



Paper No. 36
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OFFICE OF PETITIONS

In re Application of
Frade
Application No. 09/581,472
Filed: August 14, 2000
Attorney Docket No. P06781US00/BAS

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:DECISION ON PETITION
:UNDER 37 CFR 1.181(a)(3)
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This is a decision on the petition under 37 CFR 1.182 filed January 5, 2004, which is being treated as a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director to review the decision of the Group Director of Technology Center 1600 (Group Director) of November 5, 2003, and to withdraw the holding of abandonment in the above-identified application.

The petition to withdraw the holding of abandonment in the above-identified application is **DENIED**.

BACKGROUND

A Notice of Allowance and Issue Fee Due was mailed January 30, 2003, and set a three-month non-extendable period within which the issue fee must be paid in order to avoid abandonment. A Notice of Allowability was also mailed January 30, 2003, which noted the presence of certain informalities (at ¶ 8(a)) in drawing figures 3, 4, 7A, 7E, and 13A, as specified in the attached form PTO-948, and set a three-month non-extendable period within which corrected drawings must be filed. The Notice of Allowability further indicated that failure to timely comply with these requirements would result in abandonment of the above-identified application.

On April 2, 2003, petitioner filed corrected drawings, with the exception of a corrected Figure 3, and on April 30, 2003, petitioner paid the issue fee.

On May 19, 2003, according to an internal communication in the file (form E-S), the Office of Publications noted that the reply of April 2, 2003, failed to include a corrected Figure 3, required by the Notice of Allowability of January 30, 2003, and queried the Official Draftsman as how to resolve the question. The Official Draftsman determined that the PTO-948 had not been answered.

On June 19, 2003, a Notice of Abandonment was mailed. The Notice of Abandonment indicated that reason for the holding of abandonment was that the proposed new drawings were not acceptable, and provided information on reviving the application.

On August 19, 2003, petitioner filed a petition to withdraw the holding of abandonment, which petition was denied by the Group Director in a decision dated November 5, 2003.

The instant petition was filed January 5, 2004.

STATUTE AND REGULATION

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

The Office...may establish regulations, not inconsistent with law, which...

(A) shall govern the conduct of proceedings in the Office .

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 1.85(c) states

If a corrected drawing is required or if a drawing does not comply with § 1.84 at the time an application is allowed, the Office may notify the applicant and set a three month period of time from the mail date of the notice of Allowability within which the applicant must file a corrected or formal drawing in compliance with § 1.84 to avoid abandonment. This time period is not extendable under § 1.136(a) or § 1.136(b).

37 CFR 1.135(c) states:

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.

OPINION

Petitioner requests higher level review of the decision of the Group Director. Petitioner argues that while the reply of April 2, 2003, inadvertently failed to include copies of a corrected Figure 3, the reply of April 2, 2003 included all other items required by the Notices of Allowance and Allowability, and constituted a *bona fide* attempt by petitioner to advance this case to final action. Petitioner argues that rather than holding the application abandoned, they should have been given a further time period within which to perfect their reply under the provisions of 37 CFR 1.135(c).

The Group Director's decision has been reviewed, but this review fails to reveal reversible error in her holding that this application is abandoned.

Initially, there is no dispute that petitioner's reply of April 2, 2003, failed to include a corrected Figure 3, which, *inter alia*, had been required by the Notice of Allowability of January 20, 2003. The Notice of Allowability of January 20, 2003, however, clearly indicated that petitioner was required to file a reply complying with all the noted requirements to avoid abandonment, and those requirements clearly specified, *inter alia*, that a corrected Figure 3 must be filed within three months in order to avoid abandonment.

Thus, petitioner received the reasonable notice required so as ensure a timely and complete reply to the Notice of Allowability, as well the consequences of a flawed reply. That petitioner failed to timely and adequately reply by including a corrected Figure 3 in their reply was unfortunate, but such failure did not operate to save this application from abandonment (35 U.S.C. § 133; 37 CFR 1.85(c)).

Petitioner's contention that the provisions of 37 CFR 1.135(c) were, improperly, not followed in this instance is not persuasive. The regulation is specifically limited to the discretionary treatment of a "reply [only] to the non-final Office action," and is intended to facilitate advancement of prosecution to final Office action. A Notice of Allowability in this or any application is not a "non-final Office action" within the meaning of 37 CFR 1.135(c). Rather, the mailing of a Notice of Allowability in this or any application signals the culmination of prosecution where it indicates the allowability of all claims and, as clearly stated thereon, closes the application to further prosecution in the same manner as the mailing of a final Office action. See Ex parte Quayle, 25 USPQ 74 (Comm'r Pat 1935). Thus, the provisions of 37 CFR 1.135(c) are not applicable to the treatment of a defective reply to a Notice of Allowability.

Even assuming, *arguendo*, 37 CFR 1.135(c) is applicable to the circumstances of this case, the regulation merely authorizes, but does not require, an applicant to be given a new time period within which to supply an inadvertent omission to the non final office action. See 37 CFR 1.135(c) ("applicant *may* be given a new time period for reply under § 1.134 to supply the omission" (emphasis added)). Although the USPTO may attempt

to notify parties as to defective papers in order to permit timely refiling, it has no obligation to do so. See In re Colombo Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994). Rather, it is the applicant who is ultimately responsible for filing proper documents. See id.

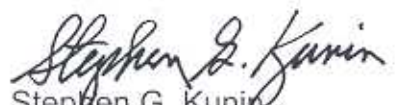
Petitioner relies upon a copy of a Notice To File Corrected Application Papers (Exhibit G) mailed from the Office of Publications in another allowed application in support of their contention that the Office of Publications incorrectly failed to afford applicants an opportunity to supply the omitted Figure 3, in lieu of holding this application abandoned. Petitioner does not assert, and inspection of Exhibit G fails to reveal, however, that the Notice of Allowability in the referenced application had first required correction of the noted informalities in the specification, and that the notice was issued as a result of any flawed reply to the requirements of the Notice of Allowability in that application. Rather, Exhibit G only indicates that the Office of Publications itself issued the first notification of informalities in that application. Furthermore, contrary to the assertion in the instant petition (at n.1) inspection of the copy of Exhibit G fails to reveal that it required submission of a drawing figure captioned "8G". Rather, Exhibit G required a conforming amendment to the specification of the referenced application in view of the lack of any drawing figure captioned 8G. Where a drawing figure referred to in the specification by a given number-letter combination is not present in that file as of the filing date, that is not an error in the drawings requiring correction by submission of the referenced (but omitted) drawing; rather it is an error in the specification requiring correction if, as in that case, there is at least one other figure labeled with that particular number in combination with a letter. Here, since Exhibit G indicates there was at least one other drawing with a number-letter combination including the number 8, *i.e.*, 8A-8C, there was in fact no requirement for submission of a figure 8G; only for submission of an amendment to the specification to delete the reference to figure 8G. See MPEP 601.01(g). Accordingly, the Group Director's decision correctly determined that Exhibit G did not evidence an incorrect treatment of this application.

DECISION

The request for higher level of the Group Director's decision is granted to the extent that the decision has been reviewed but is **denied** as to making any change(s) therein. The holding of abandonment of the above-identified application is proper and will not be withdrawn.

This decision may be viewed as a final agency action on petitioner's request to withdraw the holding of abandonment in the above-identified application. See MPEP 1002.02. This application will be retained in the Office of Petitions to await any forthcoming petition for revival under 37 CFR 1.137.

Telephone inquiries related to this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

A handwritten signature in cursive script that reads "Stephen G. Kunin".

Stephen G. Kunin
Deputy Commissioner for
Patent Examination Policy