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NIRO SCAVONE HALLER & NIRO
181 W. MADISON AVENUE
SUITE 4600
CHICAGO IL 60602-4515

In re Application of :
Per Pettersen :
Application No. 09/617,060 : DECISION ON RENEWED PETITION
Filed: July 15, 2000 : UNDER 37 C.F.R. §1.181
Title: METHOD FOR ESTABLISHING :
POTENTIAL REVENUE LINKS TO A :
MERCHANT WEB SITE WITHIN AN :
AFFILIATE WEB PAGE :

This is a decision on the renewed petition filed on March 5, 2007, pursuant to 37 C.F.R. §1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

The renewed petition pursuant to 37 C.F.R. §1.181 is **DENIED**[1].

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the Office communication, mailed on October 6, 2005, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 7, 2006. A notice of abandonment was mailed on May 3, 2006.

The original petition was filed on June 6, 2006, and was dismissed via the mailing of a decision on January 19, 2007.

1 This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

RELEVANT PORTIONS OF THE MPEP

MPEP 402.06 states, *in pertinent part*:

> In the event that a notice of withdrawal is filed by the attorney or agent of record, the file will be forwarded to the appropriate official for decision on the request. The **withdrawal is effective when approved** (emphasis included) rather than when received.

MPEP §711.03(c)(I)(A) sets forth, *in toto*:

> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the

> mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

ANALYSIS

The showing in the present petition is not sufficient to withdraw the holding of abandonment.

The timeline of relevant events is as follows:

- August 26, 2005: a request for withdrawal of power of attorney was filed by the law firm of Morrison and Forster (Morrison), further requesting that the Office change the address of record to the law firm of Niro Scavone Haller & Niro (Niro)
- October 6, 2005: an Office communication was mailed to Morrison.
- November 30, 2005: a revocation of power of attorney with new power of attorney and change of address was filed by Niro.
- April 25, 2006: Morrison's Request to withdraw was granted via the mailing of a decision. The withdrawal of Morrison became effective on this date, pursuant to the portion of the MPEP reproduced above.
- May 3, 2006: a notice of abandonment was mailed, for failure to respond to the Office communication of October 6, 2005.
- June 6, 2006: the original petition was timely filed by Niro within two months of the mailing of the notice of abandonment. Petitioner indicated that Niro did not receive the Office communication, and incorrectly set forth that Niro was the correspondence address at the time of the mailing.
- January 19, 2007: a decision was mailed, dismissing Niro's request to withdraw the holding of abandonment, setting forth that pursuant to MPEP 402.06, a notice of withdrawal is not effective until the request is approved. As such, the Office communication was properly mailed on October 6, 2005 to the correspondence address at that time - Morrison.
- March 5, 2007: the present renewed petition was filed.

With this renewed petition, Petitioner has acknowledged that the office communication of October 6, 2005 was properly mailed to Morrison, and has set forth:

> the Morrison firm did not forward the October 6, 2005 Office Action to our office, and therefor, (sic) we were unaware that any such action did exist. We did not become aware of the October 6 2005 Office Action until receiving the Notice of Abandonment dated May 3, 2006.

As such, Petitioner has indicated that the Office communication in question was not received by the practitioner. Petitioner has further included a declaration of facts which includes a statement confirming that a search of the file jacket and docket records indicates that the Office communication was not received (from Morrison). Finally, Petitioner has included a copy of the docket record where the nonreceived Office communication would have been entered had it been received (from Morrison) and docketed.

Clearly, Petitioner is attempting to meet the requirements of Delgar v. Schulyer, as delineated in MPEP §711.03(c)(I)(A), reproduced above. However, the Delgar requirements are not relevant to the pertinent case, in that the Office did not mail the relevant communication to Petitioner. In Delgar, the Office mailed a notice of allowance to the applicant, and the Delgar showing provides a mechanism by which applicants can establish that a mailing was not received from the Office. Petitioner is attempting to establish that a mailing was not received from another law firm, a situation which is outside of the scope of Delgar.

CONCLUSION

The prior decision which refused to withdraw the holding of abandonment for the above-identified application has been reconsidered. Pursuant to the discussion above, the holding of abandonment will not be withdrawn.

No further reconsideration or review of this matter will be undertaken.

The decision on the original petition advised Petitioner to file a petition pursuant to 37 C.F.R. §§1.137(a) and/or (b), however it does not appear that any petition pursuant to Rule §1.137 has been filed. Petitioner would be well advised to submit this/these petition(s) promptly, for it has long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation[2].

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2 See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within

The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment[3]. Any further delay in filing the required petition to revive may be viewed as intentional, which is an absolute bar to revival.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office

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the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

3 See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.