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In re Application of
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Application No. 08/276,674
Filed: July 19, 1994
Attorney Docket No. N/A

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OFFICE OF PETITIONS
A/C PATENTS
DENIAL PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a), filed March 20, 2001, to revive the above-identified application.

The petition is **denied**.¹

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed November 12, 1997, which set a shortened statutory period for reply of three (3) months. No extensions of time having been obtained pursuant to 37 CFR 1.136(a), this application became abandoned on February 13, 1998. A Notice of Abandonment was mailed on August 18, 1998.

Petitioner's October 9, 1998 petition to revive under 37 CFR 1.137(a) was dismissed on August 10, 1999 because petitioner failed to submit a proper reply and failed to set forth an adequate showing that the entire delay in replying to the final Office action was unavoidable.

Petitioner's September 30, 1999 petition to revive under 37 CFR 1.137(a) was dismissed on May 24, 2000 because, **for the second time**, petitioner failed to submit a proper reply and failed to set forth an adequate showing that the entire delay in replying to the final Office action was unavoidable.

Petitioner's renewed petition, filed July 3, 2000, was dismissed on February 5, 2001 because, **for the third time**, petitioner failed to submit a proper reply and failed to set forth an adequate showing that the entire delay in replying to the final Office action was unavoidable.

¹ Petitioner is advised that this is a final agency action. See MPEP § 1002.02.

STATUTE AND REGULATION

35 U.S.C. § 133 states that:

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.

37 CFR 1.113 states in pertinent part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objections to form.

37 CFR 1.116 states that:

(a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §

1.198, or to carry into effect a recommendation under § 1.196.

37 CFR 1.135 states in pertinent part:

(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.

37 CFR 1.137(a) provides:

Unavoidable. Where the delay in reply was unavoidable, 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(l);
- (3) A showing to the satisfaction of the Commissioner 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 unavoidable; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

ANALYSIS

Petitioner asserts that his reply to the November 12, 1997 final Office action was received in the Office on February 11, 1998. Therefore, petitioner contends that a reply was timely filed. In support, petitioner proffers two Receipts for Certified Mail. One receipt is date stamped February 11, 1998 by the PTO Mail Center.

The showing of record does not show that the delay in this case was unavoidable within the meaning of 35 USC 133 and 37 CFR 1.137(a).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the

outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

To prevail under an unavoidable standard petitioner must prove two things: 1) the amendment was timely filed and 2) the amendment *prima facie* placed the application in condition for allowance.

Petitioner Has Not Proved the Amendment Was Timely Filed

While petitioner has provided a Return Receipt Service mail receipt with a PTO Mail Center stamp showing February 11, 1998 as the date received, the Office has no record of receiving the actual amendment. The Office has no way of knowing exactly what was mailed in the envelope. The weight of the envelope does not prove what was inside it. The contents of the envelope could have been any papers. There is no itemized proof that the reply at issue was in that envelope. The Receipt for Certified Mail does not show *what* was in the package. All it shows was that \$3.92 worth of paper was mailed. The tracking number with the PTO stamp only shows that package arrived at the PTO. It does not prove *what* was in the package.

As explained in the February 5, 2001 dismissal, petitioner did not use any of the three officially recognized ways to send papers to the Office.² Therefore, petitioner cannot provide the Office with the only evidence it will recognize. **Because petitioner cannot prove the amendment was timely filed, petitioner cannot prove the delay was unavoidable.**

Regarding the request that the Office provide PTO Mail Center records for items received on February 11, 1998, petitioner is advised that it is petitioner's obligation to prove his own diligence. The Office will not provide evidence to bolster petitioner's case.

Petitioner's failure to file the February 11, 1998 reply at issue in compliance with 37 CFR 1.8 or 1.10 precludes a finding that the delay was unavoidable. A "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the PTO, as well as preserve adequate evidence of such filing, a delay

² When the Office has no record of getting papers on a specific date, there are only **three ways** to get the Office to recognize receipt on that date. -- (1) a copy of the document with an affixed certificate of mailing (See 37 CFR 1.8), (2) a copy of an Express Mail label and a copy of the document that contains a reference to the express mail number (37 CFR 1.10), or (3) an itemized postcard receipt with a PTO stamp showing the date received.

caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute "unavoidable" delay. See Krahn v. Commissioner, 15 USPQ2d 1823, 1825, (E.D. Va 1990); see also MPEP 711.03(c)(III)(C)(2).

Petitioner has not shown that adequate provisions were made for the careful handling of Office actions in order to ensure a timely response thereto. A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

The Amendment Did Not Place This Application in *Prima Facie* Condition for Allowance

Even if petitioner could prove that the amendment reached the Office on February 11, 1998, petitioner still has not provided the Office with a **proper** reply. After a final action, there are only four possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, or (4) an amendment after final that makes the case ready for issuance. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in prima facie condition for allowance.

Petitioner has submitted two amendments after final, but both have failed to eliminate all of the Examiner's objections and rejections. Petitioner should note that Examiner Hua wrote, "[T]he applicant has not fully responded to the above said Final Official action..." in the Advisory Opinion of July 10, 1998. Petitioner had only one chance to submit a proper Amendment After Final. Petitioner cannot continue arguing with the Examiner after final Office action by filing additional Amendments After Final. The Advisory Opinion does not restart the prosecution of the application. The post-final rejection proposal of amendments does not obligate the Office or examiner to provide an applicant with a new time period or time limit in which to provide a complete response under 37 CFR 1.113.

The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

In the last dismissal, mailed February 5, 2001, petitioner was put on notice that no further after final amendments would be considered. Despite this warning, petitioner's March 20, 2001 filing includes "further explanation" of the February 11, 1998 amendment after final. This "further explanation" is just another amendment after final. It does not matter what petitioner calls it. It is yet another amendment after final, and as such, it will not be considered. Therefore, petitioner still has not provided a proper reply.

In summary, petitioner has not shown that the delay in responding to the November 12, 1997 Office action was unavoidable. Petitioner has not proved the amendment was timely filed. Even if petitioner could prove the reply was timely filed, the reply was not proper because it did not place the application in *prima facie* condition for allowance.

OPINION

The decision of February 5, 2001 has been reconsidered, but for the reasons given in the previous decision and those noted above, the delay in this case has not been shown to have been unavoidable within the meaning of 35 USC 133 and 37 CFR 1.137(a).

Accordingly, the application will not be revived under the provisions of 35 USC 133 and 37 CFR 1.137(a), and the case remains abandoned.

Nevertheless, petitioner may wish to *promptly* seek revival under the provisions of 35 USC 41(a)(7) and 37 CFR 1.137(b), as this decision does not prevent petitioner from seeking revival under the less stringent "unintentional" standard. The filing of that petition can not be intentionally delayed. While petitioner indicates that the \$620 petition fee is forthcoming, as it has not been received, the merits of the petition under 37 CFR 1.137(b) can not be addressed unless and until the fee required by law is submitted herein. The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b). **If petitioner chooses to file additional Amendments After Final, intentional delay may be ascribed to petitioner and this application may never be revived.**

Petitioner is required to file either a continuing application under the terms set forth in 1031 OG 11 (Official Gazette of June 14, 1983), a 37 CFR 1.129(a) submission as his reply, or a Notice of Appeal as the reply in a petition to revive under an unintentional standard.

This abandoned file is being forwarded to the Files Repository.

Telephone inquiries related to this decision should be directed to Petitions Attorney
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