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In re Application of  
Majid Kaemi  
Application No. 14/488,576  
Filed: 09/17/2014  
For: DISCOVERY OF ROOT CAUSE OF  
AUTOIMMUNE DISEASE; RHEUMATOID  
ARTHRITIS AND OSTEOARTHRITIS

:  
: DECISION ON PETITION  
: TO WITHDRAW HOLDING OF  
: ABANDONMENT  
:  
:  
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This is a decision on the renewed petition to withdraw the holding of abandonment filed August 30, 2016.

The petition is **denied**.

### Background

A review of the record reveals the following:

1. On September 17, 2014, the application was filed without an inventor's oath or declaration or an application data sheet (ADS).
2. On September 22, 2014, a Notice to File Missing Parts of Nonprovisional Application was mailed, requiring submission of the basic filing fee, search fee, examination fee, and at least one claim. Additionally, an inventor's oath or declaration or an application data sheet naming each inventor and identifying the mailing address and residence of each inventor were required, along with a substitute specification and an abstract of the technical disclosure, as well as a surcharge for their late filing. A two (2) month period for reply was set.
3. On September 22, 2014, the basic filing fee, search fee, and examination fee were paid in the micro entity amount. No Micro Entity Certification, however, was filed.
4. On September 30, 2014, the Notice mailed September 22, 2014 was returned to the Office as undeliverable.
5. On October 6, 2014, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating the reply filed September 22, 2014 was incomplete, and that no new time period was set for submission of the requirements set forth in the Notice mailed September 22, 2014.
6. On October 16, 2014, the Office mailed a new Notice to File Missing Parts of Nonprovisional Application, requiring submission of the basic filing fee, search fee, examination fee, and at least one claim. Additionally, an inventor's oath or declaration or an ADS naming each inventor and

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identifying the mailing address and residence of the inventor was required to be filed, along with a substitute specification and an abstract of the technical disclosure, and a surcharge for their late filing. A two (2) month period for reply was set.

7. On October 17, 2014, the Notice of Incomplete Reply mailed on October 6, 2014 was returned to the Office as undeliverable.

8. On October 24, 2014, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating the reply filed on September 22, 2014, was incomplete.

9. On November 13, 2014, the Notice of Incomplete Reply (Nonprovisional) mailed on October 24, 2014 was returned to the Office as undeliverable.

10. On November 14, 2014, the Notice to File Missing Parts mailed on October 16, 2014, was returned to the Office as undeliverable.

11. On December 30, 2014, an inventor's oath or declaration was filed, naming the sole inventor as "Majid *Kaemi*". Additionally, an ADS was filed, listing the first named inventor as "Majid Kazemi". The inventor's name on the ADS did not match the inventor's name on the executed inventor's oath or declaration, and the ADS was not underlined in accordance with 37 CFR 1.76(c). A certification of micro entity status was also filed, which recited the inventor's name as "Majid Kazemi".

12. On January 12, 2015, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the reply filed on December 30, 2014 was incomplete. Specifically, the Notice stated that a mailing address and residence for inventor Majid Kaemi had not been provided, the line spacing on the substitute specification was not 1 ½ or double spaced, a statement that the substitute specification contains no new matter was missing, and the surcharge, search fee, and examination fee were due in the small entity amount.

13. On January 16, 2015, a Certification of Micro Entity Status was filed, signed by "Majid Kazemi" along with a new oath or declaration and an unsigned ADS listing the inventor as "Majid Kazemi". The corrections on the ADS were also not marked in accordance with 37 CFR 1.76(c). As the name on the Certification of Micro Entity Status did not match the name on the inventor's oath or declaration, micro entity status could not be accorded to the application. No request under 37 CFR 1.48 was filed to correct the inventor's name.

14. On January 28, 2015, a new Notice to File Missing parts was mailed, requiring payment of the application search fee, examination fee, and a surcharge for its late filing, as well as submission of at least one claim, a mailing address for each inventor, a substitute specification, and statement that the substitute specification and statement that the substitute specification contains no new matter.

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15. Also on January 28, 2015, a Response to Request for Corrected Filing Receipt was mailed, stating that the request to correct the inventorship in accordance with 37 CFR 1.48(a) was deficient because applicant had not submitted the required processing fee and a corrected ADS properly marked to show the corrections in accordance with 37 CFR 1.76(c).

16. On January 30, 2015, an ADS was received, but the ADS was not marked up to indicate the correction of the inventor's name.

17. On February 6, 2015, 1 page containing claims was submitted, but without a preliminary amendment.

18. Also, on February 6, 2015, a corrected ADS was submitted. However, the processing fee required for a request under 37 CFR 1.48(a) was not submitted.

19. On March 16, 2015, a new Notice to File Missing Parts of Nonprovisional Application was mailed, setting a new two (2) month shortened time period for reply and requiring payment of the application search fee, examination fee, additional claim fees, and a surcharge, all in the undiscounted amount, and a mailing address for inventor "Majid Kaemi". The Notice dated March 16, 2015 also required a statement that the substitute specification contains no new matter.

20. On April 16, 2015, a Certification of Micro Entity Status was filed, along with a marked-up corrected ADS. Both were signed by "Majid Kazemi". No 37 CFR 1.48 request to correct the inventorship or fee required for a request under 37 CFR 1.48 were submitted.

21. On May 5, 2015, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the statutory basic filing fee, search fee, examination fee, and surcharge were not received and were required to be paid. The mailing address and residence of inventor Majid Kaemi was also required to be supplied in an ADS or an inventor's oath or declaration. Additionally, a statement that the substitute specification contains no new matter was required. The Notice stated that the period set in the Notice mailed on March 16, 2015 remained in effect. Also on May 5, 2015, a Response to Request for Corrected Filing Receipt was mailed, stating that the request under 37 CFR 1.48 was deficient in that the processing fee had not been paid.

22. On June 27, 2015, a corrected ADS and inventor's oath or declaration were filed, along with a page containing claims. The fee for a request under 37 CFR 1.48(a) was not submitted, however.

23. On July 13, 2015, a Notice of Incomplete Reply was mailed, stating the application search fee, examination fee, surcharge, additional claim fees, and a mailing address had not been received. Additional claim fees were also required to be filed. A Response to Request for Corrected Filing Receipt was also mailed, stating that the request to correct inventorship was deficient because the processing fee had not been paid.

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24. On July 22, 2015, an ADS and a certificate of micro entity status was filed, along with a \$35.00 payment. This payment was applied to the surcharge under 1.16(f).

25. On August 6, 2015 a Notice of Incomplete Reply was mailed, again stating that the application search fee, examination fee, surcharge, additional claim fees, the surcharge, and a mailing address for inventor Majid Kaemi had not been received. A Response to Request for Corrected Filing Receipt was also mailed August 6, 2015, stating that the request to correct inventorship was deficient because the processing fee had not been paid.

26. On September 3, 2015, an ADS and an inventor's oath or declaration were submitted, naming Majid Kazemi as the sole inventor.

27. On September 17, 2015, a Notice of Incomplete Reply was mailed, again stating that the application search fee, examination fee, surcharge, additional claim fees, and a mailing address for inventor Majid Kaemi had not been received. A Response to Request for Corrected Filing Receipt was also mailed, stating state the request to correct inventorship was deficient because the processing fee had not been paid.

28. On September 22, 2015, an ADS, an inventor's oath or declaration were submitted, and an additional Certification of Micro Entity was filed.

29. On October 19, 2015, a Notice of Abandonment was mailed.

30. On April 13, 2016, a petition to withdraw the holding of abandonment was filed.

31. On May 10, 2016, an unsigned paper styled as a petition for expedited consideration was filed, without the required petition fee.

32. On May 23, 2016, an additional paper styled as a petition for expedited consideration was filed, accompanied by payment of the petition fee in the micro entity amount. This paper was not properly signed in accordance with 37 CFR 1.4, however.

33. On June 6, 2016, a decision dismissing the petition for expedited consideration as improperly signed was mailed.

34. On June 7, 2016, a signed renewed petition for expedited consideration under 37 CFR 1.182 was filed.

35. On June 14, 2016, a decision was mailed granting the petition for expedited consideration under 37 CFR 1.182 and dismissing the petition to withdraw the holding of abandonment.

36. On August 30, 2016, the subject letter, which states "Please take this letter for removal of abandonment," was filed. The letter is being treated as a renewed petition to withdraw the holding of abandonment. The letter is accompanied by an inventor's oath or declaration naming

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Majid Kazemi as the sole inventor, a corrected ADS naming Majid Kazemi as the sole inventor, and a certification of micro entity status signed by Majid Kazemi.

### **Law and Regulation**

35 U.S.C. 133 states:

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, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.133(b) states:

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office actions as specified in § 1.111 and 1.135.

37 CFR 1.134 states:

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 states:

(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.

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### Opinion

Petitioner again asserts, in essence, that the application was not abandoned. The present petition does not provide any arguments in support of the petition to withdraw the holding of abandonment. However, under the circumstances of this case, the petition will be treated as again presenting the arguments found in the prior petitions. Petitioner previously argued, in essence, that he timely and properly replied to each Office communication, or at least attempted so to do.

Petitioner's argument has been considered, but is not persuasive. A review of the record reveals that a proper response to the Notice mailed on March 16, 2015 was never filed. The Notice required payment of the search fee, examination fee, surcharge, and additional claim fees in the undiscounted amount, submission of a mailing address and residence for inventor Majid Kaemi, and a statement that the substitute specification contains no new matter.

Petitioner argues that he filed a certification of micro entity status, and therefore the fees should be due in the micro entity amount.

Petitioner's argument has been considered, but is not persuasive. A proper certification of micro entity status was not submitted: the micro entity status form was signed by Majid Kazemi. However, the first signed inventor's oath or declaration named the inventor as "Majid Kaemi", and a proper request under 37 CFR 1.48(a) to correct the name of the inventor from "Majid Kaemi" to "Majid Kazemi" was never filed.

37 CFR 1.48(a) states:

*Nonprovisional application:* Any request to correct or change the inventorship once the inventorship has been established under § 1.41 must include:

- (1) An application data sheet in accordance with § 1.76 that identifies each inventor by his or her legal name; and
- (2) The processing fee set forth in § 1.17(i) .

In this regard, the processing fee was never submitted. On July 22, 2015, petitioner submitted a Certification of Micro-Entity Status accompanied by a payment of \$35.00. The paper, however, did not specify the fees to which the \$35.00 payment was to be applied. Therefore, the payment was properly applied to the surcharge.

MPEP 509 states, in pertinent part:

In situations in which a payment submitted for the fees due on filing in a nonprovisional application filed under 35 U.S.C. 111(a) is insufficient and the applicant has not specified the fees to which the payment is to be applied, the

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Office will apply the payment in the following order until the payment is expended:

- (1) the basic filing fee (37 CFR 1.16(a), (b), (c), or (e));
- (2) the non-electronic filing fee (37 CFR 1.16(t));
- (3) the application size fee (37 CFR 1.16(s));
- (4) the late filing surcharge (37 CFR 1.16(f));
- (5) the processing fee for an application filed in a language other than English (37 CFR 1.17(i));
- (6) the search fee (37 CFR 1.16(k), (l), (m), or (n));
- (7) the examination fee (37 CFR 1.16(o), (p), (q), or (r)); and
- (8) the excess claims fee (37 CFR 1.16(h), (i), and (j)).

In situations in which a payment submitted for the fees due on filing in a provisional application filed under 35 U.S.C. 111(b) is insufficient and the applicant has not specified the fees to which the payment is to be applied, the Office will apply the payment in the following order until the payment is expended:

- (1) the basic filing fee (37 CFR 1.16(d));
- (2) the application size fee (37 CFR 1.16(s)); and
- (3) the late filing surcharge (37 CFR 1.16(g)).

As such, a proper request to correct the inventor's name was never filed. Additionally, as the inventor's name was never corrected, the certification of micro entity status could not be accepted as the inventor's name on the micro entity status form was different from the inventor's name in Office records. As such, applicant was required to pay the filing fees in the undiscounted amount. As these fees were not timely paid in the proper amount, the application is abandoned.

Further still, assuming, *arguendo*, the \$35.00 was applied to the request under 37 CFR 1.48(a), the fee was untimely because it was not accompanied by the required extension of time. The Notice mailed March 16, 2015 set a two (2) month shortened period for reply. The reply filed on July 22, 2015, including the \$35.00, was filed more than two months after date of mailing of the Notice mailed March 16, 2015. Accordingly, a petition for a 3 month extension of time under 37 CFR 1.136(a) and extension of time fee were required to be filed to make the reply of July 22, 2015 a timely reply. No extension of time fee and request were filed on July 22, 2015. As such, the reply was untimely and could not be considered a timely and proper reply to the Notice mailed March 16, 2015.

Lastly, applicant had not provided a proper statement of no new matter. While a paper entitled "no new matter" was filed on June 27, 2015, this paper was unsigned and also did not state that the substitute specification contained no new matter. While the letter filed on August 30, 2016 also states "no new matter", this paper does not state that the substitute specification contains no new matter, and was not timely filed in response to the Notice mailed on March 16, 2015 in that



it was filed on August 30, 2016, which is after October 16, 2015, the last date a reply to the Notice mailed on March 16, 2015, could be filed with an extension of time.

37 CFR 1.135(b) is manifest that 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.

Further, while it is unfortunate that applicant did not timely file the proper documents, it is the responsibility of the applicant, not the Office, to ensure a proper response is timely filed. In this regard, while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction. *See In re Colombo*, 33 USPQ2d 1530, 1532 (Comm’r Pat. 1994).

As a proper and timely reply to the Notice mailed on March 16, 2015 was not filed, the case was properly held abandoned.

As petitioner has filed, despite repeated attempts, to provide any persuasive arguments meriting withdrawal of the holding of abandonment, the petition is **denied**.

## Conclusion

The prior decision, which refused to withdraw the holding of abandonment, has been reconsidered, and is affirmed.

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).

Further correspondence with respect to this matter should be addressed as follows:

By mail:                Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By FAX: (571) 273-8300  
Attn: Office of Petitions



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By hand: Customer Service Window  
Mail Stop Petition  
Randolph Building  
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By internet: EFS-Web<sup>1</sup>

Telephone inquiries related to this decision should be directed to Attorney Advisor Douglas I. Wood at 571-272-3231.

/Charles Kim/  
Director (Acting)  
Office of Petitions

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<sup>1</sup> [www.uspto.gov/ebc/efs\\_help.html](http://www.uspto.gov/ebc/efs_help.html) (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)