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**MAILED**

SEP 24 2012

**OFFICE OF PETITIONS**

In re Application of :  
KEITH R. WILLIAMS :  
Application No. 11/522,931 : DECISION ON RENEWED PETITION  
Filed: September 19, 2006 : PURSUANT TO  
Title: GRADUATION GAME : 37 C.F.R. § 1.137(A)

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.137(a) submitted on August 14, 2012.

This renewed petition pursuant to 37 C.F.R. § 1.137(a) is **DENIED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed September 15, 2011, which set a shortened statutory period for reply of three months. A response was received on March 14, 2012, however a three-month extension of time under the provisions of 37 C.F.R. § 1.136(a) so as to make timely the response was not included. Accordingly, the above-identified application became abandoned on December 16, 2011. A notice of abandonment was mailed on April 5, 2012.

THE APPLICABLE STANDARD

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard:

In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's

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interpretation of those provisions is entitled to considerable deference.<sup>1</sup>

[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense.<sup>2</sup>

The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'<sup>3</sup>

The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency.<sup>4</sup>

The burden of showing the cause of the delay is on the person seeking to revive the application.<sup>5</sup>

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."<sup>6</sup>

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

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1 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference."))

2 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

3 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. § 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

4 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

5 Id.

6 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

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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 (D.C. Cir. 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).

As such, the general question asked by the Office is: "[d]id petitioner act as a reasonable and prudent person in relation to his most important business?"

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."<sup>7</sup>

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."<sup>8</sup>

#### RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.134 sets forth, *in toto*:

An Office action will notify the applicant of any non-statutory or shortened statutory time 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, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, *in toto*:

(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.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently

<sup>7</sup> Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.

<sup>8</sup> Haines v. Quigg, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

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omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

#### PROCEDURAL HISTORY AND ANALYSIS

A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(1);
- (3) A showing to 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, and;
- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

An original petition pursuant to 37 C.F.R. § 1.137(a) was filed on June 1, 2012 along with, *inter alia*, the petition fee and a statement of facts. The original petition pursuant to 37 C.F.R. § 1.137(a) was dismissed via the mailing of a decision on June 18, 2012 which indicated requirements (1) and (2) of 37 C.F.R. § 1.137(a) have been satisfied, requirement (3) of 37 C.F.R. § 1.137(a) has not been satisfied, and the fourth requirement of 37 C.F.R. § 1.137(a) is not applicable since a terminal disclaimer is not required.<sup>9</sup>

Regarding the third requirement of 37 C.F.R. § 1.137(a), on original petition, Petitioner asserted financial difficulty in that he lacked the funds necessary to submit the three-month extension of time fee.

The decision on the original petition pursuant to 37 C.F.R. § 1.137(a) indicated that the Office provided Petitioner with a period of three months to respond to the non-final Office action. The need for a three-month extension of time could have been avoided by submitting a response to the non-final Office action prior to the expiration of the three-month period for response. It seems that if the funds to secure a three-month extension of time were not available, a prudent and careful man, acting in relation to his most important business, would have ensured that a response was submitted within the three-month period for response so as to obviate the need for an extension of time and thus avoid the abandonment of his application for failure to provide a timely response.

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<sup>9</sup> See Rule 1.137(d).

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With this renewed petition pursuant to 37 C.F.R. § 1.137(a), Petitioner has asserted that "it never once occurred to Applicant" that a response could have been provided within the three-month period provided by the non-final Office action of September 15, 2011, "in order to avoid having to request an extension of time."<sup>10</sup>

The PTO has a well-established and well-publicized practice of providing applicants with a set period of time to provide a response to an Office action, and for providing Applicants with a manner for extending said period via the purchase of an extension of time. It appears that Petitioner failed to provide a response within the allotted period of time, while possessing the knowledge that the funds to purchase an extension of time were not available to him. These set of facts might support a finding that the entire period of delay was unintentional, however the record does not support a finding that the entire period of delay was unavoidable. It follows that the third requirement of 37 C.F.R. § 1.137(a) remains unsatisfied.

#### CONCLUSION

The prior decision which refused to reinstate the instant application under 37 C.F.R. § 1.137(a), have been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unavoidable within the meaning of 35 U.S.C. §41(c)(1) and 37 C.F.R. § 1.137(a).

#### THERE WILL BE NO FURTHER RECONSIDERATION OF THIS MATTER BY THIS OFFICE.

Petitioner may file a petition pursuant to 37 C.F.R. § 1.137(b).

**Notice regarding fees: the revised Fee Schedule goes into effect on October 5, 2012.** Historically the fees that the USPTO charges for doing business increase at the beginning of each fiscal year (October 1, 2012). Please be advised that applicants should monitor the USPTO website for future updates whenever any necessary money is sent. More information can be obtained here:

<http://www.uspto.gov/web/offices/ac/qs/ope/fees.htm>.

Any subsequent filing pertaining to the abandonment of this application should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail,<sup>11</sup> hand-delivery,<sup>12</sup> or facsimile.<sup>13</sup> Registered

<sup>10</sup> Renewed petition, page 11.

<sup>11</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

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users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>14</sup>

If corresponding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the decision maker.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.



Anthony Knight  
Director  
Office of Petitions/  
Petitions Officer

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12 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

13 (571) 273-8300: please note this is a central facsimile number.

14 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>