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

IN THE MATTER OF NELSON GOODMAN, ET AL.
Serial No. 412,449
May 1, 1987
***1** Filed: August 27, 1982

For: A NOVEL MUTANT OF CORYNEBACTERIUM LILIUM AND PROCESS FOR PRODUCTION OF L-
GLUTAMIC ACID WITH THE MUTANT

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Deputy Commissioner of Patents and Trademarks

DECISION ON ABANDONMENT

Applicants have responded to the ORDER TO SHOW CAUSE why this application should not be held abandoned. Applicants argue that under the applicable rules, the application is not abandoned. They also assert that holding the application abandoned at this stage of prosecution is contrary to due process of law. Alternatively, applicants ask that the Commissioner waive the provisions of 37 CFR § 1.135(b) or revive the application under 37 CFR § § 1.137(a) or (b).

I

The above-identified application is a continuation-in-part (C-I-P). The subject matter of the invention relates generally to mutated microorganisms. The parent application identifies the microorganism by reference to the American Type Culture Collection (ATCC) number. The specification of the parent also states that the microorganism is deposited in the regular collection of the ATCC. Deposits in the regular collection become publicly available upon issuance of the patent. Prior to the filing of the C-I-P, applicants changed the deposit to the ATCC's Safety Deposit Collection. This was emphasized in the additional subject matter added to the C-I-P:

> The only change in this continuation-in-part application is that the conditions of the deposit of the microorganism culture have been changed so that the culture was transferred from the regular collection of the American Type Culture Collection (ATCC), 12301 Parklawn Drive, Rockville, Maryland 20852, to their Safety Deposit Collection, which places the control and release of the culture at the sole discretion of the Depositor . . . .

In the first office action in the C-I-P, the examiner rejected the claims, inter alia, under 35 U.S.C. § 112, first paragraph. The examiner succinctly stated the basis as follows:

> It is not apparent that the invention can be practiced without the deposited microorganism. The last sentence of page 1 indicates the

deposit will be under applicants' control until the expiration of the patent. The practice regarding microorganism deposits requires that all restrictions will be irrevocably removed upon the granting of the patent. MPEP 608.01(p) (page 104 top of second column, Rev. 8). (Emphasis in original.)

In response applicant stated:

Applicants' [sic] note that the Examiner has made no requirement that an affidavit under 35 U.S.C. 132 [sic, 37 CFR 1.132] be submitted concerning the deposit particulars. Are applicants statements at page one of the specification concerning the provisions of the deposit adequate to comply with all aspects of adequacy of disclosure under 35 U.S.C. 112, or will these have to be spelled out in an independent affidavit?

***2** Applicants' [sic] do not intend to change the conditions of their deposit to conform to the PTO's current deposit requirements that the deposit be made ultimately available on issuance of the patent. Applicants intend to contest this requirement if it is maintained. The above quoted language is the entire response to the rejection under 35 U.S.C. § 112.

The examiner then issued a final rejection, again rejecting the claims under the first paragraph of section 112. The statement of the rejection incorporated by reference the reasons given in the first Office action. He again informed applicants that the statements in the specification failed to comply with all aspects of adequacy of disclosure. The Examiner also informed applicants that the proposed affidavit would not cure the objection.

Applicants' 'AMENDMENT AFTER FINAL' did not even refer to the rejection under the first paragraph of section 112.

Applicants appealed the final rejection to the Board of Patent Appeals and Interferences (board). In their appeal brief applicants addressed, for the first time, the merits of the rejection. After the filing of the examiner's answer, applicant's reply brief and a supplemental examiner's answer, the board affirmed the rejection. The board adhered to its affirmance on reconsideration. Applicant appealed to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. § 141.

The Patent and Trademark Office (PTO) requested remand from the Court to consider whether the application should be considered abandoned for failure to respond properly to the first Office action. The Court remanded the case to the PTO. On January 28, 1987, the Deputy Commissioner issued an order to show cause why the application should not be held abandoned.

II

Section 132 of Title 35 provides in pertinent part:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be

useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined.

Section 1.111 of 37 CFR specifies what patent applicants must do to obtain reconsideration:

(a) After the Office action, if adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply thereto and may request reconsideration or further examination, with or without amendment.

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must make request therefor in writing. The reply by the applicant or patent owner must distinctly and specifically point out the supposed errors in the examiner's action and must respond to every ground of objection and rejection in the prior Office action. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. [Emphasis added.]

***3** Thus, the rule makes it plain that any response must clearly point out the purported errors in the examiner's action. The penalty for failing to do so may be abandonment of the application. Section 1.135 of 37 CFR provides:

(a) If an applicant of a patent application fails to respond within the time period provided under § § 1.134 and 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to respond and to advance the case to final action, and is substantially a complete response to the Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

III

The threshold issue here turns upon compliance with 37 CFR 1.111(b). That section requires that 'the applicant . . . must distinctly and specifically point out the supposed errors in the examiner's action . . ..' Applicants' response to the first Office action, however, fails in any way to explain or even attempt to explain how the examiner's rejection was in error. Nor do applicants now urge that their response pointed out any alleged errors. Rather, applicants argue that the

response was sufficient since the examiner did not hold the response to be insufficient. While it is true that the primary examiner has some latitude in determining whether an applicant's response complies with Rule 1.111(b), examiners have no authority to waive the provisions of a rule. The response to the first Office action in this case was totally lacking in even a minimal attempt to 'specifically point out the supposed errors in the examiner's action.' The response was no more than a statement that applicants would not comply with the PTO's guidelines on microorganism deposits. Applicants' response was so insufficient, that, as a matter of law, they were not entitled to reconsideration.

Applicants' assertion that the examiner recognized that applicants were challenging the PTO's policy relating to microorganism deposits is equally unpersuasive. Rule 1.111(b) requires much more than presentation of an issue or mere disagreement with the examiner's findings or conclusions. It requires that applicants 'distinctly and specifically point out the supposed errors in the examiner's action.'

Based on the 'unless an Office action indicates otherwise' language of 37 CFR § 1.135(a), applicants argue that the examiner's issuance of a final rejection after the applicants filed their response to the first Office action was tacitly an indication that the application was not abandoned. However, subsection (a) must be read together with subsection (b) of the Rule. That subsection provides:

***4** The admission of an amendment not responsive to the last Office action, . . . and any proceedings relative thereto, shall not operate to save the application from abandonment.

Reading the two sections together, it is apparent that Rule 135(a) contemplates an express indication of an alternative to abandonment for failure to properly respond to an Office action. The rule gives the primary examiner the authority, in an appropriate circumstance, to indicate a different result. For example, the failure to copy or make claims for purposes of an interference is a disclaimer of the subject matter rather than abandonment of the application. See Manual of Patent Examining Procedure (M.P.E.P.) § 710.01. To interpret the rule otherwise would totally vitiate the provision of subsection (b) that the admission of a nonresponsive amendment and any prosecution related to that amendment cannot save the application from abandonment.

Applicants also argue that holding the application abandoned would be violative of due process of law. In particular they assert that 37 CFR § 1.135(a) requires only 'such complete and proper action as the condition of the case may require,' and that the examiner found that the response was sufficient. Again, applicants misapprehend the meaning of the rules. The nature of a patent applicant's response to an Office action depends upon the substance of that action. A restriction or election requirement requires an election, a notice of allowance requires payment of the appropriate issue fee, a response to a nonfinal rejection requires a response in compliance with 37 CFR § 1.111(b). Applicants' assertion that the response was all that the condition of the case required is inconsistent with the position taken in their brief before the board. Applicants there argued (1) that no deposit was required under the particular circumstances of the application and (2) that unrestricted availability of the microorganism constitutes a compulsory license as to the claimed invention. Neither of these assertions were argued to nor considered by the examiner. If

applicants' response to the first Office action was sufficient as they allege, why did they feel it necessary to rely upon arguments which they never presented to the examiner to demonstrate error? It is totally contrary to the orderly prosecution of patent applications to withhold arguments relating to patentability from the examiner and then present them for the first time to the board.

Applicants also assert that due process of law is violated since they were not given notice of the possibility of abandonment at a time when it would have been possible to take corrective action. The Order to Show Cause gave applicants notice and an opportunity to explain their action.

Applicants' comments relating to the sua sponte determination by another PTO official being a trap for the unwary are also unpersuasive. It is the Commissioner who is charged by law to superintend the examination of applications and to issue patents. 35 U.S.C. § § 6, 131. As part of his supervisory responsibilities, it is appropriate that the Commissioner step in to take corrective action as to matters which come to his attention which may result in a cloud upon any patent that may issue.

***5** For the reasons stated above, application Serial No. 412,449 became abandoned on July 20, 1983 for failure to properly respond to the first office action.

IV

Applicants also request that the requirements of 37 CFR § 1.135 be suspended. As was stated above, it is the failure to comply with Rule 1.111(b) that compels the abandonment of this application. The request to waive the operation of 37 CFR § 1.135 is, therefore, denied.

Applicants also request that the application be revived under 37 CFR § 1.137(a) or (b). The request to revive the application under subsection (b) as unintentionally abandoned is granted. The record makes it manifest that applicants did not intend the application to become abandoned. Under the particular circumstances of this application, including the late stage of the proceedings in which the issue of abandonment was raised, the provisions of 37 CFR § 1.137(b) relating to the one year time limit and the requirement to file a proposed response are waived. 37 CFR § 1.183. This application is revived, nunc pro tunc, as of July 20, 1983.

This application is being forwarded to the Board of Patent Appeals and Interferences for reentry of its decision dated September 18, 1986.

Pursuant to applicants' authorization, a fee of $560 has been charged to deposit account No. 06-916.

3 U.S.P.Q.2d 1866

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