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CHIH-CHUNG CHOU
F2, NO. 129, TSIN-GIN RD
TAICHUNG, ROC 404 TW TAIWAN

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OFFICE OF PETITIONS

Paper No. 15

In re Application of :
CHOU :
Application No. 08/768,863 : ON PETITION
Filed: December 17, 1996 :
Attorney Docket No. USP6201T-DM :

This is a decision on a renewed petition under 37 CFR 1.137(b), March 1, 2007, to revive the above-identified application.

The petition under 1.137(b) is **DENIED**[1].

The instant application became abandoned for failure to timely pay the issue fee on or before April 19, 1999, as required by the Notice of Allowance and Issue Fee Due and Notice of Allowability, mailed January 19, 1999, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on April 20, 1999. A petition to revive the application under 37 CFR 1.137(b) was filed on November 1, 2006. The petition was dismissed on January 12, 2007, requesting more information regarding the delayed response that originally resulted in the abandonment and the inordinate delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application. A renewed petition was received March 1, 2007 to address the requested information.

STATUTE AND REGULATION

35 U.S.C. § 41(a)(7) states:

> GENERAL FEES. — The Director shall charge the following fees:
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> . . .
>
> (7) REVIVAL FEES. — On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any

[1] 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 Manual or Patent Examining Procedure (MPEP) 1002.02. No further consideration or reconsideration of this matter will be given.

reexamination proceeding, $1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $500.

35 U.S.C. § 151 states in pertinent part:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

37 CFR 1.137(b) states:

Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent.

A grantable petition pursuant to this paragraph 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 § 1.17(m);
(3) A statement 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 unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

OPINION

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply[2], unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement 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(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d).[3] Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. Additional information explaining the period of delay (from April 19, 1999 until November 1, 2006) was required in the January 12, 2007 decision.

[2] In the instant application, the issue fee and corrected drawings were due. Corrected drawings have not been filed.
[3] No terminal disclaimer is required in this application. See MPEP 711.03(c)(II)(G).

Petitioner has not demonstrated requirement (3) to the satisfaction of the Director. There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

> (1) the delay in replying to the Office correspondence that originally resulted in the abandonment;
> (2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and
> (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

The delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

With regards to period (1), the patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation. Where, as here there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

In view of the inordinate delay (over seven years) in attempting to resume prosecution, the Office questioned whether the entire delay was unintentional in the petition decision mailed January 12, 2007. Petitioner should note that the issue is not whether some of the delay was unintentional by any party. Rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional. As the courts have made clear, it is pointless for the Office to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (D.C. E. Mich. 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn. Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

In the renewed petition, petitioner (Chou) explains on page 2 "because I wanted the attorney to add one more claim, so I [with]held the payment." The deliberate course of action made by petitioner to forego payment of the issue fee beyond the statutory period for response set forth in

35 U.S.C. § 151 shows petitioner's conscious decision to delay payment of the issue fee resulted in the abandonment of the application. Petitioner also states, "And I keep waiting [for] the answer. I assumed the deadline should not be closed if I still have discussion with the patent office." However, Office records contradict Chou's assertions that he never received a response to the inquiry to add a claim until he met with his attorney in 2000. Office records show that on March 4, 1999 the Office directly communicated[4] with applicant by facsimile about his inquiry and before the due date for the issue fee. This response clearly articulated that the amendment would not be entered, and, thus, there was no reason to delay payment. Additionally and as best understood, petitioner also appears to state that the Taiwanese representative did get a response regarding the addition of the claim and contacted him ("**except he got the answer regarding adding a claim** and contacted me. I thought the payment day could be extended then."[5]) All this evidence shows that, despite having the knowledge that the issue fee was due on April 19, 1999 and being contacted regarding non-entry of the new claim to the application, petitioner chose not to pay the issue fee due.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). Moreover, foreign agents representing applicants for United States patents through local correspondence are held to the same standards of conduct, which apply to American counterparts. See Gemveto Jewelry Co. v. Lambert Bros., Inc., 542 F. Supp. 933, 216 USPQ 976 (S.D.N.Y. 1982) (wherein a patent was held invalid or unenforceable because patentee's foreign counsel did not disclose to patentee's United States counsel or to the Office prior art cited by the Dutch Patent Office in connection with the patentee's corresponding Dutch application.). Thus, even assuming Chou's representative failed to inform him of the Office's response to the after-allowance amendment to add a claim, Chou is bound by the consequences that result from his duly authorized representative's failure to act appropriately in a timely manner.

Moreover, the record does not explain to the satisfaction of the Director why Chou would think the period for response could be extended at all, less more than seven years, until the filing of the first petition to revive the application was received on November 1, 2006. Chou appears to argue on pages 2 and 3 of the renewed petition that had he seen the Notice of Allowance and Allowability indicating that extensions of time were not available and that prosecution was closed, he would have made the payment. Petitioner further argues that the delay in filing the petition to revive is due to his lack of knowledge of the system and his attorney failing to inform him of his options. These arguments are found unpersuasive. First, Chou admits on page 2 of the renewed petition his representative did inform him that the due date for payment of the issue fee was April 19, 1999. Second, the reason, in all likelihood, Chou's representative did not mention the possibility of extending the time period for response is because, under 35 U.S.C. § 151, no

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[4] Facsimile in the record is addressed to "Chih-Chung Chou."

[5] Page 3 of the "Renewed Petition under 37 CFR 1.137(b)."

extensions of time are permitted. Lastly, 37 CFR 1.312 states, "[n]o amendment may be made as a matter of right in an application after the mailing of the notice of allowance." As MPEP 714.16 further explains, "[c]onsideration of an amendment under 37 CFR 1.312 cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and thus be complete . . . at the time of the Notice of Allowance." Thus, in spite of the fact that Chou possessed the information that the due date for the issue fee was April 19, 1999, that the law does not permit an extension of time to pay the issue fee, and that the regulations do not permit entry of amendment filed after prosecution is closed as a matter of right, Chou still chose to wait for the Office to address an amendment filed after allowance and not pay the issue fee timely. All this evidence fails to demonstrate that the entire delay in responding to the Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed January 19, 1999 was unintentional.

As to period (2), petitioner argues:

> I thought it was abandoned then (in 2000) when I saw those notices and letter ***("not extendable", and no claim can be added)***, and the case was **closed, *no need to talk more, but I did not know actually there is still a process to revive it,*** so I did not apply a petition to revive it **right away** when I saw those notices, and letter, **and that is why it is long abandoned**.
> Last Aug. (Aug. 2006) I saw the patent application material again (from a pile of document mixed up in **a big grade 7 earthquake on Sept. 21st 1999**) and thought that there may be some process I could get it back, then **I asked around**, and found this petition process. That's why I make this petition application. I am late in petition **application because *I didn't even know the existence of this revival process until Aug. 2006.***

These statements indicate that Chou was aware of the abandonment in 2000, but was operating under assumption that he has no option to continue prosecution. At that time in 2000, Chou made a second conscious and deliberate choice not to pursue options to revive the application and continue prosecution. Moreover, the record does not reflect why in 2006 Chou would think he might be able to revive the application some six years later, but not believe or investigate whether it was possible to revive the application in 2000. The choice not to act to revive the application and to let the application be inactive for over six after Chou learned the application was abandoned shows a choice not to pursue the application and that Chou acquiesced to the status of application as abandoned.

Finally, Chou may be arguing that the earthquake that hit Taiwan on September 21, 1999 resulted in the delay in filing his petition to revive until November 1, 2006. However, while the earthquake may have caused some delay in responding, Chou was able to speak or meet with his Taiwanese representative in 2000. This meeting would have been a good opportunity for Chou to discuss the possibility of reviving the application. Additionally, because Chou was able to meet and speak with his representative in 2000, the earthquake and its fallout do not explain the delay in filing the petition from the meeting in 2000 until the filing of the original petition in November 1, 2006. In a nutshell, the record does not show that the consequences of the

earthquake caused the entire delay between the due date for the issue fee and the filing of the petition to revive the above application.

The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). Upon review, Chou has not explained to the satisfaction of the Director that the entire delay in replying the Notice of Allowance and Issue Fee Due and the Notice of Allowability was unintentional. Evidence in the record shows Chou made a deliberate decision withhold the issue fee payment beyond the statutory period for response. In addition, while Chou was aware that the application was abandoned in 2000, he waiting more than six years until filing a petition to revive the application and has not explained satisfactorily that the entire period of delay was unintentional.

Because petitioner has failed to demonstrate that the entire delay in paying the issue fee was unintentional, the $700 issue fee will be refunded by U.S. Treasury Check. The petition fee is not refundable.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

Charles Pearson
Director
Office of Petitions