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**MAILED**

**MAY 18 2011**

**OFFICE OF PETITIONS**

In re Application of	:	
Harris	:	
Application No. 11/355,327	:	DECISION ON PETITION
Filed: February 15, 2006	:	
Attorney Docket No. PA3519US	:	

This is a decision on the renewed petition filed January 3, 2011, which is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DENIED**. No further consideration of this matter will be undertaken by the Office. Petitioner is not precluded from seeking revival of the present application under 37 CFR 1.137 as explained in the conclusion to this decision.

**BACKGROUND**

This application became abandoned for failure to timely submit the issue fee, as required by the Notice of Allowance and Fee (s) Due, which was mailed December 17, 2009. The Notice of Allowance and Fee (s) Due and the Notice of Allowability set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on March 18, 2010. A Notice of Abandonment was mailed on April 2, 2010.

Petitioner contends that the application was improperly held abandoned because the examiner issued a second Notice of Allowance on March 16, 2010 that indicated a new time period for reply. Further, petitioner contends the interview summary of March 16, 2010 indicated that a new time period would be reset. Thus petitioner contends that he relied upon the written record pursuant to 37 CFR 1.2.

**APPLICABLE RULES AND REGULATIONS**

35 U.S.C. 151 Issue of patent in pertinent part:

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. Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

## MPEP 203.05 Abandoned

An abandoned application is, inter alia, one which is removed from the Office docket of pending applications:

- (A) through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or by the attorney or agent of record;
- (B) through failure of applicant to take appropriate action at some stage in the prosecution of a nonprovisional application;
- (C) for failure to pay the issue fee ( MPEP \* § 711 to § 711.05); or
- (D) in the case of a provisional application, no later than 12 months after the filing date of the provisional application (see MPEP § 711.03(c) and 35 U.S.C. 111 (b) (5)).

37 CFR 1.316 Application abandoned for failure to pay issue fee.

If the issue fee is not paid within three months from the date of the notice of allowance, the application will be regarded as abandoned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

### ANALYSIS

Petitioner's argument has been considered but has been deemed unpersuasive. A review of the record confirms that only one Notice of Allowance was mailed on December 17, 2009. A supplemental Notice of Allowability was mailed on March 16, 2010. The Notice of Allowability informed petitioner "if not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. In this instance, the Notice of Allowance (PTOL-85) was previously mailed on December 17, 2009.

Petitioner contends that the Notice of Allowability mailed on March 16, 2010 provided applicant with three months to respond. However, the Notice of Allowability mailed on March 16, 2010 did not provide a three month reply period. The Notice of Allowability states "Applicant has THREE MONTHS FROM THE MAILING DATE" of this communication to file a reply complying with the requirements noted below." Since the Notice of Allowability did not indicate requirements such as a substitute oath or declaration, corrected drawings, or deposit of and/or Information about the deposit Biological Material were required, the three month reply period was not applicable. The controlling three month reply period for submitting the issue and publication fee was provided in the Notice of Allowance mailed on December 17, 2009.

35 U.S.C. 151 requires that the submission of the issue fee within three months. Although the interview summary indicated that the time period for reply would be reset, the time period was not reset while the application was pending. Once the application was abandoned, it was no longer considered pending. See 37 CFR 1.316. Thus, the examiner



did not have the authority to restart the time period of reply in an abandoned application. Essentially petitioner seeks to waive the requirement that an issue fee be submitted within three months of the mailing of the Notice of Allowance which is statutory and thus cannot be waived. The interview summary cannot overcome the statutory requirements that the failure to submit the issue fee within three months of the mailing of the Notice of Allowance will result in the abandonment of the application.

### CONCLUSION

As such, the holding of abandonment will not be withdrawn.

Petitioner may wish to consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the \$810.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.



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