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SEP 26 2005

OFFICE OF PETITIONS

In re Application of	:	
Ronald L. Plesh	:	
Application No. 10/877,571	:	ON PETITION
Filed: 25 June, 2004	:	
For: ROLLERS MOUNTABLE TO A COOLING BED PLATE TRANSFER GRID	:	

This is a decision on the renewed petition under 37 CFR 1.137(a) filed on 11 August, 2005, to revive the above-identified application.

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

BACKGROUND

This application became abandoned on 11 November, 2004, for failure to timely file a response to the Notice to File Corrected Application Papers mailed on 10 September, 2004 (hereafter "Notice"), which set a two (2) month shortened period for reply. A Notice of Abandonment was mailed on 10 June, 2005.

On 16 June, 2005, a petition under 37 CFR 1.137(a) was filed. In that petition, petitioner asserted that the delay was unavoidable because it was attributed to a docketing error. Specifically, petitioner's counsel inadvertently docketed the reply to the Notice as due on 10 December, 2004, rather than 10 November, 2004. Petitioner further indicated that a reply to the Notice was mailed on 23 November 2004, but that the reply identified an incorrect application number and did not include an extension of time under 37 CFR 1.136(a).

[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.

The petition was dismissed on 19 July, 2005

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 1.137(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(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 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.

ANALYSIS

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.[2]

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned 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, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[3]

Petitioner argues that a docketing error made by an applicant's attorney "acting as a docketing clerk" may serve as a proper basis for finding unavoidable delay within the meaning of 35 U.S.C. 133. It is noted that petitioner has not cited any authority holding that a docketing error made by applicant's attorney, as opposed to a reliable employee of the attorney, may serve as a basis for finding unavoidable delay. To the contrary, it is well-settled that such mistakes by an applicant's attorney will not establish unavoidable delay.[4] This distinction was addressed long ago by the Seventh Circuit in *Lay v. Indianapolis Brush & Broom Mfg. Co.*[5]

> [T]he other assumption is that, if the complainants failed in their application through the negligence of

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[2] 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).

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

[4] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982); Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130)(delay resulting from counsel's preoccupation with other matters is not unavoidable delay and is binding on petitioner).

[5] 120 F. 831 (1903).

> their attorney, the delay would be unavoidable which is wholly unwarranted in the law. It is of the very nature of negligence that it should not be unavoidable otherwise it would not be actionable. The negligence of the attorney would be the negligence of the [client]. The purpose of the statute was to put an end to such pleas, and there would be no limit to a renewal of these applications if every application, however remote, could be considered under the plea of negligence of attorneys, by whom their business is generally conducted.[6]

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.[7] Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133.[8]

Moreover, even assuming, arguendo, that a docketing error by applicant's attorney should be treated analogous to a docketing error made by an employee in the performance of a clerical function, the petition still could not be granted. As set forth in MPEP 711.03(c), to establish "unavoidable delay" based on a docketing error, petitioner must show:

> *(A) the error was the cause of the delay at issue;*
> *(B) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and*
> *(C) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.*

In the present case, counsel's docketing error was not the cause of the delay at issue, as required under (A). Counsel's error in docketing the reply for December 10, rather than November 10, merely caused the reply to be prepared after the two-month period set in the Notice but still well within the extendable period for

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[6] Id. at 836.

[7] Link v. Wabash, 370 U.S. 626, 633-34 (1962).

[8] Haines v. Quigg, 673 F. Supp. 314, 316-317, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987); 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 (Comm'r Pat. 1891).

reply under 37 CFR 1.136(a). However, in preparing the reply mailed 23 November 2004, counsel made further errors that caused the delay at issue. Specifically, counsel failed to: 1) carefully read the Notice and recognize that a one-month extension of time was needed; and 2) correctly identify the U.S. application number on the reply.[9] Indeed, counsel concedes these points in the petition filed on 16 June 2005:

> I was careless in the docketing, in providing an incorrect serial number, and in failing to notice that an extension of time was needed at the time the reply was mailed. I have committed myself to be more careful in docketing office actions in the future and in ascertaining that I am within the due dates and have listed the correct heading information when mailing replies to office actions.[10]

Finally, petitioner cites the case of *In re Decision Dated Feb. 18, 1969*,[11] in which it was held that an attorney's reasonable misinterpretation of a rule was sufficient for holding a delay to be unavoidable.[12] This case is inapposite to the present situation, however, because petitioner's counsel does not allege a reasonable misinterpretation of any rule. Rather, the instant application became abandoned because of multiple admittedly careless mistakes. The record in this case fails to show that petitioner exercised the care or diligence that is generally used and observed by prudent and careful persons with respect to their most important business.

OPINION

The decision of 11 August, 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.

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[9] Had the reply been directed to the correct application, the Office would have notified petitioner of the need for an extension of time well within the extendable period for reply.

[10] Page 3 of petition.

[11] 162 USPQ 383 (Comm'r Pats. 1969).

[12] Id. at 384.

Nevertheless, petitioners may wish to *promptly* seek revival under the provisions of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). The filing of that petition can not be intentionally delayed.

This abandoned file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at 571-272-3231.

Charles A. Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy