



Paper No. 15

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OFFICE OF PETITIONS

**ON SECOND RENEWED
PETITION**

In re Application of :
Yokov Altshuler :
Application No. 09/210,463 :
Filed: December 12, 1998 :
Title: ADJUSTABLE PENILE :
CONSTRUCTOR :

This is a decision on the second renewed petition under 37 CFR 1.137(a), filed June 2, 2001, to revive the above-identified application.

The second renewed petition is **DENIED**.

BACKGROUND

The record reflects that on:

- December 12, 1998, petitioner filed the application herein;
- March 13, 2000, a "Notice of Allowance and Issue Fee Due", which set forth a statutory period for reply of three months from its mailing date, was mailed to petitioner;
- March 13, 2000, a "Notice of Allowability", which set forth a shortened statutory period for reply of three months from its mailing date was mailed to petitioner and informed petitioner that extensions of time for reply were available pursuant to 37 CFR 1.136(a);
- October 16, 2000, a "Notice of Abandonment" indicating that the above-cited application had become abandoned because new formal drawings were not received within the allowable period as required by the "Notice of Allowability";
- November 6, 2000, correspondence was received from petitioner indicating that the new formal drawings were mailed on June 10, 2000, and that petitioner could not mail the drawings prior to that date because of petitioner's poor health and that such delay in mailing the drawings was unavoidable;
- November 6, 2000, petitioner filed a "Petition to Revive" pursuant to 37 CFR 1.137(a) along with a "Declaration" in support of the petition, copies of medical bills, and new formal drawings;
- April 2, 2001, the "Petition to Revive" was dismissed because the required petition fee was not remitted and because petitioner failed to demonstrate 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 was unavoidable;

- April 23, 2001, a renewed petition pursuant to 37 CFR 1.137(a) was filed along with additional medical bills;
- May 9, 2001, the renewed petition pursuant to 37 CFR 1.137(a) was dismissed because the required petition fee was not remitted and because petitioner failed to demonstrate 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 was unavoidable;
- June 2, 2001, a second renewed petition, which is the subject of this decision, was filed along with a "Medicare Summary Notice";
- September 14, 2001, a facsimile letter was filed by petitioner along with a letter, dated September 4, 2001, from petitioner's treating physician.

STATUTES AND REGULATIONS

35 USC 41(a)(7) states that the Director shall charge the following fee:

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, \$1,240, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.00.

35 USC 41(h)(1)

Fees charged under subsection (a) or (b) shall be reduced by 50 percent with respect to their application to any small business concern as defined under section 3 of the Small Business Act, and to any independent inventor or nonprofit organization as defined in regulations issued by the Director.

37 CFR 1.134

An Office action will notify the applicant of any non-statutory or shortened statutory period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, the maximum period of six months is allowed.

37 CFR 1.135(a)

If an applicant of a patent application fails to reply within the time period provided under 37 CFR 1.134 and 37 CFR 1.136, the application will become abandoned unless an Office action indicates otherwise.

37 CFR 1.136(a)(1), in pertinent part

If an applicant is required to reply within a nonstatutory or shortened statutory period, applicant may extend the time period for reply up to the earlier of any maximum period set by statute or five months after the time period set for reply, if a petition for extension of time and the fee set forth in 37 CFR 1.17(a) are filed . . .

37 CFR 1.8(a)

Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in 37 CFR 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with 37 CFR 1.6(d);

(ii) the correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

37 CFR 1.8(b)

In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

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.

MPEP 711.03(c) states in pertinent part that:

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. See Haines, 673 F.Supp. at 317, 5USPQ2d at 1132; 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). . . . Likewise, as 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 caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 or 1.10 does not constitute "unavoidable" delay. See Krahn, 15 USPQ2d at 1825.

OPINION

The Commissioner may revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable;" 35 USC 133.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay 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.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (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 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Summary of Petitioner's Arguments

In addition to declaring the that decision of April 2, 2001, dismissing the petition filed November 6, 2000, was ". . . punitive, unfair, and cruel", petitioner asserts that petitioner's failure to respond timely to the Notice of Allowability was due to the Office's loss of the new formal drawings which petitioner allegedly deposited with the United States Postal Service on June 10, 2000. Petitioner further asserts that the Office should have provided petitioner with some notice that the new formal drawings were not received and that abandonment of the application was imminent. Petitioner also maintains that, due to petitioner's age and infirmities, the Office should show some leniency to petitioner relative to petitioner's compliance with the statutory requirements. Petitioner also maintains that the fee of \$620.00 associated with the filing of a petition pursuant to 37 CFR 1.137(b) is a "penalty."

Unavoidable Delay Not Sufficiently Established

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, facsimile, 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 establish unavoidable delay, petitioner must demonstrate diligence in the prosecution of the matter.

The record does not indicate that petitioner took all actions necessary for a timely response to be filed to the March 13, 2000, Notice of Allowability. Petitioner has provided no independent documentation that the new formal drawings were mailed prior to conclusion of three-month shortened statutory period for reply, such as a copy of a dated postcard receipt. Further, petitioner did not provide adequate documentation to support petitioner's contention that physical infirmity prevented petitioner from mailing the new formal drawings prior to June 10, 2000 (the date the drawings were allegedly mailed) and ensuring that the new formal drawings were received on time.

Petitioner maintains that the new formal drawings were mailed on June 10, 2000, and were subsequently lost by the Office. Petitioner argues that the Office previously lost an application file of which petitioner was a party of interest and, on that basis, suggests that it is likely that the new formal drawings for the

present application were lost by the Office. There is no evidence, however, that new formal drawings were ever received by Office. Further, petitioner is advised that the merit of a petition filed is determined by the facts and evidence as demonstrated in the petition itself, not by any prior action, inaction, or mishap as may be alleged to have been committed by the Office. The fact that a previous unrelated application file was lost by the Office is irrelevant and is not sufficient to establish that the new formal drawings were lost by the Office and that the delay in their filing was unavoidable.

The Office notes that petitioner's failure to file the 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 Office, as well as preserve adequate evidence of such filing, a delay 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). It is further noted that were the filing made in accordance with 37 CFR 1.8 of 1.10, that 37 CFR 1.8(b) would have offered petitioner relief.

Moreover, petitioner's failure to request an extension of time for reply in compliance with 37 CFR 1.136(a) also precludes a finding that the delay was unavoidable. Where, as in this case, petitioner is not able to mail the required reply until the shortened statutory period for reply has nearly expired, it can be said that a "reasonably prudent person" would request the necessary extension of time pursuant to 37 CFR 1.136(a) and remit the required fee to make a reply that may otherwise be untimely, timely.

In the normal course, a delay in filing a timely reply to an Office action would be deemed unavoidable if a medical condition, that existed during the entire relevant period, prohibited petitioner from filing a timely reply and petitioner established the same by documentary evidence, i.e. medical records and/or physician's statement describing petitioner's health during the relevant period. Accompanying each petition filed relative to the revival of the above-cited application were copies of medical bills for services rendered. Likewise, in the previous dismissals of those petitions, the Office advised petitioner that medical bills, without more, are not sufficient to establish the degree of petitioner's incapacitation. Specifically, in the dismissal of May 9, 2001, petitioner was advised that "... the Office must determine the severity of petitioner's illness in order to determine whether the illness alleged could have reasonably prevented petitioner from filing a timely reply" and that "... petitioner must file adequate evidence documenting petitioner's alleged illness whether such documentation is in the form of a statement from the treating physician or medical records." Petitioner filed with the instant petition a Medicare Summary Notice which only shows for the period of April 9, 2001 through May 3, 2001, the type of services provided and the fee for those services. The Medicare Summary Notice does not, alone, speak to the degree of petitioner's illness and does not cover the relevant period of March 13, 2000 (the date the "Notice of Allowability" was mailed) through June 2, 2001 (the date the instant petition was filed.)

Most recently, petitioner provided a letter from petitioner's physician, dated September 4, 2001, which indicates that petitioner is being treated for glaucoma and is totally blind in the left eye. The physician also indicates that as of August 2001, petitioner would be considered legally blind. While the physician's letter speaks to the severity of petitioner's infirmity, it does not speak to petitioner's health during the entire relevant period (as defined above.) Petitioner has not established that petitioner's health during the entire relevant period was so poor as to reasonably prevent petitioner from filing a timely response to the Notice

of Allowability. Based on the documentary evidence provided, the Office has no way of determining whether petitioner's infirmities may have reasonably prevented petitioner from responding to the Notice of Allowability in a timely manner. It cannot be said, therefore, that the delay in filing the required reply was unavoidable.

Relative to petitioner's assertion that the Office should have provided some warning to petitioner that the application was in danger of becoming abandoned, pursuant to 37 CFR 1.134, the Office is only obligated to inform petitioner of the shortened statutory period for reply in each Office action. As the Office actions are sufficiently detailed as to what is required of petitioner, no further notice relative to the period set for reply is provided to petitioner. Pursuant to 37 CFR 1.135(a), if petitioner does not reply with the allowed period as prescribed by the Office action, the application becomes abandoned. Petitioner is advised that this is the standard procedure of the Office and is in compliance with the governing laws. Therefore, the fact petitioner did not receive additional notice from the Office beyond the Notice of Allowability indicating that the possibility that the application may become abandoned does nothing to bolster petitioner's argument that the delay in filing the required was unavoidable.

Petitioner's Request for Leniency

Petitioner suggests that the Office should show leniency to petitioner because of petitioner's age and alleged physical infirmity. While, the Office appreciates the challenges that are presented by petitioner's age and infirmities, the Office cannot waive the statutory requirement that the unavoidable delay in filing the required reply be established to the satisfaction of the Commissioner. Satisfactorily establishing that unavoidable delay existed for the entire relevant period is an integral part of a petition filed pursuant to 37 CFR 1.137(a). The Office cannot, therefore, waive the requirement that petitioner establish that the entire delay in filing the required reply was unavoidable whether such delay is established by medical records or physician's statement.

Petitioner's Argument that 37 CFR 1.137(b) Petition Fee is a 'Penalty'

It is noted that petitioner maintains that the fees charged for various services performed by the Office are established based on the amount of work associated with the service provided, and that the fee of \$620.00 associated with the filing of a petition under 37 CFR 1.137(b), in the alternative to a petition filed under 37 CFR 1.137(a) is a 'penalty.' It not clear from where petitioner garnered the idea that the Office fees are based on the amount of work associated with the service, and the Office will not attempt to offer an explanation to petitioner of how the respective fees are formulated. It is not, however, the opinion of the Office that the fee associated with the filing of a petition under 37 CFR 1.137(b) is a penalty as was indicated (in detail) in the dismissal of May 9, 2001. At this juncture, the Office believes that it is sufficient to state that the fee for a petition filed under 37 CFR 1.137(b) is authorized by 35 USC 41(a)(7) (and reduced, in some cases, by 35 USC 41(h)(7)) and that payment of the same is required before the application can be revived under 37 CFR 1.137(b).

CONCLUSION

For the reasons stated above, the petition under 37 CFR 1.137(a) is **DENIED**. Therefore, the application will not be revived and the application remains abandoned. Petitioner is again reminded that he may wish to consider filing a renewed petition under amended 37 CFR 1.137(b).

This application file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.



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