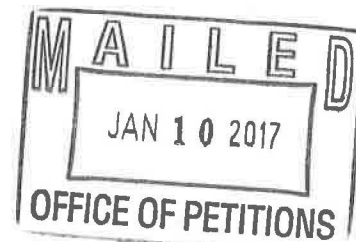




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In re Application of :  
Christopher Rence : On Petition  
Application No. 14/214,995 :  
Filed: March 16, 2014 :  
Attorney Docket No. 1100.002UA :



This is in response to the RENEWED PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE HOLDING OF ABANDONMENT filed October 18, 2016.

The decisions of March 29, 2016 and August 25, 2016 dismissing the petitions to withdraw the holding of abandonment in the above-identified application have been reconsidered; the petition is **DENIED** to the extent that the holding of abandonment will not be withdrawn.

**BACKGROUND**

On April 8, 2014, the Office mailed a Notice to File Missing Parts of Nonprovisional Application Papers in the above-identified application. The Notice required a new application data sheet (ADS) in compliance with 37 CFR 1.76 or an inventor's oath or declaration in compliance with 37 CFR 1.63 identifying the mailing address and if appropriate, residence of inventor Christopher Joseph Rence. The Notice stated that the ADS filed March 16, 2014 would only be treated as a transmittal letter as it was not properly signed. The Notice set a period for reply of two (2) months from the mail date of the Notice, with extensions of time obtainable under the provisions of 37 CFR 1.136(a).

On April 8, 2014, the Office also mailed an application filing receipt, which provided in pertinent part the following information for the inventor/applicant: "Christopher Joseph Rence, Residence Not Provided."

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On April 17, 2014, applicant filed an ADS. However, the ADS was not in compliance with 37 CFR 1.76. By Response to Request for Corrected Filing Receipt mailed July 16, 2014, applicant was advised that the ADS was not properly marked up to show the desired changes. The Office's Response stated that "For information being changed relative to the information already of record, additions must be shown with underlining, and deletions must be shown with strike-through or brackets. See 37 CFR 1.76(c)(2)."

On July 16, 2014, the Office mailed a new Notice to File Missing Parts of Nonprovisional Application, which reset the period for reply. In addition to requiring a new application data sheet (ADS) in compliance with 37 CFR 1.76 or an inventor's oath or declaration in compliance with 37 CFR 1.63 identifying the mailing address and if appropriate, residence of inventor Christopher Joseph Rence, this Notice required payment of the statutory basic filing fee, the application search fee, the examination fee and the late surcharge. The Notice set a period for reply of two (2) months from the mail date of the Notice, with extensions of time obtainable under the provisions of 37 CFR 1.136(a).

On July 22, 2014, applicant responded clarifying persuasively that the statutory basic filing fee, application search fee and examination fee were not due as they were paid with the filing of the original application papers.

On July 25, 2014, the Office mailed a new Notice of Incomplete Reply (Nonprovisional). This Notice required a new application data sheet (ADS) in compliance with 37 CFR 1.76 or an inventor's oath or declaration in compliance with 37 CFR 1.63 identifying the mailing address and if appropriate, residence of inventor Christopher Joseph Rence; as well as, the late surcharge set forth in 37 CFR 1.16(f). The Notice set a period for reply of two (2) months from the mail date of the Notice to File Missing Parts mailed July 16, 2014, with extensions of time obtainable under the provisions of 37 CFR 1.136(a).

On August 4, 2014, applicant filed another ADS. However, this ADS was not entered as it was not properly signed. The S-signature was not in compliance as the signature was not inserted between forward slash marks. See 37 CFR 1.4(d)(2). (The signature was inserted between back slash marks).

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On December 9, 2014, the Office mailed a further Notice to File Missing Parts of Nonprovisional Application. The Notice again required a new application data sheet (ADS) in compliance with 37 CFR 1.76 or an inventor's oath or declaration in compliance with 37 CFR 1.63 identifying the mailing address and if appropriate, residence of inventor Christopher Joseph Rence; as well as, the late surcharge set forth in 37 CFR 1.16(f). (It was noted that an unapplied \$70 would be applied to the surcharge). The Notice stated that the ADS filed August 4, 2014 would only be treated as a transmittal letter as it was not properly signed. The Notice set a new period for reply of two (2) months from the mail date of this Notice, with extensions of time under the provisions of 37 CFR 1.136(a) obtainable.

On December 18, 2014, applicant filed another ADS. Again, this ADS was not in compliance with 37 CFR 1.76.

By Response to Request for Corrected Filing Receipt mailed February 4, 2015, applicant was advised that the ADS was not properly marked up to show the desired changes. The Office's Response again stated that "For information being changed relative to the information already of record, additions must be shown with underlining, and deletions must be shown with strike-through or brackets. See 37 CFR 1.76(c)(2)."

On February 4, 2015, the Office mailed a further Notice to File Missing Parts of Nonprovisional Application. The Notice again required a new application data sheet (ADS) in compliance with 37 CFR 1.76 or an inventor's oath or declaration in compliance with 37 CFR 1.63 identifying the mailing address and if appropriate, residence of inventor Christopher Joseph Rence. The Notice set a new period for reply of two (2) months from the mail date of the Notice, with extensions of time under the provisions of 37 CFR 1.136(a) obtainable.

On February 14, 2015, applicant filed another ADS. Again, this ADS was not in compliance with 37 CFR 1.76. This ADS was not properly marked up to show the desired changes.

On October 7, 2015, the Office mailed a Notice of Abandonment for failure to timely or properly reply to the Notice to File Missing Parts mailed February 4, 2015.

By decision mailed March 29, 2016, the initial petition filed October 7, 2015 was dismissed. The record was reviewed and it

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was determined that applicant had not timely filed a proper reply to the February 4, 2015 Notice (i.e. a properly executed ADS in compliance with 37 CFR 1.76).

By decision mailed August 25, 2016, the March 29, 2016 decision was affirmed. The withdrawal of the holding of abandonment was again determined to not be warranted as applicant did not timely file a proper reply to the February 4, 2015 Notice.

**STATUTE AND REGULATION**

35 U.S.C. 133 Time for prosecuting application.

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.

37 CFR 1.134 Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 CFR 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

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(c) 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.

37 CFR 1.63(b) provides that:

Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify:

- (1) Each inventor by his or her legal name; and
- (2) A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

37 CFR 1.76(c) provides that:

(1) Information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63, § 1.64 or § 1.67, **or otherwise of record**, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship changes must comply with the requirements of § 1.48, foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78, and correspondence address changes are governed by § 1.33(a).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and **must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed**, except that identification of information being changed is not required for an application data sheet

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included with an initial submission under 35 U.S.C. 371.  
(**emphasis** added).

### OPINION

On petition, Applicant asserts their belief that a proper reply was submitted on February 14, 2015. Applicant's representative states that "it is Applicant's understanding, based on its own, and others, years of experience with PTO practices, and the PTO's help desk, that if the submission was not proper, the PTO would have issued a communication that acknowledged the receipt of the document and requirements for curing deficiencies. In this case, no communication of deficiencies was issued or received, leaving the Applicant to believe that all was well after the February 14, 2015 submission."

Applicant's argument has been considered, and found not persuasive to warrant withdrawal of the holding of abandonment. The Office gave applicant more than sufficient Notice of deficiencies prior to holding this application abandoned for failure to timely and properly reply to the many Notices issued by the Office requiring either an ADS in compliance with 37 CFR 1.76 (or an inventor's oath or declaration in compliance with 37 CFR 1.63).

- The initial Notice mailed April 8, 2014, requiring an ADS in compliance with 37 CFR 1.76 (or an inventor's oath or declaration in compliance with 37 CFR 1.63), set a two (2) month period for reply, with extensions of up to five (5) months obtainable.
- The Office mailed a corrected Notice on July 16, 2014. As the Office added a requirement to pay additional filing fees to the requirement to provide an ADS in compliance with 37 CFR 1.76 (or an inventor's oath or declaration in compliance with 37 CFR 1.63), the July 16, 2014 Notice set a new two (2) month extendable period for reply.
- The Office then mailed a third Notice on December 9, 2014, again resetting the period for reply to provide an ADS in compliance with 37 CFR 1.76 (or an inventor's oath or declaration in compliance with 37 CFR 1.63).
- The Office then mailed a fourth Notice on February 4, 2015, again resetting the period for reply to provide an ADS in

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compliance with 37 CFR 1.76 (or an inventor's oath or declaration in compliance with 37 CFR 1.63).

Usually contemporaneously with the mailing of these Notices, the Office mailed "Responses to Requests for Corrected Filing Receipt" stating the deficiency in the ADS (e.g., not properly marked up to show desired changes).

From April 8, 2014, through three new reset seven (7) month periods, (from July 16, 2014 to February 16, 2015; from December 9, 2014 to July 9, 2015; and from February 4, 2015 to September 4, 2015, as detailed above), Applicant was advised by notice of the deficiencies in the various ADSs filed. Notices were sent to Applicant on July 16, 2014; July 25, 2014; December 9, 2014; February 4, 2015 to no avail. Nonetheless, Applicant continued to submit ADSs without proper signature and/or not in compliance with 37 CFR 1.76(c)(2).

These many specific Notices were sufficient to advise Applicant of the need to file an ADS in compliance with the rules prior to the end of the maximum period for reply, which ended on September 4, 2015. Applicant was also advised of the alternative of filing an oath or declaration to provide the missing inventor address information.

In addition, Applicant is expected to be aware of the rules of practice including 37 CFR 1.4(d), 37 CFR 1.76(c)(2) and 37 CFR 1.63; and submit replies in compliance with those rules prior to the end of the maximum period for reply. The burden is on Applicant to submit a timely, complete and proper reply to a Notice to File Missing Parts of Application.

In citing the deficiencies in the ADSs filed, the Office repeatedly directed Applicant to 37 CFR 1.76. Moreover, 37 CFR 1.76 gave Applicant notice of what was required for the February 14, 2015 ADS submission to be proper. 37 CFR 1.76(c)(1) advised Applicant:

Information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63, § 1.64 or § 1.67, **or otherwise of record**, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, ...



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37 CFR 1.76(c)(2) further advised Applicant that:

An application data sheet ***must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, ... (emphasis added).***

A straightforward reading of this rule gives notice that in this circumstance 1) the information to be corrected or updated was that of record as set forth on the filing receipt, and 2) as the Office considered the residence of the inventor to have not been provided, as reflected on the filing receipt (i.e., "Christopher Joseph Rence, Residence Not Provided"), the ADS submitted to provide this information needed to have all of the added residence (or mailing address) information for the inventor underlined.

As to the information to be corrected, in applying or not applying this rule, Applicant disregarded that they had been advised that the ADS submitted on filing was treated as a transmittal letter and thus, was not a previously submitted application data sheet within the meaning of 37 CFR 1.76(c)(1).

All was not well after the February 14, 2015 submission, and Applicant had no reasonable expectation that it was. Applicant had previously been advised specifically by Notice and generally by rule of what would constitute a proper submission on February 14, 2015. Yet, Applicant again submitted a reply that was not in compliance with 37 CFR 1.76(c)(2). All of the information not of record (as reflected in the filing receipts stating "Christopher Joseph Rence, Residence Not Provided.") was not underlined. Looking to the ADS that was treated as a transmittal letter, Applicant chose only to underline "1449-188<sup>th</sup> Avenue" and not the complete residence/mailing address. Further, not having been successful in meeting the requirements of submitting information by application data sheet, Applicant chose not to use the alternative of submitting an oath or declaration in compliance with 37 CFR 1.63.

After having repeatedly advised applicant of the deficiencies in the ADSs filed and applicant being expected to be knowledgeable of the rules of practice, the Office was within its discretion to send no further Notices in reply to the ADS filed February 14, 2015. Rather, upon expiration of the maximum extendable period for reply, the Office properly held the application



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abandoned after having still not received a compliant application data sheet (or alternatively, a compliant oath or declaration).

**CONCLUSION**

In view thereof, the petition is denied. It is concluded that withdrawal of the holding of abandonment is not warranted.

This decision represents the conclusion by the United States Patent and Trademark Office (USPTO) of petitioner's request to withdraw the holding of abandonment. This decision does not prejudice the petitioner filing a petition to revive the application under 37 CFR 1.137(a). However, the filing of such a petition should not be intentionally delayed. An intentional delay in filing of the petition will lead to the dismissal of the petition regardless of the original circumstances that led to the abandonment of the application.

Telephone inquiries concerning this decision may be directed to Nancy Johnson, Attorney Advisor at 571-272-3219.

/Charles Kim/  
Director  
Office of Petitions