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OFFICE OF PETITIONS

In re Application of :
Hoshizaki et al. :
Application No.: 08/901,033 : ON PETITION
Filed: July 25, 1997 :
Attorney Docket No. 373612000111 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed April 25, 2011, to revive the above-identified application.

The petition is **DENIED**¹.

BACKGROUND

An Office action was mailed November 24, 2003, setting forth a three (3) month period for reply. A Notice of Abandonment was issued on May 29, 2007, stating that the responses received on September 26, 2005, November 2, 2005 and November 22, 2006 were not proper replies, and therefore the instant application was abandoned.

Petitions under 37 CFR 1.137(b) to revive the above-identified application were filed July 25, 2007, October 13, 2008, April 13, 2010, and August 23, 2010. Each petition was in turn dismissed on July 18, 2008, March 15, 2010, July 30, 2010 and March 8, 2011, respectively.

This decision is in response to the renewed petition of April 25, 2011.

STATUTE AND REGULATION

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

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

¹ This decision is a final agency action within the meaning of 5USC 704 for purposes of seeking judicial review.
See MPEP 1002.02

(A) shall govern for the conduct of proceedings in Office. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, provides 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." Specifically, 35 U.S.C. § 41(a)(7) 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, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

37 CFR 1.2 states:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

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.

OPINION

Petitioner asserts the delay and entire circumstances of the abandonment was unintentional. Specifically, petitioner states, "After reviewing the Decision mailed March 8, 2011, Applicant notes that the present case was filed after June 8, 1995, and the Examiner erroneously asserts that the present case was filed before that date to support the filing of abandonment and requirement for a terminal disclaimer." However, the terminal disclaimer required is not one required by 37 CFR 1.137(b), but rather, it is one required by the Examiner during prosecution of the application.

Further, petitioner states, "Applicants note the latest decision and all prior decisions on the petition to revive fail to appreciate that the Communication mailed on December 21, 2000, by a prior Examiner is actually a Notice of Allowability that placed no burden on Applicant to provide further information prior to a decision on Applicants voluntary request for interference.

Applicant was later told by Examiner Jacob Ackun that abandonment occurred because Applicant failed to obtain mailing of Notice of Allowance within the statutory period for response to final rejection. The Examiner clearly erred in assuming the case was under final rejection and withdrawal of the finding of abandonment is just without any further submissions by Applicant.”

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must include the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) an adequate 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) in some instances, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks items (1) and (3) above.

As to item (1), petitioner continues to argue that no reply is necessary. Petitioner references a Communication mailed December 21, 2000, which states, “This communication is to inform applicant that the amendment filed December 11, 2000 has been entered, and that claims 33-42, and 46-71 are allowable over the prior art of record. Applicant’s request for an interference between application 08/901,033 and Patent 5,795,215 and Patent 5,803,799 is being considered.”

However, petitioner fails to mention the subsequent communications mailed June 15, 2001, April 9, 2002 and finally November 24, 2003.

The communication dated June 15, 2001, states, “All claims are allowable. However, due to a potential interference, *ex parte* prosecution is SUSPENDED FOR A PERIOD OF 6 MONTHS from the date of this letter. Upon expiration of the period of suspension, applicant should make an inquiry as to the status of the application.”

The communication dated April 9, 2002, reiterates what was said in the December 21, 2000 communication, but further states, “The applicant is required to confirm the assignee of the instant application, and to the best knowledge, who are the assignees of Patent 5,791,215 and Patent 5,803,799. Applicant is given one month time period to respond to this communication.”

On April 30, 2002, a response was filed, confirming the assignees as requested by the April 9, 2002 communication.

The communication dated November 24, 2003, states, “In response to Applicant’s response filed on April 30, 2002, Applicant is request to take the following actions:

1) With reference to 37 CFR 1.602(a) which is stated hereby “(a) Unless good cause is shown, an interference shall not be declared or continued between (I) applications owned by a single party or (b) application and an unexpired patent owned by a single party”, applicant is required to declare who is the first inventor between the instant application and U.S. Patent 5,795,215, both assigned to Applied Material. 2) In the event that the instant application is declared as the first inventor, Applicant is required to provide a disclaimer in U.S. Patent No. 5,791,215 to eliminate conflicting claims.

Until the above two actions are resolved the Patent Office cannot declare an interference with a third party, namely U.S. Patent 5,830,499. Applicant is given three months from the date of this letter to comply with 37 CFR 1.602(a). If there is no compliance at the end of the time limit, the Office will consider what steps to take with respect to the application.”

A Notice of Abandonment was issued by the Examiner on May 29, 2007, which states, "As to paragraph 1 above, the Responses of 09/26/05, 11/2/05 and 11/22/06 do not constitute proper replies to the Office Action of 11/24/03."

In each of the previous petition decisions, petitioner has been advised on exactly what needed to be submitted to revive in the instant application. However, petitioner has each time failed to provide what was lacking.

As to item (3), petitioner has not shown to the satisfaction of the Director that the entire delay herein was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). 35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (i.e., to the revival of an abandoned application), however, it precludes the Director from reviving the above-identified application. The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director 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." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

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." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but 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).

Here, in the petition decision mailed March 8, 2011, it states, "Any further renewed petition that lacks the reply required in (1) above may be construed as an intentional delay in reviving the above-identified application." Petitioner has still not complied.

The showing is further that applicant made no effort to submit the proper reply to the Office action of November 24, 2003, which has been asked for in each of the four previous petition decisions. The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing a grantable petition to revive must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See *Changes to Patent Practice and Procedure*; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997).

However, the delay herein in filing a grantable petition to revive, with the proper response, is inconsistent with a finding that the entire delay herein was unintentional, such that revival is proper. Simply put, a course of conduct resulting in a delay that is, as here, purposefully chosen does not qualify as unintentional delay.

It is further noted that 35 U.S.C. § 41(a)(7) does not require an affirmative finding that the delay was intentional, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing); see also In re Application of G, supra (petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

DECISION

The prior decisions under 37 CFR 1.137(b), which refused to grant the petition to revive, for the above-identified application have been reconsidered. For the above stated reasons, the abandonment of this case cannot be regarded unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b). Therefore, the application will not be revived and the application remains abandoned.

Telephone inquiries regarding this decision should be directed to Petitions Examiner Liana Walsh at (571) 272-3206.



Anthony Knight
Director
Office of Petitions