



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 17

BARBARA RAE-VENTER,
RAE-VENTER LAW GROUP PC
PO BOX 60039
PALO ALTO, CA 94306

COPY MAILED

OCT 08 1999

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of :
Milos Sovak, et al. :
Application No. 08/491,135 : ON PETITION
Filed: June 16, 1995 :
For: FORMYL DERIVATIVES AS NONIONIC :
CONTRAST MEDIA :

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed April 7, 1999, 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 timely reply to the non-final Office action of December 13, 1996, which set a three-month shortened statutory period for reply. No extensions of time having been obtained pursuant to the provisions of 37 C.F.R. § 1.136(a), the above-identified application became abandoned on March 14, 1997. A Notice of Abandonment was mailed on July 18, 1997.

A petition under 37 C.F.R. § 1.137(b) was filed on June 15, 1998, and was dismissed in the decision of September 29, 1998. The decision of September 29, 1998 required additional evidence to determine whether the delay until the filing of the petition under 37 C.F.R. § 1.137(b) of June 15, 1998 was unintentional.

The instant renewed petition under 37 C.F.R. § 1.137(b) was filed on April 7, 1999, and requests reconsideration of the decision of September 29, 1998.

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, \$1210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

37 C.F.R. § 1.137(b) provides:

(b) 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

The patent statute at 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 C.F.R. § 1.137(b)(3) provides that a petition under 37 C.F.R. § 1.137(b) must be accompanied by 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 37 C.F.R. § 1.137(b) 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 C.F.R. § 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

Petitioners assert that the abandonment and delay in filing a petition to revive the above-identified application was the result of two independent docketing errors: (1) an error in docketing the Office action of December 13, 1996; and (2) an error in docketing the time period for filing a petition to revive. Petitioners specifically assert (with regard to the error in docketing the time period for filing a petition to revive), *inter alia*, that: (1) when the Notice of Abandonment was received at Flehr, Hohbach, Test, Albritton & Herbert, LLP (Flehr), it was reviewed by Mark Kresnak (Kresnak) who determined that a reply to the Office action of December 13, 1996 was not filed; (2) Kresnak informed Richard F. Trecartin (Trecartin) of the status of the above-identified application; (3) the Notice of Abandonment was returned to the Flehr docketing clerk for the purpose of docketing the one-year time period within which to file a petition to revive; (4) the one-year time period for filing a petition to revive was docketed based upon an abandonment date six months after the mail date of the Office action of December 13, 1996, rather than three months after the mail date of the Office action of December 13, 1996. See petition of April 7, 1999 at 6-8. Petitioners argue that the delay resulting from this misdocketing of the one-year time period within which to file a petition to revive was based upon a reasonable misinterpretation of the rules. See petition of April 7, 1999 at 11-12. Petitioners cite In re Application of Takao, 17 USPQ2d 1155 (Comm'r Pats. 1990), and In re Decision dated February 18, 1969, 162 USPQ 383 (Comm'r Pats. 1969), in support of the position that this delay was unintentional (if not unavoidable). See id.

37 C.F.R. § 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 (Aug. 20, 1993), 1154 Off. Gaz. Pat. Office 35 (Sept. 14, 1993). This change clarified that 37 C.F.R. § 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 C.F.R. § 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, 58 Fed. Reg. at 44278, 1154 Off. Gaz. Pat. Office at 36. The one-year filing period requirement in former 37 C.F.R. § 1.137(b)(4) was not a substitute for the requirement that the delay have been "unintentional"; rather, it has long been the position of the Office that the use of the one year filing period in 37 C.F.R. § 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).

37 C.F.R. § 1.137(b) was further amended in December of 1997 to eliminate the one-year filing period requirement. See Changes to Patent Practice and Procedure, Final Rule Notice, 62 Fed. Reg. 53131, 53157-63, 53194-95 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 85-90, 119-20

(Oct. 21, 1997). 37 C.F.R. § 1.137(b) as in effect between July of 1997 (the mail date of the Notice of Abandonment) and December of 1997 required, *inter alia*, that: (1) the delay was unintentional; and (2) a petition under 37 C.F.R. § 1.137 be filed within one year of the date on which the application became abandoned. 37 C.F.R. § 1.137(b) as amended in December of 1997 requires, *inter alia*, that the delay was unintentional, but does not include a filing period requirement.

The showing of record is that, upon receipt of the Notice of Abandonment in July of 1997, both Trecartin and Kresnak (both registered practitioners) were aware of the fact that the above-identified application was abandoned. See Trecartin, decl. of Mar. 29, 1999, ¶ 13; Kresnak, decl. of Mar. 29, 1999, ¶¶ 2 and 3. Rather than file a petition under 37 C.F.R. § 1.137 to revive the above-identified application upon discovering its abandoned status, Trecartin and Kresnak instead chose to have the above-identified application docketed for revival based upon the former one-year filing period requirement in 37 C.F.R. § 1.137(b). See Trecartin, decl. of Mar. 29, 1999, ¶ 15; Kresnak, decl. of Mar. 29, 1999, ¶ 5. There is no adequate showing that Trecartin or Kresnak either did or intended to take any action to revive the above-identified application until shortly (two weeks) before the end of the one-year time period set forth in former 37 C.F.R. § 1.137(b)(4) for filing a petition under 37 C.F.R. § 1.137(b). The ten-month delay between July of 1997 and June of 1998 resulting from that deliberately chosen course of action cannot reasonably be considered an “unintentional” delay within the meaning of 37 C.F.R. § 1.137(b).

Petitioners’ arguments that the docketing clerk misdocketed the one-year time period and reliance upon Application of Takao¹ and Decision dated February 18, 1969 are misplaced. Regardless of whether the mistaken docketing of the Notice of Abandonment was a reasonable or unreasonable error, the scheduling (or docketing) of the above-identified application for revival at a date no earlier than shortly (two weeks) before the perceived end of the one-year time period in former 37 C.F.R. § 1.137(b) and consequent delay in seeking revival until that date constitutes an intentional delay in seeking revival of the above-identified application. A deliberate delay in filing a petition under 37 C.F.R. § 1.137 to revive, whether based on a correct or mistaken (either

¹ It is brought to petitioners’ attention the delay at issue in Takao was a delay in seeking reconsideration of a previously filed petition to revive, not the initial delay in filing a petition to revive (which is at issue in the instant petition). In any event, Takao does not stand for the proposition that such a delay was consistent with the “prompt” filing of a petition under 37 CFR 1.137; the decision discusses at length the impropriety of such a delay in seeking reconsideration of a decision refusing to revive an abandoned application. See id. at 1157-59. Rather, the Commissioner decided that, at the time of that practitioner’s delay, it was a reasonable misunderstanding of the regulations to seek reconsideration of a previously filed petition to revive outside the two-month time frame provided in 37 CFR 1.181(f). See id. at 1160. Put simply, Takao is an advisory opinion to place the public on notice that, in the future, such a delay would preclude the grant of a petition under 37 CFR 1.137.

reasonably or unreasonably) calculation of the end of the former one year filing period requirement, precludes a grant of the petition under 37 C.F.R. § 1.137(b). See Application of S, 8 USPQ2d at 1632; Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53158, 1203 Off. Gaz. Pat. Office at 86.

Whether petitioners filed a petition to revive the above-identified application upon receipt of the Notice of Abandonment, or deferred the filing of such a petition for some interval thereafter, was strictly up to petitioners. The Patent and Trademark Office (PTO) has indicated that petitions to revive, or to withdraw the holding of abandonment, 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 (Mar. 19, 1991). The PTO has also cautioned applicants that a petition to revive may be denied where the applicant intentionally delays filing a petition to revive and such intentional delay comes to the attention of the PTO because of a miscalculation of the date of abandonment. See Changes in Procedures for Revival of Patent Applications and Reinstatement of Patents, 58 Fed. Reg. at 44279, 1154 Off. Gaz. Pat. Office at 37. The PTO requires that the **entire delay** be 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”).

Petitioners (through their representatives) were aware in July 1997 that the above-identified application was abandoned, but chose to delay taking action to revive the above-identified application until the end of the one-year time period set forth in former 37 C.F.R. § 1.137(b). Petitioners' actions between July of 1997 and June of 1998 are consistent with a decision to use the former one year filing period requirement as an extension of time, and to delay the revival of the above-identified application until the perceived end of the one-year time period set forth in former 37 C.F.R. § 1.137(b). Therefore, the showing of record is that the delay between July of 1997 and at least June of 1998 is a result of a deliberate decision on the part of Trecartin and Kresnak to use the one year filing period in 37 C.F.R. § 1.137(b) as an extension of time, and to delay the revival of the above-identified application for at least one year from the supposed or actual date of abandonment. This course of action precludes revival of the above-identified application under 37 C.F.R. § 1.137.

CONCLUSION

The showing of record is that petitioners deliberately chose to delay seeking the revival of the above-identified abandoned application. Thus, petitioners cannot establish to the satisfaction of the Commissioner that the delay was “unintentional” within the meaning of 37 C.F.R. § 1.137(b).

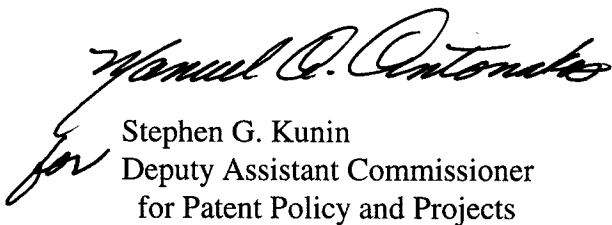
For the above-stated reasons, the petition under 37 C.F.R. § 1.137 to revive the above-identified application is **denied**. Therefore, the above-identified application will not be revived and remains abandoned.

The \$605.00 petition fee (37 C.F.R. § 1.17(m)) for a petition under 37 C.F.R. § 1.137(b) is not required for the renewed petition of April 7, 1999. Therefore, this \$605.00 petition fee will be refunded to Deposit Account No. 06-1300 in due course.

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

This abandoned application is being forwarded to the Files Repository.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Karen Canaan at (703) 306-3313.


for Stephen G. Kunin
Deputy Assistant Commissioner
for Patent Policy and Projects