



COHEN & POKOTILOW LTD
12TH FLOOR SEVEN PENN CENTER
1635 MARKET STREET
PHILADELPHIA PA 19103-2212

Paper No. 14

COPY MAILED

FEB 10 2006

OFFICE OF PETITIONS

ON PETITION

In re Reissue Application No. 09/442,083 :
Filed: November 15, 1999 :
Original Patent No. 5,690,962 :
Issue Date: November 25, 1997 :
Original filing Date: September 10, 1996 :
Patentee: Sherman :
Attorney Docket No. N/A :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed September 26, 2005, to revive the above-identified reissue application.

The petition is **DENIED**¹.

BACKGROUND

This application became abandoned for failure to respond in a timely manner to the non-final Office action of December 30, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on March 31, 2003. A Notice of Abandonment was mailed August 7, 2003.

A petition under 37 CFR 1.137(b) was filed January 12, 2005 to revive the above-identified reissue application. The petition was dismissed in the decision of June 10, 2005.

This decision is in response to the renewed petition of September 26, 2005.

STATUTE AND REGULATION

35 U.S.C. § (2)(B)(2) provides, in part, that:

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

(A) shall govern for the conduct of proceedings in 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, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

37 CFR 1.137(b) 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 § 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 this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

OPINION

Petitioner asserts the delay was unintentional in that as the Federal Circuit, see Apotex v. Merck, 254 F3d 1031 (Fed. Cir. 2001), had affirmed the district court holding of invalidity, see Apotex v. Merck, 2000 WL 97,582 (N.D. Ill. Jan. 25, 2000), of the original patent claims under 35 U.S.C. §102(g), which rejection had also been made by the examiner in the above-noted outstanding Office action herein, "[a]pplicant was unable to file a response to overcome the examiner's rejection." Petitioner additionally states that on November 12, 2004, a new complaint was filed in that same lower court which requests a finding of validity predicated on

“Merck’s fraudulent submissions to the Court.” Furthermore, petitioner requests reconsideration of the June 10, 2005 petition decision because: (1) applicant discontinued prosecution on the belief that the Examiner had no authority to overrule the decision in Apotex v. Merck, 254 F3d 1031 (Fed. Cir. 2001), which petitioner alleges was based on facts fraudulently presented to the Court, and as such, the abandonment of the above-identified reissue application was unintentional within the meaning of 35 USC 41(a)(7); (2) the entire delay was unintentional as petitioner took steps to promptly file the petition upon discovery that the facts before the Court were fraudulently presented; (3) there was no mechanism for petitioner to challenge the Examiner’s rejection based on the facts that existed at the time of the rejection; and (4) petitioner did not delay the filing of a response until the belated discovery of an incorrect initial conclusion that the claims are not patentable over the references relied upon in the outstanding Office action as the facts before the Court were fraudulently produced, the Examiner had no choice but to accept the court’s ruling that the original patent was invalid and accordingly rejected the claims of the above-identified reissue application, and thus, petitioner was unintentionally prevented from responding to the Examiner’s rejection by virtue of facts that are alleged to have been fraudulently produced.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee required by 37 CFR 1.17(m); (3) an adequate 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; and (4) in some instances, a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (3) above.

Petitioner has not shown to the satisfaction of the Director that the entire delay herein was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).

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 Director from reviving the above-identified application. The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director 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. 6-7 (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." Where there is a question whether the delay was unintentional, the petitioner 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). Here, the showing is that applicant intentionally discontinued prosecution and permitted the application to become abandoned, due to its own conclusion that the rejection could not be overcome by a timely amendment.

The showing is further that applicant made no effort to seek revival until after becoming aware of what petitioner characterizes as possible "fraudulent submissions" to the court. The language of both 35 USC 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. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997).

However, both the delay herein in filing the reply during prosecution, and in filing the petition after abandonment, are inconsistent with a finding that the entire delay herein was unintentional, such that revival is proper. Simply put, a course of conduct resulting in a delay that is, as here, purposefully chosen does not qualify as unintentional delay.

It is further noted that 35 U.S.C. § 41(a)(7) does not require an affirmative finding that the delay was intentional, but only an explanation as to why the petitioner has failed to carry his or her burden to establish that the delay was unintentional. Cf. Commissariat A. L'Energie Atomique v. Watson, 274 F.2d 594, 597, 124 USPQ 126, 128 (D.C. Cir. 1960)(35 U.S.C. § 133 does not require the Commissioner to affirmatively find that the delay was avoidable, but only to explain why the applicant's petition was unavailing); see also In re Application of G, *supra* (petition under 37 CFR 1.137(b) denied because the applicant failed to carry the burden of proof to establish that the delay was unintentional).

Here, while petitioner contends that he was precluded from filing a reply to the rejection made herein under § 102(g)² during the pendency of the application, petitioner nevertheless did not even seek revival until there was a change in circumstance long after abandonment. However, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application. A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action.

While the entire record has been carefully reviewed, the showing of record is inconsistent with a finding that the entire delay herein was unintentional:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). 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). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) 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; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) 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. Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention (a submarine application) is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53132 at 53158-59 (October 10, 1997), reprinted at 1203 Off. Gaz. Pat. Office, 65 at 86 (October 21, 1997) (citations omitted).

Where, as here, the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, *supra*. 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).

DECISION

The prior decision under 37 CFR 1.137(b), which refused to grant the petition to revive, for the above-identified reissue application has been reconsidered. For the above stated reasons, the abandonment of this case cannot be regarded unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b). Therefore, the application will not be revived and the application remains abandoned.

The application file is being forwarded to the Files Repository.

Telephone inquiries regarding this decision should be directed to Petitions Examiner David Bucci at (571) 272-7099.



Charles Pearson
Director, Office of Petitions

¹ This decision may be viewed by petitioner as a final agency action within the meaning of 5USC 704 for purposes of seeking judicial review. See MPEP 1002.02

² In the petition decision of June 10, 2005 petitioner was advised that one way of prosecuting an application after the receipt of a rejection as anticipated under § 102 is to amend the claims so as to avoid the anticipation rejection and thereby shift prosecution to consideration of patentability of the amended claims under 35 U.S.C. § 103, which was not an issue decided by the court, and which places additional burdens on an examiner seeking to make a *prima facie* case of obviousness. See e.g., MPEP 706.02(j). Petitioner has not contested the availability of this avenue of prosecution.