



Paper No. 33

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ON PETITION

In re Application of
Hitoshi Onodera
Application No. 08/148,832
Filed: 5 November, 1993
Attorney Docket No. 39193-PCT-US

This is a decision on the Second Request for Reconsideration of the Group Director's refusal to withdraw the holding of abandonment, treated as a petition under the provisions of 37 C.F.R. §1.181,¹ filed 3 April, 1997, and supplemented on 20 August, 1999.²

The Office regrets the delay in addressing this matter.

This application became abandoned on 28 January, 1996, for failure to file timely a proper brief on appeal.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

- (a) 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. * * *
- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.
- (c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.
- (d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *
- (f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

² Petitioner's Counsel, Ernest A. Beutler (Counsel), offered during a telephone conference on 19 August, 1999, *inter alia*, to provide "several" examples of occasions in which the Office accepted appeal briefs that reflected his interpretation of the "change" he asserts has occurred in the rules as to the content and form of briefs filed on appeal. On 20 August, 1999, Counsel faxed to the Office a single one-page decision (dated 2 February, 1998) stating no facts with which to compare or contrast the instant question.

Petitioner also included in that faxed material a letter authorizing the charge against Deposit Account No 11-1410 of the petition fee (\$130.00 under 37 C.F.R. §1.17(h) or (i)). That charge has been assessed.

BACKGROUND

The series of events that resulted in the abandonment is more involved than the statement of the result implies, and it is as follows:

- Concurrently with the Notice of Appeal, filed 18 August, 1995, Petitioner sought via petition to the Group Director relief from the finality of the Examiner's Office action of 16 May, 1995.
- While denying the relief sought in the decision of 27 November, 1995, the Group Director did reset until two (2) months thereafter (i.e., 27 January, 1996) the due date for Petitioner's Brief.
- Petitioner filed his brief on 22 January, 1996.
- Upon review of the brief, on 26 March, 1996, the Examiner:

--held the brief to be informal in that it did not comply with the requirements of 37 C.F.R. §1.192(c); specifically, the Examiner stated:

1. The brief includes a statement that claims in the same group stand or fall together, therefore the claims in different groups do not stand or fall together, but fails to present reasons in support thereof as required under 37 C.F.R. [§]1.192(c)(7). * * *

2. The brief does not contain a concise explanation of the invention defined in the claims involved in the appeal, which refers to the specification by page and line number, and to the drawing, if any, by reference characters as required by 37 C.F.R. [§]1.192(c)(5). * * *

--gave Petitioner one (1) month within which to cure the deficiency; and

--informed Petitioner that:

If a new brief that fully complies with 37 C.F.R. [§]1.192(c) is not timely submitted, the appeal will be dismissed as of the date of the expiration of the period provided by 37 C.F. R. [§]1.192(a).

No extension of this ONE MONTH TIME LIMIT may be obtained under either 37 C.F.R. [§]1.136(a) or (b) but the original TWO-MONTH period for filing the brief may be extended under 37 C.F.R. [§]1.136(a) for up to SIX MONTHS from the date of the Notice of Appeal.

- On 15 April, 1996, Petitioner filed an "Amendment to Appeal Brief"--stating therein in pertinent part:

Enclosed herewith is a corrected brief, identifying Claim 23 as being argued separately, and not standing or falling with any other grouping of claims.

As to the other objections [to the brief] raised by the Examiner, they are not being corrected because it is believed that the Examiner's rejection is not consistent with the [Manual of Patent Examining Procedure] M.P.E.P., the rules, or the practice of the Board.

Petitioner cited no statute, regulation, M.P.E.P. provision or case law in support of this position.

- On 26 September, 1996, Petitioner filed a status request, stating therein that a conversation with Office staff indicated that the instant case was held abandoned, but Petitioner had received no notice to that effect, and--as of that writing--Petitioner had received no response to the amended brief filed 15 April.
- On 24 October, 1996, the Examiner forwarded to Petitioner the Notification of Defective Notice of Appeal or Defective Brief, and held that:
 - the appeal was dismissed because defects previously noted were not corrected, and
 - the application contained no allowed claims and was deemed abandoned.
- Notice of Abandonment was mailed on 14 November, 1996.³
- On 22 November, 1996, Petitioner filed a petition requesting that the Commissioner:
 - exercise supervisory authority,
 - direct the Examiner to withdraw the 24 October notice, and
 - send the case forward to the Board of Patent Appeals and Interferences (the Board) for the Board to determine the sufficiency of the brief.

³ Petitioner filed on 9 December, 1997, a Reply to the Notice of Abandonment: acknowledging receipt of the notice and confirming that a petition previously had been filed seeking intervention by the Commissioner, but taking no other action. That inaction apparently ignored the explicit statement of the regulations set forth at 37 C.F.R. §181(f), and provided above at Fn 1, which cautions that the filing of a petition under its provisions stays no proceedings.

Again, Petitioner cited no statute, regulation, provision of the M.P.E.P. or case law in support of this position.

- On 20 December, 1996, the Group Director denied the petition, stating:

A Notice of Defective Brief was sent to [Petitioner] for failure to comply with 37 C.F.R. [§1.192(c)(5)] which requires, "A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters."

Petitioner contends that the Patent Office changed the rules concerning this requirement and for that reason, [Petitioner] did not comply with this part of the rule.

In view of the fact that the Rule **has not** changed and the examiner has specifically noted this deficiency in the Brief, the petition is **DENIED**. As such, there will be no withdrawal of either the Notice of Defective Brief or Holding of Abandonment. (Emphasis, the original.)

- On 27 January, 1997, the Petitioner filed a Request for Reconsideration

For the third time, Petitioner cited no statute, regulation, provision of the M.P.E.P. or case law in support of this position.

- On 26 February, 1997, the Group Director denied the petition for reconsideration, stating:

In short, whatever [Petitioner's] perception of the history of appeal practice is, the examiner was bound to follow the requirements of 37 C.F.R. §§1.192(c) and (d), and was without authority to waive these requirements. The examiner followed these requirements precisely. The record contains no facts or arguments which would support a holding that the examiner acted in an arbitrary or capricious manner, or in any way abused his authority, in dismissing the appeal in the application. The examiner did not act in an arbitrary or capricious manner, or in any way abuse his authority by holding the application to be abandoned. It appears that [Petitioner's] remedy in this case is to petition to revive the application under 37 C.F.R. §1.137.

- As noted above, Petitioner filed on 3 April, 1997, the pending, action, entitled "Second Request for Reconsideration," and states:

It is understood that the M.P.E.P. gives the Examiner original jurisdiction over considering the sufficiency of the brief. However, the Board of Appeals has acted and has had the rules changed in order to eliminate a process which created unnecessary paperwork for them and unnecessary material to read. * * *

* * * [W]hen the rules were changed some time ago in connection with the requirement to have a description of the invention, this was done to avoid the practice which was followed by most attorneys up to that time. This was to submit in the brief a paraphrasing of the originally filed specification. The Board specifically requested the rules to be changed to stop this practice.

The Examiner's request is to in effect reinstate it. * * *

This is now the fourth occasion on which Petitioner argues a change in the rules before the Board. Nonetheless, to date Petitioner has:

--cited no statute, regulation, provision of the M.P.E.P. or case law⁴ in support of this position;

--ignored the Group Director's guidance in advancing the matter to resolution; and

--ignored the rules of practice promulgated pursuant to the Administrative Procedure Act, 5 U.S.C. §553 (1999), and set forth at 37 C.F.R. §1.192 (appeals to the Board), §1.181 (appeals to the Commissioner), and §1.137⁵ (revival of abandoned applications).

⁴ On 20 August, 1999, Counsel submitted via FAX a copy of a one-page decision dated 2 February, 1998 (the 1998 decision), of record in another application. (Paper No. 33, *in globo*, includes a one-page Note to File, a one-page transmittal and the one-page 1998 decision in an unrelated matter.) According to the one-page transmittal letter that accompanied the 1998 decision, the decision is intended to support Counsel's position herein.

The 1998 decision is an action of a Supervisory Patent Examiner (SPE) in another Art Unit, and states that it is the response to a request for reconsideration, which request "indicates that the appeal brief [in the unrelated application] complies with the Rules and that rewriting the summary would be a rehash of information already provided." Having made that summary recital of the request, the 1998 decision grants the request in that unrelated matter, vacates a Notice of Non-Compliance, and directs an Examiner's Answer. There is no further statement of fact or law upon which the decision is based.

The 1998 decision, which refers only to an "appeal brief" (without further detail) in another matter (without further detail) when neither that brief nor that matter are of record herein, provides no support to Counsel, his Petitioner, nor their position herein.

⁵ The regulations at 37 C.F.R. §1.137 provide:

§1.137 Revival of abandoned application or lapsed patent.

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

STATUTES, REGULATIONS, AND ANALYSIS

The provisions of 35 U.S.C. §6(a) charge the Commissioner to "superintend or perform all duties required by law respecting the granting and issuing of patents," and authorize him to "establish regulations, not inconsistent with the law, for the conduct of proceedings in the . . . Office."

In furtherance of that statutory mandate and grant of authority, the Commissioner has promulgated the regulations, set forth at 37 C.F.R. Part I, for the conduct of proceedings within the Office.

The "rule change"

Petitioner asserts, without specification or definition, that the rules--with regard to the statement or explanation of the invention, and the reference to specification by page, line, and drawing reference character--have changed.

At present the statement of the rule in question is set forth at 37 C.F.R. §1.192 (c)(5), which provides that the brief, if filed by a registered practitioner, shall contain "under appropriate headings and in the order indicated":

(5) *Summary of invention.* A concise explanation of the invention defined in the claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.

(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 for 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 required by 37 C.F.R. §1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(t)) required pursuant to paragraph (c) of this section.

(b) *Unintentional.* Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). A grantable petition filed under the provisions of 37 C.F.R. §1.137(b) 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 37 C.F.R. §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 37 C.F.R. §1.137(b) 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 set forth in 37 C.F.R. §1.20(d)) required pursuant to paragraph (c) of this section.

(c) In a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995, any petition to revive pursuant to this section must be accompanied by a terminal disclaimer and fee as set forth in §1.321 dedicating to the public a terminal part of the term of any patent granted on any continuing application that contains a specific reference under 35 U.S.C. 120, 121, or 365(c) to the application for which revival is sought. The provision of this paragraph do not apply to lapsed patents.

(d) Any request for reconsideration or review of a decision refusing to revive an abandoned application or lapsed patent upon petition filed pursuant to this section, to be considered timely, must be filed within two months of the decision refusing to revive or within such time as set in the decision. Unless a decision indicates otherwise, this time period may be extended under the provisions of §1.136.

(e) A provisional application, abandoned for failure to timely respond to an Office requirement, may be revived pursuant to this section so as to be pending for a period of no longer than twelve months from its filing date. Under no circumstances will a provisional application be regarded as pending after twelve months from its filing date,

The next prior statement of specification of the *Summary of invention* occurred in 1995, and the nature of the change is that it was renumbered to item (5) from item (3).⁶

And the regulation had exactly that formulation and location from 1988⁷ to 1995.

The appeal to the Commissioner

In enacting 35 U.S.C. §133,⁸ Congress directed the Commissioner to oversee a timely prosecution process.

The regulations at 37 C.F.R. §1.135⁹ set forth the effects of the failure to reply properly within the time allowed.

Abandonment takes place by operation of law, *inter alia*, for one's failure to reply properly and/or timely to an Office action.¹⁰

More than 35 years ago the Court of Customs and Patent Appeals warned practitioners in Lorenz v. Finkl.¹¹

- not only that "ordinary prudence" demands that they take "appropriate action" as

⁶ See: 60 Fed. Reg. 14488, 17 March, 1995, effective 21 April, 1995.

⁷ See: 53 Fed. Reg. 23734, 23 June, 1988, effective 12 September, 1998.

Prior to that amendment, the regulations at 37 C.F.R. §1.192 provided:

§1.192 Appellant's brief.

(a) The appellant shall, within 2 months from the date of the notice of appeal under §1.191 in a application, reissue application, or patent under reexamination, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate. The brief must be accompanied by the requisite fee set forth in §1.17(f) and must set forth the authorities and arguments on which the appellant will rely to maintain the appeal. The brief must include a concise explanation of the invention which should refer to the drawing by the reference characters, and a copy of the claims involved. * * * (Emphasis supplied.)

⁸ 35 U.S.C. §133 Time for prosecuting application.

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 Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁹ §1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under §1.134 and §1.136, the application will become abandoned unless an Office action indicates otherwise.
(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. * * *

¹⁰ See also: Krahn v. Commissioner, 15 USPQ2d 1823 (E.E. Va. 1990).

¹¹ Lorenz v. Finkl, 142 USPQ 26, 27-28 (CCPA 1964).

directed and determined by the Examiner standing in the shoes of the Commissioner, but

- also that practitioners disregard this warning at the peril of abandonment to their client's applications.

Here the regulations at 37 C.F.R. §§1.192(c) and (d) specify the requirements Petitioner and Counsel's brief must satisfy. On multiple occasions the Examiner and his Group Director have directed Petitioner and Counsel's attention to the fact that their brief fails to satisfy the regulatory requirements. Yet, Petitioner and Counsel steadfastly continue to ignore the guidance and directives of the Examiner and Group Director.

While the Commissioner has authority under 37 C.F.R. §1.183¹² to waive the rules in the interest of justice, Petitioner not only has made no showing that justice would be served in this regard,¹³ Petitioner has made no effort to make such a showing.¹⁴

Rather than articulate with some specification, demonstrate with a comparison, or illustrate with contrasting examples the changes he asserts exists in the rules, Petitioner instead has elected to state without support the rightness of his position and wrongness of the Examiner's.

While 37 C.F.R. §1.181 mandates no particular form for a petition to the Commissioner, it does require that one file a petition, a memorandum in support—whether separate or incorporated into the petition—and a specification of facts with affidavits or declaration and exhibits supporting those facts.

If Petitioner's Counsel, without further detail, fails to provide these materials in support of his client's position, one is compelled to conclude that Counsel, for whatever reason, has chosen not to comply. And the actions or inactions of Counsel must be imputed to Petitioner, who hired Counsel to represent him.¹⁵

And, as noted below, Counsel apparently ignored the Group Director's February 1997

¹² The regulations at 37 C.F.R. §1.183 provide:

§1.183. Suspension of the rules.

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). (Emphasis supplied.)

¹³ The failure of a party's attorney to take a required action does not create an extraordinary situation. Moreover, the neglect of a party's attorney is imputed to that party and the party is bound by the consequences. See Huston v. Ladner, 973 F.2d 1564, 23 USPQ2d 1910 (Fed Cir. 1992); Herman Rosenberg and Parker-Kalon Corp. v. Carr Fastener Co., 10 USPQ 106 (2d Cir. 1931).

¹⁴ The failure to show extraordinary situation warranting suspension of the rules fails to satisfy requirements of 37 C.F.R. §1.183. In re Sivertz, et al., 222 USPQ 617 (Comm'r Pats. 1985).

¹⁵ Link v. Wabash Railroad Co., 370 U.S. 626, 633-634, 82 S.Ct. 1386, 1390-91 (1962).

suggestion that Counsel consider filing a petition under the provisions of 37 C.F.R. §1.137(a) or (b).¹⁶

The question to be answered herein, therefore, is one as to the reasonableness of the action of the Group Director--i.e., was she arbitrary and capricious in her action(s).¹⁷

The record fails to demonstrate that the Group Director has been arbitrary, capricious or otherwise abused her discretion herein. Rather, the record demonstrates the Group Director's continuing patience in the face of Counsel's abject refusal to consider any position save his own as possibly proper in the premises.

Moreover, the steadfast refusal of Petitioner and Counsel either to:

- follow the directives of the Examiner and Group Director, or
- make a showing why the directives of the Examiner and Group Director are in error,

is illustrative of the failure of Petitioner and Counsel to demonstrate even the minimum diligence required of them to support the reversal of the Group Director's decisions of 20 December, 1996, and 26 February, 1997, or otherwise direct the withdrawal of the holding of abandonment.¹⁸

CONCLUSION

The facts herein require that the Office follow the teachings of Lorenz and Krahn, *supra*. Withdrawal of the holding of abandonment, therefore, is not proper

Therefore, the petition for reconsideration is granted to the extent that this review has been made and rendered.

¹⁶ The test set forth in Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887), is one of diligence: In the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. See also: Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

Moreover, it is the practice of the Office--exemplified by the statement of the Group Director in her decision of 26 February, 1997--to suggest that a petitioner consider filing, alternatively as might be appropriate, a petition under the provisions of 37 C.F.R. §1.137(a) or (b). However, the Petitioner's clear election to ignore the caveat of 37 C.F.R. §1.181(f)--"[t]he mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings"--may well preclude obtaining relief under those regulations nearly four years after abandonment and almost three years after Petitioner acknowledged receipt of the Notice of Abandonment.

¹⁷ In 1947 Congress enacted the Administrative Procedure Act (APA), 5 U.S.C. §552 (1994), inter alia, to "...hold unlawful and set aside agency action, findings, and conclusions found to be...arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law..." (*Staff of Sen. Comm. On the Judiciary, 79th Congress, Administrative Procedure Act, Legislative History 1944-46 (1946)* (APA Legislative History, at 2163). For further discussion of the history of the test, see: Dickinson v. Zurko, et al., 119 S.Ct. 1816 (1999).

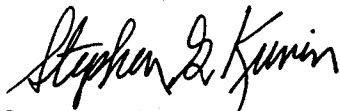
¹⁸ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

DENIED, and, therefore, the refusal of the Group Director to withdraw the holding of abandonment is **affirmed**.

As noted above, Petitioner and Counsel heretofore have ignored the Group Director's suggestion that they consider filing a petition under the provisions of 37 C.F.R. §1.137(a) or (b). Petitioner and Counsel hereby are placed on notice that they have three (3) months from the date of this decision in which to file a petition citing and satisfactorily evidencing unavoidable or unintentional delay under 37 C.F.R. §1.137(a) or (b), or be deemed to have waived the right to so plead. The filing requirements are set forth at Fn. 5, above.

The application file is being forwarded to Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Attorney John J. Gillon, Jr. at (703) 305-9199.



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