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

IN RE APPLICATION OF PIERRE E. MALDAGUE
Serial No. 725,592
June 10, 1988
***1** Filed: April 22, 1985

For: PROCESS AND APPARATUS FOR EXTRACTING LIQUIDS FROM AGGREGATES AND FROM
GAS/VAPOR MIXTURES

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James E. Denny

Deputy Assistant Commissioner for Patents

ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a) or (b), filed February 8, 1988, to revive the above identified application.

The petition is denied.

This application became abandoned for failure to respond in a timely manner to the final Office action of May 2, 1986.

BACKGROUND

(1) On May 2, 1986, a final Office action was mailed.
(2) On June 30, 1986, Roger Roodhooft, patent agent/liason for Belgonucleaire, the assignee of record, instructed Robert R. Priddy, United States counsel, not to file a response to the Office action of May 2, 1986.
(3) On April 2, 1987, Roger Roodhooft informed Pierre Maldague, the inventor, about the abandonment of the application.
(4) On August 3, 1987, a Petition To Revive in the alternative under 37 CFR 1.137(a) or (b) along with the requisite fees, an Affidavit of Roger Roodhooft, a Terminal Disclaimer along with the requisite fee, and a continuation application, Serial No. 080,931, were filed.
(5) On November 5, 1987, a decision by this Office dismissing the alternative petition was mailed.
(6) On February 8, 1988, a Request For Reconsideration (renewed petition) was filed.

DICSUSSION

In the alternative Petition to Revive, Paper No. 8, filed August 3,

1987, petitioner sets forth the following:

"..... As shown by paragraph 8 of Mr. Roodhooft's Declaration, he carefully reviewed and analyzed the office action of May 2, 1986. This review and analysis and the response to the previous office action were handled without the assistance of Mr. Maldague, who had retired from Blegonucleaire and started his own company (the above-mentioned XRG Systems S.A.). At this time Mr. Maldague had no ownership interest in the application and no right to control its prosecution.

In the course of Mr. Roodhooft's review of the office action of May 2nd, 1986, he reviewed not only the office action but also the cited references and the claims and the description of the application. As he reviewed these documents, he sought to find flaws in the rejection, such as in the teachings of the references or in the Examiner's application of them. Despite diligent efforts on his part, he could find no such flaws, and he accordingly concluded that the rejection was reasonable and that there was no possibility of successfully defending against it.

As is shown by paragraphs 9 through 14 of Mr. Roodhooft's Declaration, his conclusion, although formed with reasonable care and diligence, was in error. More specifically, he did not recognize or understand that the invention differed in a subtle but significant manner from the teachings of the references."

***2** The showing of record has been carefully reviewed. This showing establishes that the assignee, through their representative Mr. Roodhooft, deliberately chose not to respond to the May 2, 1986 final Office action. That course of action, deliberately chosen, cannot reasonably be considered to amount to an unavoidable abandonment within the meaning of 37 CFR 1.137(a). Intentional abandonment precludes revival under 37 CFR 1.137(a).

With regard to the alternative renewed petition under 37 CFR 1.137(b), the showing of record establishes that the above identified application was deliberately abandoned. Petitioner asserts that Mr. Roodhooft's June 30, 1986 decision, although formed with reasonable care and diligence, was in error. A distinction must be made between a mistake in fact, which may form the basis for a holding of unintentional abandonment under 37 CFR 1.137(b), and the arrival at a different conclusion after reviewing the same facts a second time. An intentional act is not rendered unintentional when an applicant reviewing the same facts changes his mind as to the appropriate course of action to pursue. An application abandoned as a result of a deliberative, intentional course of action after comparing the claimed invention with the prior art, does not amount to an unintentional abandonment within the meaning of 37 CFR 1.137(b). Intentional abandonment precludes revival under 37 CFR 1.137(b).

CONCLUSION

The assignee through their representatives deliberately chose not to file a response to the May 2, 1986 final Office action and thereby deliberately allowed this application to become abandoned. That course of action cannot reasonably be considered to amount to an unavoidable or an unintentional abandonment within the meaning of 37 CFR 1.137(a) or (b).

Therefore, the relief petitioner seeks cannot be granted.

10 U.S.P.Q.2d 1477

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