



MITCHELL R. SWARTZ
16 PEMBROKE ROAD
WESTON MA 02493

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In re Application of :
Mitchell R. SWARTZ :
Application No. 10/761,536 : ON PETITION
Filed: January 22, 2004 :
Attorney Docket No. N/A :

This is a decision on the petitions under 37 CFR 1.181(a)(3), filed December 16, 2008, requesting the Director exercise his supervisory authority and overturn the decision of the Petitions Examiner, dated December 8, 2008, which refused to withdrawal of the holding of abandonment of the above-identified application.

The petition to withdrawal the holding of abandonment is **DENIED**¹.

RELEVANT BACKGROUND

Given the voluminous number of petitions and petition decisions only the portions of prosecution relevant to the abandoned status of this case are set forth below.

On September 29, 2005, an amendment was filed.

On December 5, 2005, a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed.

On December 22, 2005, applicant filed a second amendment in response to the Notice of Non-Compliant Amendment.

On March 1, 2006, a second Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed.

On March 9, 2006, applicant filed a petition under 37 CFR 1.181.

On March 22, 2007, a decision denying the petition of March 9, 2006 was mailed.

On April 9, 2007, applicant filed a third amendment.

On April 9, 2007, a Notice of Abandonment was mailed.

On April 13, 16, and 17, 2007, applicant filed petitions under 37 CFR 1.181.

On December 8, 2008, a decision dismissing the petition of April 16, 2007 was mailed.

On December 16, 2008, a petition requesting review of the petition decision of December 8, 2008 was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

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 1.135 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. 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.

37 CFR 1.181(f) states:

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.

OPINION

Petitioner specifically requests that the Director overturn the Petitions Examiner's decision of December 8, 2008 and (1) withdraw the holding of abandonment and (2) accept the amendment filed April 9, 2007.

This application was held abandoned for failure to timely file a proper reply on or before April 1, 2006, in response to the Notice of Non-compliant Amendment mailed March 1, 2006. A Notice of Abandonment was mailed on April 9, 2007.

Petitioner states that a proper reply was in fact filed. However, a review of the record, especially the petition decision of March 22, 2007, the petition decision of December 8, 2008, and the Notice of Non-Compliant Amendment of March 1, 2006, confirms that a proper reply was not timely filed on or before April 1, 2006.

A proper reply to the Notice of Non-Compliant Amendment of March 1, 2006 should have incorporated correction of informalities listed in the Notice of Non-Compliant Amendment. Specifically, the March 1, 2006 Notice of Non-Compliant Amendment stated:

Applicant has not properly responded to the examiner's objection to the specification in section 3 of the 6/28/05 Office action.

In said Office action, the examiner stated:

"The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f)." Underlining provided.

In his 9/29/05 Response to said Office action, applicant stated:

"Attention is directed to the fact that the other material is **NOT relied upon to overcome any objection, rejection, or other requirement imposed by the Office.**" *Emphasis provided.*

Contrary to applicant's statement above, there are several materials (e.g., publications) that are incorporated by reference in the specification that have been relied upon to overcome the rejection of claims, e.g., under 35 U.S.C. 112, first paragraph. For example,

- Applicant cites the following publications as incorporated by reference - Swartz (92), Swartz (94) on page 6; Swartz (97B) on page 7; Swartz (97A, 98B, 98A) on page 8. These publications are used in the traverse of the claim rejections, e.g., see pages 27 and 51 of the 9/29/05 Response.

- Applicant cites the Miles (02) publication as incorporated by reference on page 9 of the specification. Miles (02) is used in the traverse of the claim rejections, *e.g.*, see page 39 of the 9/29/05 Response.
- Applicant cites the Beaudette (02) publication as incorporated by reference on page 9 of the specification. Beaudette (02) is used in the traverse of the claim rejections, *e.g.*, see page 36 of the 9/29/05 Response.
- Etc.

Since the period for reply set forth in the prior Office action has expired, this application will become abandoned unless applicant corrects the deficiency and obtains an extension of time under 37 CFR 1.136(a). See previous sheet.

A thorough review of Office records indicates the only reply to the March 1, 2006 Notice of Non-Compliant Amendment, filed prior to April 1, 2006, was a Petition under 37 CFR 1.181, filed March 9, 2006, requesting supervisory review of the examiner's action. Petitioner argues that a response entitled "Applicant's Response To Office Communication Dated 3/1/06" was in fact filed. While such a paper was filed on March 9, 2009 it was treated as part of the petition filed on even date. Moreover, the March 9, 2009 response only provided arguments therein and thus, petitioner failed to correct the informalities noted in the March 1, 2006 Notice of Non-Compliant Amendment. As stated in 37 CFR 1.135(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." Additionally, 37 CFR 1.181(f) states: "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." Petitioner filed no timely amendment to save the application from abandonment within the time period provided in the March 1, 2006 Notice of Non-Compliant Amendment. In fact petitioner filed no amendment until April 9, 2007, after the petition decision of March 22, 2007. Since the filing of the petition on March 9, 2006 did not toll the time for filing a response and the amendment filed April 9, 2007 was filed outside the period for reply to the March 1, 2006 Notice of Non-Compliant Amendment the application has been properly held abandoned.

For the reasons set forth above, the Petition Examiner's decision to refuse petitioners' requests to: (1) withdrawal the holding of abandonment; and (2) accept the amendment filed April 9, 2007 is not shown to be in clear error.

DECISION

A review of the record indicates that the Petitions Examiner did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of December 8, 2008. The record establishes that the Petitions Examiner had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Petitions Examiner of December 8, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of December 8, 2008 will not be disturbed. The petition is **denied**.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(a) or (b) to revive the application.

A handwritten signature in cursive script that reads "Charles Pearson". The signature is written in black ink and is positioned above a horizontal line.

Charles Pearson
Director, Office of Petitions

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02