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OFFICE OF PETITIONS

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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In re Application of :
John R. Milton :
Application No. 09/938,465 : DECISION ON RENEWED PETITION
Filed: August 23, 2001 : UNDER 37 C.F.R. §1.181(A)
Attorney Docket Number: :
10010979-1 :
Title: SYSTEM AND METHOD FOR :
TRACKING PLACEMENT AND USAGE OF :
CONTENT IN A PUBLICATION :

## Background

This is a decision on the renewed petition under 37 CFR §1.181(a), filed May 1, 2006, to withdraw the holding of abandonment.

The request to withdraw the holding of abandonment is **DENIED**[1].

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed April 21, 2005, which set a shortened statutory period for reply of three (3) months. An after-final amendment was received on May 25, 2005, and an advisory action was mailed on June 13, 2005. No further responses were received, and no extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 22, 2005. A notice of abandonment was mailed on December 23, 2005.

The original petition was submitted on January 24, 2006, and was dismissed via the mailing of a decision on March 9, 2006. With

1 This decision may be regarded as a final agency action within the meaning of 5 U.S.C. §704 for the purposes of seeking judicial review. See MPEP 1002.02.

the present petition pursuant to 37 C.F.R. §1.181(a), Petitioner has again failed to establish that the holding of abandonment should be withdrawn. A discussion follows.

## The Relevant Law and Regulations

35 U.S.C. 133: Time for prosecuting application.

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.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. §1.2: Business to be transacted in writing.

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.

§ 1.113: Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[24 FR 10332, Dec. 22, 1959; 46 FR 29182, May 29, 1981; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; revised, 65 FR 14865, Mar. 20, 2000, effective May 29, 2000 (adopted as final, 65 FR 50092, Aug. 16, 2000); para. (a) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (a) revised, 68 FR 14332, Mar. 25, 2003, effective May 1,

2003; para. (a) revised, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

§ 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(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.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

## Analysis

With the original petition, Petitioner asserted that he did not believe that any action needed to be taken after receiving the advisory action which was mailed in response to an after-final amendment, due to a telephone conversation he had with the Examiner. Petitioner asserted that he was informed over the phone that a new office action would be forthcoming - and thus he "took no further action in the case[2]," relying on this oral understanding.

In short, Petitioner decided it best to discount the advisory action, based on an understanding he had with the Examiner. The original petition was dismissed via the mailing of a decision on March 9, 2006, since 37 C.F.R. §1.2 prohibits reliance on an oral assurance which was made by the Examiner.

Since the mailing of this decision, the Examiner has introduced an interview summary into the record, where a conversation which took place more than 6 months prior is memorialized. With this renewed petition, Petitioner would have the Office grant his

2 Original petition, paragraph 8.

request and withdraw the holding of abandonment, as this interview summary constitutes "written evidence of record[3]."

It is noted in passing that this interview summary indicates that the Examiner would issue a new office action, but nowhere is it stated that the final Office action would be withdrawn.

The failure to submit a response

As described above, Petitioner received a final Office action, submitted an after-final amendment, and received an advisory action in response thereto. Petitioner then spoke with the Examiner and received an oral assurance that a new office action would be forthcoming. 35 U.S.C. §1.113(c) clearly states that the proper response to a final rejection must include either the cancellation or appeal from the rejection of each rejected claim, and that if any claims stand allowed, the reply to the final rejection must comply with any requirements or objections to form. Put simply, a reply to a final rejection must consist of some form of a response. However, Petitioner did not submit any response, as he decided against taking any further action.

Petitioner will note U.S.C. §133 is a self-executing law, which indicates that upon the failure of the applicant to prosecute the application within six months after any action therein, the application shall be regarded as abandoned by the parties thereto. Petitioner received an advisory action, and did not continue the prosecution of this application. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

Petitioner will further note that 37 C.F.R. §1.135 is a self-executing regulation which indicates that the failure to reply within the time period provided under 37 C.F.R. §§1.134 and § 1.136 will result in the abandonment of the application. Furthermore, Petitioner did not further prosecution of this application to save the same from abandonment, as no reply was submitted in response to the advisory action. As such, the application went abandoned by operation of law, and it would be improper for this Office to withdraw the abandonment.

The reliance on an oral assurance

The decision on the original decision dismissed Petitioner's request to withdraw the holding of abandonment, on the grounds that Petitioner's reliance on an oral promise is expressly prohibited by 37 C.F.R. §1.2. With the

3 Renewed petition, page 1.

introduction of this oral understanding into the record via the interview summary, nothing has changed. This information was not placed into the record until more than six months after Petitioner's reliance. At the time of Petitioner's reliance, the understanding was a mere oral promise. This section of the C.F.R. expressly prohibits Petitioner's reliance on the oral understanding, and withdrawal of the holding of the abandonment based on an action which is in contravention to a regulation would be improper.

Furthermore, it is noted that the interview on which this interview summary is based took place on November 10, 2005, which is subsequent to the date on which the present application became abandoned (July 22, 2005). Petitioner cannot rely on this interview summary, for an Examiner no longer has jurisdiction over an application once an application becomes abandoned.

## CONCLUSION

The prior decision which refused to withdraw the holding of abandonment under 37 C.F.R §1.181(a) has been reconsidered. For the above stated reasons, the holding of abandonment will not be withdrawn.

As stated in the previous decision, no further reconsideration or review of this matter will be undertaken.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office