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OFFICE OF PETITIONS

In re Application of :
Mark V. Dahl :
Application No. 10/046,427 : ON PETITION
Filed: October 26, 2001 :
Attorney Docket No. DAHL-002 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 10, 2004, to revive the above-identified application.

The petition is denied.

BACKGROUND

This application became abandoned for failure to reply within the meaning of 35 USC 133 to the non final Office action of January 2, 2003, which set a shortened period for reply of three months. As no reply was filed, and no extensions of time were obtained, the application became abandoned at midnight April 2, 2003. A Notice of Abandonment was mailed November 4, 2003.

STATUTE AND REGULATION

35 USC 2(b)(2) provides, in part, that:

The Office. . . may establish regulations, not inconsistent with law, which

(A) shall govern the conduct of proceedings in the Office;

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, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, \$1,210 [\$1,330], unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$110.

37 CFR 1.137(b)¹ 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 37 CFR 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 37 CFR 1.137(b) was unintentional; Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D); and
- (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c).

OPINION

Petitioner has not met his burden of proof to establish to the satisfaction of the Commissioner that the entire delay in prosecution was herein unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b).

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

35 U.S.C. 41(a)(7) applies to the situation of the above-identified application (i.e., to the revival of an abandoned application), however, it precludes the Commissioner from reviving the above-identified application. The patent statute at 35 U.S.C. 41(a)(7) authorizes the Commissioner to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 67 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

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." As amended December 1, 1997, 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, the petition 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). The language of both 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. However, as noted in more detail *infra*, both the delay herein in filing a reply during prosecution, and in filing the petition after abandonment, are inconsistent with a filing that the entire delay herein was unintentional, such that revival is warranted.

The showing of record is that applicant deliberately withheld a reply to the non-final Office action, stating "I will not be responding to Office Action." Thus, the applicant intended that no reply be filed, and this application became abandoned as a result of that deliberate intent.

Further, the showing of record is that, upon review of the Office action of January 2, 2003, applicant found no compelling reason to reply thereto and pursue further prosecution of this application. This is evident from applicant's and counsel's-- expressed belief that the claims of the patented parent application, which formed the basis for the obviousness-type double patenting rejection, provided adequate coverage for the embodiment sought to be patented herein: "[i]n my opinion, the detailed [Office] action confirms [counsel's] opinion that the original patent did cover computer as a control unit." See petition at 1, ¶ B.

The relevant inquiry in determining whether a delay is intentional is whether the course of action resulting in the delay was, as here, deliberate. See In re Maldague, 10 USPQ2d 1477 (Comm'r Pat. 1988); In re Application of G, 11 USPQ2d 1378 (Comm'r Pat. 1989); Lawman Armor v. Simon, 2005 U.S. Dist. Lexis 10843, 74 USQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005). A deliberate decision, as here, not to pursue further prosecution ("I will not be responding to the Office action" [emphasis in original]) warrants the conclusion that the abandonment of this application was not unintentional. See, 2005 U.S. Dist. Lexis 10843, 74 USQ2d 1633 (DC EMich 2005). Here, since the delay results from a deliberate cause of action (or inaction), it cannot be considered unintentional delay. Maldague, supra; G, supra; Lawman, supra; Field Hybrids, supra.

Moreover, an intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken, and now seeks, on petition to remit the deliberately withheld reply. Maldague, at 1478; Lawman, 73 USPQ2d at 1637-38; Lumenyte Int'l Corp. v. Cable Lite Corp., 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished). This is so even if the prior decision not to continue prosecution arose from a good faith error, that is subsequently discovered. Maldague, supra. Rather, the subsequent discovery of a reason(s) to continue prosecution is simply a change in circumstance that does not change the resultant delay into unintentional delay. Id. This conclusion is reinforced in this instance by the protracted delay between the April 2, 2003, date of abandonment and the filing of the petition and reply some 17 months later. As noted in MPEP 711.03(c)II subsection (c)(1):

An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her

mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

Under the unintentional delay standard, it is well-established that if the abandonment of an application is considered to be a deliberately chosen course of action, the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See Application of G, 11 USPQ2d at 1380. Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). Moreover, an intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

- (A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;
- (B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or
- (C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

The intentional abandonment of an application precludes revival under 37 CFR 1.137(a) or (b). *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

DECISION

For the reasons given above, petitioner has not demonstrated to the satisfaction of the Commissioner that the entire delay herein was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b). Accordingly, this abandoned application will not be revived.

This decision may be viewed as a final agency action within the meaning of 5 USC 704 for purposes of seeking judicial review. See MPEP 1002.02. The provisions of 37 CFR 1.137(d) no longer apply to this case.

This abandoned application is being forwarded to the Files Repository.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (571) 272-3204.

A handwritten signature in dark ink, appearing to read "Charles Pearson", with a long horizontal line extending to the right.

Charles Pearson
Director
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy