



**OLSON & CEPURITIS, LTD
20 NORTH WACKER DRIVE
36TH FLOOR
CHICAGO IL 60606**

MAILED

JUN 27 2011

In re Application of : **OFFICE OF PETITIONS**
Thomas C. Piotrowski et al :
Application No. 11/312,283 : **DECISION ON PETITION**
Filed: December 20, 2005 :
Attorney Docket No. PROT-007 :

This is a decision on the renewed petition, filed February 28, 2011 under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DENIED**.

BACKGROUND

The instant application was filed on December 20, 2005.

On August 5, 2009, a nonfinal Office action was mailed. The Office action set a statutory period of three-months from the mail date of the Office action to reply.

An amendment in response to the nonfinal Office action was timely received on October 29, 2009. However, on February 12, 2010, a Notice of Non-Compliant Amendment (37 CFR 1.121) was mailed to applicant. An Interview Summary was conducted on February 18, 2010. A Notice of abandonment was mailed on October 8, 2010. A petition to withdraw holding of abandonment was filed on October 13, 2010. On February 14, 2011, a petition dismissing the October 13, 2010 petition was mailed. On February 28, 2011, the instant renewed petition was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.2 states:

All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

37 CFR 1.135(b) states:

Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include each 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.

As was stated in the decision mailed February 14, 2011, Applicant files the present petition and states that "As stated in the Examiner's Interview summary, counsel pointed out where the amended claim in question was properly marked. The Examiner agreed that the amendment was properly marked, agreed to withdraw the Notice of Non-Compliant Amendment and re-docket the case to the Examiner for reconsideration. The Examiner indicated to undersigned counsel that no separate Interview Summary Recorded by Applicant was required.

OPINION

Petitioners request that the holding of abandonment indicated in the Notice of Abandonment mailed October 8, 2010 be withdrawn.

Petitioners were notified in the Notice mailed February 12, 2010, that the amendment filed October 29, 2009 was non-compliant and that Amended claim 11 contains no underlining and/or strike-through markings to indicate the amendment to the claim (section 4(E) of the Notice). The application was held abandoned for failure to reply to the Notice mailed February 12, 2010.

Petitioners argue that "The allegation was erroneous, because amended claim 11 was compliant as filed, and on February 18, 2010, Petitioners telephonically brought this Office error to the attention of the Examiner. The Examiner agreed that claim 11 was compliant and entered into the written record an Interview Summary mailed on February 22, 2010, stating that "The notice

of non-compliant amendment will be withdrawn...” and that “The case will be re-docketed to the examiner for consideration.”

However, while applicants did contact the examiner by phone and an Examiner’s Interview was conducted on February 22, 2010 and made of record, stating that “The notice of non-compliant amendment will be withdrawn as Ms. Kenney pointed out that claim 11 has proper markings for an amended claim at line 5. The case will be re-docketed to the examiner for consideration.” The contact by phone was not the proper procedure to be followed on applicant’s part. Again, all business with the Patent and Trademark Office should be transacted in writing (37 CFR 1.2). Therefore, the written record is clear that a complete response to the Notice mailed February 12, 2010, was not provided by applicant and the application was properly abandoned (see 37 CFR 1.135).

DECISION

A review of the record indicates that the Notice of Abandonment mailed October 8, 2010 was proper due to applicant’s failure to timely reply to the Notice mailed February 12, 2010. As such, the petition is denied.

ALTERNATIVE AVENUE:

Petitioners are encouraged to file a petition under 37 CFR 1.137 to revive the above referenced application. For petitioner’s convenience forms PTO/SB/61 and PTO/SB/64 are attached.

Telephone inquiries concerning this decision should be addressed to Karen Creasy at 571-272-3208.



Anthony Knight
Director, Office of Petitions

ATTACHMENT: Petition Forms PTO/SB/61 and PTO/SB/64