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In re Application of :
Robert K. Peterson *et al.* :
Application No. 08/125,048 :
Filed: September 21, 1993 :
For: INTEGRATED CIRCUIT PACKAGING :
METHOD AND THE PACKAGE :

OFFICE OF PETITIONS
A/C PATENTS
ON PETITION

This is a decision on the request for reconsideration, filed December 19, 1997, which is being treated as a petition to withdraw the abandonment in the above-identified application, or revive the above-identified application, and reinstate the appeal in the above-identified application.

The petition to withdraw the abandonment in the above-identified application, or revive the above-identified application, and reinstate the appeal in the above-identified application is **DENIED**.

BACKGROUND

A Notice of Appeal was filed in the above-identified application on September 30, 1994, and a brief in support of the appeal was filed in the above-identified application on September 23, 1994. An examiner's answer was mailed on May 30, 1995. The examiner's answer indicated that. (1) claims 1 through 16 and 27 through 30 were withdrawn from consideration (pursuant to 37 CFR 1.142(b)); (2) claims 17 through 26 were allowed; and (3) claims 31 through 34 were unpatentable under 35 U.S.C. § 103 over Barker III (U.S. Patent No. 5,175,613) and Steffen (U.S. Patent No. 5,041,395).

A reply brief was filed in the above-identified application on June 19, 1995. The reply brief of June 19, 1995 was acknowledged in the Office communication of July 18, 1995, and the above-

identified application was forwarded to the Board of Patent Appeals and Interferences (Board) for a decision on the appeal.

Jay M. Cantor, petitioner's representative of record, filed a letter on April 14, 1997 in the above-identified application stating:

Applicants, through their attorney, hereby expressly abandon the subject application.

The appeal in the above-identified application was dismissed by Order of the Board mailed May 28, 1997, and the letter of express abandonment of April 14, 1997 was acknowledged in the Notice of Abandonment mailed June 3, 1997.

A first petition requesting reinstatement of the appeal and withdrawal of the abandonment was filed in the above-identified application on September 22, 1997. The petition of September 22, 1997 states, *inter alia*, that: (1) a final rejection was mailed in application No. 08/477,027, a continuation of the above-identified application, in which the only rejection was based upon provisional double patenting in view of the claims of the above-identified application; (2) a letter of express abandonment was filed in the above-identified application to overcome the provisional double patenting in application No. 08/477,027; and (3) a new final rejection was mailed on August 1, 1997 in application No. 08/477,027 containing rejection(s) of the claims based upon the prior art cited in the appeal in the above-identified application (see petition of September 22, 1997 at 2-3). A review of application No. 08/477,027 reveals: (1) a final Office action was mailed on March 27, 1997 containing a provisional rejection of claims 17 through 26 and 31 through 34 (all of the claims pending in application No. 08/477,027) on the basis of nonstatutory double patenting over the pending claims of the above-identified application and no rejection based upon prior art; and (2) a second final Office action was mailed on August 1, 1997 containing a rejection of claims 17 through 26 and 31 through 34 under 35 U.S.C. § 103 as being unpatentable over Barker III (U.S. Patent No. 5,175,613) and Steffen (U.S. Patent No. 5,041,395).

The petition of September 22, 1997 was treated as a petition under 37 CFR 1.182 and dismissed in the decision of November 24, 1997, which advised petitioners that any request to restore the above-identified application to pending status must be by way of a petition under 37 CFR 1.137(b) (see decision of November 24, 1997 at 2-4). The instant petition was filed in the above-identified application on December 12, 1997, and requests reconsideration of the decision of November 24, 1997.

STATUTE AND REGULATION

35 U.S.C. § (6) (a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark 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 Commissioner shall charge:

On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, \$820, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$78.

37 CFR 1.137(b)¹ 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

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

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.

37 CFR 1.138 provides that:

An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant and the assignee of record, if any, and identifying the application. An application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

37 CFR 1.181(a) provides that:

Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.182² provides that:

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing

² As amended effective December 1, 1997. See Changes to Patent Practice and Procedure, Final Rule Notice, 62 Fed. Reg. at 53196, 1203 Off. Gaz. Pat. Office at 121.

Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

OPINION

Petitioners argue that they expressly abandoned the above-identified application in reliance upon the absence of any rejection in application No. 08/477,027, other than a provisional double patenting rejection based upon the claims of the above-identified application. Petitioners specifically argue that: (1) a rejection of the claims of application No. 08/477,027 on the basis of provisional double patenting in view of the claims of the above-identified application required that the examiner be aware of the claims of the above-identified application; (2) 37 CFR 1.105 (now 37 CFR 1.104(b)) and MPEP 707.07 require that an examiner's action be complete as to all matters; (3) the examiner's failure to set forth a rejection based upon the prior art cited in the appeal in the above-identified application until the final Office action of August 1, 1997 is inconsistent with the requirements of 37 CFR 1.104(b) and MPEP 707.07; (4) petitioners' express abandonment of the above-identified application was in reliance on the examiner's actions in application No. 08/477,027, in that the absence of a prior art rejection (during the pendency of the above-identified application) implied that the claims of application No. 08/477,027 were considered allowable over the prior art (including the prior art cited in the appeal in the above-identified application). Petitioners invoke the Commissioner's authority under 37 CFR 1.183 to withdraw the abandonment and reinstate the appeal in the above-identified application.

37 CFR 1.138 provides that an application may be expressly abandoned "by filing a written declaration of abandonment signed by the attorney or agent of record " The letter of express abandonment of April 14, 1997: (1) identifies the above-identified application; (2) by written declaration expressly abandons the above-identified application; and (3) is signed by a

registered practitioner of record in the above-identified application. Therefore, the above-identified application became abandoned on June 3, 1997 (when the letter of express abandonment was recognized in the Notice of Abandonment of June 3, 1997) by operation of petitioners' filing of a proper letter of express abandonment on April 14, 1997.

Since the recognition in the Notice of Abandonment of June 3, 1997 of petitioners' letter of express abandonment of April 14, 1997 was appropriate and resulted in the abandonment of the above-identified application (*i.e.*, the above-identified application is properly held abandoned), the holding of abandonment in the above-identified application cannot be withdrawn pursuant to 37 CFR 1.181.

Petitioners' argument concerning the application of 35 U.S.C. § 47(a)(7) to the situation of the above-identified application is without merit. 35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (*i.e.*, to the revival of an abandoned application), however, it precludes the Commissioner from reviving the above-identified application.

The patent statute at 35 U.S.C. § 41(a)(7)³ authorizes the Commissioner to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional** as opposed to being unintentional or unavoidable." See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71 (emphasis added).

A standard principle of statutory construction is: *expressio unius est exclusio alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other

³ While 35 U.S.C. § 41(a)(7) sets forth the fees for petitions to revive abandoned applications, it is 35 U.S.C. § 41(a)(7) that sets forth the Commissioner's authority to revive an unintentionally abandoned application (without a showing that the delay was unavoidable). Thus, petitioners' assertion that 35 U.S.C. § 41(a)(7) "deals solely with fees" is incorrect.

remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Law 97-247 a specific scheme for the revival of abandoned applications (i.e., the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., 37 CFR 1.182 or 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, and 151. See Morganroth v. Ouigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989) (the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

Finally, that the provisions under which an applicant may expressly abandon an application are solely a creation of the rules of practice does not affect the status of an application in which an applicant has filed and the Office has recognized a declaration of abandonment as an application that is abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120. The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See In re Morganroth, 6 USPQ2d 1802, 1803 (Comm'r Pats. 1988). In addition, under 35 U.S.C. § 120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, and (3) proceedings in the application may be terminated. Id. When the applicant files and the PTO recognizes a written declaration that the applicant seeks to discontinue prosecution, proceedings in that application are terminated no later than the date of such recognition. Where proceedings in an application are terminated in a manner which does not result in an allowance of the application, such application is no longer pending but is abandoned Cf. MPEP 1214.06 & 1216.01.

Thus, while the patent statute does not provide for express abandonment of an application, an application becomes abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120 by operation of the filing by the applicant and recognition by the PTO of a written declaration that the applicant seeks to discontinue prosecution in (or expressly abandon) an application. That is, while the Office need not have promulgated rules and procedures

for the acceptance of a written declaration of express abandonment, by doing so, an application will become abandoned within the meaning of 35 U.S.C. §§ 41(a)(7) and 120 upon recognition of a written declaration of express abandonment.

Therefore, any petition that the above-identified application be revived or otherwise restored to pending status must be authorized by 35 U.S.C. §§ 41(a)(7), 111, 133, or 151 and pursuant to their implementing regulation (37 CFR 1.137).⁴

35 U.S.C. §§ 111 or 151 obviously do not apply in instances in which an applicant has filed a letter of express abandonment. In addition, 35 U.S.C. § 133 authorizes the Commissioner to revive an application abandoned for failure to prosecute in instances in which it is shown to the satisfaction of the Commissioner that the delay in prosecution was unavoidable. 35 U.S.C. § 133 does not authorize the Commissioner to revive an application abandoned by express or formal abandonment. See Ex parte Hirth, 1908 Dec. Comm'r Pat. 240 (1908). Thus, in instances in which an applicant has filed a letter of express abandonment, the revival of such

⁴ Assuming, *arguendo*, that the Commissioner is authorized to grant the requested relief, 37 CFR 1.183 authorizes the waiver of a requirement of the rules of practice only when the following conditions are met: (1) the situation is extraordinary; and (2) justice requires the waiver. See *Issidorides v. Ley*, 4 USPQ2d 1861, 1861-62 (Comm'r Pats. 1985). The Office recommends that an applicant file a terminal disclaimer under 37 CFR 1.321 to overcome a nonstatutory double patenting rejection. See MPEP 804.02(II). The Office does not recommend the intentional abandonment of the earlier filed application to overcome a double patenting rejection. Since petitioners chose to overcome the double patenting rejection in application No. 08/477,027 by the intentional and express abandonment of the above-identified application (rather than by filing a terminal disclaimer in application No. 08/477,027), this is not a situation in which "justice requires" that petitioners be permitted to revive the above-identified application. In any event, resort to 37 CFR 1.183 is inappropriate when the rules of practice already provide an avenue for obtaining the relief sought. See *Cantello v. Rasmussen*, 220 USPQ 664, 664 (Comm'r Pats. 1982). As the rules of practice provide petitioners with a means to pursue a patent (via application No. 08/477,027) on the claims that were before the Board in the above-identified application, the circumstances of the above-identified application simply do not present an "extraordinary situation" in which "justice requires" the extraordinary relief requested by petitioners. See 37 CFR 1.183.

application must be under and authorized by 35 U.S.C. § 41(a)(7), in that the filing of such letter of express abandonment must have been unintentional for the PTO to be authorized to revive the application.

Accordingly, any petition to revive an expressly abandoned application must be under 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).⁵

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989)

The showing of record is that petitioners, through their representative, chose to file a letter of express abandonment in the above-identified application for the purpose of overcoming a provisional double patenting rejection in application No. 08/477,027. The filing of a letter of express abandonment is viewed as an act of deliberation, intentionally performed. See MPEP 711.01. An application abandoned by a deliberate decision not to continue prosecution of such application is not an "unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(a)(7). See Application of G, 11 USPQ2d at 1380.

While petitioners question the definition of the term "unintentional" and argue that there was no deliberate decision not to continue prosecution of the above-identified application

⁵ Notwithstanding that petitioners were advised to file a petition under 37 CFR 1.137(b) containing the items required by 37 CFR 1.137(b)(1)-(4) in the decision of November 24, 1997, petitioners chose to simply argue that 35 U.S.C. § 41(a)(7), which provides the statutory authority for 37 CFR 1.137(b), was clearly "inapposite in the present situation." See petition of December 12, 1997 at 3. In addition to not meeting the threshold requirement that the above-identified application be "an unintentionally abandoned application" (35 U.S.C. § 41(a)(7)), the instant petition also lacks the petition fee (37 CFR 1.137(b)(2) and 1.17(m)) and terminal disclaimer (37 CFR 1.137(b)(4)) required by 37 CFR 1.137(b).

but for the improper action of the examiner, this argument only addresses why petitioners expressly abandoned the above-identified application; it does not cause petitioners' prior intentional abandonment of the above-identified application to become an unintentional abandonment.

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office, or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival. Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention (a submarine application) is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to [37 CFR] 1.137.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59, 1203 Off. Gaz. Pat. Office at 86 (citations omitted).

Therefore, petitioners' contentions concerning either the correctness or propriety of the examiner's actions in application No. 08/477,027 or the new rejections of the claims in application No. 08/477,027 that occurred subsequent to the abandonment of the

above-identified application does not cause petitioners' intentional abandonment of the above-identified application to be considered an unintentional abandonment within meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).

As this application was intentionally abandoned, a course of action deliberately chosen by petitioners, the abandonment of this application cannot reasonably be considered to have been unintentional within meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). Accordingly, petitioner cannot establish to the satisfaction of the Commissioner that the above-identified application was "an unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(a)(7). See Application of G, 11 USPQ2d at 1380.

CONCLUSION

For the above-stated reasons, the petition to withdraw the abandonment in the above-identified application, or to revive the above-identified application, is **denied**. Since the above-identified application will **not** be revived and remains abandoned, the petition to reinstate the appeal in the above-identified application is **denied**.

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

The application file is being forwarded to Files Repository.



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