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In re Application of
Dwayne T. Friesen et al.
Application No. 08/631,190
Filed: April 11, 1996
Docket No.: BRI/N2CH4/CI

ON PETITION

This is a decision on the petition filed September 14, 1998, which is being treated as a petition under 37 CFR 1.182 to disregard the request for a continued prosecution application (CPA) under 37 CFR 1.53(d) filed August 5, 1998.

The petition is **DISMISSED**.

On July 20, 1998, the Patent and Trademark Office (PTO) mailed a Notice of Allowance and a Notice of Allowability in the above-identified application (a CPA under 37 CFR 1.53(d) of May 8, 1998). The Notice of Allowability indicated that claims 1 through 12, 26, and 28 were allowed.

On August 5, 1998, petitioners filed: (1) a request for a divisional CPA under 37 CFR 1.53(d) of application No. 08/631,190; and (2) a preliminary amendment canceling claims 2 through 12, 26, and 28. On August 6, 1998, petitioners filed the issue fee for application No. 08/631,190 (the CPA of May 8, 1998), with a certificate of mailing dated August 4, 1998.

PTO records indicate that: (1) the request for a CPA of August 5, 1998 was entered into the file of application No. 08/631,190 on September 3, 1998; and (2) an interview was conducted on September 8, 1998 during which it was indicated that petitioners did not desire a CPA divisional application under 37 CFR 1.53(d).

The instant petition under 37 CFR 1.182 was filed on September 14, 1998, and requests that: (1) the abandonment of application No. 08/631,190 which occurred by operation of the filing of a request for a CPA on August 5, 1998 be set aside; (2) the request for a CPA of August 5, 1998 be vacated; (3) the \$967.00 in filing fees submitted for the CPA of August 5, 1998 be credited to Deposit Account No. 03-1550; and (4) application No. 08/631,190 be passed to issue containing allowed claims 1 through 12, 26, and 28.

37 CFR 1.53(d) provides that:

A continuation or divisional application (but not a continuation-in-part) of a prior nonprovisional application may be filed as a continued prosecution application under [37 CFR 1.53(d)], provided that:

- (i) The prior nonprovisional application is either:
 - (A) Complete as defined by § 1.51(b); or
 - (B) The national stage of an international application in compliance with 35 U.S.C. 371; and
- (ii) The application under [37 CFR 1.53(d)] is filed before the earliest of:
 - (A) Payment of the issue fee on the prior application, unless a petition under § 1.313(b)(5) is granted in the prior application;
 - (B) Abandonment of the prior application; or
 - (C) Termination of proceedings on the prior application.

See 37 CFR 1.53(d)(1).

A certificate of mailing under 37 CFR 1.8(a) applies to the timeliness of a reply, but the date the reply is received in the PTO (*i.e.*, the date the reply is “filed”) is the date of the reply for all other purposes. *See* section 512 of the Manual of Patent Examining Procedure (7th ed. 1998)(MPEP). While the issue fee was submitted for prior application No. 08/631,190 with a certificate of mailing dated August 4, 1998, the issue fee was not received in the PTO until August 6, 1998. Thus, the CPA of August 5, 1998 was filed before payment of the issue fee on the prior application.

In addition, the preliminary amendment submitted with the CPA of August 5, 1998 resulted in at least one claim (claim 1) remaining in the application. See Any Application Filed With Instructions to Cancel All of the Claims in the Application is Not Entitled to a Filing Date; Notice, 1216 Off. Gaz. Pat. Office 46, 46 (November 10, 1998).

Accordingly, the CPA of August 5, 1998 was a proper CPA under 37 CFR 1.53(d)(1) and was entitled to a filing date of August 5, 1998 as a CPA under 37 CFR 1.53(d).

The instant petition under 37 CFR 1.182 was not brought before an appropriate deciding official (or even filed) before the request for a CPA of August 5, 1998 was entered into prior application 08/631,190 on September 3, 1998. The PTO has indicated that:

If applicant wants the PTO to disregard a previously filed request for a CPA (and not recognize its inherent request to expressly abandon the prior application) and to treat the paper as the filing of an application under 37 C.F.R. § 1.53(b), the applicant must file a petition under 37 C.F.R. § 1.182. A request to expressly abandon an application is not effective until the abandonment is acknowledged, including the express abandonment of the prior application of a CPA that occurs by operation of 37 C.F.R. § 1.53(d)(2)(v). See Changes to Patent Practice and Procedure; Training and Implementation Guide, Question and Answer 66 (December 1997). The express abandonment of the prior application is acknowledged and becomes effective upon processing and entry of the CPA into the file of the prior application. Thus, such a petition under 37 C.F.R. § 1.182 should be filed expeditiously since the petition will not be granted once the request for a CPA has been entered into the prior application (and the inherent request to expressly abandon the prior application has been acknowledged). If the request for a CPA has been entered into the prior application by the time the petition under 37 C.F.R. § 1.182 and the application file are before the deciding official for a decision on the petition, the petition will be denied.

See Continued Prosecution Application (CPA) Practice; Notice, 1214 Off. Gaz. Pat. Office 32, 32 (September 8, 1998).

Therefore, the instant petition under 37 CFR 1.182 to disregard (or “vacate”) the request for a CPA of August 5, 1998 cannot be granted.

The express abandonment of prior application No. 08/631,190 occurred as a result of the recognition by the PTO of petitioners’ filing of a CPA on August 5, 1998. Any petition to “set aside” such abandonment (*i.e.*, revive the prior application) must meet the conditions of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). The PTO views the express abandonment of an application to be the result of a deliberately chosen course of action. See MPEP 711.01. An application that is abandoned as the result of a deliberately chosen course of action is not considered an “unintentionally abandoned application” within the meaning of 35 U.S.C. § 41(a)(7). See MPEP 711.03(c).

Petitioners may, of course, file a petition under 37 CFR 1.137(b) to request the revival of the prior application (the CPA of May 8, 1998). Nevertheless, even if petitioners are successful in establishing that the express abandonment of such prior application was unintentional, this course of action: (1) will require the petition fee set forth in 37 CFR 1.17(m); and (2) will not

result in the refund of any filing fee submitted for the CPA of August 5, 1998. Therefore, this course of action is **not** recommended.

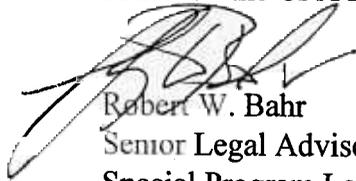
35 U.S.C. § 42(d) authorizes the PTO to refund fees paid by mistake or in excess of that required. While petitioners now consider the filing of a divisional CPA under 37 CFR 1.53(d), rather than a divisional under 37 CFR 1.53(b), to have been a "mistake," the authorization in 35 U.S.C. § 42(d) for the refund of fees is applicable only to a mistake relating to the fee payment. See Ex parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943). As the filing fees charged to Deposit Account No. 03-1550 (in accordance with petitioners' authorization) for the CPA of August 5, 1998 were the fees required by 35 U.S.C. § 41(a)(1) and 37 CFR 1.16 for the filing of the CPA of August 5, 1998, these fees were not paid by mistake or in excess of that required within the meaning of 35 U.S.C. § 42(d). Therefore, the \$967.00 in filing fees submitted for the CPA of August 5, 1998 cannot be refunded to Deposit Account No. 03-1550.

As allowed application No. 08/631,190 (the CPA of May 8, 1998) was abandoned on August 5, 1998 by operation of the recognition of the CPA of August 5, 1998, the \$660.00 issue fee filed on August 6, 1998 was unnecessary. Petitioner may request a refund of this \$660.00 fee. Such a request must be submitted in writing to the Office of Finance, and accompanied by a copy of this decision.

Finally, petitioners' request that application No. 08/631,190 be passed to issue containing allowed claims 1 through 12, 26, and 28 cannot be granted. The CPA of August 5, 1998 (which is the only pending application No. 08/631,190): (1) contains only claim 1 as a result of the preliminary amendment of August 5, 1998; and (2) has not been examined under 35 U.S.C. § 131 or allowed under 35 U.S.C. § 151. Petitioners are advised to submit an amendment which results in application No. 08/631,190 (now the CPA of August 5, 1998) containing claims corresponding to previously allowed 1 through 12, 26, and 28 in application No. 08/631,190 (the CPA of May 8, 1998).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-9285.

The above-identified application is being returned to Technology Center 1700 for appropriate action on the CPA filed August 5, 1998.



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