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Michael Z. Shen
4707 Holland Drive
Troy MI 48085

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OFFICE OF PETITIONS

In re Application of	:	
Michael Z. Shen	:	
Application No. 12/211,563	:	DECISION ON PETITION
Filed: September 16, 2008	:	
Title: ENGAGEMENT TOOLING FOR	:	
CYLINDRICAL CONNECTOR IN	:	
ELECTRIC VEHICLE CHARGING SYSTEM	:	

This is a decision on the renewed petition filed August 20, 2010, which is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DENIED**. No further consideration of this matter will be undertaken by the Office. Petitioner is not precluded from seeking revival of this application under 37 CFR 1.137 as set forth in the conclusion to this decision.

BACKGROUND

On September 29, 2008, the Office mailed a Notice to File Missing Parts, which set a two month shortened statutory period to reply. An incomplete reply and a two month extension of time pursuant to 37 CFR 1.136(a) was submitted on January 28, 2009. A Notice of Incomplete Reply was mailed on February 9, 2009. An incomplete reply was submitted on March 3, 2009. A second Notice of Incomplete Reply was mailed on March 20, 2009. The application became abandoned on January 30, 2009, for failure to submit a timely complete response to the September 29, 2008 Notice. On May 4, 2009, the Office mailed a Notice of Abandonment.

A petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment filed June 5, 2009 was dismissed on March 29, 2010. A second petition filed under 37 CFR 1.181 was dismissed on June 18, 2010.

On renewed petition, Petitioner requests that the Office withdraw the holding of abandonment because a complete reply was submitted. Petitioner insists that he is not required to submit \$110.00 fee for an extra independent claim, as he only claimed three independent items, which is allowed in/by a standard application fee. Petitioner contends while he had additional claims, they were dependent claims for which he can submit 20 without an additional fee. Petitioner continues to state that he was informed that an

applicant may not define whether claims are dependent or independent. Lastly, petitioner states that the format requirements have been met with the submission of documents with the instant petition.

APPLICABLE RULES AND REGULATIONS

37 CFR § 1.8 Certificate of mailing or transmission sets forth in pertinent part:

- (a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. 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 § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;
- (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6 (d); or
- (C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and
- (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.

ANALYSIS

A review of the record confirms that the Office did not receive a timely complete reply to the Notice to File Missing Parts. The Notice to File Missing Parts required the filing fee, search fee, examination fee, surcharge, oath or declaration pursuant to 37 CFR 1.63, replacement drawings, replacement claims, replacement abstract and additional claim fees. The response which included a two month extension of time submitted on January 28, 2009 failed to include a replacement specification pursuant to 37 CFR 1.121, replacement claim(s) commencing on a separate sheet in compliance with 37 CFR 1.75(h) and 1.121, drawings in compliance with 37 CFR 1.121(d) and additional claim fees. The first Notice of Incomplete Reply mailed February 9, 2009 informed petitioner that the replacement claims were not compliant with 37 CFR 1.75(h), 1.121 and 1.126. The Notice also informed applicant the abstract was not compliant with 37 CFR 1.72(b) and 1.121. Further, petitioner failed to submit the additional claim fees or cancel the additional claims. Since the Notice of Incomplete Reply did not set a new reply period but continued the original reply time period set in the Notice of Missing Parts, the reply submitted on March 3, 2009 without additional extension of time and fee rendered this response

untimely. The communications submitted in effort to remedy the incomplete reply to the Notice to File the Missing Parts after January 29, 2009 are untimely.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction). Nor does the lack of knowledge or reliance on oral advice from Office employees allow for the Office to withdraw the holding of abandonment.

As such the application was properly held abandoned. Petitioner's request to withdraw the holding of abandonment is **DENIED**.

CONCLUSION

As such, the holding of abandonment will not be withdrawn.

Petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was "unavoidable." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the \$810.00 petition fee.

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 cannot make a statement that the delay was unintentional unless the entire delay, including 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).

Telephone inquiries concerning this decision should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.


Anthony Knight
Director
Office of Petitions