



Alice O. Kiely
71 Stonewall Court
Yorktown Heights NY 10598

MAILED
MAR 26 2012
OFFICE OF PETITIONS

In re Application of :
Kiely : **DECISION ON PETITION**
Application No. 10/347,018 :
Filed: January 17, 2003 :
For: EDIBLE HOMOGENOUS SUPPORTS :
FOR COMESTIBLES WITH OPTIONAL :
MESS GUARDS AND DRIP GUARDS :

This decision is in response to the "PETITION INVOKING SUPERVISORY REVIEW OF THE DIRECTOR OF THE USPTO Petition to Withdraw Holding of Abandonment," filed September 30, 2011. This matter is being properly treated under 37 CFR 1.181(a)(1) and (a)(3) as a petition to invoke the supervisory authority of the Office of Petitions with respect to the holding of abandonment upheld by the Group Director of Technology Center 1700 in the decision mailed September 12, 2011.

The petition under 37 CFR 1.181 is **DENIED**.

BACKGROUND

A final Office action was mailed October 29, 2008.

A response to the final Office action was filed on January 29, 2009.

In response thereto, an Advisory Action was mailed February 18, 2009. The Advisory Action indicated, *inter alia*, that the amendment filed January 29, 2009 would not be entered because the amendment failed to place the application in condition for allowance.

An amendment, including petition for two month extension of time, was filed March 9, 2009.

In response thereto, an Advisory Action was mailed April 1, 2009. The Advisory Action indicated, *inter alia*, that the amendment filed March 9, 2009, would not be entered because it failed to place the application in condition for allowance.

A Notice of Abandonment was mailed June 8, 2009. The Notice of Abandonment indicated that ~~the application was abandoned for failure to timely submit a proper reply to the final Office~~ action mailed October 29, 2008.

On June 15, 2009, applicant submitted a request for continued examination (RCE), including the required submission and fee.

On March 3, 2010, applicant submitted a request for a first Office action in response to the RCE filed June 15, 2009.

On April 28, 2010, the examiner mailed a Letter to the applicant advising the applicant that further consideration of the application would not be forthcoming because the application was in fact abandoned.

On September 22, 2010, applicant filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment and withdrawal of the finality of the final Office action mailed October 29, 2008.

On December 23, 2010, the petition was DENIED by the Director of Technology Center 1700. The final Office action was deemed proper as it was necessitated as a result of applicant's reply filed June 27, 2007. Thus, the finality of the Office action was not deemed premature and the holding of abandonment was upheld.

On January 24, 2011, applicant filed requests for reconsideration of the decision mailed September 22, 2010 and withdrawal of the finality of the final Office action mailed October 29, 2008.

On May 11, 2011, the request for reconsideration of the decision mailed September 22, 2010 was DENIED under 37 CFR 1.181(f). Further, with respect to the petition for withdrawal of the finality of the final Office action mailed October 29, 2008, the petition was DENIED AS UNTIMELY under 37 CFR 1.181(f).

On May 27, 2011, a further request for reconsideration was mailed. On September 12, 2011, the request for reconsideration was again DENIED for the reasons previously set forth in the previous decisions on petition.

The instant petition to the Director was filed September 30, 2011.

STATUTE AND REGULATIONS

35 U.S.C. § 132 states:

- (a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
- (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish

appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

35 USC 133 states:

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

37 CFR 1.113 states:

- (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.
- (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.
- (c) Reply 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 reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.181 states:

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

-
- (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

- (b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs 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 declarations (and exhibits, if any) must accompany the petition.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

OPINION

Petitioner filed a petition under 37 CFR 1.181 (a)(1) and (3) on September 30, 2011, requesting a review of the TC Director's decision mailed September 12, 2011.

Wherein petition states:

“A Request for Reconsideration for the decision of 5/11/2011 has been denied, without any reason regarding Applicant's particular arguments. Applicant has not been heard.”

It is held that the TC Director properly DENIED AS UNTIMELY the request for withdrawal of the finality of the final Office action mailed October 29, 2008. Any petition under 37 CFR 1.181 not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The final Office action was mailed October 29, 2008. The replies filed January 29, 2009 and March 9, 2009 did not include a petition under 37 CFR 1.181 for withdrawal of the finality of the final Office action mailed October 29, 2008. Accordingly, applicant seemingly acquiesced to the finality of the Office action inasmuch as applicant submitted replies in response thereto. Accordingly, the denial of the petition as untimely with respect to the finality of the final Office action is upheld.

With respect to the withdrawal of the holding of abandonment, it is further held that the TC Director properly denied applicant's petition for withdrawal of the holding of abandonment. The record fails to establish that a proper reply to the final Office action mailed October 29, 2009 was timely received on or before the maximum extendible period of time for reply. A proper reply was required to consist of an amendment *prima facie* placing the application in condition for allowance, a request for continued examination (including fee and submission), a notice of appeal (including fee), or a continuation application (including fee), and, if applicable, a petition for extension of time (including fee).

A proper reply was not received. Failure by applicant of a patent applicant to reply within the time period provided under § 1.134 and § 1.136 results in abandonment of the application as a matter of law. See, 37 CFR 1.135(a). As the record fails to establish that a proper reply to the final Office action mailed October 29, 2009 was timely filed within the time period for reply set forth therein, the holding of abandonment will not be withdrawn.

CONCLUSION

With respect to (1) the petition to withdraw the finality of the final Office action mailed October 29, 2009 and (2) the petition for withdrawal of the holding of abandonment, petitioner's arguments do not provide legal authority for setting aside or otherwise disturbing (1) the final Office action mailed October 29, 2008 and (2) the TC Director's decisions on petition mailed December 23, 2010, May 11, 2011, and September 12, 2011. Petitioner's arguments do not provide any legal authority for the withdrawal of the holding of abandonment which occurred as a matter of law for failure to timely submit a proper reply to the final Office action mailed October 29, 2008. Further, subsequent to submitting replies in the response to the final Office, applicant raised arguments that the finality of the Office action mailed October 29, 2008 was improper. As these arguments were submitted subsequent to applicant's replies to the Office action and subsequent to the abandonment of the application, applicant's arguments that the finality of the final Office action was improperly was properly deemed untimely.

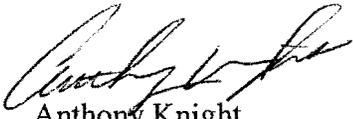
Accordingly, the petition is granted to the extent that the petition for withdrawal of finality of the Office action and the petition for withdrawal of the holding of abandonment have been reconsidered. However, the petitions under 37 CFR 1.181(a)(1) and (a)(3) are hereby **DENIED**.

ALTERNATE VENUE

As previously suggested, petitioner may wish to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which 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". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee (currently \$930.00 for a small entity) and reply (it is noted that an RCE was previously filed June 15, 2009). See, enclosed.

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 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).

Telephone inquiries concerning this matter may be directed to Attorney Advisor at (571) 272-3205.



Anthony Knight
Director
Office of Petitions

Enclosure
