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OFFICE OF PETITIONS

In re Application of :
Mariano G. TORRES et al. :
Application No. 11/165,968 : DECISION ON PETITION
Filed: June 24, 2005 :
Attorney Docket No. 17130-US :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 13, 2010, to revive the above-identified application.

The petition is **DENIED**.

BACKGROUND

The above-identified application was filed June 24, 2005. A request for its express abandonment under 37 CFR 1.138 was filed on April 7, 2008. The express abandonment was recognized in the Notice of Abandonment mailed on April 14, 2008. Accordingly, the above-identified application became abandoned on April 14, 2008.

Petitions filed May 7, 2008, and on April 27, 2008, seeking revival of the instant application, were dismissed in decisions mailed February 27, 2009, and May 21, 2010, respectively. The instant petition was filed on August 13, 2010, seeking "favorable" reconsideration of the previous decisions. Petitioner asserts that the Notice of Express Abandonment was prepared and filed in error, and should have been prepared and filed for then co-pending application Serial No. 11/374,405, with the error allegedly arising from a mix up in attorney docket numbers. In this regard, petitioner's correction of the reference to application Serial No. 11/574,405 (in the previously filed petitions) is acknowledged.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 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 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is

a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). This petition lacks item (3).

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 USC § (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.

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, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

§ 1.137 Revival of abandoned application, terminated or limited reexamination prosecution, or lapsed patent.

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination prosecution terminated under §§ 1.550(d) or 1.957(b) or limited under § 1.957(c), or a lapsed patent. A grantable petition pursuant to this paragraph 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 Director 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.

§ 1.138 Express abandonment.

(a) An application may be expressly abandoned by filing a written declaration of abandonment identifying the application in the United States Patent and Trademark Office. Express abandonment of the application may not be recognized by the Office before the date of issue or publication unless it is actually received by appropriate officials in time to act.

(b) A written declaration of abandonment must be signed by a party authorized under § 1.33(b)(1), (b)(3), or (b)(4) to sign a paper in the application, except as otherwise provided in this paragraph. A registered attorney or agent, not of record, who acts in a representative capacity under the provisions of § 1.34(a) when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

MPEP 711.01 states:

The applicant (acquiesced in by an assignee of record), or the attorney/agent of record, if any, can sign an express abandonment. It is imperative that the attorney or agent of record exercise every precaution in ascertaining that the abandonment of the application is in accordance with the desires and best interests of the applicant prior to signing a letter of express abandonment of a patent application. Moreover, special care should be taken to ensure that the appropriate application is correctly identified in the letter of abandonment.

OPINION

A thorough review of USPTO records shows that: (1) petitioner filed in the above-identified application, on April 7, 2008, a petition for express abandonment under 37 CFR 1.138; (2) the Office recognized the express abandonment in the above-identified application on April 14, 2008; (3) in application No. 11/374,405, the Office received a letter of express abandonment on May 23, 2008, and the abandonment was recognized on May 30, 2008.

As an initial matter, it is noted that petitioner was notified by the Office of the abandoned status of this application on April 14, 2008. However, no petition to revive this application was filed until May 07, 2008. That is, while petitioner may not have been aware of the abandoned status of this application until a file audit, petitioner was notified of the abandoned status of this application on April 14, 2008.

The reference in the instant petition to the declaration by inventor Smemo, filed April 27, 2009, has been noted. However, the statement by inventor Smemo that the filing of the amendment on March 28, 2008, is indicative of the intent to continue prosecution is not relevant to the question of whether the instant application was unintentionally abandoned. Instead, it is the intentional action of the petitioner in filing the request for express abandonment on April 7, 2008, that is relevant. The USPTO must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the consequences of those actions or inactions are

binding. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

The showing of record raises questions as to whether the abandonment of this application was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b).

The patent statute at 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. This is because § 41(a)(7) only 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.**" See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted* in 1982 U.S.C.C.A.N. 770-71 (emphases added).

A standard principle of statutory construction is: *expression unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific 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); 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 has provided in Public Law 97-247 a specific scheme for the revival of abandoned applications (i.e., the specific situations under which PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., 37 CFR 1.182 or 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Director'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, and 151. See Morganroth v. Quigg, 885 F.2nd 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 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

Finally, 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 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, (3) proceedings in the application may be

terminated. 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 than 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 35 U.S.C. §§ 41(a)(7) and 120 by operation of the filing by the applicant and upon recognition by the PTO of a written declaration that the applicant seeks to discontinue prosecution in (or expressly abandon) an application. That is, while 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 35 U.S.C. §§ 41(a)(7) and 120 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, or 151 and pursuant to their impending regulation (37 CFR 1.137).

35 U.S.C. §§ 111 or 151 obviously do not apply in instances in which an applicant has filed a letter of express abandonment. 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. 35 U.S.C. §133 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 (1908). Thus, in instances in which an applicant has filed a letter of express abandonment, the revival of such an application must be under and authorized by 35 U.S.C. § 41(a)(7), in that the filing of such a letter of express abandonment must have unintentional for the Office to be authorized to revive the application.

As this application was intentionally abandoned, a course of action deliberately chosen by the petitioner, the abandonment of this application cannot be reasonably considered to have been unintentional within the meaning of 35 U.S.C. § 41(c)(1) and 37 CFR 1.137(b). Accordingly, petitioner cannot meet his burden of proving to the satisfaction of the Director that above-identified application was "an unintentionally abandoned application" within the meaning of 35 U.S.C. § 41(c)(1). See In re Application of G, 11 USPQ2d at 1380. The revival of an intentionally abandoned application, as this application was, is antithetical to the meaning and intent of the statute and regulation.

DECISION

For the above-stated reasons, this application will not be revived, and this application remains abandoned. The petition to revive the instant application is **denied**.

This is a **final agency action** within the meaning of 5 U.S.C. § 704. The Director will undertake no further reconsideration or review of this matter.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914.



Anthony Knight
Director,
Office of Petitions