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OFFICE OF PETITIONS

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In re Application of
CHING-MING CHANG
Application No. 10/033,472
Filed: December 24, 2001
Attorney Docket No. n/a

: DECISION ON PETITION

This is a decision on the **renewed** petition under the unavoidable provisions of 37 CFR 1.137(a), filed February 6, 2006, to revive the above-identified application.

The petition is **DENIED**[1].

This application became abandoned for failure to timely file a proper reply within the meaning of 37 CFR 1.113 to the Final Office action mailed April 20, 2004, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time was obtained pursuant to the provisions of 37 CFR 1.136(a). Accordingly, the date of abandonment of this application is October 21, 2004. A Notice of Abandonment was mailed on December 10, 2004.

The first, second, third, and fourth petitions to revive under 37 CFR 1.137(a) were DISMISSED on March 1, 2005, May 20, 2005, May 27, 2005, and January 6, 2006, respectively.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (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 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition lacks item (1) the required reply and (3) a showing to the satisfaction of the Director.

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[1] This decision may be viewed by petitioner as a final agency action within the meaning of 5 USC 704 for purposes of seeking judicial review. See MPEP 1002.02.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay 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.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Regarding item (1) the required reply:

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the Final Office action of April 20, 2004.

A reply under 37 CFR 1.113 to a Final Office action must include a Request for Continued Examination (RCE) under 37 CFR 1.114, the filing of a continuing application, or cancellation of, or appeal from the rejection of, each claim so rejected. Accordingly, in a nonprovisional application abandoned to failure to timely file a proper reply to a final action, the reply required for consideration of a petition to revive must be one of the following:

(A) a Notice of Appeal and appeal fee;

(B) an amendment under 37 CFR 1.116 that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance;

(C) the filing of an RCE (accompanied by a submission that meets the reply requirements of 37 CFR 1.111 and the requisite fee) under 37 CFR 1.114 for utility or plant applications filed on or after June 8, 1995 (see paragraph (d) below); or

(D) the filing of a continuing application under 37 CFR 1.53(d). See MPEP 711.03(c).

It should be noted that in the instant application the proper reply to would be either items (A), (C), or (D). Item (B) would not be applicable because any proposed amendment after a final rejection is not entered as a matter of right. Since no claims were indicated allowable in the Final

Office action of April 20, 2004, there is no prima facie evidence for placing the instant application in condition for allowance.

The proposed amendment filed on February 6, 2006 with the instant petition has been reviewed by the Examiner, and it does not place the application in condition for allowance. A courtesy copy of the PTOL-303 Advisory Action is attached to the instant decision. However, please note, this courtesy copy of the advisory form PTOL-303 merely serves as an advisory notice to the Office of Petitions regarding the decision of the examiner on the proposed amendment after final rejection. Another proposed amendment was filed with the third petition on June 14, 2005 which also did not place the application in condition for allowance. The fourth petition decision mailed January 6, 2006 indicated that the required reply was insufficient.

The required reply to the Final Office action must be an amendment that prima facie places the application in condition for allowance, a Notice of Appeal with the requisite fee, Request for Continued Examination (RCE), or the filing of a continuing application. **As such, the required reply has not been submitted, and the petition must be dismissed.**

Regarding item (3) a showing to the satisfaction of the Director:

Petitioner implies that the abandonment of the application was unavoidable because the Final Office action was never received as evidenced by the five (5) letters to the Office by applicant from April 23, 2004 thru August 12, 2004 requesting the re-mailing of the Office action.

In each instance of the aforementioned requests for re-mailing due to non-receipt of the Office action and in the instant petition, petitioner did not submit any statements, documentary evidence, or an explanation of his method for tracking due dates for filing responses to communications from the USPTO to show he did not receive the Final Office action dated April 20, 2004. A review of the record indicates no irregularity in the mailing of the Final Office action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office action was properly mailed to the address of record.

Furthermore, a petition to revive an abandoned application should not be confused with a petition to withdraw an examiner's holding of abandonment due to non-receipt of an office action. **If the evidence adequately supported the non-receipt of an office action, the Office may grant the petition to withdraw the holding of abandonment, and the resulting remedy would be the re-mailing the Office action in question, rather than a revival of an abandoned application. Even if the holding of abandonment was withdrawn and the final office action remailed, petitioner has not provided an adequate response to the final Office action.**

In the present application, the question of withdrawing the holding of abandonment due to non-receipt is considered MOOT because the official record of the above-identified application indicates that petitioner timely submitted a response to the Final Office action along with a three (3) month extension of time on October 20, 2004. However, as noted in the Advisory Action mailed on December 8, 2004, the response, a proposed amendment, did NOT place the

application in condition for allowance. As such, the application became abandoned on October 21, 2004 when the extended statutory period for response expired.

Accordingly, the file record shows that the instant application was abandoned for failure to timely file a proper reply within the meaning of 37 CFR 1.113 to the Final Office action mailed April 20, 2004, rather than the instant application being abandoned based on the failure to receive an office action. Therefore any showing of non-receipt of an office action by the petitioner is not relevant to the revival of an abandoned application under the "unavoidable" standard. See MPEP 711.03(c).

Also note that petitioner may not rely upon non-receipt of an advisory action to establish that the delay was unavoidable. 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 an applicant simply permits the maximum extendable statutory period for reply to a Final Office action to expire while awaiting a notice of allowance or other action. See MPEP 711.03(c)(III)(C)(2).

Furthermore, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. *See* Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), 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). 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: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See* In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985); *see also* In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

The showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Alternative Venue

While the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable, the showing of record may be sufficient to establish that the entire delay in filing the petition was unintentional. Petitioner is strongly encourage to consider filing a renewed petition under amended 37 CFR § 1.137(b), as explained in the decisions of January 6, 2006 and May 27, 2005. Accordingly, petitioner is not prejudiced by this unfavorable decision.

In order to revive the instant application, petitioner should consider filing a petition under 37 CFR 1.137(b) *with* a Request For Continued Examination (RCE) or a continuing application under 37

CFR 1.53(b) or a Notice of Appeal, as the last two proposed amendments dated October 20, 2004 and February 6, 2006 did not place this case in the condition for allowance.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to Amelia Au at (571) 272-7414.

Charles Pearson
Director
Office of Petitions

cc: Advisory Action PTOL-303

bh/aa