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APR 30 1998

**OFFICE OF PETITIONS
A/C PATENTS**

ON PETITION

In re Application of :
Regan W. Stinnett :
Application No. 08/376,702 :
Filed: January 23, 1995 :
For: PULSED ION BEAM ASSISTED :
DEPOSITION :

This is a decision on the renewed petition under 37 CFR 1.137(b),¹ filed on December 15, 1997, to revive the above-identified application.

The petition to revive the above-identified application is **DENIED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action of February 22, 1996, which set a shortened statutory period for reply of three (3) months. No reply under 37 CFR 1.113 was timely filed, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Therefore, the above-identified application became abandoned on May 23, 1996. A Notice of Abandonment was mailed on October 18, 1996.

¹ As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

A petition under 37 CFR 1.137(b) to revive the above-identified application was filed on August 22, 1997, and was dismissed in the decision of October 15, 1997. The instant petition was filed on December 15, 1997, and again requests that the above-identified application be revived pursuant to 37 CFR 1.137(b).

STATUTE AND REGULATION

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, \$820, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$78.

Between May 23, 1996 and November 30, 1997,² 37 CFR 1.137(b) provided:

An application unintentionally abandoned for failure to prosecute may be revived as a pending application if the delay was unintentional. A petition to revive an unintentionally abandoned application must be:

(1) Accompanied by a proposed response to continue prosecution of that application, or filing of a continuing application, unless either has been previously filed;

(2) Accompanied by the petition fee as set forth in § 1.17(m);

(3) Accompanied by a statement that the delay was unintentional. The showing must be a verified showing if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and,

(4) Filed either:

² See 37 CFR 1.137(b) (1995)-(1997).

- (i) Within one year of the date on which the application became abandoned; or
- (ii) Within three months of the date of the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the application became abandoned.

Effective December 1, 1997, 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

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

Petitioner asserts, *inter alia*, that: (1) Regan W. Stinnett (Stinnett) assigned the above-identified application to the United States on January 30, 1995;³ (2) the United States assigned the above-identified application to Sandia Corporation d/b/a Sandia National Laboratories (Sandia) on January 3, 1996;⁴ (3) the above-identified application was filed by Gregory A. Cone (Cone), a registered practitioner and employee of Sandia;⁵ (4) Sandia and Quantum Manufacturing Technologies, Inc. (Quantum) entered into an agreement under which Quantum took over prosecution of the above-identified application;⁶ (5) Quantum retained DeWitt M. Morgan (Morgan) of Rodey, Dickason, Sloan, Akin, & Robb to prosecute the above-identified application;⁷ (6) Cone was unaware of the Office action of February 22, 1996 until late October 1996 when Cone was advised of its existence by Dell Kump, the Sandia Patent Center docket clerk;⁸ (7) a copy of the Office action of February 22, 1996 was first received by Rodey, Dickason, Sloan, Akin, & Robb in late October of 1996 (but no later than October 28, 1996);⁹ (8) Cone was unaware of the existence of the Notice of Abandonment until December 11, 1997, at which point Cone advised Morgan and Teri L. McHugh (McHugh) of its existence;¹⁰ (9) based upon an error in determining that August 22, 1996 was the date of abandonment of the above-identified application, McHugh docketed August 22, 1997 as an "administrative bar";¹¹ and (10) between October of 1996 and August of 1997, Morgan and Stinnett prepared a reply to the Office action of February 22, 1996.¹²

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- ³ Petition of December 15, 1997 (¶ 5).
- ⁴ Petition of December 15, 1997 (¶ 6).
- ⁵ Petition of December 15, 1997 (¶ 1).
- ⁶ Petition of December 15, 1997 (¶¶ 8-10).
- ⁷ Petition of December 15, 1997 (¶ 11).
- ⁸ Petition of December 15, 1997 (¶ 20).
- ⁹ Petition of December 15, 1997 (¶¶ 21-22).
- ¹⁰ Petition of December 15, 1997 (¶ 25).
- ¹¹ Petition of December 15, 1997 (¶ 24).
- ¹² Petition of December 15, 1997 (¶¶ 26-29).

37 CFR 1.137(b) was amended in September of 1993 to require a statement that the "delay was unintentional." See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents; Final Rule Notice, 58 Fed. Reg. 44277 (August 20, 1993), 1154 Off. Gaz. Pat. Office 35 (September 14, 1993). This change clarified that 37 CFR 1.137(b) required that the entire delay, including the delay between the date it was discovered that the application was abandoned up until the petition to revive was actually filed (and not just the abandonment itself), was unintentional; that is, an applicant who intentionally delays filing a petition to revive cannot meet the requirement in 37 CFR 1.137(b)(3) for a statement that the delay was unintentional. See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents; Final Rule Notice, 58 Fed. Reg. at 44278, 1154 Off. Gaz. Pat. Office at 36. The one year filing period requirement in former 37 CFR 1.137(b)(4) was not a substitute for the requirement that the "delay was unintentional"; rather, it has long been the position of the Office that the use of the one year filing period in 37 CFR 1.137(b) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications. See In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988).

The showing of record is that both Cone and Morgan were aware of the Office action of February 22, 1996 no later than October 28, 1996,¹³ and that Cone and Morgan were aware of the Notice of Abandonment of October 18, 1996 no later than December 12, 1997.¹⁴ Whatever the cause of abandonment and delay until October or December of 1996, salient point remains that both Cone and Morgan were cognizant no later than December of 1996 of the fact the above-identified application was abandoned. Rather than file a petition under 37 CFR 1.137 to revive the above-identified application upon discovering its abandoned status, Morgan (through McHugh) chose to simply docket an "administrative bar" date based upon the one year filing period requirement in former 37 CFR 1.137(b).

The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment. See Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). The Office has further cautioned applicants that a petition to revive may be denied where the applicant

¹³ Petition of December 15, 1997 (¶¶ 20-22).

¹⁴ Petition of December 15, 1997 (¶ 25); Morgan decl. (¶ 10); Cone decl. (¶ 12).

intentionally delays filing a petition to revive and such intentional delay comes to the attention of the Office because of a miscalculation of the date of abandonment. See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents; Final Rule Notice, 58 Fed. Reg. at 44279, 1154 Off. Gaz. Pat. Office at 37. The Office requires that the entire delay was at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment").

Petitioner's (or its representative's) actions between December of 1996 and August of 1997 are inconsistent with a decision to take action to revive the above-identified application without intentional delay. Petitioner's actions are consistent with a decision to use the one year filing period requirement as an extension of time, and to delay the revival of the above-identified application until September 22, 1997 (the date docketed as the one year anniversary of the date of abandonment of the above-identified application). Therefore, the showing of record is that at least the delay between December of 1996 and September of 1997 is a result of a deliberate decision on the part of petitioner to use the one year filing period in 37 CFR 1.137(b) as an extension of time, and to delay the revival of the above-identified application for nine (9) months. This course of action precludes revival of the above-identified application under 37 CFR 1.137(a) or (b).

Petitioner asserts that the nine (9) month delay between December of 1996 and September of 1997 in taking action to revive the above-identified application was not the result of intentional delay, but was the result of: (1) difficulties in obtaining a copy of the above-identified application; and (2) Stinnett's

travel schedule.¹⁵ Petitioner's statements concerning the steps taken to prepare a reply to the Office action of February 22, 1996¹⁶ have been carefully considered; however, the instant petition lacks any reasonably specific showing of what steps were taken between December of 1996 and August of 1997 to prepare a reply to the Office action of February 22, 1996, and why such steps were unsuccessful. That is, as to the period between December of 1996 and August of 1997, the petition only states that a number of unsuccessful attempts were made during this period to prepare a reply, but does not state the particulars of such unsuccessful attempts.

In any event, the steps that needed to be taken to prepare a reply to the Office action of February 22, 1996 are simply not so extraordinary as to warrant the nine (9) month delay between December of 1996 and September of 1997. The suggestion that obtaining a copy of the file of an application, preparing a reply to an Office action, and a petition under 37 CFR 1.137(b) to revive an application warranted a nine (9) month delay in filing a petition to revive the above-identified application is untenable.¹⁷

¹⁵ Contentions that an applicant (or his or her representative) was preoccupied with other matters that took precedence over the revival of an abandoned application have not been viewed as an adequate justification for delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Rather, the revival of an application that was not intentionally abandoned is the applicant's "most important business." See Ex parte Pratt, 1887 Dec. Comm'r Pats. 31, 32-33 (1887). Specifically, an applicant seeking revival of an abandoned application is expected to file a petition under 37 CFR 1.137 within two to three months of discovering its abandonment. See In re Kokaji, 1 USPQ2d 2005, 2007 (Comm'r Pats. 1986); see also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53161, 1203 Off. Gaz. Pat. Office at 88-89 (response to comment 65).

¹⁶ Petition of December 15, 1997 (¶¶ 26-27); Morgan decl. (¶¶ 11-15); Stinnett decl. (¶¶ 11-14).

¹⁷ Petitioner indicates that 13.5 hours of attorney time and 6 hours of paralegal time were involved in meeting with Stinnett and preparing the amendment and petition under 37 CFR 1.137(b). Morgan decl. (¶ 14).

Finally, it is noted that the first petition to revive the above-identified application was filed on September 22, 1997, the date believed by petitioner to be the last day on which a petition under 37 CFR 1.137(b) could be filed without being barred. While the instant petition contains numerous assertions that none of Stinnett, Cone, Morgan, or McHugh intended to delay the filing of a petition to revive the above-identified application, there is no showing that any of Stinnett, Cone, Morgan, or McHugh took any specific step to cause a petition to be filed earlier than the September 22, 1997 "administrative bar" date. This points away from the conclusion that the delay between December of 1996 and September of 1997 was unintentional, and points toward the conclusion that petitioner (and/or its representative) viewed the one year filing period in former 37 CFR 1.137(b) as an "extension of time." As stated above, the use of the one year filing period in 37 CFR 1.137(b) as an "extension of time" is considered an "abuse" of the procedures for reviving abandoned applications, and precludes the revival of an abandoned application under 37 CFR 1.137(a) or (b). See Application of S, 8 USPQ2d at 1632.¹⁸

The showing of record is that petitioner (or its representative) deliberately chose to delay seeking the revival of the above-identified abandoned application. Therefore, the resulting delay between December of 1996 and September of 1997 in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See Application of G, 11 USPQ2d at 1380. Accordingly, petitioner has failed to establish to the satisfaction of the Commissioner that the "delay was unintentional" within the meaning of (either current or former) 37 CFR 1.137(b)(3). Id.

CONCLUSION

For the above-stated reasons, the petition under 37 CFR 1.137(b) is **denied**. Therefore, the above-identified application will not be revived and remains abandoned.

¹⁸ See also Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53159, 1203 Off. Gaz. Pat. Office at 87 (applicant's failure to carry the burden of proof to establish that the "entire" delay was "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application).

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

The application file is being forwarded to Files Repository.



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In re Application of
Regan W. Stinnett
Application No. 08/376,702
Filed: January 23, 1995
For: PULSED ION BEAM ASSISTED
DEPOSITION

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ON PETITION

This is a decision on the petition filed August 31, 1998, requesting reconsideration of the decision of April 30, 1998, which decision denied the petition under 37 CFR 1.137(b) to revive the above-identified application.

The petition under 37 CFR 1.137(b) to revive the above-identified application has been reconsidered but is again **DENIED**.

The evidence and arguments submitted in the instant petition have been considered; however, they are not persuasive that there is any error in the decision refusing to grant petitioner's request to revive the above-identified application. The showing of record remains that petitioner (or petitioner's representative): (1) was aware of the abandonment of the above-identified application no later than December 12, 1997; (2) chose to simply docket an "administrative bar" date based upon the one year filing period requirement in former 37 CFR 1.137(b) rather than file a petition under 37 CFR 1.137 to revive the above-identified application upon discovering its abandoned status; and (3) actions between December of 1996 and August of 1997 were consistent with a decision to use the one-year filing period in former 37 CFR 1.137(b) as an extension of time.

While the "unintentional" delay standard in 37 CFR 1.137(b) is less stringent than the "unavoidable" delay standard in 37 CFR 1.137(a), the Patent and Trademark Office (PTO) has

long and consistently held that an inordinate delay (a delay of nine months) in seeking revival of an application resulting from a decision to use the revival procedures as an extension of time does not constitute an "unintentional" delay within the meaning of 37 CFR 1.137(b). See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents; Final Rule Notice, 58 Fed. Reg. 44277, 44278 (August 20, 1993), 1154 Off. Gaz. Pat. Office 35, 36 (September 14, 1993)(an applicant who intentionally delays filing a petition to revive cannot meet the requirement in 37 CFR 1.137(b) for a statement that the delay was unintentional); Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991)(petitions to revive must be filed promptly after the applicant becomes aware of the abandonment); and In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988)(use of the one year filing period in 37 CFR 1.137(b) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome a prior intentional delay in seeking revival of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997).

The showing of record remains that petitioner (or petitioner's representative) deliberately chose to delay seeking the revival of the above-identified abandoned application. Therefore, the resulting delay between December of 1996 and August of 1997 in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

CONCLUSION

The petition of August 31, 1998 is granted to the extent that the decision of April 30, 1998 has been reconsidered; however, the petition is **DENIED** with regard to disturbing the decision of April 30, 1998 or reviving the above-identified application.

This decision may be viewed as final agency action. See MPEP 1002.02(b). The provisions of 37 CFR 1.137(d) do **not** apply to this decision.

Telephone inquiries regarding this decision should be directed to Brian Hearn at (703) 305-9282.

The application file is being forwarded to Files Repository.



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