



Lorri W. Cooper  
Jones Day  
901 Lakeside Avenue  
Cleveland OH 44114

**COPY MAILED**

SEP 06 2005

**OFFICE OF PETITIONS**  
Paper No. 8

In re Patent No. D488,082 :  
Issue Date: April 6, 2004. :  
Application No. 29/178,471 :  
Filed: March 26, 2003 :  
Inventor: Alaric Scott DURR et al :  
Attorney Docket No. 578340326165 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 21, 2005, to revive the above-identified "application", now issued as D488,082.

The petition is **DENIED**<sup>1</sup>.

**BACKGROUND**

The above-identified application issued as U.S. Patent No. D488,082 on April 6, 2004.

Petitioner seeks revival of the above-identified application under 37 CFR 1.137(b) solely for purposes of obtaining copendency with a divisional application filed under 37 CFR 1.53(b) on April 6, 2005. Petitioner further asserts that the failure to file a continuing application during the pendency of the above-identified application was unintentional.

**STATUTE AND REGULATION**

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

Public Law 97-247, § 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, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

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 in 35 U.S.C. 135 and 35 U.S.C. 251 through 256 and 35 U.S.C. 302 through 307.

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 \$1500 or a fee of \$500 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 35 U.S.C. §§ 41(a)(7), 111, 133, and 151. See Morganroth v. 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, unfortunately, 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 USPQ 145, 148-149 (CCPA 1977). Likewise, the PTO lacks the authority or discretion to accord § 120 benefit to an application filed after termination of proceedings of the parent application. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot fashion a remedy that contravenes the copendency requirement of 35 USC 120).

#### 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**.

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).

Telephone inquiries regarding this decision should be directed to Petitions Examiner David Bucci at (571) 272-7099.



Charles Pearson  
Director, Office of Petitions

<sup>1</sup> This decision may be viewed by petitioner as a final agency action within the meaning of 5USC 704 for purposes of seeking judicial review. See MPEP 1002.02