



Paper No. 16

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OFFICE OF PETITIONS

In re Application of
Takahashi, et al. : DECISION ON PETITION
Application No. 10/064,284 :
Filed: June 28, 2002 :
Attorney Docket No. FY50192JPO :

This is a decision on the papers titled "Resending Request for Reconsideration by the Commissioner", filed April 13, 2005, and the "Second Renewed Petition to Revive Under 37 CFR 1.137A", filed October 29, 2003.

A decision denying the renewed petition under 37 CFR 1.137(a) was mailed on December 29, 2004, but was returned to the Office as undeliverable. A copy of that decision is enclosed.

Petitioner's request that the Director personally intervene and decide this case is **DISMISSED**.

A party to a proceeding in the Patent and Trademark Office has a right to petition, and may expect to receive a decision by either the Office official delegated authority to render the decision, or the delegating official.¹ While a higher level official, at the request of the party, may further review a decision rendered pursuant to delegated authority, such review is a matter which lies within the sound discretion of that higher level official, and is not a matter of right.²

Rather, a decision rendered pursuant to delegated authority will not be reviewed by a higher level official except in unusual or

¹ See In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991).

² Id.

exceptional circumstances.³ In this regard, decisions on petition under 37 CFR 1.137(a) have been delegated to the Office of Petitions in the Office of the Deputy Commissioner for Patent Examination Policy, pursuant to MPEP 1002.02(b). Accordingly, the decision of December 29, 2004 is a final agency action for purposes of seeking judicial review, and as such will not be further revisited on yet another petition. Petitioner is understandably unhappy that his application has not been revived, but such does not adequately demonstrate that such unusual or exceptional circumstances are present herein.⁴ Inspection of the instant petition fails to reveal a showing of such unusual or exceptional circumstances that would justify involvement by the Commissioner in light of the principles discussed above.

The renewed petition under 37 CFR 1.137(a) is **DENIED**. 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.

BACKGROUND

- On June 28, 2002, the above application was filed electronically.
- A Notice of Allowance and Notice of Allowability were mailed on November 1, 2002. The Notice of Allowance set a three month non extendable period for reply for issue fee transmittal. The Notice of Allowability indicated that formal drawings were required, and set a three month non extendable period for their transmission.
- On November 25, 2002, petitioner filed an Information Disclosure Statement, together with a cover letter. The cover letter stated that applicants believed that the request for formal drawings was made in error, and requested clarification.
- A Supplemental Notice of Allowability was mailed on January 14, 2003. This notice was silent with regards to formal drawings.
- On January 28, 2003, petitioner filed a "Request for Acknowledgement [sic] of Priority Document and Clarification of Drawing Request". Applicants pointed out that they believed there was no further need for formal drawings, and requested clarification.
- On February 2, 2003, the three month statutory period for paying the issue fee lapsed. As no issue fee had been received, the application became abandoned on that date.
- A second Supplemental Notice of Allowability was mailed on March 5, 2003. This notice indicated that the drawings originally filed with the application were accepted by the Examiner.

³ See In re Staeger, 189 USPQ 284 (Comm'r Pat. 1984).

⁴ Id.

- On March 14, 2003, petitioner filed a petition to revive under 37 CFR 1.137(a), unavoidable delay.
- By Decision mailed September 8, 2003, the petition was dismissed. Petitioner had not established to the satisfaction of the Commissioner that the entire period of delay in paying the issue fee was unavoidable.
- On October 14, 2003, petitioner filed a renewed petition under 37 CFR 1.137(a).
- By Decision mailed October 16, 2003, the petition was again dismissed.
- On October 29, 2003, petitioner filed the instant request for reconsideration.

RELEVANT STATUTES, RULES AND REGULATIONS

35 U.S.C. 151 provides, in pertinent part, that:

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.

37 CFR 1.137(a) provides, in pertinent part, that:

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) the reply required to the outstanding Office action or notice, unless previously filed;
- (2) the petition fee required by 37 CFR 1.17(1);
- (3) a showing to the satisfaction of the Commissioner 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 37 CFR 1.137(a) was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) as required pursuant to 37 CFR 1.137(d).

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or

imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.⁵

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.⁶

OPINION

Petitioner has not met his burden of establishing that the entire period of delay to the filing of the instant petition was unavoidable.

The Notice of Allowance and the Notice of Allowability mailed on November 1, 2002 set forth concurrent but distinct requirements with which applicants were required to comply. However, petitioner states that he did not pay the issue fee because there was a question regarding the submission of formal drawings. Accordingly, petitioner states that he was stuck "between a rock and a hard place." In petitioner's mind, he could not pay the issue fee because if new drawings were validly required and the issue fee was paid without their submission, the application would become abandoned, and the payment of the issue fee without the submission of the required drawings could be considered by the Office to be evidence of intentional delay that would bar revival. As a result, petitioner neither paid the issue fee or filed formal drawings, but instead filed his status requests seeking clarification with regards to the drawings, while pointing out that he believed no new formal drawings were required.

As indicated above, the requirements for payment of the issue fee and new drawings set forth in the Notice of Allowance and Notice of Allowability, respectively, are separate and distinct requirements, and abandonment for failure to comply with such requirements arise under separate statutory provisions. See 35 U.S.C. 151 and 133. As stated in MPEP 711.03(c) at page 700-165:

While the revival of applications abandoned for failure to timely prosecute and for failure to timely pay the issue fee are incorporated together in 37 CFR 1.137, the statutory

⁵ In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

⁶ See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

provisions for the revival of an application abandoned for failure to timely prosecute and for failure to timely submit the issue fee are mutually exclusive. See Brenner v. Ebbert, 398 F.2d 762, 157 USPQ 609 (D.C. Cir. 1968).

The instant application became abandoned pursuant to 35 U.S.C. 151 for failure to timely pay the issue fee. Petitioner asserts that payment of the issue fee was unavoidable because payment of the issue fee without submission of any validly required drawings would be considered an intentional act of abandonment foreclosing revival. Petitioner's argument is unpersuasive. As indicated above, the requirement to prosecute the application is separate and distinct from the requirement to pay the issue fee. Payment of the issue fee is simply not relevant to the issue of abandonment for failure to prosecute the application. Delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP does not constitute "unavoidable" delay. See MPEP 711.03(c) at page 700-177. As the facts of this case clearly show, petitioner was not "caught between a rock and a hard place," as payment of the issue fee would have avoided abandonment of the instant application. A reasonably prudent person, in relation to his most important business, would have timely paid the issue fee to avoid certain abandonment under 35 U.S.C. 151, notwithstanding any uncertainty with respect to the propriety of other requirements the failure to comply of which could result in abandonment under another statutory provision.

Lastly, with respect to petitioner's "unanswered question", petitioner has requested whether a terminal disclaimer is required, and if so, whether it must include the time period between the filing of the first 37 CFR 1.137(a) petition on March 14, 2003, and the first decision on petition, mailed September 8, 2003 (nearly six months). Petitioner is directed to 37 CFR 1.137(d), which states that in a utility or plant application, a terminal disclaimer is only required if the application was filed prior to June 8, 1995.

CONCLUSION

Thus, it is concluded that petitioner has not demonstrated that the entire period of delay in submitting the issue fee was unavoidable.

Petitioner's only available remedy to revive the application is to file a petition under 37 CFR 1.137(b). A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m), currently \$1,500; and (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.

Petitioner's failure to promptly file a petition under 37 CFR 1.137(b) may be considered as evidence of intentional delay, and held to be an absolute bar to revive.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
 Commissioner for Patents
 P.O. Box 1450
 Alexandria VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

Telephone inquiries specific to this decision may be directed to Petitions Attorney Cliff Congo at (571)272-3207.



Charles Pearson
Director
Office of Petitions

Enc: Denial mailed December 29, 2004 (5 pages)