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

IN RE APPLICATION OF DAN E. FISCHER
Serial No. 799,168
February 25, 1988
***1** Filed: May 23, 1977

For: CONTROLLED DIFFUSION MEDICAMENT APPLICATOR

K.S. Cornaby

James E. Denny

Deputy Assistant Commissioner for Patents

ON PETITION

This is a decision on the combined petition filed October 21, 1987 under 37 CFR 1.137(b) and 37 CFR 1.183, respectively, to revive the above- identified application and to waive the one-year time period requirement in § 1.137(b). In rendering this decision the arguments presented in the Response to the Opposition filed on November 20, 1987 have also been considered.

This application was permitted to become abandoned as of July 14, 1979 in favor of a "CIP" application which was filed on July 25, 1979. Accordingly, the instant application and "CIP" application serial number 60,382 were never copending.

It is argued in the petition that the copendency problem can and should be eliminated by reviving this application pursuant to 37 CFR 1.137(b) and 1.183, particularly in view of a notice entitled "Petitions Under 37 CFR 1.183 to Waive the One Year Time Period Requirement in 37 CFR 1.137(b), 1.155(c) and 1.316(c)," 1059 Official Gazette 4 (October 1, 1985).

It is clear that the instant application cannot be revived under 37 CFR 1.137(b) alone since the one-year time period requirement set forth therein is not satisfied by the facts of this case.

The date on which this application became abandoned is fixed by operation of law. 35 U.S.C. § 133. It follows that the date of abandonment-in-fact for this application is July 15, 1979 and that an appropriate petition was not filed within one year from this date as required in 37 CFR 1.137(b).

Further, a waiver of this § 1.137(b) requirement pursuant to 37 CFR 1.183 is not compelled by the mere fact that the PTO accepted and processed the improper "CIP" application. Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C.1985). (While the Court indicates that the § 1.137(b) proscription against extensions of the one-year time period for petitioning under § 1.137(b) supersedes and displaces the more general provisions permitting time waivers (§ 1.183), it also states

that "even if it did not, that regulation leaves such decisions to the discretion of the PTO, and that discretion was not abused under these circumstances.").

Petitioner argues that a § 1.183 waiver of the § 1.137(b) one-year time period requirement is appropriate in this instance because the facts of this case meet all of the conditions set forth in the October 1, 1985 O.G. Notice. Petitioner, however, does not meet the "very limited conditions" set forth in the October 1, 1985 O.G. Notice under which the Commissioner will exercise his authority pursuant to 37 CFR 1.183 to waive the one-year time period requirement for filing a § 1.137(b) petition to revive. Petitioner's averment notwithstanding, the facts of this case fail to satisfy conditions (2) and (4) of the October 1, 1985 O.G. Notice.

***2** As that notice in the O.G. indicates, the Commissioner's announcement of his intent to favorably exercise his discretion and waive the one-year time period requirement with respect to 37 CFR 1.137(b) applies to only "certain very limited conditions." Condition (2) includes the following requirement:

> The Office performed a positive, documented and Official act which could lead a reasonable individual to conclude that the action or inaction was proper and this conclusion was a contributing factor in the applicant's failure to realize the true abandoned status of his application in time to file a petition under one of the above-noted subsections. (Emphasis added).

In this case, the Office did not contribute to a failure to timely file a § 1.137(b) petition as required in condition (2). Section 1.137(b) did not become effective until October 1, 1982, over three years after the date of abandonment. Thus, it was the nonexistence of these provisions rather than any act on the part of the PTO which prevented the filing of a § 1.137(b) petition within one year from the date on which this application became abandoned. [FN1] By including the underlined requirement in condition (2), the Commissioner confined the special provision for waiver of the § 1.137(b) time requirement to petitions to revive filed after 37 CFR 1.137(b) became effective, thereby excluding revival of long-abandoned applications. It is noted that 37 CFR 1.137(b) was applied retroactively to the limited extent set forth in the transition period criteria published at 1021 Official Gazette 44-45 (August 10, 1982). However, as indicated by the language in condition (2), the limited circumstances for waiving the time requirements do not extend to situations relating to the transition period criteria.

Section 1.137(b) was promulgated pursuant to Public Law 97-247 (See § 3, 96 Stat. 317 (1982)). The legislative history for Pub.L. 97-247 (See. H.R.Rep. No. 97-542, 97th Cong., 2d Sess. (1982), reprinted in 1982 U.S.Code Cong. & Ad.News 765, 770-771) states that the Commissioner could establish time limits for receiving petitions to revive unintentionally abandoned applications. Under § 1.137(b), the time limit for petitioning to revive an unintentionally abandoned application was set at one year. It was then later determined that under certain very limited conditions (1059 O.G. 4), the one-year requirement would be waived. In addition, transition periods were provided for filing petitions to revive under both 37 CFR 1.137(b) and the special circumstances set forth in the October 1, 1985 O.G. Notice.

Thus, the Commissioner has determined under what conditions the one-year time requirement in § 1.137(b) will be waived.

Waiver of the § 1.137(b) time limit for reviving unintentionally abandoned applications has been specifically limited in order to prevent the revival of long-abandoned applications. As discussed above, the language in condition (2) of the special provision for waiver of the one-year time limit was employed to exclude revival of such applications. As legislative history indicates, Pub.L. 97-247 was intended to provide the Commissioner with more discretion to revive abandoned applications in appropriate circumstances. In accordance with this discretion, the Commissioner has set time limits and conditions for reviving unintentionally abandoned applications, balancing both the inventor's interest in revival of an unintentionally abandoned application and the public's interest in protecting individuals or companies who have acted in reliance on the abandonment of the application. Section 1.183 provides for suspension of the rules "[i]n an extraordinary situation, when justice requires" such a waiver. The facts presented in this petition do not lead to a finding that an extraordinary situation exists. Petitioner has argued forcefully that equitable considerations require that the application be revived. However, petitioner has neither shown nor alleged that the general public will not be harmed by revival of this long-abandoned application. Furthermore, there is no mention of petitioner's licensees nor potential licensees who may have acted in reliance on the abandoned status of the applications. [FN2] Accordingly, petitioner has not shown that "justice requires" waiver of the one-year time limit for filing a petition to revive pursuant to § 1.137(b).

***3** The petition is denied.

FN1. It is noted that condition (4) of the 1059 O.G. 4 Notice is also not satisfied. While that condition requires a terminal disclaimer, petitioner has not submitted a proper one. Instead, petitioner filed a terminal disclaimer for a period of eleven days which is not the period of abandonment. However, it is unnecessary to decide that issue at this time since condition (2) is not satisfied as discussed above.

FN2. In this respect, the present situation differs from the facts considered in New South Industries, Inc. v. Apache Grounding Corp., No. 3-86-0810 (M.D.Tenn. August 19, 1987). In New South Industries, there was no claim that defendants acted in reliance on the abandoned state of the subject application. Rather, it appears that defendants acquired this information after the civil action was filed.

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