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MAILED

OCT 01 2010

OFFICE OF PETITIONS

In re Application of	:	
Conrado G. CASTRO	:	
Application No. 11/731,031	:	ON PETITION
Filed: March 27, 2007	:	
Attorney Docket No.	:	

This is in response to the renewed petition filed November 25, 2009 and supplemented with a communication filed January 29, 2010, to revive the above-identified application. The communications are being treated as a petition to withdraw the holding of abandonment under 37 CFR §1.181.

The petition is **DENIED**.

This decision is an action on petitioner's request to withdraw the abandonment. On February 25, 2008, the Office mailed a non-final Office action, which set a three month shortened statutory period to reply. Petitioner filed responses on March 21, 2008 and May 23, 2008, and supplemented the said responses on August 16, 2008, and October 20, 2008. However, the petitioner's initial responses dated March 21, 2008 and May 23, 2008 were deemed to be non-responsive for failure to address all issues raised by the examiner in the office action dated February 25, 2008. The Office on July 18, 2008 mailed a Notice of Non-Compliant Amendment, which gave petitioner one month or thirty (30) days to supply the omissions or corrections in order to avoid abandonment. Extensions of time were available under 37 CFR §1.136(a). No extension of time was requested. Petitioner responded to the July 18, 2008 Notice on August 16, 2008. Petitioner's August 16, 2008 response was deemed not fully responsive. The examiner on September 18, 2008 mailed a second Notice of Non-Compliant Amendment. Petitioner responded on October 20, 2008. Because the response was incomplete, the application became abandoned on August 19, 2008, for failure to submit a proper response to the February 25, 2008 Office action. On May 19, 2009, the Office mailed a Notice of Abandonment.

Petitioner in the renewed petition filed November 25, 2009 and supplemented January 29, 2010 request reconsideration of the decision mailed September 28, 2009. Petitioner urges that he

responded to the Office letters of July 18, 2008 on August 16, 2008 and replied to the Office letter of September 18, 2008 on October 20, 2008.

STATUTES, REGULATIONS AND EXAMINING PROCEDURES

35 USC §133 provides that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR §1.135(b) provides that:

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

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

DISCUSSION OF PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

Petitioner relies upon the decision rendered September 28, 2009 as support for the statement in the renewed petition that responses to the Notice of Non-Compliant Amendment were in fact filed. Petitioner states that since he has responded to all the Notice of Non-Compliant Amendments the application should not have been abandoned. Specifically, in the decision dated September 28, 2009, at page two, paragraph one, under Discussion of Petition to Withdraw the Holding of Abandonment, it is stated "A review of the file indicates that petitioner did in fact respond to the Notice of Non-Compliant Amendments."

Here petitioner has failed to appreciate the distinction between a failure to respond, and a failure to properly respond. Additionally in the decision dated September 28, 2009, petitioner was advised that the response dated March 21, 2008 and the additional response of May 23, 2008 were incomplete.

On February 25, 2008 the Office mailed a non-final Office action, which set a three month ~~shortened statutory period~~ to reply. The response was due May 25, 2008. On May 23, 2008 a

reply was received. A review of this reply by the examiner indicated that the reply did not constitute a proper reply and a Notice of Non-Compliant Amendment was mailed July 18, 2008. The Notice indicated that 1) the claim status was not provided, 2) the amended paragraphs in the specification did not include markings, 3) an Abstract should be presented on a separate sheet and 4) the drawings were not properly identified as Replacement Sheets, and should contain markings indicating the changes made through the amendment. The action included a reference to rule 37 CFR §1.121, Manner of making amendments in applications. Petitioner was given one (1) month or thirty days from the mailing of the notice, whichever was longer, within which to supply the omission or corrections in order to avoid abandonment. Extensions of time were available under 37 CFR §1.136(a). Petitioner timely responded on August 16, 2008 and in a communication dated September 18, 2008, petitioner was notified that the response filed was non-responsive. The Notice indicated that 1) the implied claim status was not provided, 2) the annotations in the outstanding reply must indicate markings of all amendments to the claims, 3) amended paragraphs in the specification do not include markings and 4) the drawings are properly identified in the top margin as Replacement Sheets and should contain markings indicating the changes made through the amendment. No heading and no other information should be on the Replacement Sheet for the drawing.

The Notice of September 18, 2008, again gave one (1) month or thirty (30) days from the mailing of the Notice, whichever is longer, within which to supply the omissions or corrections in order to avoid abandonment. Extensions of time may be granted under 37 CFR §1.136(a). On October 20, 2008, petitioner replied and requested withdrawal of Notice and examination of the application. No comments were submitted with regard to the formal issues raised in the September 18, 2008. Since the response was not considered to be a bona fide attempt to respond, the application was held abandoned. Specifically, petitioner neither requested deferral of the formal requirements nor supplied the requested omissions. Once an inadvertent omission is brought to the attention of petitioner, the question of inadvertence no longer exists. The response of October 20, 2008 constitutes a deliberate omission of a necessary part of a complete reply. Where there has been a deliberate omission, the practice set forth in 37 CFR §1.135(c) of the examiner setting forth a new time period for petitioner to respond and complete the reply, would not be appropriate. Hence the abandonment of this application is deemed proper.

The prior decisions which refused to withdraw the holding of abandonment in this application pursuant to 37 C.F.R §1.181 has been reconsidered. For the above reasons, the holding of abandonment will not be withdrawn.

ALTERNATIVE VENUE

Petitioner is strongly encouraged to consider filing a petition under 37 CFR §1.137(b) to revive an unintentionally abandoned application. Delay in filing such a petition may be interpreted as intentional delay which would preclude this application from being revived. This means that petitioner's continued filing of letters requesting that the holding of abandonment be withdrawn will be treated as an act of intentional delay since a final agency action has been issued.

A grantable petition pursuant to 37 CFR §1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed. In nonprovisional utility application abandoned for failure to respond to a non-final Office action, the required reply may be met by filing either (A) an argument or amendment under 37 CFR §1.111 or (B) a continuing application under 37 CFR § 1.53(b).
- (2) The petition fee as set forth in 37 CFR §1.17(m), currently **\$810.00 for a small entity**;¹
- (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 was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

A form for filing a petition to revive an unintentionally abandoned application accompanies this decision for petitioner's convenience. If petitioner desires to file a petition under 37 CFR § 1.137(b) instead of filing a request for reconsideration, petitioner must complete the enclosed petition form (PTO/SB/64) and pay the \$810.00 petition fee.

This decision is a final action on petitioner's request to withdraw the abandonment.

Telephone inquiries related to this decision may be directed to Thurman K. Page at (571) 272-0602.



Anthony Knight
Director
Office of Petitions
United States Patent and Trademark Office

Enclosure: Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR §1.137(b); Form PTO/SB/64, Privacy Act Statement.

¹ Fee changes do occur. Please visit the following link for up to date fee information, www.uspto.gov/about/offices/cfo/finance/fees.jsp, or call 703-786-9199.