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ROSENBAUM & SILVERT, P.C.
1480 TECHNY ROAD
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OFFICE OF PETITIONS

In re Application of :
Regina Velasco, et al. :
Application No. 12/205,838 : ON PETITION
Filed: September 5, 2008 :
Attorney Docket No. CRD5407USNP :

This is a decision on the renewed petition under 37 CFR 1.137(b),
filed October 10, 2011, to revive the above-identified application.

The petition is denied.

BACKGROUND

The application became abandoned in view of a letter of express
abandonment filed May 10, 2011, which was signed by the registered
patent attorney of record.

STATUTE AND REGULATION

35 USC 2(b)(2) provides, in part, that:

The Office. . .may establish regulations, not
inconsistent with law, which
(A) shall govern the conduct of proceedings in the 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 Director 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, 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.

37 CFR 1.137(b)¹ provides:

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.

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

¹ As amendment effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

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.

OPINION

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. 67 (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 Director 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 Director may require additional information where there is a question whether the delay was unintentional, the petition 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). The language of both 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. However, as noted in more detail *infra*, both the delay herein in filing a reply during prosecution, and in filing the petition after abandonment, are inconsistent with a finding that the entire delay herein was unintentional.

The showing of record is that the application became abandoned in view of a letter of express abandonment filed by an attorney of record. Petitioner, Advanced Bio Prosthetic Surfaces (ABPS), argues that counsel, Mayumi Maeda was a representative of Cordis and that such action was taken without ABPS being pre-informed. Petitioner advises that Cordis and ABPS "jointly owned" the invention at the time the letter of express abandonment was filed. Further, petitioner states that Cordis has "since then assigned the present application to ABPS". However, delay resulting from a lack of proper communication between an applicant and his representatives with respect to filing a communication with the Patent and Trademark Office is a delay binding on applicant. See, In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988); Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1989). Moreover, the Office is not the proper forum for resolving a dispute between petitioner and his representatives as to communicating with the Office. Ray, Id. The evidence of record is that Mayumi Maeda was duly authorized to act in this case. The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of petitioner, and petitioner is bound by the consequences of those actions or inactions. 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 Patent and Trademark Office (Office) looks on express abandonments as acts of deliberation, intentionally performed, and as such, cautions that care should be exercised in these situations. See MPEP 711.01.

Petitioner contends, in essence, that he should not suffer the consequences of his representatives' act(s) because petitioner was unaware of, and did not authorize, the representative's actions. This argument is not persuasive, as such runs counter to established Supreme Court precedent holding that:

There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent. Any other notion would be wholly inconsistent with our system of representative litigation, in which each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'

Link, at 633-34 (1962) (citation omitted). Petitioner is again reminded that the Patent and Trademark Office is not the forum for resolving a dispute between an applicant and his duly appointed and freely selected representative. See Ray, supra.

Further in this regard, with respect to the lack of a satisfactory showing under 37 CFR 1.137(b) herein:

If we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.²

While petitioner argues that there was no intentional abandonment on the part of the inventors/assignee, this argument fails to address why the delay resulting from petitioner's representative's intentional delay can, or should be, considered "unintentional" delay. Rather, delay resulting from petitioner's representative's prior deliberate withholding of a response, and instead filing an letter of express abandonment does not become transformed into petitioner's unintentional delay merely due to petitioner's lack of awareness.

Under the unintentional delay standard, it is well-established that if the abandonment of an application is considered to be a deliberately chosen course of action, the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See In re Application of G, 11 USPQ2d at 1380.

The intentional abandonment of an application precludes revival under 37 CFR 1.137(a) or (b). In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

DECISION

The decision of August 5, 2011 has been reconsidered. Petitioner has not met his burden of establishing that both the abandonment of, as well as the delay in prosecution, was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b) Accordingly, this abandoned application will not be revived.

² Huston v. Ladner, supra

This decision is a final agency action within the meaning of 5 USC 704 for purposes of seeking judicial review. See MPEP 1002.02. The provisions of 37 CFR 1.137(d) do not apply to this case.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (571) 272-3204.



Anthony Knight
Director
Office of Petitions