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Paper No. 19.5

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In re Application of :
Michael R. Levine :
Application No. 08/384,442 : ON PETITION
Filed: February 2, 1995 :
For: SCHEDULE DISPLAY SYSTEM FOR :
VIDEO RECORDER PROGRAMMING

This is a decision on the renewed petition filed March 2, 1998,[1] which is being treated as a petition under 37 CFR 1.137 to revive the above-identified application.

The petition to revive the above-identified application is **DENIED**.

BACKGROUND

The above-identified application (application No. 08/384,442) was filed on February 2, 1995. The above-identified application claims the benefit under 35 U.S.C. § 120 of application No.

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[1] Copies of the petition of March 2, 1998, decision of September 29, 1997, and petition of May 21, 1997 were filed on June 21, 1999. The petition filed March 2, 1998, decision of September 29, 1997, and petition filed May 21, 1997 cannot be located within the file of the above-identified application (which is now located within the file of application No. 08/527,417, now U.S. Patent No. 5,508,815). Nevertheless, the evidence submitted on June 21, 1999 is convincing that a renewed petition to revive was filed on March 21, 1998 and was subsequently lost. The copies of petition of March 2, 1998, decision of September 29, 1997, and petition of May 21, 1997 filed on June 21, 1999 have been entered in the file of the above-identified application in place of the lost originals.

08/149,386, filed November 9, 1993 (now abandoned), which application claims the benefit under 35 U.S.C. § 120 of application No. 07/595,393, filed October 10, 1990 (now abandoned), which application claims the benefit under 35 U.S.C. § 120 of application No. 07/484,175, filed February 23, 1990 (now U.S. Patent No. 4,963,994), which application claims the benefit under 35 U.S.C. § 120 of application No. 07/213,162, filed June 29, 1988 (now U.S. Patent No. 4,908,713), which application claims the benefit under 35 U.S.C. § 120 of application No. 06/634,179, filed July 24, 1984 (now abandoned), which application claims the benefit under 35 U.S.C. § 120 of application No. 06/330,111, filed December 14, 1981 (now abandoned). A Notice of Allowance was mailed in the above-identified application (application No. 08/384,442) on June 27, 1995.

On September 13, 1995, petitioner deposited a request for a file wrapper continuing (FWC) application under former 37 CFR 1.62 of the above-identified application. The FWC request deposited on September 13, 1995 was signed by Allen M. Krass (Krass), petitioner's representative of record in the above-identified application. The FWC request deposited on September 13, 1995 contained: (1) a warning that its filing would result in the express abandonment of the prior application (page 1); and (2) a box to request that the prior (the above-identified) application be abandoned when the FWC application is accorded a filing date, which box was marked (not pre-printed) with a double "X" (page 10).

The FWC request deposited on September 13, 1995 was accorded a filing date of September 13, 1995 as a proper application under former 37 CFR 1.62 and was assigned application No. 08/527,417. The above-identified application (application No. 08/384,442) was processed into the file of application No. 08/527,417, and was expressly abandoned by operation of former 37 CFR 1.62(g). FWC application No. 08/527,417 issued on April 16, 1996 as U.S. Patent No. 5,508,815.

A petition under 37 CFR 1.137(a) was filed on March 19, 1997, and was dismissed in a decision mailed September 29, 1997. The instant renewed petition under former 37 CFR 1.316(b) was filed on March 2, 1998.[2] The instant petition requests that: (1) the above-identified application be revived pursuant to 37 CFR 1.137(a); (2) the above-identified application be revived pursuant to 37 CFR 1.137(b); or (3) the former one year filing period requirement in 37 CFR 1.137(b) be

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[2] Papers in a FWC application are numbered beginning with the number after the last paper in the prior application (*i.e.*, the Notice of Allowance in the above-identified application is paper No. 19, and the information disclosure statement submitted in FWC application No. 08/527,417 is paper No. 20). To avoid confusion, the petition under 37 CFR 1.137 of March 19, 1997 is assigned paper No. 19.1, the decision of September 29, 1997 is assigned paper No. 19.2, the instant petition under 37 CFR 1.137 of March 2, 1998 is assigned paper No. 19.3, the paper filed June 21, 1999 is assigned paper No. 19.4, and this decision is assigned paper No. 19.5.

waived pursuant to 37 CFR 1.183 and the above-identified application be revived pursuant to 37 CFR 1.137(b).

STATUTE AND REGULATION

35 U.S.C. § (6)(a) provides, in part, that:

> The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

Section 3 of Public Law 97-247, 96 Stat. 317 (1982), amended 35 U.S.C. § 41 to provide for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." 35 U.S.C. § 41(a)(7) specifically provides that the Commissioner shall charge:

> On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $110.

Section 532 of Public Law 103-465, 108 Stat. 4809 (1994), amended 35 U.S.C. § 154 to provide, in part, that:

> (a) * * *
> (2) TERM.-Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.
> * * * * *
> (c) CONTINUATION.-
> (1) DETERMINATION.-The term of a patent that is in force on or that results from an application filed before [June 8, 1995] shall be the greater of the 20-year term as provided in subsection (a), or 17 years from grant subject to any terminal disclaimers.
> * * * * *

35 U.S.C. § 133 provides 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 Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

35 U.S.C. § 151 provides that:

> 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.
>
> Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.
>
> If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

Former 37 CFR 1.62[3] provided, in part, that:

> (a) * * * * *
>
> (e) An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application number. Changes to the prior application must be made in the form of an amendment to the prior application as it exists at the time of filing the application under this section.

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[3] In December of 1997, FWC application practice under 37 CFR 1.62 was replaced with continued prosecution application practice under 37 CFR 1.53(d), and the provisions for revival of an abandoned application or lapsed patent were revised and condensed into a single section (37 CFR 1.137). See Changes to Patent Practice and Procedure, Final Rule Notice, 62 Fed. Reg. 53131 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63 (October 21, 1997).

No copy of the prior application or new specification is required. The filing of such a copy or specification will be considered improper, and a filing date as of the date of deposit of the request for an application under this section will not be granted to the application unless a petition with the fee set forth in § 1.17(i) is filed with instructions to cancel the copy or specification.

(f) * * * * *

(g) The filing of a request for a continuing application under this section will be considered to be a request to expressly abandon the prior application as of the filing date granted the continuing application.

37 CFR 1.137(b) provides:

Unintentional. Where the delay in reply was unintentional, 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 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(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 Commissioner 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 (c) of this section.

37 CFR 1.138 provides that:

An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant and the assignee of record, if any, and identifying the application. An application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

DECISION

Petitioner, Michael R. Levine (Levine) asserts, *inter alia*, that: (1) Levine entered into a series of agreements with Gemstar Development Corporation (Gemstar) under which Gemstar licensed (*inter alia*) U.S. Patent No. 4,908,713 and the above-identified application; (2) Starsight Telecast, Inc. (Starsight) brought suit against Gemstar and Levine on January 21, 1994, which involved allegations of unequitable conduct during the prosecution of the application for U.S. Patent No. 4,908,713; (3) depositions were taken of William Leventer and Charles B. Clupper (Leventer and Clupper depositions) on February 13, 1995 in the course of the lawsuit between Gemstar and Starsight; (4) upon or after receipt of the Notice of Allowance of June 27, 1995, petitioner's representatives determined that the Leventer and Clupper depositions needed to be disclosed to the Patent and Trademark Office (PTO) to avoid an allegation by Starsight of unequitable conduct during the prosecution of the above-identified application; and (5) petitioner filed a FWC application to ensure that the Leventer and Clupper depositions were considered by PTO in the FWC application. Petitioner argues, *inter alia*, that: (1) the abandonment of the above-identified was not intentional because petitioner was forced by the duty of disclosure and PTO regulation (37 CFR 1.97) to file a FWC application to obtain consideration of the Leventer and Clupper depositions; and (2) the twenty (20) month delay between the filing of the FWC application (and abandonment of the above-identified application) and the filing of a petition under 37 CFR 1.137 to revive the above-identified application was not intentional because of the ongoing litigation between Gemstar and Starsight.

Initially, it is brought to petitioner's attention that, while petitioner failed to timely pay the issue fee in reply to the Notice of Allowance of June 27, 1995, the above-identified application is not abandoned by operation of 35 U.S.C. § 151 and 37 CFR 1.316 for failure to timely pay the issue fee in reply to the Notice of Allowance of June 27, 1995. The above-identified application was expressly abandoned by operation of 37 CFR 1.62(g) due to petitioner's filing (and the PTO's recognition) of a request for a FWC of the above-identified application. Therefore, the above-identified application (08/384,442) became abandoned as of September 13, 1995 (the filing date accorded FWC application No. 08/527,417) by operation of 37 CFR 1.62(g).

37 CFR 1.137(a) and (b) contemplate the revival of an application abandoned for failure to timely reply to an Office action or notice ("[w]here the delay in reply was" "unavoidable" (37 CFR 1.137(a)) or "unintentional" (37 CFR 1.137(b)), not the revival of an expressly abandoned application. Public Law 97-247 amended the patent statute at 35 U.S.C. § 41(a)(7) to authorize the Commissioner 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 (emphasis added).

In the absence of legislative intent to the contrary, when a statute expressly provides a specific remedy for a situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n of R.R. Passengers, 414 U.S. 453, 458 (1974)(*expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing) is a standard principle of statutory construction); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress provided a specific scheme for the revival of abandoned applications in Public Law 97-247 (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each situation), the creation of other schemes for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 133, 151, and 371(d). See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because the patent statute (35 U.S.C. §§ 41(a)(7), 133, or 151) do not provide for the revival of an application abandoned in such a manner).

That the provisions under which an applicant may expressly abandon an application are solely a creation of the rules of practice does not affect the status of an application in which an applicant has filed (and the Office has recognized) a declaration of abandonment as an application that is abandoned within the meaning of the patent statute (*e.g.*, 35 U.S.C. §§ 41(a)(7) and 120). The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See In re Morganroth, 6 USPQ2d 1802, 1803 (Comm'r Pats. 1988). In addition, under 35 U.S.C. § 120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, and (3) proceedings in the application may be terminated. Id. When the applicant files and the PTO recognizes a written declaration that the applicant seeks to discontinue prosecution, proceedings in that application are terminated no later that the date of such recognition. Where proceedings in an application are terminated in a manner which does not result in an allowance of the application, such application is no longer pending but is abandoned. Cf. MPEP 1214.06 & 1216.01.

Thus, while the patent statute does not provide for express abandonment of an application, an application becomes abandoned within the meaning of that term as it is used in the patent statute (*e.g.*, 35 U.S.C. §§ 41(a)(7) and 120) by operation of the filing by the applicant and recognition by the PTO of a written declaration that the applicant seeks to discontinue prosecution in (or expressly abandon) an application. That is, while the Office need not have promulgated rules

and procedures for the acceptance of a written declaration of express abandonment, by doing so, an application will become abandoned within the meaning of that term as it is used in the patent statute upon recognition of a written declaration of express abandonment.

Therefore, any petition that the above-identified application be revived or otherwise restored to pending status must be authorized by 35 U.S.C. §§ 41(a)(7), 111, 133, 151, or 371(d) and pursuant to their implementing regulation (37 CFR 1.137).

35 U.S.C. §§ 111, 151,[4] or 371(d) obviously do not apply in instances in which an applicant has expressly abandoned an application. In addition, 35 U.S.C. § 133 authorizes the Commissioner to revive an application abandoned for failure to prosecute in instances in which it is shown to the satisfaction of the Commissioner that the delay in prosecution was unavoidable, but does not authorize the Commissioner to revive an application abandoned by express or formal abandonment. See Ex parte Hirth, 1908 Dec. Comm'r Pat. 240, 241 (1908).[5] Thus, in instances in which an applicant has expressly abandoned an application, the revival of such application must be under and authorized by 35 U.S.C. § 41(a)(7), in that the express abandonment of such application must have been unintentional for the PTO to be authorized to revive the application.

Accordingly, any petition to revive this expressly abandoned application must be under 35 U.S.C. § 41(a)(7) and its implementing regulation (37 CFR 1.137(b)).

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[4] As discussed above, the above-identified application did not become abandoned by operation of 35 U.S.C. § 151 and 37 CFR 1.316 due to petitioner's failure to timely pay the issue fee, but by operation of 37 CFR 1.62(g) due to petitioner's filing of a FWC application.

[5] In any event, the record does not show that the abandonment of the above-identified application occurred despite the exercise of due care on the part of petitioner. See Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887); see also Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995)(to satisfy the "unavoidable delay" standard of 35 U.S.C. § 133, one must show that he or she exercise the due care of a reasonably prudent person); and In re Mattullath, 38 App. D.C. 497, 514-15 (1912). The clear showing of record is that the abandonment of the above-identified application occurred due to deliberate and intended action (filing of a FWC application) on the part of petitioner. In addition, petitioner did not file a petition under 37 CFR 1.137(a) upon becoming aware of the abandonment of the above-identified application. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable delay pursuant to 37 CFR 1.137(a). See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

37 CFR 1.137(b) as amended in December of 1997 (rather than former 37 CFR 1.137(b)) is applicable to the instant petition to revive the above-identified application. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53159-60, 1203 Off. Gaz. Pat. Office at 87. Therefore, the alternative request that the former one year filing period requirement in 37 CFR 1.137(b) be waived pursuant to 37 CFR 1.183 so as to permit revival of the above-identified application under 37 CFR 1.137(b) is moot.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by 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, but also provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the 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).

There are three (3) periods to be considered in evaluating 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. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53158, 1203 Off. Gaz. Pat. Office at 86. As the record shows that the abandonment of the above-identified application was not unintentional, the above-identified application does not meet the "unintentionally abandoned application" requirement of 35 U.S.C. § 41(a)(7) to be revived under either current or former 37 CFR 1.137(b). In addition, the record also shows that the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the above-identified application was not unintentional.

As discussed above, the above-identified application was expressly abandoned by operation of former 37 CFR 1.62(g) when petitioner, through his representative of record, filed a request for a FWC application of the above-identified application. The showing of record precludes a finding that the express abandonment (by operation of 37 CFR 1.62(g)) of the above-identified application was the result of omission, oversight, or inadvertence. Petitioner submitted a FWC request containing a box marked, and not pre-printed, with a double "X" to request that the prior (the above-identified) application be abandoned when the FWC application is accorded a filing date, and this FWC request was signed by petitioner's representative of record (Krass). This action manifests an intent to abandon the above-identified application in favor of the FWC application.

Petitioner also acknowledges that the express abandonment of the above-identified application was the intended result of the filing of a FWC application. Krass specifically acknowledges that:

> On September 13, 1995, I filed a file wrapper continuation with a Supplemental Information Disclosure Statement disclosing the [Clupper and Leventer depositions] and Ackley et al. patent and simultaneously filed an express abandonment.

See Petition of May 27, 1997, Krass aff., ¶ 9.

Krass further acknowledges that:

> . . . [I]t was decided to re-file the case, submitting the Clupper and Leventer [depositions] as part of a new Information Disclosure Statement (Exhibit F). We were forced to re-file the [above-identified] application as a file-wrapper continuation application, since the filing of a continuation application would enable the [above-identified] application to issue as a patent[6] without citing the Clupper and Leventer [depositions]. It was therefore necessary to abandon the [above-identified] application].

See Petition of March 2, 1998, Krass decl. (copy unsigned), ¶ 18.

Petitioner has not asserted that the express abandonment (by operation of 37 CFR 1.62(g)) of the above-identified application was an unintended result of the filing of a FWC application on September 13, 1995.[7] Rather, the showing of record is that the express abandonment of the above-identified application (via the filing of an FWC request) was an act of deliberation,

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[6] FWC application No. 08/527,417 is a continuation application. Presumably, petitioner means since the filing of an application under 37 CFR 1.53(b) or former 1.60 would enable the above-identified application to issue as a patent.

[7] As discussed above, while petitioner failed to timely pay the issue fee in reply to the Notice of Allowance of June 27, 1995, the above-identified application is not abandoned for failure to timely pay the issue fee in reply to the Notice of Allowance of June 27, 1995, but was expressly abandoned by operation of 37 CFR 1.62(g) due to petitioner's filing (and the PTO's recognition) of a request for a FWC of the above-identified application. Petitioner's failure to timely pay the issue fee in reply to the Notice of Allowance of June 27, 1995 simply confirms that petitioner's abandonment of the above-identified application (via filing of a FWC application) was an act of deliberation, intentionally performed, and not the result of omission, oversight, or inadvertence (*i.e.*, was not unintentional).

intentionally performed. See MPEP 711.01. In view of the statements by petitioner's representative (Krass) and document (FWC request) signed by petitioner's representative showing that the abandonment of above-identified application (via the filing of an FWC application) was the result of a deliberate intent to abandon the above-identified application, the PTO cannot conclude that the above-identified application is an "unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(a)(7). See Application of G, 11 USPQ2d at 1380.

The argument that petitioner was forced to file a FWC application to ensure consideration of the Leventer and Clupper depositions by the PTO at best addresses why petitioner intentionally filed a FWC application and expressly abandoned the above-identified application.[8] It does not cause petitioner's prior intentional abandonment of the above-identified application to become an unintentional abandonment:

> An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival. . . . An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an

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[8] Petitioner cites and relies upon In re Katrapat, A.G., 6 USPQ2d 1863 (Comm'r Pat. 1988), as supporting the position that petitioner's decision to file a FWC application constituted the exercise of the due care of prudent and careful persons in relation to their most important business (petition of March 2, 1999 at 10-15). This argument fails to distinguish the exercise of due care in taking the necessary steps to continue prosecution of an application (to which Pratt and its progeny are applicable), and the exercise of due care in determining whether to continue the prosecution of an application. When an application is abandoned as a result of a decision to permit the application to become abandoned, such abandonment (and delay) is considered a deliberately chosen course of action, and is not unintentional (much less unavoidable) within the meaning of 37 CFR 1.137. Cf Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53161-62, 1203 Off. Gaz. Pat. Office at 66 (response to comment 66: errors in judgment as to whether to permit an application to become abandoned cannot form the basis of unintentional delay within the meaning of 37 CFR 1.137).

> abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to [37 CFR] 1.137.

See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53158-59, 1203 Off. Gaz. Pat. Office at 86 (citations omitted).

In addition, PTO regulations did not require petitioner to file a FWC and expressly abandon the above-identified application. Petitioner could have submitted an information disclosure statement (IDS) containing the Leventer and Clupper depositions in the above-identified application with a petition under 37 CFR 1.183 (recounting the circumstances outlined in the instant petition) requesting that the PTO waive the requirements of 37 CFR 1.97(e) and consider such IDS. Petitioner chose the route of expressly and intentionally abandoning the above-identified application in favor of a FWC application to gain consideration of the Leventer and Clupper depositions in the FWC over the route seeking consideration of the Leventer and Clupper depositions in the above-identified application via a petition under 37 CFR 1.183. Moreover, PTO regulations did not prevent petitioner from evaluating whether the Leventer or Clupper depositions (or other information) should be submitted to the PTO until a Notice of Allowance was mailed in the above-identified application (June 27, 1999).

In any event, the time period and certification requirements of 37 CFR 1.97 are purely regulatory. Thus, if petitioner had sought consideration of the Leventer and Clupper depositions in the above-identified application via a petition under 37 CFR 1.183, the PTO could have taken the circumstances outlined by petitioner in the instant into account in considering such a petition. Petitioner, however, expressly and intentionally abandoned the above-identified application in favor of a FWC application to gain consideration of the Leventer and Clupper depositions in the FWC application. The patent statute does not authorize the PTO to revive an abandoned application, unless such application is "an unintentionally abandoned application." See 35 U.S.C. § 41(a)(7). The PTO cannot waive or ignore a requirement of the patent statute to rescue applicants from the results of their actions or inactions. See Baxter International, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-35 (Fed. Cir. 1998); Brenner v. Ebbert, 398 F.2d 762, 764, 157 USPQ 609, 610 (D.C. Cir. 1968).

Finally, petitioner choice of filing mechanism (a FWC application under former 37 CFR 1.62) for the continuing application in which to gain consideration of the Leventer and Clupper depositions does not support a conclusion that further prosecution (or issuance) of the above-identified application was contemplated in September of 1995 or anytime prior to May of 1997. Petitioner could have filed a continuing application under any of 37 CFR 1.53(b), former 1.60, or former 1.62 and obtained consideration of the Leventer and Clupper depositions such continuing application (even if petitioner considered it a necessity to permit the above-identified application

to become abandoned by not timely paying the issue fee).[9] Petitioner chose the only one (former 37 CFR 1.62) of these three filing mechanisms that required use of the file wrapper and contents of the above-identified application for the continuing application (37 CFR 1.62(e), rendering further prosecution and issuance of the above-identified application infeasible (since its contents are now the contents of application No. 08/527,417, now U.S. Patent No. 5,508,815).

Petitioner's explanation of the delay between September of 1995 and May of 1997 (continuing litigation and search for prior art) does not support a conclusion that this delay was unintentional, but in fact supports the conclusion that the abandonment of the above-identified application in September of 1995 and delay until May of 1997 in seeking revival was intentional. There was no reasonable justification for delaying revival of the above-identified application while the duty of candor issues in the litigation between Gemstar and Starsight were resolved or any search for prior art was being completed (*i.e.*, these matters did not require or cause petitioner to delay the prosecution of FWC application No. 08/517,417, or its issuance in April of 1996 as U.S. Patent No. 5,508,815). There is nothing in the patent statute, rules of practice, or MPEP requiring (or even suggesting) that all relevant prior art be uncovered before an applicant seeks revival of an abandoned application. To the contrary, the PTO has indicated that petitions to revive must be filed promptly or without delay after the applicant becomes aware of the abandonment. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53161 and 53162-63, 1203 Off. Gaz. Pat. Office at 88-89 and 90 (responses to comments 65 and 71); and Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991).

Petitioner's explanation of delay between September of 1995 and May of 1997 in seeking revival of the above-identified application supports the conclusion that this delay was result of a deliberate choice rather than necessity. Thus, petitioner's decision to delay seeking revival of the above-identified application until May of 1997 (twenty (20) months after petitioner expressly and intentionally abandoned the above-identified application) precludes a conclusion that the entire delay between September of 1995 and May of 1997 was unintentional.

Finally, petitioner complains that this situation threatens to deprive petitioner of eleven (11) years of patent protection to which petitioner is entitled. Patent No. 5,508,815 is not entitled to a patent term of the longer of twenty years from its earliest claimed filing date under 35 U.S.C. §§ 120, 121, or 365(c) or seventeen years from its date of grant because that patent was applied

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[9] Petitioner asserts that under the unique circumstances of the above-identified application, petitioner had to file a FWC application (petition of March 2, 1998 at 14); however, petitioner provides no explanation, and there is no reason, as to why petitioner had no choice but to file the continuing application under former 37 CFR 1.62 (rather than 37 CFR 1.53(b) or former 1.60).

for on or after June 8, 1995. See 35 U.S.C. § 154(c)(1). While any patent issuing on the above-identified application would have been entitled to a patent term of the longer of twenty years from its earliest claimed filing date under 35 U.S.C. §§ 120, 121, or 365(c) or seventeen years from its date of grant (subject the terminal disclaimer filed in the above-identified application), that possibility was lost because petitioner expressly abandoned the above-identified application in favor of an application filed on or after June 8, 1995. Put simply, petitioner's patent term situation is a result of petitioner's actions (expressly abandoning the above-identified application in favor of an application filed on or after June 8, 1995) and not the result of any action or inaction on the part of the PTO.

CONCLUSION

As this application was intentionally abandoned, a course of action deliberately chosen by petitioners, this application cannot reasonably be considered "an unintentionally abandoned application" within meaning of 35 U.S.C. § 41(a)(7). In addition, the entire delay between September of 1995 and May of 1997 in seeking revival of the above-identified cannot reasonably be considered to have been unintentional within meaning of 37 CFR 1.137(b). Accordingly, petitioner cannot establish to the satisfaction of the Commissioner either: (1) that the above-identified application was "an unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(a)(7) or; (2) that "the entire delay . . . until the filing of [any] petition pursuant to [37 CFR 1.137] was unintentional" within the meaning of 37 CFR 1.137(b)(3).

For the above-stated reasons, the petition under 37 CFR 1.137 to revive the above-identified application (application No. 08/384,442) is **denied**. Therefore, the above-identified application will not be revived and remains abandoned.

This decision may be viewed as final agency action. See MPEP 1002.02(b). The provisions of 37 CFR 1.137(d) do **not** apply to this decision.

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

The application file (which is in the file of U.S. Patent No. 5,508,815) is being forwarded to Files Repository.

Stephen G. Kunin
Deputy Assistant Commissioner
for Patent Policy and Projects

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