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JUL 05 2002

In re Application of :
Itoh et al. :
Application No. 09/162,168 :
Filed: September 29, 1998 :
Attorney Docket No. Y&A-112 :

**OFFICE OF PETITIONS
ON PETITION**

This is a decision on the petition filed March 20, 2001, requesting review under 37 CFR 1.181(a)(3) of the June 6, 2001 decision by a Group Director which refused to withdraw the holding of abandonment. This is also a petition under 37 CFR 1.183 requesting suspension of the rules.

The petition under 37 CFR 1.181(a)(3) is **DENIED**.¹

The petition under 37 CFR 1.183 is **dismissed**.

BACKGROUND

The drawings submitted with the original application were not declared to be informal.

On June 23, 2000, a Notice of Allowability was mailed which stated that formal drawings needed to be submitted because the original drawings were declared by applicant to be informal.

Petitioner failed to file a response to the Notice of Allowability or to obtain any extensions of time. The application became abandoned on September 24, 2000.

A Notice of Abandonment was mailed on January 8, 2001.

Petitioner has filed two petitions seeking withdrawal of the holding of abandonment. A Group Director for Technology Center 1700 has denied both petitions.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 USC 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.

¹ This decision may be viewed as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP 1002.02. The terms of 37 CFR 1.378(e) *do not apply* to this decision.

OPINION

The standard for review of the action or inaction of any employee or operation within the United States Patent and Trademark Office is whether that employee or operation acted in an arbitrary or capricious matter, such that the action or inaction was tantamount to an abuse of discretion. However, a review of the Group Director's refusal to withdraw the holding of abandonment fails to demonstrate any abuse of discretion.

35 USC 133 requires that if an action is mailed, and if an applicant fails to respond to such action within 6 months, the application goes abandoned as a matter of law. The statute does not distinguish "correct" Office actions from "incorrect" Office actions. An Office action in the form of a Notice of Allowability was mailed on June 23, 2001. Applicant did not respond to the Office action within 6 months. Applicant had up to 6 months to traverse or otherwise respond to the request to file new formal drawings, but applicant chose not to do so. Therefore, as a matter of law, the application is abandoned.

Abandonment is not based on the correctness, in whole or in part, of an Office action: it is based upon operation of law. For example, if an applicant fails to respond to a restriction requirement which the examiner later determines is untenable as drafted, the application is abandoned. If an Office action is mailed rejecting claims based on anticipation over a reference that was facially not available as prior art against the application, an applicant must still respond to the Office action in order to avoid abandonment.

Petitioner failed to respond to the Notice of Allowability. Such response could have taken the form of a written traversal stating the facts in the instant petition regarding the original drawings. Petitioner could have directly contacted the examiner and taken steps to have the examiner withdraw the requirement in writing prior to the expiration of the shortened (or extended) time period.

Petitioner has filed a petition under 37 CFR 1.183 seeking waiver of the rules. However, the petition fee has not been paid. Specifically, the wording and context of the fee authorization appears to imply that the fee is authorized only if the Commissioner decides to grant a petition under 37 CFR 1.183. A petition fee must be paid for the merits of a petition to be considered regardless of whether the petition is ultimately granted or dismissed. Therefore, the merits of the petition under 37 CFR 1.183 have not been considered. However, petitioner may wish to note that the Office does not have the authority to waive a statute such as 35 USC 133. Any request for reconsideration of the petition under 37 CFR 1.183 must be filed within two months and must be accompanied by \$130 or authorization to charge \$130 to petitioner's deposit account.

Petitioner should promptly seek revival of this application under 37 CFR 1.137.²

² By mail: Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
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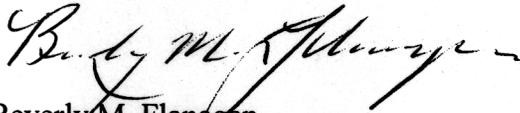
DECISION

A review of the record indicates that the Group Director did not abuse his discretion or act in an arbitrary manner.

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

The patent file is being forwarded to Files Repository.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.



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