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210
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OFFICE OF PETITIONS**

In re Application of :
Joel Adam DREESSEN :
Application No. 11/656,804 : **ON PETITION**
Filed: January 22, 2007 :
Attorney Docket No. 090705/001001 :

This is a decision on the petition filed August 19, 2011 under 37 CFR 1.181(a)(3) requesting withdrawal of the holding of abandonment in the above-identified application, dated September 9, 2009.

The petition is **DENIED**¹.

RELEVANT BACKGROUND

The instant application was filed January 22, 2007.

A Notice of Allowance and Fee(s) Due was mailed May 15, 2009 requiring a \$755 Issue Fee and a \$300 Publication Fee.

On August 17, 2009, a PTOL-85b was received with an amount of \$1050.

On September 9, 2009, a Notice of Abandonment was mailed.

A petition requesting the abandonment be withdrawn was filed March 11, 2010 and resubmitted March 15, 2010.

On March 18, 2010, a decision dismissing the petition filed March 11, 2010 was mailed.

On May 26, 2010, a renewed petition requesting withdrawal of the holding of abandonment was filed.

On February 4, 2011, a decision dismissing the petition of May 26, 2010 was mailed.

On April 4, 2011, a renewed petition requesting withdrawal of the holding of abandonment was filed.

On June 28, 2011, a decision dismissing the petition of April 4, 2011 was mailed.

On August 19, 2011, the instant petition was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

The American Inventors Protection Act enacted November 29, 1999, as Public Law 106-113, states:

18 SEC. 4506. COST RECOVERY FOR PUBLICATION.

19 The Under Secretary of Commerce for Intellectual
20 Property and Director of the United States Patent and
21 Trademark Office shall recover the cost of early publica
22 tion required by the amendment made by section 4502 by
23 charging a separate publication fee after notice of allow
24 ance is given under section 151 of title 35, United States
25 Code

35 U.S.C. 122(b)(1)(A) states:

Subject to paragraph (2), each application for a patent shall be published, in accordance with procedures determined by the Director, promptly after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought under this title. At the request of the applicant, an application may be published earlier than the end of such 18-month period.

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.

35 U.S.C. 151 states:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice

shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 CFR 1.211(e) states:

The publication fee set forth in § 1.18(d) must be paid in each application published under this section before the patent will be granted. If an application is subject to publication under this section, the sum specified in the Notice of Allowance under § 1.311 will include the publication fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable. If the application is not published under this section, the publication fee (if paid) will be refunded.

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 1.311(a) states:

If, on examination, it appears that the applicant is entitled to a patent under the law, a notice of allowance will be sent to the applicant at the correspondence address indicated in § 1.33. The notice of allowance shall specify a sum constituting the issue fee which must be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application.

The sum specified in the notice of allowance may also include the publication fee, in which case the issue fee and publication fee (§ 1.211(e)) must both be paid within three months from the date of mailing of the notice of allowance to avoid abandonment of the application. This three-month period is not extendable.

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.

MPEP 1126 states:

The publication fee set forth in 37 CFR 1.18(d) must be paid in each application published (or scheduled to be published) under 35 U.S.C. 122(b) before a patent will be granted on the application. The publication fee will be required with the Notice of Allowance and Fee(s) Due, unless the publication fee was previously paid. If an application becomes abandoned without being allowed, no publication fee is required.

MPEP 1306 states:

The issue fee and any required publication fee are due 3 months from the date of the Notice of Allowance. The amount of the issue fee and any required publication fee are shown on the Notice of Allowance.

OPINION

Petitioner requests that the Director: (1) withdraw the holding of abandonment; and (2) allow the patent to issue.

Petitioner argues: (1) 35 U.S.C. 151 states that upon payment of the issue fee the patent shall issue; but if payment is not timely made, the application shall be regarded as abandoned; and (2) 35 U.S.C. 151 makes no mention of a publication fee, nor provides for abandonment due to failure to pay the publication fee. Accordingly, petitioner concludes that the USPTO is acting beyond its authority by abandoning the instant application as Congress has not given the USPTO the authority to abandon an application for failure to pay the publication fee. Petitioner further argues that MPEP 1126 states: if an application becomes abandoned without being allowed, no publication fee is required. Thus, petitioner concludes that the USPTO should, when

there is a shortage of the required fees, apply the issue fee first as there is no basis in law for abandoning an application for failure to pay the publication fee, and as such, the issue fee would be fully paid, and the USPTO has no option other than to issue a patent.

Petitioner's argument that only 35 U.S.C. 151 applies here is unfounded. All of the statutes governing the operation of the USPTO apply and must be met. Here, The American Inventors Protection Act enacted November 29, 1999, as Public Law 106-113, 35 U.S.C. 122(b)(1)(A), 35 U.S.C. 133, and 35 U.S.C. 151 each apply. Public Law 106-113 states that the USPTO: "shall recover the cost of early publication required by the amendment made by section 4502 by charging a separate publication fee after notice of allowance is given under section 151 of title 35, United States Code." Moreover, 35 U.S.C. 122(b)(1)(A) states: "each application for a patent shall be published, in accordance with procedures determined by the Director". Therefore, Congress has required the USPTO to collect the publication fee and set forth procedures by which to do so. Additionally, 35 U.S.C. 133 permits the USPTO to abandon an application if applicant fails to timely prosecute an application. In this instance, petitioner has either: (1) failed to prosecute the application under 35 U.S.C. 133 by failing to pay the publication fee required by Public Law 106-113 and 35 U.S.C. 122(b)(1)(A); or (2) failed to pay the issue fee as required by 35 U.S.C. 151. Either scenario leads to a proper abandonment of the application under the statutes which govern operation of the USPTO.

Furthermore, petitioner has been put on Notice by the USPTO in the form of regulations under 37 CFR 1.211(e) and 37 CFR 1.311(a) that payment of both the issue fee and publication fee is required before a patent is issued. MPEP 1126 and 1306 also provide applicant Notice as to the consequences of failing to pay either the issue fee or publication fee. Additionally, as set forth in the FAQ's in 1249 *Official Gazette* 82 (August 21, 2001):

CS2. I received a Notice of Allowance and Fee(s) Due requiring payment of the publication fee. I, however, forgot to pay the publication fee within the 3-month period for reply set forth in the notice. What do I need to submit to make sure that the application will issue as a patent? (Posted on 3/04/02; updated on 8/01/02).

In this situation, you will need to file a petition to revive an abandoned application for failure to timely pay the publication fee under 37 CFR 1.137(b). See MPEP 711.03(c), pages 700-140 and 700-141 (August 2001). You may use the form PTO/SB/64 [PDF] available on the USPTO web site at <http://www.uspto.gov/web/forms/sb0064.pdf> [PDF]. The petition must be accompanied by: (1) the petition fee as set forth in 37 CFR 1.17(m); (2) the publication fee; a complete reply to the notice (i.e., the issue fee, corrected drawing, etc.); and (3) a statement that the entire delay in filing the reply and/or

fee(s) from the due date until the filing of a grantable petition was unintentional. In addition, if a complete reply to the Notice of Allowance was not filed (e.g., if the issue fee was also not paid, and any drawings, declaration, or biological deposit was not filed), then a complete reply to the Notice of Allowance must also be filed. The petition and an authorization to charge the fees to a deposit account or credit card may be faxed to the Office of Petitions (703) 308-6916.

Petitioner would have one believe that the USPTO is required to issue a patent without payment of the publication fee due to the language of 35 U.S.C. 151 and that the issue fee should be considered paid before the publication fee in the event of a shortage of fees. However, as set forth above, petitioner is required to pay both the issue fee and publication fee before a patent is issued and the failure to pay both results in abandonment of the application. Assuming, *arguendo*, that the issue fee should have been paid and the publication fee held deficient, the provisions of 35 U.S.C. 122(b)(1)(A) provide that each application for a patent shall be published, in accordance with procedures determined by the Director. 37 CFR 1.211(e) and 1.311(a) are each validly promulgated binding regulations to implement the provisions of 35 U.S.C. 122(b)(1)(A) and petitioner has not followed the provisions therein. In this scenario, no publication fee would have been timely paid, and the USPTO has clearly construed U.S.C. 122(b)(1)(A) to require the publication fee to be paid before a patent is issued and that failure to do so will result in abandonment of the application. Accordingly, U.S.C. 122(b)(1)(A) precludes the USPTO from issuing a patent until payment of the publication fee is made and requires abandonment of the application for failure to timely pay the publication fee. See Howard Florey Institute v. Dudas, 87 USPQ2d 1913 (EDVa 2008). Petitioner is reminded that no Executive Branch agency may act in derogation of a federal statute. See A.F. Stoddard & Co. v. Dann, 564 F.2d 556, 195USPQ 97 (D.C. Cir 1977).

For the reasons set forth above, the abandonment of this application by Patent Publication Branch, Office of Data Management is not shown to be in clear error.

DECISION

A review of the record indicates that the USPTO did not abuse its discretion or act in an arbitrary and capricious manner abandoning this application.

The petition is **denied**.

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

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



Anthony Knight
Director
Office of Petitions/
Petitions Officer

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