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OFFICE OF PETITIONS

In re Application of :
Dirk VAN DEN BOOM et al. :
Application No. 10/888,359 :
Filed: July 9, 2004 :
Attorney Docket No. SEQ.001.P :

ON PETITION

This is a decision on the petition under 37 CFR 1.181(a)(3), filed February 21, 2006, for review of the refusal of Office of Initial Patent Examination to refund the petition fee submitted August 4, 2005 in the above-identified application.

The petition is **DENIED**¹.

BACKGROUND

On September 23, 2004 a Notice to File Missing Parts of Nonprovisional Application was mailed.

On November 24, 2004 the application became abandoned for failure to reply to the Notice to File Missing Parts of Nonprovisional Application.

On August 4, 2005 a Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) was filed along with a request that the \$750 petition fee be refunded as the Office committed an error by mailing the Notice to File Missing Parts of Nonprovisional Application to the wrong address.

On August 24, 2005 a decision was mailed dismissing the petition under 37 CFR 1.137(b) and refusing the request for refund.

On September 9, 2005 a renewed petition under 37 CFR 1.137(b) was filed.

On October 4, 2005 a decision was mailed granting the petition under 37 CFR 1.137(b).

On December 19, 2005 a letter was mailed refusing petitioners request for a refund of the petition fee.

In the instant petition, petitioner requests that the \$750 petition fee be refunded as the Office committed an error by mailing the Notice to File Missing Parts of Nonprovisional Application to the wrong address.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides that the Director shall charge:

On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

35 U.S.C. § 42(d) provides:

The director may refund any fee paid by mistake or any amount paid in excess of that required.

37 CFR 1.26(a) provides, in part, that:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollar or less unless a refund is specifically requested, and will not notify the payor of such amounts.

37 CFR 1.33(a) provides, in part, that:

When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing.

37 CFR 1.137(b) provides:

Unintentional. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

35 U.S.C. 133 provides:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

MPEP 403 provides:

PATENT APPLICATION FILED WITHOUT CORRESPONDENCE ADDRESS

In accordance with the provisions of 35 U.S.C. 111(a) and 37 CFR 1.53, a filing date is granted to a nonprovisional application for patent filed in the U.S. Patent and Trademark Office, if it includes at least a specification containing a description pursuant to 37 CFR 1.71 and at least one claim pursuant to 37 CFR 1.75, and any drawing referred to in the specification or required by 37 CFR 1.81(a). If a nonprovisional application which has

been accorded a filing date does not include the appropriate filing fee, or oath or declaration, the applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) in order to prevent abandonment of the application. If a provisional application which has been accorded a filing date does not include the appropriate filing fee, or the cover sheet, the applicant will be so notified and given a period of time within which to file the missing parts to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(l) in order to prevent abandonment of the application.

In order for the Office to so notify applicant, a correspondence address must also be provided by the applicant. For example, the address of the applicant's registered attorney or agent may be used as the correspondence address. If the applicant fails to provide the Office with a correspondence address, the Office will be unable to provide the applicant with notification to complete the application and to pay the surcharge as set forth in 37 CFR 1.16(e) for nonprovisional applications and 37 CFR 1.16(l) for provisional applications. In such a case, the applicant will be considered to have constructive notice as of the filing date that the application must be completed and the applicant will have 2 month from the filing date in which to do so before abandonment occurs.

The periods of time within which the applicant must complete the application may be extended under the provisions of 37 CFR 1.136. Applications which are not completed in a timely manner will be abandoned.

OPINION

The standard for review of the action or inaction of any employee or operation within the U.S. Patent and Trademark Office is whether that employee or operation acted in an arbitrary and capricious matter, such that the action or inaction was tantamount to an abuse of discretion. However, a review of the refusal to refund the petition fee in question fails to demonstrate any abuse of discretion.

The applicable statute, 35 U.S.C. 42(d), authorizes the Director to refund "any fee paid by mistake or any amount paid in excess of that required." Thus, the U.S. Patent and Trademark Office (USPTO) may refund: (1) a fee paid when no fee is required (i.e., a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r pats. 1943)(the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment, and not the underlying action). In the situation, as herein, in which an applicant takes an action "by mistake" (e.g., files a petition "by mistake"), the submission of fees required to take that action (e.g., a petition fee submitted with a petition) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). See Changes to Implement the Patent Business Goals, Notice of Proposed Rulemaking, 64 FR 53771, 53780 (October 4, 1999), 1228 Off. Gaz. Pat. Office, 15, 23 (November 2, 1999).

35 U.S.C. 41(a)(7) requires that the Director charge a fee of \$1500 on filing each petition for the revival of an unintentionally abandoned application for a patent. In this regard, there was no mistake relating to the payment itself. Petitioner is reminded that the use of "shall" appears in 35 U.S.C. 41(a) pertaining to the collection of fees upon the filing of a petition for the revival of an unintentionally abandoned application for a patent. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). That is, it is mandatory that the Director charge, and the applicant pay, the fees specified by statute upon presentation of a request for a service by the USPTO. See BEC Oressyre /Controls Corp. v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (N.D. Ind. 1974). As such, the petition fee was due when such was submitted to the USPTO on August 4, 2005, and was paid in the correct amount. Id. The language of the statute does not permit the Director any discretion with respect to charging the fees set forth therein. Id.

Furthermore, that petitioner may have erred in presenting the Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b) to the USPTO for this application does not warrant a finding that the payment was made "by mistake." Rather, the fee was owed at the time it was paid. As noted in 37 CFR 1.26(a), petitioner's change of purpose does not constitute a "mistake" in payment warranting refund of the fees previously paid. The payment of the fee automatically was due, by statute, when petitioner presented, rightly, or wrongly, the Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b). Thus, it is immaterial to the question of "mistake" in payment of the instant petition fee, that petitioner may have erred in submitting the aforementioned submission. Here, it is noted, that petitioner requested revival of the above-identified application under 37 CFR 1.137(b) and did not request any other form of relief.

Petitioner requests that the \$750 petition fee be refunded as the Office committed an error by mailing the Notice to File Missing Parts of Nonprovisional Application to the wrong address. Petitioner asserts that the correspondence address appears on the post card and on the Express Mailing receipt submitted with the application and thus, the agent's correct address was provided elsewhere in a clearly identifiable manner in any paper submitted with the application. Moreover, petitioner submits that the Office of Enrollment and Discipline had previously been provided with petitioner's correct address.

A thorough review of the application file reveals that none of the application papers contains a clearly identifiable correspondence address; therefore one can only speculate as to how a clerk at the USPTO may have obtained petitioner's previous address. Additionally, while petitioner may have provide a correct address on a return post card and Express Mailing receipt this "fugitive information" is not kept as part of the application file and thus, these documents are not considered to be papers submitted with an application filing. Moreover, neither a return post

card nor Express Mail receipt is clearly identifiable as a correspondence address for the application. Additionally, that petitioner filed a Change of Address for Registered Patent Attorneys and Agents, which form states "this address change is only for the roster of Attorneys and agents and will not change the address of any applications in the patent process" is immaterial to the issue at hand as this paper is not a change in correspondence address in accordance with 37 CFR 1.33(a) and MPEP 403. Therefore, there is no mistake on the part of the Office in the mailing of the Notice to File Missing Parts of Nonprovisional Application.

DECISION

A review of the record indicates that the Office of Initial Patent Examination did not abuse its discretion or act in an arbitrary manner in its December 19, 2005 treatment of the request for refund. The record establishes that the Office of Initial Patent Examination had a reasonable basis to support its findings and conclusion that petitioner is not entitled to have the petition fee refunded.

The petition is granted to the extent that the decision of the Office of Initial Patent Examination of December 19, 2005 has been reviewed, but is denied with respect to making any change therein. As such, the decision of December 19, 2005 will not be disturbed. The petition is **denied**. The petition fee will not be refunded.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



Charles Pearson
Director, Office of Petitions