In re Patent No. 5,818,339
Issue Date: October 6, 1998
Application No. 08/835,200
Filed: April 7, 1997
Attorney Dkt. No. n/a

This is a decision on the petition under 37 CFR 1.137(b), filed October 2, 1999 to revive the above-identified application.

The petition is DENIED.

BACKGROUND

The above-identified application issued as U.S. Patent No. 5,818,339 on October 6, 1998.

Petitioner seeks revival of the above-identified application under 37 CFR 1.137(b) solely for purposes of obtaining copendency with an application filed under 37 CFR 1.53(b) on the same date as the instant petition. Petitioner further asserts that the failure to file a continuing application during the pendency of the above-identified application was inadvertent, and, as such, "the continuation was unintentionally abandoned."

STATUTE AND REGULATION

35 U.S.C. § (6)(a) provides, in part, that:

The Commissioner . . . may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

Public Law 97-241, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that
the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides that the Commissioner shall charge:

On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, $820[1210], unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $78[110].

37 CFR 1.137(b) provides:

Unintentional. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

Opinion

The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See In re Morganroth, 6 USPQ2d 1802, 1803 (Comm'r Pats. 1988). In addition, under 35 U.S.C. § 120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, and (3) proceedings in the application may be terminated. Id. When the application issues as a United States Patent, proceedings in
that application are terminated no later than the date of such
issue. Once an applicant pays the issue fee in reply to a
Notice of Allowance, the PTO has little discretion but to issue
the patent, as happened herein. See 35 USC § 151, ¶ 2 (Upon
payment of the issue fee, "the patent shall issue"). Where
proceedings in an application are terminated by way of the
granting of a patent, such application is no longer neither
pending nor abandoned, but is patented. See Chapter 15 of Title
35, United States Code. However, as noted in MPEP 1306:

Once the patent has been granted, the Patent and Trademark
Office can take no action concerning it, except as provided

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the
Commissioner to revive an "unintentionally abandoned
application." The legislative history of Public Law 97-247
reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit
the Office to have more discretion than in 35 U.S.C. §§ 133 or
151 to revive abandoned applications in appropriate
circumstances, but places a limit on this discretion, stating
that ":[u]nder this section a petition accompanied by either a
fee of $500 or a fee of $50 would not be granted where the
abandonment or the failure to pay the fee for issuing the patent
was intentional as opposed to being unintentional or
unavoidable."[emphasis added]. See H.R. Rep. No. 542, 97th
Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-
71.

Thus, the Commissioner's authority to revive an application is
limited to those which are abandoned within the meaning of
Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir.
1989) (the Commissioner lacks the authority to revive an
application abandoned by termination of court proceedings
because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for
the revival of an application abandoned in such a manner).

A standard principle of statutory construction is: expressio
unius est exclusio alterius (the mention of one thing implies
exclusion of another thing), namely absent legislative intent to
the contrary, when a statute expressly provides a specific
remedy for a specific situation, the statute is deemed to
exclude other remedies for such situation. See National R.R.
Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S.
453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be
done in a particular mode, it includes the negative of any other
mode"). Since Congress has provided in Public Law 97-247 a
specific scheme for the revival of abandoned applications (i.e.,
the specific situations under which the PTO may revive an
abandoned application and the specific requirements (fee amounts
and standards) applicable to each specific situation), the
creation—or furtherance—of a scheme for the revival of any
application that is not an abandoned application, but rather, is
a patent, would be inconsistent with the patent statute.

As 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) do not apply to the
situation of the above-identified application (i.e., to the
revival of an issued patent) such precludes the Commissioner
from reviving the above-identified application thereunder. In
other words, the PTO lacks jurisdiction to revive an application
which enjoys the status of a properly issued patent.

A failure to timely file a continuing application does not
warrant relief from the consequences of that delay with respect
to the original application. See In re Watkinson, 900 F.2d.
230, 14 USPQ2d 1407 (Fed. Cir. 1990). Rather, applicant's
failure to timely file another application is simply not germane
to any question of error or delay in the prosecution of the
original application. See In re Orita, 550 F.2d 1277, 1281, 193

DECISION

As the above-identified application is patented, and is not
abandoned, there is no question of abandonment, and, as such,
the application will not, and cannot, be revived. Accordingly
the petition to revive the above-identified patented application
is denied. Likewise, as the continuing application is not
abandoned, there can be no issue of revival herein of the latter
application.

The petition fee is due to the PTO "[o]n filing" the petition
regardless of the applicability of the statute or outcome of the
decision, and, as such, will not be refunded. See 35 USC
41(a)(7); Ex parte VENTURA CITRUS ASSOCIATION, 71 USPQ 103, 104
(Comm'r Pat. 1946).

This patented file is being forwarded to the Files Repository.
Telephone inquiries regarding this decision should be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

[Signature]

Stephen G. Kunin
Deputy Assistant Commissioner
for Patent Policy and Projects