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OFFICE OF PETITIONS

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In re Application of
Ulf Palmblad et al.
Application No. 10/270,163
Filed: October 15, 2002
Attorney Docket No. TPP 31467

ON PETITION

This is a decision on the "Combined Petition to Review TC 1700 Director's Decision On Petition [sic] To Withdraw Erroneous Holding of Abandonment or in the Alternative Petition to Revive an Unintentionally Abandoned Application" filed December 31, 2008, which is being treated as a petition under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 1700 (Technology Center Director), dated October 31, 2008, which refused to withdraw the holding of abandonment mailed April 11, 2007. Additionally and in the alternative, the petition requests the application be revived as unintentionally abandoned under 37 USC 1.137(b).

The petition under 37 CFR 1.181(a)(3), to overturn the decision of the Technology Center Director dated October 31, 2008, is DENIED.

The petition to revive an application unintentionally abandoned under 37 CFR 1.137(b) is GRANTED.

As to the petition under 37 CFR 1.181(a)(3):

BACKGROUND

A final Office action was mailed May 25, 2006.

An appeal brief was filed October 23, 2006 and in response thereto a Notification of Non-Compliant Appeal Brief was mailed December 12, 2006.

A supplemental appeal brief was filed January 9, 2007 and in response thereto a Communication Re: Appeal was mailed April 11, 2007. This communication included a notification that the application was abandoned.

A petition to Withdraw the Holding of Abandonment and in the alternative a Petition to Exercise Supervisory Authority under 37 CFR 1.181 was filed May 2, 2007. The petition was denied in a decision mailed June 14, 2007.

A renewed petition to Withdraw the Holding of Abandonment and in the alternative a petition to Revive an Unintentionally Abandoned Application was filed July 13, 2007. The renewed petition to withdraw the holding of abandonment was denied and the petition for revival of an unintentionally abandoned application was referred to the Office of Petitions in a decision mailed October 31, 2008.

The instant petition was filed December 31, 2008.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 41.37(d) states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

MPEP § 1205.03 states in part:

The Office may use the form paragraphs set forth below or form PTOL-462, "Notification of Non-Compliant Appeal Brief (37 CFR 41.37)" to notify appellant that the appeal brief is defective. The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified.

MPEP § 1215.04 states in part:

An appeal will also be dismissed if an applicant fails to timely and fully reply to a notice of noncompliance with 37 CFR 41.37(d). See MPEP § 1205.03 and 37 CFR 41.37(d). As in examples (B)-(C) above, if no allowed claims remain in an application, the application is abandoned as of the date the reply to the notice was due. The applicant may petition to revive the application as in other cases of abandonment, and to reinstate the appeal.

OPINION

Petitioners seek reversal of the Technology Center Director's decision of October 31, 2008, on the grounds that the decision is inconsistent with patent statutes and her interpretation of patent rules.

The Technology Center Director's decision correctly takes the position that the dismissal of the appeal and resulting abandonment of the application was proper due to petitioners' failure to provide a compliant appeal brief. A first appeal brief was filed October 23, 2006. The brief was determined to be non-compliant and resulted in the mailing of a Notification of Non-Compliant Appeal Brief on December 12, 2006. Petitioners responded with a supplemental appeal brief on January 9, 2007. The supplemental appeal brief was determined to be non-compliant as it did not overcome all the deficiencies in the brief noted in the Notification of Non-Compliant Appeal Brief. As a result, the appeal was dismissed and the application held abandoned as noted in the Communication Re: Appeal.

Petitioners argue that the application should not have been held abandoned and that there was extendable time remaining to file a second supplemental brief. The first petition filed May 2, 2007 did include a second supplemental appeal brief and a four month extension of time. Since the application was held abandoned after the submission of the first supplemental brief, the second supplemental appeal brief was not considered. Through all the petitions of record, petitioner has continuously argued that there was time remaining to file a second supplemental brief, which was submitted, and that petitioner should be allowed to file any number of supplemental briefs as long as he submitted them within the extendable time with proper extensions of time submitted.

The Technology Center Director takes the position that since the supplemental appeal brief, filed January 9, 2007 did not overcome all the reasons for non-compliance of the original appeal brief, the appeal was properly dismissed in accordance with 37 CFR 41.37(d). The fact pattern of this application falls completely within the rule as set forth in 37 CFR 41.37(d). Further, MPEP 1215.04 clearly establishes that if the response to the notice of non-compliance fails to fully reply to the notice then the application is abandoned. The notice was mailed December 12, 2006 and gave a response time of one month or 30 days, whichever is longer. Petitioners filed the supplemental brief

timely on January 9, 2007. Since the supplemental brief did not correct all the deficiencies set forth in the notice, the application became abandoned on January 13, 2007. Any submissions of second or subsequent supplemental appeal briefs would be untimely as the application became abandoned after the first supplemental brief was filed. Once an application becomes abandoned, requests for extensions of time have no effect. Petitioners argue that the Technology Center Director's decision was based on a "strained reading" of 37 CFR 41.37(d). However, it is clear the decision was based on the only possible reading of that rule and the MPEP. "The amended brief" must overcome all reasons for non-compliance stated in the notice of non-compliance and if this is not done the appeal is dismissed. There is no suggestion or implication that any number of supplemental briefs can be filed in an extended period in an effort to overcome the non-compliance issues. "The" amended brief can only be a first amended brief. The rule can only be interpreted to mean that an applicant has only one opportunity to correct all the deficiencies noted in the appeal brief as initially filed.

Petitioners argue that other Technology Centers follow a policy of allowing supplementary appeal briefs within the extended time and provides as evidence a copy of a form PTOL-462(Rev. 7-05), Notification of Non-Compliant Appeal Brief (37 CFR 41.37). This form has been altered and has unauthorized language in the first major paragraph as noted by the Technology Center Director in her decision of October 31, 2008. Further, the form has been redacted of all identifying information making it impossible to review the facts and circumstances of this application. In any event, that other Technology Centers have disregarded the provisions of 37 CFR 41.37(d) in other applications in regard to supplemental appeal briefs is of no moment. As stated by the Federal Circuit,

The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases In re Boulevard Entertainment, Inc., 67 USPQ2d 1475 (Fed Cir 2003) citing Int'l Flavers & Fragrances, 51 USPQ2d 1513 (Fed Cir. 1999).

Being as generous as possible, petitioners' evidence is that some examiner has not followed Office procedure in one instance. This is not grounds for the USPTO to discontinue our established practice.

For the reasons set forth above, the Technology Center Director's decisions to refuse petitioner's request to revive the application is not shown to be in error.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of October 31, 2008. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of October 31, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of October 31, 2008 will not be disturbed. The petition is **denied**.

As to the petition under 37 CFR 1.137(b):

This petition is **Granted**.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the required reply in the form of an acceptable supplemental appeal brief; (2) the petition fee of \$1,620; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center Art Unit 1733 for consideration of the supplemental appeal brief filed concurrent with this petition in due course.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.



Anthony Knight
Director
Office of Petitions