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OFFICE OF PETITIONS

In re Application of :
Juris Zanis Pupols :
Application No. 10/336,582 : **ON PETITION**
Filed: January 6, 2003 :
Attorney Docket No. :

This is a decision on the renewed petition filed November 13, 2007 under 37 CFR 1.137(a) to revive the above-identified application.

The petition is **DENIED**.

BACKGROUND

The above-identified application became abandoned on March 12, 2004 for failure to file a proper reply to the Notice to File Corrected Application Papers mailed December 11, 2003, which set a shortened statutory period for reply of two (2) months. On March 11, 2004, petitioner filed a one (1) month extension of time along with a substitute specification but failed to submit the additional claim fees of \$645 (for fifteen independent claims over three) or properly cancel claims for which fees were due as required by the Notice mailed December 11, 2003. On March 19, 2004, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the period for reply remained as set forth in the Notice to File Corrected Application Papers mailed on December 11, 2003, and that the reply filed March 11, 2004 did not include the additional claim fees of \$645 and that applicant must submit the additional claim fees or cancel the additional claims for which fees were due. A Notice of Abandonment was mailed January 12, 2005. On June 6, 2005 a petition to revive the application under the unavoidable standard of 37 CFR 1.137(a) was filed. On July 14, 2005 the petition was treated as a petition under 37 CFR 1.181 as it lacked the fee required under 37 CFR 1.137(a) and was dismissed as petitioner failed to timely submit the required response to the Notice of March 19, 2004. On July 26, 2005 a renewed petition to withdraw the holding of abandonment was filed. The renewed petition was dismissed in the petition decision of August 19, 2005. On September 20, 2005 a renewed petition to withdraw the holding of abandonment was filed. This renewed petition was dismissed in the petition decision of May 3, 2006. A petition under 37 CFR 1.137(a) was filed November 1, 2006. The petition was dismissed in the petition decision of March 29, 2007 for lacking the

petition fee required. A renewed petition under 37 CFR 1.137(a) was filed June 5, 2007. The renewed petition was dismissed in the petition decision of September 5, 2007. The instant petition was filed November 13, 2007.

STATUTE AND REGULATION

35 U.S.C. 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 1.137(a) states:

If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(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(l);
- (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 (d) of this section.

OPINION

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, 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, 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).

The showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

Specifically, an application is "unavoidably" abandoned 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, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.

Initially it is noted that petitioner, after filing six (6) petitions and receiving five (5) petition decisions which informed petitioner in detail of the required response, has failed to submit the required response to the outstanding Notice, *i.e.*, petitioner has neither (1) submitted the additional claim fees of \$645 (\$150 remaining balance if previously paid fees are applied), nor (2) canceled the additional claims for which fees are due. The instant renewed petition lacks any new evidence that materially addresses the issues of incapacitation and financial hardship. Additionally, the instant renewed petition again submits a copy of the specification without any clear indication of claim cancellation or a submission of the required claim fees. Moreover, the instant renewed petition was filed outside the time period reply without the requisite extension of time under 37 CFR 1.136(a). It is not seen how this failure to properly reply to the outstanding Office requirements is the greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business.

35 U.S.C. 133 and 151 each require a showing that the "delay" was "unavoidable". Which requires not only a showing that the delay which resulted in the abandonment of the application was unavoidable, but also a showing of unavoidable delay until the filing of a petition to revive. See In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pat. 1990). The burden of continuing in the process of presenting a grantable petition in a timely manner likewise remains with the applicant until the applicant is informed that the petition is granted. Id at 1158. Thus, an applicant seeking to revive an "unavoidably" abandoned application must cause a petition

under 37 CFR 1.137(1) to be filed without delay (i.e., promptly upon becoming notified, or otherwise becoming aware, of the abandonment of the application).

Therefore, there are three periods to be considered during the evaluation of a petition under 37 CFR 1.137:

- (1) The delay in reply that originally resulted in the abandonment;
- (2) The delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and
- (3) The delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

Petitioner argues incapacitation and financial hardship are the cause of the delay.

Initially, petitioner asserts incapacitation as the cause of unavoidable delay. A showing of "unavoidable" delay based upon incapacitation must establish that petitioner's incapacitation was of such nature and degree as to render petitioner unable to conduct business (e.g., correspond with the Office) during each of the three periods discussed above. Such a showing must be supported by a statement from petitioner's treating physician, and such statement must provide the nature and degree of petitioner's incapacitation during this above-mentioned periods. Unfortunately, petitioner's showing of incapacitation does not support a finding of unavoidable delay.

Petitioner has included statements from physicians. These statements merely establish that petitioner received treatment for medical injuries on July 14, 2003, October 22, 2003, June 9, 2005, and December 13, 2005. None of the statements establish that petitioner's injuries were of such a nature and degree as to render petitioner unable to conduct business (e.g., correspond with the Office) during each of the three periods discussed above. The physicians statement of July 14, 2003, the date of petitioner's injury, from Memorial Center for Occupational Health and signed by Jeffrey P. Wiencek (submitted with the petition filed November 1, 2006) indicated that he could return to work on July 14, 2003 with the limitation of not deep knee bending and not lifting, pushing, or pulling more than 15 pounds. Another physicians statement of July 14, 2003, the date of petitioner's injury, from Memorial Center for Occupational Health and signed by Eric P. Wohlrab (submitted with the petition filed November 13, 2007) indicated that the employee is released to maximum lifting, pushing and pulling of 20 pounds. None of the documents submitted by petitioner indicate that the nature and degree of petitioner's injuries would prevent him from conducting business (e.g., correspond with the Office) during any of the three periods discussed above. Moreover, petitioner has corresponded with the Office six (6) times since his injury, which further suggests that the nature and degree of his injury did not render petitioner unable to conduct business with the Office during the relevant periods.

Additionally, petitioner asserts financial hardship as the cause of the unavoidable delay. A showing of unavoidable delay based upon financial hardship must establish that the financial condition of petitioner during the entire period of the delay was such as to excuse the delay. See Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891). A complete showing, with supporting documentation, is required of the financial condition of petitioner or the party responsible for payment of the fees. Such a showing should include all income, expenses, assets, credit, and obligations, which made the delay in payment of the fee during each of the above three periods "unavoidable". A monthly breakdown is preferred. In essence, petitioner must show that he was aware of the need to pay the fee, and to that end was attempting to pay it, but when the fee came due, was financially unable to make the payment until the grantable petition was filed. The showing should include documentary proof of petitioner's financial condition. Unfortunately, petitioner has not made such a showing addressing each of the three periods and, therefore, has not established to the satisfaction of the Director that the delay was unavoidable due to financial hardship.

In support of petitioner's assertion of financial hardship petitioner has submitted termination notice dated July 21, 2003 from Modineer Company, a foreclosure notice to J. Elizabeth Ropp dated December 2, 2005, a 2006 social security benefit statement, and letter denying credit dated October 23, 2007. It is noted that the termination notice in and of itself does not establish financial hardship; the foreclosure notice to J. Elizabeth Ropp does not establish financial hardship on the part of petitioner even though petitioner states he was responsible for the loan payments as it would not be prudent for a financial institution to make a loan to one person and expect payment from another, *i.e.*, the loan would be based on the ability of J. Elizabeth Ropp to repay it and not petitioner; and the social security benefit statement and the letter denying credit also are not evidence of financial hardship. Petitioner has failed to provide copies of bank statements, tax returns, expenses, assets, credit and obligations as previously requested in order to establish financial hardship. Without such an accounting it would be impossible to establish financial hardship. Moreover, the reply due to the outstanding Notice did not require a payment of fees as petitioner had the option of canceling the excess claims.

Under the circumstances, petitioner has not carried his burden of proof to show that the delay was unavoidable as required by statute and by regulations of the Patent and Trademark Office. Petitioner is reminded that a petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 U.S.C. 133. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2 1130 (N.D. Ind. 1987).

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, 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). 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 Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D).

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 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).

DECISION

Petitioner has failed to meet his burden of proving to the satisfaction of the Director the entire delay in submission of the response due was unavoidable within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a). Accordingly, the application will not be revived and remains abandoned. The petition is **denied**.

The USPTO will not further consider or reconsider this matter. 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.

This patent file is being returned to the Files Repository.

Telephone inquiries should be directed to the David Bucci at (571) 272-7099.



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