**(54) **SIMPLIST YET PROCESS FOR DESCRIBING THE UNIVERSE**

(57)

ABSTRACT(76) **Inventor:** John R. Ross, Del Mar, CA (US)

Correspondence Address:
JOHN R. ROSS
PO BOX 2138
DEL MAR, CA 92014 (US)

(21) **Appl. No.:** 10/703,048(22) **Filed:** Nov. 6, 2003**Related U.S. Application Data**

- (63) Continuation-in-part of application No. 10/655,817, filed on Sep. 5, 2003.
 Continuation-in-part of application No. 10/436,286, filed on May 12, 2003.
 Continuation-in-part of application No. 10/251,577, filed on Sep. 21, 2002.
 Continuation-in-part of application No. 09/908,297, filed on Jul. 17, 2001.

Processes for describing and explaining all elements of the universe including photons, electrons, protons, neutrons, atomic nuclei, heat, temperature, magnetism and gravity. According to this model, the entire universe and everything in it from photons to electrons to protons to galaxies is comprised of nothing but a single type of elementary charged point particle. I call these "pointicles", "tronnies". A tronomie has no mass and no volume but it has a charge equal to +e or -e (i.e., about $+1.6 \times 10^{-19}$ coulomb or about -1.6×10^{-19} coulomb). Also, according to this model the only forces in the universe are Coulomb forces produced by these tronnies. Every tronomie possesses a Coulomb force field resulting from its charge that travels out spherically from the tronomie's position at the speed of light. Each tronomie is repelled by the force fields of tronnies with like charges and attracted by the force fields of tronnies with opposite charges. According to Coulomb's Law the force between charges is inversely proportional to the square of the distance between the charges and approaches infinity as the distance approaches zero. Each tronomie is repelled by its own

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Published application

Dialog



What is claimed is:

1. Godly powers are being used on planet Earth. For example, technology (i.e. Electronic and Medical) is being assisted by godly powers throughout the planet.

Godly powers could be used prior, during, and after godly product/procedure. For example;

Before—in the making of a device, like a micro-processor chip.

During—in the operation of a device, like an inkjet printer cartridge.

Afterwards—like gradual scar removal from breast implant surgery.

A magician might perform magic before, during, and after, for any given trick ("illusion").

2. There is a plan governing our existence and actions—God's plan.

3. Christopher Anthony Roller is the godly entity powering Earth with godly powers as stated in claim 1.

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International Class Codes

Dialog



SECTION A — HUMAN NECESSITIES

SECTION B — PERFORMING OPERATIONS; TRANSPORTING

SECTION C — CHEMISTRY; METALLURGY

SECTION D — TEXTILES; PAPER

SECTION E — FIXED CONSTRUCTIONS

SECTION F — MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING

SECTION G — PHYSICS

SECTION H — ELECTRICITY

Substantive issues resolved by Product

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International Class Codes

Dialog



- IPC's are indexed for every patent worldwide
- US examiners prefer US codes
- US codes will be going away; will probably be replaced by ECLA codes
- IPC's are useful for finding similar inventions
- IPC's are also useful to give a general indication of the development of an invention
- Look for a meshing of technology with the IPC

Substantive issues resolved by Product

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Negotiating background

Dialog



- I like to look up the inventors
 - Look up background on them (newspapers, doctoral dissertations, cited works, affiliations, etc.)
 - Their addresses are on the top sheet of the patent
 - Go to Google Maps and see what their house looks like

Address is approximate

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Negotiating background

Dialog



Address is approximate

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What can you do to strengthen a patent?

Dialog



- Continuation in part
 - Add new matter
 - Pendancy
- Certificate of correction
 - Minor corrections
 - USPTO can add major changes, but applicant is very limited to do so (Superior Fireplace)

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What can you do to strengthen a patent?

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- Reexamination
- Reissue
 - Can broaden claims
 - Must be done within two years of grant
- Talk with your attorney

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What you can do to strengthen a patent

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- Trademark
 - Indicates a possible product (commercialization)
 - More money invested
- Actual sales
 - Of the patent
 - Of products from the patent

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Summary

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- Check the breadth of the claims
 - Watch for exceptions
 - Okay to change under certain circumstances
- Compare claims with examples
- Check internal data
 - Citations on cover, both patent and NPL
 - Inventor, assignee
 - International classification code
 - Gut check

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Summary




- Check external data
 - Inpadoc legal status
 - PAIR
 - Citations
- Look for outside references
 - Articles
 - Trademarks
 - No references, give it some

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Determine the strength of this patent




United States Patent [19]
Strom

[11] **Patent Number:** **6,025,810**

[45] **Date of Patent:** **Feb. 15, 2000**

[54] **HYPER-LIGHT-SPEED ANTENNA**

[76] Inventor: **David L. Strom**, 1615 Geneva St.,
Aurora, Colo. 80010

[21] Appl. No.: **08/942,824**

[22] Filed: **Oct. 2, 1997**

Related U.S. Application Data

[60] Provisional application No. 60,028,204, Oct. 2, 1996.

[51] **Int. Cl.**⁷ **H01Q 1/32**

[52] **U.S. Cl.** **343/787; 343/711; 343/721;**
343/895

[58] **Field of Search** 343/711, 713,
343/721, 725, 787, 788, 895

[56] **References Cited**

U.S. PATENT DOCUMENTS

Primary Examiner—Don Wong

Assistant Examiner—James Clinger

Attorney, Agent, or Firm—Rick Martin

[57] **ABSTRACT**

A method to transmit and receive electromagnetic waves which comprises generating opposing magnetic fields having a plane of maximum force running perpendicular to a longitudinal axis of the magnetic field; generating a heat source along an axis parallel to the longitudinal axis of the magnetic field; generating an accelerator parallel to and in close proximity to the heat source, thereby creating an input and output port; and generating a communications signal into the input and output port, thereby sending the signal at a speed faster than light.

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Determine the strength of this patent




The following describes, in simple terms, what the present invention actually does. The present invention takes a transmission of energy, and instead of sending it through normal time and space, it pokes a small hole into another dimension, thus, sending the energy through a place which allows transmission of energy to exceed the speed of light.

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Determine the strength of this patent




I claim:

1. A method to transmit and receive electromagnetic waves comprising:
 - generating opposing magnetic fields each having a plane of maximum force running perpendicular to a longitudinal axis of the respective magnetic field;
 - generating heat from a heat source along an axis parallel to the longitudinal axis of the magnetic field;
 - generating an accelerator parallel to and in close proximity to the heat source, thereby creating an electromagnetic injection point; and
 - generating a communication signal into the electromagnetic injection point, thereby sending and receiving the communication signal at a speed faster than a known speed of light.

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Determine the strength of this patent

Dialog

First, you need to create a hot surface that is more than 1000 degrees Fahrenheit. Next, it requires a strong magnetic field. Then, you need an accelerator, followed by an electromagnetic injection point. For communications or data communication, you need 2 devices. Each device is connected to a transmitter and receiver. This allows electromagnetic energy to enter a dimension and to travel at speeds faster than the speed of light.

The magnetic fields are focused onto the heat generating device. The electromagnetic injection point is the plane generated by the two opposing magnetic fields.

It has been observed by the inventor and witnesses that accelerated plant growth can occur using the present invention.

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Thank you for your time

Ron Kaminecki

ron.kaminecki@dialog.com

+1-773-276-3725

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