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MAR 10 2008

OFFICE OF PETITIONS

In re Application of :
Michael Brian Wittig : DECISION ON PETITION
Application Number: 11/142881 :
Filing Date: 05/31/2005 :
For: HIGH POWER DENSITY :
ELECTRIC MOTOR :
:

This is a decision on the twice renewed petition filed on January 18, 2008, under 37 CFR 1.137(a),¹ to revive the above-identified application.

The petition is DENIED.²

BACKGROUND

The application became abandoned on March 16, 2007, for failure to timely file a response to the final Office action mailed on December 15, 2006, which set a three (3) month shortened

¹ A grantable petition under 37 CFR 1.137(a) 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 a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. 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. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(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 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

² This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The provisions of 37 CFR 1.137(d) do not apply.

statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on July 24, 2007. The petition filed on August 19, 2007, was dismissed on October 4, 2007. The renewed petition filed on December 4, 2007, was dismissed on January 15, 2008.

On January 18, 2008, the present second renewed petition was filed.

STATUTE AND REGULATION

35 U.S.C. § 133 states that:

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 1.135 states in pertinent part:

(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.

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 a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a Nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. 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(1);

(3) A showing to the satisfaction of the Director 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.

37 CFR 1.33(a) states, in pertinent part:

Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing. If no correspondence address is specified, the Office may treat the mailing address of the first named inventor (if provided, see §§ 1.76 (b)(1) and 1.63 (c)(2)) as the correspondence address. The Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the correspondence address.

MPEP 711.03(c) states, in pertinent part:

Where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing that due

care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (see MPEP § 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. The following do not constitute proper notification of a change in correspondence address:

(A) the mere inclusion, in a paper filed in an application for another purpose, of an address differing from the previously provided correspondence address, without mention of the fact that an address change was being made;

(B) the notification on a paper listing plural applications as being affected (except as provided for under the Customer Number practice - see MPEP § 403);
or

(C) the lack of notification, or belated notification, to the U.S. Patent and Trademark Office of the change in correspondence address.

OPINION

Petitioner again argues that the final Office action mailed on December 15, 2006, was never received. Petitioner states that he believes that the Office action was stolen from the mail. In support, petitioner has provided a copy of a letter from Postal Inspector Keith Hannon stating that Matthew Perry was suspected of stealing mail from petitioner and others from December, 2006, through his arrest on March 14, 2007. Petitioner has also presented an explanation of his docketing system.

Further, petitioner avers that he relocated on July 1, 2006, and filed a change of address with the USPS at that time. A change of correspondence address was filed with the USPTO on July 5, 2007.

A grantable petition under 37 CFR 1.137(a) 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 a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. 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.

In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(1);

(3) a showing to the satisfaction of the Director 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 37 CFR 1.137(a) was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

The petition lacks item (3).

With regards to item (3), the Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".³ 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,

³ 35 U.S.C. § 133.

there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁴

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).⁵ 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.⁵

Petitioner's argument has been carefully considered, but is not persuasive because petitioner did not timely file a change of correspondence address. In this regard, it is noted that petitioner concedes that he relocated on July 1, 2006, but did not file a change of correspondence address with the USPTO until July 5, 2007, over a year later.

As such, the showing of record is that the delay occurred because petitioner failed to timely provide a current correspondence address upon his relocation on July 1, 2006. A delay caused by the failure on the part of petitioner, or petitioner's representative, to provide the U.S. Patent and Trademark Office with a current correspondence address does not constitute an unavoidable delay.⁶

MPEP 601.03 requires an attorney or agent of record (or applicant, if he or she is prosecuting the application *pro se*) to promptly notify the Patent and Trademark Office of a change in the correspondence address. The required notification need take no particular form, but must be provided in a manner calling attention to the fact that a change of address is being made.

⁴ 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).

⁵ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁶ See Ray v. Lehman, 55 F.3d 606, 34 USPQ2d 1786 (Fed. Cir. 1995).

Here, petitioner clearly failed to timely inform the Office of the address change. Petitioner should note that merely filing a change of address form with the USPS is not equivalent to filing a change of correspondence address with the Office, and does not satisfy the requirements of MPEP 601.03.

In the subject petition, petitioner argues "the Office is confusing the definition of a correspondence address with the definition of an address of residence."

Petitioner further asserts that:

The petitioner believes the Office recognizes that the correspondence address can differ from the address of residence of the attorney, agent of record, or applicant.

...

The Petitioner believes that the correspondence address is correctly understood to be a legitimate mailing address, as recognized by the U.S. Postal Service, that correspondence can be sent by the United States Patent and Trademark Office such that the U.S. Postal Service will deliver the correspondence to the attorney, agent of record, or applicant.

Petitioner's argument has been considered, but is not well taken. Petitioner appears to be confusing the requirement to provide the applicant's residence and mailing or post office address under 37 CFR 1.63 with the requirement for a correspondence address under 37 CFR 1.33.

MPEP 605.02 and 605.03 require that the residence city and state or city and foreign country, and mailing address, respectively be provided for each applicant. As stated in MPEP 605.03, applicant's mailing address is that address at which he or she customarily receives his or her mail. Either applicant's home or business address is acceptable as the mailing address.

The MPEP further states that the object of requiring each applicant's mailing address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instruction to send communications to applicant in care of the attorney is not sufficient.

The requirement to provide a residence address is different from that of 37 CFR 1.33, which states that the Office will direct, or otherwise make available, all notices, official letters, and other communications relating to the application to the person associated with the **correspondence address**.

As such, while the applicant's mailing address (or residence) is required in the event that no other means is available to contact an applicant, the correspondence address is the address of record to which all Official correspondence is mailed. As such, it is imperative that the applicant ensure that the correspondence address on file at the Office is current and accurate.

The Office recognizes that for many *pro se* applicants, such as petitioner, the correspondence address may be the same as applicant's mailing address. When that is the case, however, applicants must ensure that the correspondence address is the address at which applicants are currently receiving mail.

Petitioner also argues that that "the correspondence address is...a *legitimate* mailing address, as recognized by the [USPS]." (emphasis added)

While it is unclear what constitutes a "legitimate" mailing address, petitioner appears to assert that any mailing address, once used by petitioner to receive mail, can continue to serve as the correspondence address, even after petitioner no longer receives mail at that address. This interpretation is not in accordance with 37 CFR 1.33(a), however, which states that the application **must** specify a correspondence address to which the Office will send notice, letters, and other communications relating to an application. The correspondence address must either be in an application data sheet (37 CFR 1.76) or in a clearly identifiable manner elsewhere in any papers submitted with the application filing.⁷

As such, if the address at which petitioner receives correspondence from the USPTO changes, petitioner has a duty to notify the Office promptly. If petitioner's residence address is the address at which he receives correspondence from the USPTO, and petitioner relocates, such that he is no longer receiving mail at the old address, a showing of diligence requires that applicant inform the Office that his correspondence address has changed.

⁷ MPEP 601.03

Simply put, petitioner must show the level of care of as a reasonably prudent person acting with a level of care that would be expected when tending to his most important business. In this respect, it is assumed that petitioner promptly informed his bank, employer, and creditors that his address had changed and did not rely solely on the USPS, for over a year, to forward bills, checks, and bank statements from the previous address to the new address. Petitioner has not shown that the same level of care was used with regard to his business at the USPTO.

As stated above and in the previous decisions, it is settled law that delays resulting from the failure on the part of petitioner, or petitioner's representative, to provide the USPTO with a current correspondence address does not constitute unavoidable delay.⁸ Further, while the alleged theft of mail from petitioner's old address is unfortunate, it is at most an intervening, rather than a superseding, cause of the delay in responding to the final Office action mailed on December 15, 2006.

As such, had petitioner timely filed a change of correspondence address, the showing of record is that the delay in question would not have occurred.

To conclude, petitioner has not shown unavoidable delay in that petitioner did not timely provide the Office with the correct correspondence address. Accordingly, the petition must be denied.

CONCLUSION

The decision of January 15, 2008, has been reconsidered, but for the reasons given in the previous decision and noted above, the delay in this case has not been shown to have been unavoidable within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a).

Accordingly, the application will not be revived under the provisions of 35 U.S.C. 133 and 37 CFR 1.137(a), and the case remains abandoned.

Nevertheless, petitioner may wish to *promptly* seek revival under the provisions of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b), as this decision does not prevent petitioner from seeking revival under the less stringent "unintentional" standard. The filing of that petition can not be intentionally delayed.

⁸ See note 6, supra.

In future prosecution, the services of a registered attorney or agent are strongly advised.

Telephone inquiries related to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at 571.272.3231.

A handwritten signature in black ink, appearing to read "Charles A. Pearson", with a long horizontal flourish extending to the right.

Charles A. Pearson
Director, Office of Petitions