



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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In re Application of
Hideki MOTOSUGHII
Application No. 14/188,331
Filed: February 24, 2014
Attorney Docket No. ITOH0003

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.181 filed June 19, 2017, requesting reconsideration of the decision on petition dated April 17, 2017, which decision refused to overturn the decision dated August 18, 2014, recognizing express abandonment of the above identified application.

The request to overturn the decision granting the petition under 37 CFR 1.138(d) and withdraw the abandonment of the application is **DENIED**.

RELEVANT BACKGROUND

The above identified application was filed on February 24, 2014.

On July 25, 2014, petitioner filed two separately signed petitions for (1) Express Abandonment to Avoid Publication under 37 CFR 1.138(c), using form PTO/AIA/24A, and for (2) Express Abandonment to Obtain a Refund under 37 CFR 1.138(d), using form PTO/AIA/24B.

In two separate decisions both dated August 18, 2014, the Office (1) dismissed the request for express abandonment to avoid publication because there was insufficient time to avoid publication, and (2) granted the petition for express abandonment to obtain a refund and refunded the utility search fee. Accordingly, the above identified application is currently in an abandoned status as indicated in the Notice of Abandonment that was also mailed on August 18, 2014.

On October 20, 2014, petitioner filed a petition under 37 CFR 1.181 to overturn the decision granting the petition under 37 CFR 1.138(d) and recognizing the express abandonment of the above identified application.

On May 18, 2015, a decision was mailed dismissing petitioner's petition of October 20, 2014.

On July 20, 2015, a renewed petition was filed requesting supervisory review of the decision to overturn the decision granting the petition under 37 CFR 1.138(d) and recognition of express abandonment.

On April 17, 2017, a decision was mailed dismissing petitioner's petition of July 20, 2015.

On June 19, 2017, petitioner filed the instant petition requesting reconsideration of the decision of April 17, 2017.

REGULATIONS AND EXAMINATION PROCEDURE

37 CFR 1.138 provides that:

(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) or (b)(3) 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 when filing a continuing application, may expressly abandon the prior application as of the filing date granted to the continuing application.

(c) An applicant seeking to abandon an application to avoid publication of the application (see § 1.211(a)(1)) must submit a declaration of express abandonment by way of a petition under this paragraph including the fee set forth in § 1.17(h) in sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process. Applicants should expect that the petition will not be granted and the application will be published in regular course unless such declaration of express abandonment and petition are received by the appropriate officials more than four weeks prior to the projected date of publication.

(d) An applicant seeking to abandon an application filed under 35 U.S.C. 111(a) and § 1.53(b) on or after December 8, 2004, to obtain a refund of the search fee and excess claims fee paid in the application, must submit a declaration of express abandonment by way of a petition under this paragraph before an examination has been made of the application. The date indicated on any certificate of mailing or transmission under § 1.8 will not be taken into account in determining whether a petition under § 1.138(d) was filed before an examination has been made of the application. If a request for refund of the search fee and excess claims fee paid in the application is not filed with the declaration of express abandonment under this paragraph or within two months from the date on which the declaration of express abandonment under this paragraph was filed, the Office may retain the entire search fee and excess claims fee paid in the application. This two-month period is not extendable. If a petition and declaration of express abandonment under this paragraph are not filed before an examination has been made of the application, the Office will not refund any part of the search fee and excess claims fee paid in the application except as provided in § 1.26.

37 CFR § 1.181 provides that (in part):

- (a) Petition may be taken to the Director:
 - (1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;
 - (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and
 - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

- (f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
- (g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

Manual of Patent Examining Procedure (MPEP) 711.01 provides in part that:

The applicant 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.

....

V. FORMS FOR FILING EXPRESS ABANDONMENT

Form PTO/AIA/24 (or PTO/SB/24 for applications filed before September 16, 2012) may be used for filing a letter of express abandonment or a letter of express abandonment in favor of a continuing application. Form PTO/AIA/24A (or PTO/SB/24A for applications filed before September 16, 2012) may be used for filing a petition for express abandonment under 37 CFR 1.138(c) to avoid publication of the application. Form PTO/AIA/24B (or PTO/SB/24B for applications filed before September 16, 2012) may be used for filing a petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and excess claims fee.

OPINION

Petitioner asserts that the decision of April 17, 2017 was not a final agency action within the meaning of 5 U.S.C. §704, and therefore petitioner requests reconsideration of the decision. Petitioner also states that petitioner clearly intended that the petition to obtain a refund be included within the petition to avoid publication and petitioner also indicates this was always the objective intention.

Petitioner states that “Applicants specifically stated: “[I]f the publication cannot be stopped please do not withdraw the application.” That was the applicant's unequivocal intention and it is the intention of applicants that should determine the outcome of the present case.” The statement by the petitioner as to the wishes of the applicant have been duly noted. However, the Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. *See Link v. Wabash R.R. Co.*, 370 U.S. 626, 633 – 34 (1962). *See also Huston v. Ladner*, 973 F. 2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992). As noted in MPEP § 711.01, “[i]t 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... A letter of abandonment properly signed becomes effective when an appropriate official of the Office takes action thereon.”

In this case petitioner's attorney of record filed separately signed and distinct petitions for (1) Express Abandonment to Avoid Publication under 37 CFR 1.138(c) and for (2) Express Abandonment to Obtain a Refund under 37 CFR 1.138(d). Petition (1) made no indication that petition (2) should not be considered if publication could not be stopped.

Petitioner insinuates that nothing about form 24B suggests that it only applies when a refund is needed. However, it is clear from the language of form 24A, form 24B, and MPEP 711.01 V that “[f]orm PTO/AIA/24A ... may be used for filing a petition for express abandonment under 37 CFR 1.138(c) to avoid publication of the application[, and f]orm PTO/AIA/24B ... may be used for filing a petition for express abandonment under 37 CFR 1.138(d) to obtain a refund of the search fee and excess claims fee.”

Petitioner's comments regarding the term on the forms “included” ignore other language in the forms which makes it clear that both forms are not intended to be included together in every circumstance. For instance form 24B states “TO REQUEST A REFUND OF SEARCH FEE AND EXCESS CLAIMS FEE (IF ELIGIBLE), PLEASE ALSO INCLUDE FORM PTO/SB/24B WITH THIS FORM”. It is clear when looking at the entire phrase that form PTO/AIA/24B should only be included in order to request the refund.

Form PTO/AIA/24B is titled “PETITION FOR EXPRESS ABANDONMENT TO OBTAIN A REFUND” and includes the language “I hereby petition to expressly abandon the above-identified application to obtain a refund of any previously paid search fee and excess claims fee

in the application.” The semantics of the petition form indicates that it is its own separate petition. By signing this form, petitioner indicated that he had the intent to expressly abandon the application to obtain a refund.

It is also noted that 35 U.S.C. 41(a)(2)(C) and (d)(1)(C) authorize the Director to promulgate regulations to provide for a refund of the excess claim fees and the search fee only if a written declaration of express abandonment as prescribed by the Director is filed before an examination is made. The Director acting on this authorization promulgated 37 CFR 1.138(d) which provides that only where there is a declaration of express abandonment under that paragraph could a refund of the excess claim fee and search fee be made. Thus, by rule seeking refund of the excess claims fee and search fee requires compliance with 37 CFR 1.138(d). In the same notice the Director modified 37 CFR 1.138(c) to note that declarations of express abandonment to avoid publication must be made under paragraph 37 CFR 1.138(c) rather than under section 37 CFR 1.138. See Changes To Implement the Patent Search Fee Refund Provisions of the Consolidated Appropriations Act, 2005, 71 Fed. Reg. 12,281 (March 10, 2006).

As promulgated, 37 CFR 1.138(d) does not condition granting an express abandonment filed by the appropriate party under that paragraph other than the statutory condition that the declaration must be filed before an examination has occurred. Thus, granting a petition under 37 CFR 1.138(d) is only conditioned on whether an examination has occurred and not whether publication of the application could be avoided. To the extent that Applicant argues that presenting, on the same date, a petition under 37 CFR 1.138(c) and a petition under 37 CFR 1.138(d) must result in the Office applying the conditions of both rules in determining whether to grant the petition under 37 CFR 1.138(d), the argument is not persuasive as the argument is contrary to the requirements of 37 CFR 1.138(d).

Therefore, each of the requests included on forms 24A and 24B did entail a separate request for the application to be expressly abandoned. As each of the forms 24A and 24B was properly executed by an attorney of record, the abandonment became effective upon acceptance of the letter of express abandonment (form 24B) by the Office as noted in the communication mailed August 18, 2014.

DECISION

The petition is granted to the extent that the decision on petition dated April 17, 2017, which decision refused to overturn the decision dated August 18, 2014, recognizing express abandonment of the above identified application, has been reviewed. However, for the previously stated reasons, petitioner's request to overturn the decision granting the petition under 37 CFR 1.138(d) and withdraw the abandonment of the application is **DENIED**.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained.

Telephone inquiries concerning this decision should be directed to Jacob F B  tit at (571)-272-4075.

/ROBERT CLARKE/

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Office of the Deputy Commissioner
for Patent Examination Policy