



Paper No. 35

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KOREA, REPUBLIC OF

COPY MAILED

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OFFICE OF PETITIONS

In re Application of	:	
Un Kil Paek	:	
Application No. 09/214,748	:	
Filed: 8 January, 1999	:	ON PETITION
For: HIGH-POWERED POWERTRAINS	:	
BY WHEEL AND AXLE POTENTIAL	:	
ENERGY	:	

This is a decision on the renewed petition under 37 CFR 1.137(a) filed on 6 June 2005, to revive the above-identified application.

The petition is DENIED.¹

BACKGROUND

On 14 March 2001, a final Office action rejecting all claims before the examiner for consideration was mailed to applicant. The Office action set a three (3) month shortened statutory period for reply.

On 21 May 2001, applicant submitted a reply, which was found not to place the application in *prima facie* condition for allowance. An Advisory Action was mailed on 4 June 2001.

On 19 June 2001, a request for reconsideration was filed. The request was not accompanied by a petition/fee for a one-month extension of time necessary to render the request timely.

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

On 25 June 2001, a Notice of Appeal was filed.

On 17 July 2001, an Advisory Action was mailed acknowledging receipt of the Notice of Appeal and indicating that an extension of time under 37 CFR 1.136(a) was required to permit consideration of applicant's 19 June 2001 request.

On 30 July 2001, a petition under 37 CFR 1.181 to withdraw the final Office action and issue a Notice of Allowance was filed.

On 10 August 2001, an Appeal Brief and a two (2) month extension of time under 37 CFR 1.136(a) were filed.

On 25 January 2002, a decision by the Director of Technology Center 3600 was mailed dismissing the petition under 37 CFR 1.181 filed 30 July 2001. The decision held the instant application to be abandoned for failure to timely submit the correct fee in accordance with 37 CFR 1.17(b) with the Notice of Appeal, as required under 37 CFR 1.191(a). Specifically, the decision indicated that applicant submitted a Notice of Appeal fee in the amount of \$150.00 when in fact the correct fee was \$155.00. The decision also noted that applicant failed to submit the fee required under 37 CFR 1.192(a) with the Appeal Brief.

On 28 January 2002, a Notice of Abandonment was mailed.

On 7 March 2002, a petition under 37 CFR 1.137(a) was filed. The petition was dismissed on 2 April 2002.

On 23 May 2002, a renewed petition under 37 CFR 1.137(a) was filed.

On 14 April 2005, the renewed petition was dismissed. The decision held that petitioner failed to: 1) submit the reply required under 37 CFR 1.137(a)(1), and 2) provide a sufficient showing that the entire delay in filing the required reply was unavoidable, as required under 37 CFR 1.137(b)(3).

STATUTE AND REGULATION

35 U.S.C. § 133 states 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 1.113 states in pertinent part that:

(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.

37 CFR 1.116 states that:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

37 CFR 1.135 states in pertinent part:

(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.

37 CFR 1.137(a) provides:

(a) *Unavoidable*. If the delay in reply by applicant or patent owner was unavoidable, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(1);
- (3) A showing to the satisfaction of the Director 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 unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

OPINION

Initially, it is noted that Petitioner takes issue with the indication in the previous decision that the instant application became abandoned on "15 August 2001." Specifically, Petitioner asserts that this is incorrect because "no reply to the final Office action was ever filed on 15 August, 2001." Petitioner is incorrect. A petition for a two-month extension of time was filed on 10 August 2001, effectively extending the period for reply to the final Office action mailed 14 March 2001 to midnight of 14 August 2001. Accordingly, because a timely and proper reply to the final Office action was not filed, the application became abandoned on 15 August 2001. See MPEP 710.02(e).

It is also noted, contrary to the indication in the previous decision, that petitioner has in fact furnished the proper reply under 37 CFR 1.137(a)(1). Specifically, a review of Office records reveals that the Notice of Appeal fee in the proper amount was received on 7 March 2002.

However, the showing of record is not sufficient to establish that the delay in furnishing the required reply was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to have been "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies

and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

An application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.³ A petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁴

The instant application became abandoned on 15 August 2001 because petitioner failed to timely submit the proper fee required under 37 CFR 1.191(a) and 1.17(b) with the Notice of Appeal filed 25 June 2001. Specifically, petitioner's payment of \$150.00 with the Notice of Appeal was deficient by \$5.00.

It is well settled that delay caused by an applicant's lack of knowledge of USPTO rules and procedures does not constitute "unavoidable" delay. See MPEP 711.03(c):

Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.⁵ For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when the applicant simply permits the maximum extendable statutory period for

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

³ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

⁴ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁵ See Haines, 673 F. Supp. at 317, 5 USPQ2d at 1132; Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

reply to a final Office action to expire while awaiting a notice of allowance or other action...

Accordingly, the delay in the instant case, due to petitioner's lack of knowledge of the proper notice of appeal fee required under the rules, does not constitute unavoidable delay within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a).

Petitioner argues that the failure to indicate the fee deficiency in the Advisory Action mailed 17 July 2001 warrants a finding of "unavoidable delay." This is not persuasive. Any failure by the Office to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action will not support a finding of unavoidable delay. See MPEP 711.03(c), which states, in pertinent part:

Finally, a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from PTO employees; or (B) the PTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action.

With regard to petitioner's argument that the petitions attorney failed to comply with 37 CFR 1.181(c) by not directing the examiners to furnish written statements to the petitions attorney for consideration in his decision, such argument is not persuasive. The issue presented by applicant's petition to revive an abandoned application under 37 CFR 1.137(a) is whether applicant's delay in furnishing the required reply was unavoidable. Since the relevant inquiry for such petitions is on applicant's conduct, statements by the examiners are irrelevant. Furthermore, 37 CFR 1.181(c) does not mandate the Director to require examiners to provide written statements in all cases. Petitioner's other arguments concerning the propriety of the various actions taken by the examiners during prosecution are similarly not relevant to the issue of whether the delay in paying the proper notice of appeal fee was unavoidable.

CONCLUSION

The decision of 6 June 2005 has been reconsidered, but for the reasons given in the previous decision and noted above, the delay

in this case has not been shown to have been unavoidable within the meaning of 35 U.S.C. 133 and 37 CFR 1.137(a).

Accordingly, the application will not be revived under the provisions of 35 U.S.C. 133 and 37 CFR 1.137(a), and the case remains abandoned.

Nevertheless, petitioner may wish to promptly seek revival under the provisions of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b), as this decision does not prevent petitioner from seeking revival under the less stringent "unintentional" standard. The filing of that petition cannot be intentionally delayed. Petitioner is strongly advised to consider obtaining the services of an attorney or agent registered to practice for the USPTO.

This abandoned file is being forwarded to the Files Repository.

Telephone inquiries related to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at 571.272.3231.



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For Patent Examination Policy