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OFFICE OF PETITIONS

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In re Application of
Williard M. Stephens
Application No. 09/205,412
Filed: December 3, 1998
Attorney Docket No.: 11703-1100
Title: VEHICLE SUN VISOR PROMOTIONAL DECAL HOLDER WITH STRETCHABLE BAND ATTACHMENT

DECSION ON SECOND RENEWED PETITION UNDER 37 C.F.R. §1.137(B)

This is a decision on the second renewed petition filed December 9, 2005, pursuant to 37 C.F.R. §1.137(b)[1], to revive the above-identified application.

The request to revive the above-identified application is **DENIED**[2].

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed November 23, 1999, which set a shortened statutory period for reply of three (3) 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 February 24, 2000. A Notice of Abandonment was mailed June 1, 2000.

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1 A grantable petition pursuant to 37 CFR 1.137(b) 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 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 (d) of this section.

2 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.

Statute, Rule, and Portion of the MPEP relevant to the abandonment of this application

35 U.S.C. 133 Time for prosecuting application.

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. § 1.135 Abandonment for failure to reply within time period.

(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.
(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

MPEP 711.03(c) sets forth, in part:

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), 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 [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional (emphasis added) as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b).

Background

Prior to the filing of this petition, Petitioner submitted a letter on January 2, 2004, requesting that the above-identified application be revived. On January 30, 2004, the Office responded to this letter, informing the applicant that he may wish to consider filing a petition under 37 C.F.R. §§1.137(a) or (b). The response described the requirements of each of these portions of the C.F.R., including the requirement to provide the required reply.

On March 8, 2004, Petitioner submitted a duplicate copy of what had been previously presented on January 2, 2004. On March 31, 2004, the Office sent another letter, again informing the applicant that he may wish to consider filing a petition under 37 C.F.R. §§1.137(a) or (b). The response described the requirements of each of these portions of the C.F.R., including the requirement to provide the required reply.

Petitioner next submitted a petition under 37 C.F.R. §1.137(a). The original petition under 37 C.F.R. §1.137(a) was submitted on July 22, 2004, and was dismissed via the mailing of a

decision on September 14, 2004, for failure to submit any petition fee. The decision indicated that the required reply would need to be provided before the petition could be granted.

The renewed petition under 37 C.F.R. §1.137(a) was filed on December 8, 2004, and was dismissed via the mailing of a decision on February 1, 2005. The decision set forth, in part:

> Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action. The required reply (emphasis added) is the reply sufficient to have avoided abandonment, had such reply been timely filed[3]. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1), i.e. either an amendment, a request for reconsideration, or the filing of a continuing application. The petition was not accompanied by any of these replies.
>
> It is noted that the decisions mailed on January 30, 2004, March 31, 2004, and September 14, 2004 each made reference to the requirement of the required reply (emphasis added), yet the reply has not been submitted. Since the requirement for this reply was set forth in three separate decisions, the failure to submit the same appears to be intentional. Petitioner will need to explain why the failure to submit the same does not constitute an intentional delay of the presentation of a grantable petition, since intentional delay constitutes an absolute bar to revival.

Petitioner next submitted the original petition under 37 C.F.R. §1.137(b) on May 2, 2005, and this petition was dismissed via the mailing of a decision on May 19, 2005, for failure to submit the petition fee in full. It is noted that the decision reiterated the need for the required reply.

A renewed petition under 37 C.F.R. §1.137(b) was submitted on July 21, 2005 along with the petition fee, which was dismissed via the mailing of a decision on September 6, 2005. The decision set forth, in part:

> Regarding the first requirement, the requirement has not been satisfied because Petitioner did not submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed[4]. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(a)(1), i.e. either an amendment, a request for reconsideration, or the filing of a continuing application. This petition was not accompanied by any of these replies.
>
> It is noted that the decisions mailed on January 30, 2004, March 31, 2004, September 14, 2004, February 1, 2005, and May 19, 2005 each made reference to the requirement of the required reply, yet the reply has not been submitted. Since the requirement for this reply was set forth in five separate decisions, the failure to submit the same appears to be intentional. Petitioner has had numerous occasions to present a response to the non-final Office action of November 23, 1999, but has failed to do so on a plurality of occasions. Petitioner will need to explain why he has chosen not to submit the required reply, as well as why the Office should not determine that the failure to submit the same does not constitute an intentional delay of the presentation of a grantable petition, since intentional delay constitutes an absolute bar to revival.

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3 See M.P.E.P. 711.03(c).

4 See M.P.E.P. 711.03(c).

Analysis

With the present second renewed petition under 37 C.F.R. §1.137(b), Petitioner has included the one-month extension of time which is required to make the previous petition of July 21, 2005 timely. Petitioner has further asserted that the delay has been unintentional, and has been due to a lack of knowledge of the applicable rules as well as a lack of finances[5]. Petitioner has indicated that it is his intent to dedicate "special time to educating myself on the 37 CFR and other patent related information[6]."

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors[7].

Both the portion of MPEP 711.03(c) cited above and simple logic set forth that Petitioner cannot assert that the entire period of delay was unintentional if the delay was in fact intentional.

As developed above, the present application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed November 23, 1999.

Petitioner was made aware of the need to submit a required reply to this non-final rejection on 6 separate occasions: the need was expressly indicated in the Office mailings of January 30, 2004, March 31, 2004, September 14, 2004, February 1, 2005, May 19, 2005, and September 6, 2005. With the latter two decisions, Petitioner was warned that the continued failure to submit the required reply could result in the finding that the delay was intentional, an absolute bar to revival. With each of his submissions, Petitioner has submitted nothing that could be construed as even an attempt to submit a reply.

The non-final Office action of November 23, 1999 has been reviewed, and it is clear that the Examiner indicated that the claims contained allowable subject matter. However, Petitioner does not appear to be willing to overcome these rejections, and seems intent on unnecessarily prolonging the examination process by continuing to file a plurality of petitions, each of which fails to address the merits of the rejection.

It is clear that Petitioner has, on numerous occasions, intentionally chosen not to submit the required reply. As such, it is obvious that Petitioner has intentionally delayed prosecution, and as such, the present application cannot be revived.

With the present petition, Petitioner has implied that he needs more time to study the applicable rules. It is noted that the non-final rejection in question was mailed over 6 years ago. Petitioner

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5 Petition, pages 1 and 2.
6 Id at 2.
7 See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

would be hard pressed to assert that these 6 years have posed an insufficient period of time in which to prepare a response.

In summation, Petitioner has chosen not to properly responded to the Examiner's rejection. On numerous occasions, Petitioner has been warned that the failure to submit the required response would be viewed by the Office as intentional delay. Petitioner does not appear interested in furthering the prosecution of this application. To the contrary, Petitioner is intentionally stalling the prosecution of this application by the continued filing of petitions which do not contain a submission which could be construed as an attempt to respond to the non-final Office action. As such, the Office has no choice but to determine that Petitioner is intentionally delaying the prosecution of this application. As is set forth above, the finding of intentional delay precludes revival under 37 C.F.R. §1.137(b).

CONCLUSION

The prior decisions which refused to reinstate the instant application under 37 C.F.R §1.137(b), have been reconsidered. For the above stated reasons, the delay in this case cannot be regarded as unintentional within the meaning of 37 C.F.R. §137(b).

THERE WILL BE NO FURTHER RECONSIDERATION OF THIS MATTER BY THIS OFFICE.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

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