Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE APPLICATION G
Serial No. 414,002
February 2, 1989
***1** Filed: September 2, 1982

For: THERMOPLASTIC RESIN, PROCESS FOR PRODUCING THE SAME AND USE THEREOF

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ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 6, 1988, to revive the above-identified application.

The petition is denied.

FACTS

A. Background

1. The inventors filed patent application Serial No. 414,002 on September 2, 1982.

3. On August 8, 1986, a nonfinal rejection was entered in the application. The rejection set a three-month shortened statutory period for response.

4. The six-month maximum statutory period for response expired on February 9, 1987. Since applicant did not file a timely response or request for an extension of time to the three-month shortened statutory period, the application became abandoned on November 11, 1986. A Notice of Abandonment was mailed March 10, 1987.

B. First Petition

5. A first petition to revive under 37 CFR 1.137(b) for unintentional delay was filed on September 3, 1987. The petition stated that applicants misunderstood the "finality" of the rejection.

6. A decision on petition was entered on November 6, 1987. The decision stated:

"The petition indicates that applicants did not reply to a request for instructions by their attorney to prepare a response to the outstanding Office action. Applicants' attorney surmises that the nature of the rejection of the claims was misunderstood by applicants in that the applicants believed 'there was nothing left patentable in this invention to applicants'.

These statements supplied by applicants' attorney suggest that this application was 'intentionally' abandoned by applicants. A verified statement by applicants is required setting forth the facts surrounding the failure to reply to their attorney's request for instruction. An 'intentionally' abandoned application cannot be revived under 37 CFR 1.137."

C. Second Petition

7. On February 8, 1988, petitioner, Thomas F. Moran, filed a statement that work on a second petition was in progress and was expected to be filed soon.

8. A renewed petition to revive under 37 CFR 1.137(b) for unintentional delay was filed June 6, 1988. The petition includes statements from A, B, C, D, and petitioner.

9. On August 13, 1986, Mr. Moran sent a letter to D reporting on the Office action of August 8, 1986. This letter requested that D consider the overall scope of the invention and noted that perhaps claim 32 should be amended to reduce the scope of the invention.

10. D, an employee of the E Patent Office (E), represents the applicants and their assignee, F. D sent F a copy of the Office action and a copy of Mr. Moran's letter. D included in his comments that E recommends that claim 32 be amended to require the copolymerizable monomer as an essential component and that more experimental data be supplied.

***2** 11. B, an employee of F, and C, one of the inventors and an employee of F, received the Office action, Mr. Moran's letter and D's comments on August 25, 1986. After several discussions, C advised B that more convincing experimental data could not be obtained. Thereafter, B concluded that the Office action could not be overcome and informed A of that conclusion.

12. A, manager of the Patent Department of F, sent the E Patent Office a letter dated January 22, 1987 to allow this application to become abandoned.

13. D, upon receipt of the January 22, 1987 letter, sent a telex to Mr. Moran on January 24, 1987 asking him to allow the application to become abandoned.

14. Mr. Moran received that telex and allowed this application to become abandoned.

15. A, B, C, and D state that they failed to consider limiting the application to the special uses of the thermoplastic resin as recited in claims 25 to 30. Accordingly, the abandonment was due to applicant's misjudgment that there was nothing patentable.

37 CFR 1.137(b)

Under Public Law 97-247, Section 3, 96 Stat. 317 (1982), codified at 35 U.S.C. 41(a)7, it is now possible for an applicant to revive an application, the abandonment of which was unintentional rather than unavoidable, by payment of an appropriate fee. This way of reviving an abandoned application is now set forth in 37 CFR 1.137(b), which implements 35 U.S.C. 41(a)7 providing for fees for petitions to revive unintentionally abandoned applications.

The legislative history of Public Law 97-247, as it is pertinent to 37 CFR 1.137(b), states: [FN1]

> Section 41(a)7 [of 35 USC] establishes two different fees for filing petitions with different standards to revive abandoned applications * * *. Since the section provides for two alternative fees with different standards, the section would permit the applicant seeking revival ... to choose one or the other of the fees and standards under such regulations as the Commissioner may establish * * *. The section establishes a fee of $500 [now $560] for filing each petition for revival ... where the abandonment is unintentional * * *. Under this section a petition 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. This section would permit the Commissioner to have more discretion than present law to revive abandoned applications ... in appropriate circumstances.

The legislative history does not set forth representative examples of "appropriate circumstances" where the abandonment is to be considered unintentional and the application could be revived. Thus, such a determination must be made on a case-by-case basis. It is therefore necessary to consider whether an application that has become abandoned for failure to file a response in a timely manner due to applicant's misjudgment as to the patentability of the claims falls within that category of cases, the abandonment of which was "unintentional", that may be revived under 37 CFR 1.137(b).

***3** As noted supra, the legislative history of Public Law 97-247 contains no representative examples of what type of abandonment may be deemed "unintentional" and therefore subject to revival upon payment of a fee and without a showing that the abandonment was "unavoidable." It is believed clear, however, that it was the intent of Congress to give the Commissioner the power to revive applications that have become abandoned using a less stringent standard than had been applied prior to the enactment of this "remedial" legislation.

ANALYSIS

Prior to the passage of legislation that authorized the promulgation of 37 CFR 1.137(b), it is clear that the Commissioner would not have granted a petition for revival of an application that had become abandoned due to applicant's misjudgment as to the patentability of the claims as both 37 CFR 1.137 (the predecessor to 37 CFR 1.137(a) (1982)) and 35 U.S.C. 133 require that the abandonment be "unavoidable." See Ex parte Schnuck, 1923 Dec.Comm'r Pat. 89 (Comm'r Pat. 1922).

Petitioner has not carried his burden of proof to establish that the abandonment was unintentional as required by 35 U.S.C. 41(a)7 and 37 CFR 1.137(b). The record clearly establishes that the applicants and their assignee through their representatives deliberately allowed this application to become abandoned. A deliberate act is not rendered "unintentional" when an applicant or assignee reviews the same facts (e.g., patentability of the claims) a second time which changes their minds as to the appropriate course of action to pursue. An application abandoned as a result of a deliberate, intentional course of action after comparing the claimed invention with the prior art, does not amount to an unintentional abandonment within the meaning of 35 U.S.C. 41(a)7 and 37 CFR 1.137(b).

Further, the record in this case clearly establishes that both Mr. Moran and E recommended to F that claim 32 be amended to reduce the scope of the invention. Accordingly, F's conclusion that the Office action could not be overcome is not seen to be a reasonable mistake. See In re Decision, 162 USPQ 383 (Comm'r Pat. 1969).

The revival statutes are remedial in nature. In that regard, the revival statutes are similar to the reissue statute. However, the courts have refused to grant relief in a reissue application for some intentional mistakes made by attorneys. In particular, the court in In re Wadlinger, 496 F.2d 1200, 1207, 181 USPQ 826, 832 (CCPA 1974), after observing that the term "mistake" in 35 U.S.C. 251 "has a broad sweep and is certainly inclusive of actions taken in full consciousness," concluded that:

***4** "a reissue applicant is, at most, prevented by interpretations of the language of Section 251 ... from obtaining claims which are of the same scope as the claims previously cancelled in the original application."

Similarly, the CCPA observed in In re Willingham, 282 F.2d 353, 357, 127 USPQ 211, 215 (CCPA 1960) that:

"[t]he deliberate cancellation of a claim of an original application in order to secure a patent cannot ordinarily be said to be an 'error' and will in most cases prevent the applicant from obtaining the cancelled claim by reissue."

Since the deliberate cancelling of claims is considered to be equivalent to an intentional abandonment, petitioner is not entitled to recover what it gave up when its agent consciously decided not to respond to the August 8, 1986 Office action. See Ex Parte Schnuck, 1923 Dec.Comm'r Pat. 89 (Comm'r Pat. 1922). Further, the Commissioner is concerned that allowing an assignee to resume prosecution in the Patent and Trademark Office after the assignee chose to abandon the application will seriously undermine the finality of the examination process established by 35 U.S.C. 133. [FN2]

CONCLUSION

The applicants and their assignee through their representatives deliberately chose not to file a response to the August 8, 1986 Office action and thereby deliberately allowed this application to become abandoned. That course of action cannot be considered to amount to an unintentional abandonment within the meaning of 37 CFR 1.137(b).

Petitioner has failed to establish to the satisfaction of the Commissioner that the delay in prosecution was unintentional. The petition for revival under 37 CFR 1.137(b) is denied.

FN1. H.R.Rep. No. 542, 97th Cong.2d Sess. 6-7 (1982), reprinted in 1982 U.S.Code Cong. & Ad.News 770-771.

FN2. Note, Changes in the Patent Laws, 21 J.Pat.Off.Soc'y 703, 706-7 (1939). Under the Patent Act of 1836, applicants were permitted to request reconsideration of a refusal of a patent application at any time. This was changed by the Patent Act of 1870, which gave the applicant two years to respond and again in 1897, when the period became one year. In 1927, the present six months period was instituted.

11 U.S.P.Q.2d 1378

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