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- On November 12, 2013, a second Notice of Appeal was received along with the associated fee, a second pre-appeal request for review, and a three-month extension of time so as to make timely the submissions.<sup>1</sup>
- On January 27, 2014, two documents were mailed:
  - a miscellaneous communication which contains an explanation of why the inventor's prior patent can serve as prior art over the current application, and
  - a Notice of Panel Decision from Pre-Appeal Brief review which indicates the application remains under appeal and will proceed to the Board of Patent Appeals and Interferences. The Notice of Panel Decision from Pre-Appeal Brief review reset the period for the submission of an Appeal Brief to the later of the balance of the two-month time period running from the receipt of the second notice of appeal (January 12, 2014) or one month from the mailing of the decision (February 27, 2014).
- On February 24, 2014, an amendment to the claims and remarks were received, and an advisory action was mailed on March 21, 2014.
- On March 5, 2014, a one-month extension of time was received.
- On March 19, 2014, an amendment to the claims and remarks were received, and an advisory action was mailed on April 8, 2014.
- On March 20, 2014, an Appeal Brief was received, which was timely as a result of the one-month extension of time received on March 5, 2014 which extended the due date for the submission of the Appeal Brief to March 27, 2014.
- On May 22, 2014, an amendment to the claims and specification was received, along with remarks.
- On June 27, 2014, an Examiner's Answer was mailed.

The Appeal Brief Forwarding Fee was not received subsequently to the mailing of the Examiner's Answer, and it follows the appeal stood dismissed per 37 C.F.R. § 41.45(b). Prior to appeal all claims that had been entered stood rejected. As a result, the application went abandoned by operation of law on August 28, 2014. See MPEP 1215.01. A notice of abandonment was mailed on September 23, 2014.

#### RELEVANT PORTION OF THE C.F.R.

37 C.F.R. § 41.45 sets forth, in toto:

- (a) Timing. Appellant in an application or ex parte reexamination proceeding must pay the fee set forth in §41.20(b)(4) within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under §1.181 of this chapter to designate a new ground of rejection in an examiner's answer.
- (b) Failure to pay appeal forwarding fee. On failure to pay the fee set forth in §41.20(b)(4) within the period specified in paragraph (a) of this section, the appeal will stand dismissed.
- (c) Extensions of time. Extensions of time under §1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See §1.136(b) of this title for extensions of time to

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<sup>1</sup> It is noted both the second Notice of Appeal and the second pre-appeal request for review contain a certificate of mailing dated November 6, 2013.

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reply for patent applications and §1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

### PROCEDURAL HISTORY AND ANALYSIS

An original petition pursuant to 37 C.F.R. § 1.181(a) was filed on October 14, 2014 and was dismissed via the mailing of a decision on March 16, 2015 which set forth on pages 1-2, *in pertinent part*:

As indicated above, page 7 of the Examiner's Answer mailed June 27, 2014, specifically advised applicant of the requirement to pay the appeal forwarding fee within two months from the date of the Examiner's Answer (i.e. the time period permitted by 37 CFR 41.45(a)) in order to avoid dismissal of the appeal. Furthermore, Section 1208.01 of the Manual for Patent Examination Policy and rule 37 CFR 41.45 set forth the requirement and timing for paying the appeal forwarding fee.

Furthermore, the Office and the examiner acted within the scope of the patent regulations and statutes in dismissing the appeal and issuing a Notice of Abandonment. In the event that an

appellant fails to pay the appeal forwarding fee within the time period permitted by 37 CFR 41.45(a), the appeal is dismissed by rule. The rules and regulations further provided that if no allowed claims remain in an application, the application will be abandoned. Therefore, the record reveals that applicant's failure to pay the appeal forwarding fee in a timely manner resulted in the dismissal of the appeal and the abandonment of the application. See MPEP 1208.01 and 1215. Accordingly, the application is properly held abandoned.

A renewed petition pursuant to 37 C.F.R. § 1.181(a) was filed on May 4, 2015 along with an original petition pursuant to 37 C.F.R. § 1.183, and each was dismissed via the mailing of a single decision on April 27, 2016, which set forth on pages 2-4, *in pertinent part*:

On June 27, 2014, the examiner issued an Examiner's Answer in response to the appeal brief. On page 7 of the Examiner's Answer, the examiner notified applicant of the requirement to pay the appeal forwarding fee within two months from the date of the Examiner's Answer, the time period permitted by 37 CFR 41.45(a), in order to avoid dismissal of the appeal. The record reveals that applicant did not pay the required appeal forwarding fee within the two-month period. On August 28, 2014, the Office mailed a "Communication Re: Appeal", stating that the appeal in this application was dismissed because of applicant's failure to pay the appeal forwarding fee. As the application had no allowed claims, the application became abandoned. The Office mailed a Notice of Abandonment on September 23, 2014.

On September 24, 2014, applicant submitted a Request for a Rehearing under 37 CFR 41.52 to review the "Communication Re: Appeal" and the Notice of Panel Decision from Pre-Appeal Brief Review. The Office notes that the requests for rehearing were improper. "Appellant may file a single request for rehearing within two months of the date of the original decision of the Board..." 37 CFR 41.25. As the Board did not make a decision on appeal, 37 CFR 41.25 does not apply.

On October 14, 2014, applicant filed a petition to withdraw the holding of abandonment. On March 16, 2015, the Office dismissed the petition.

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On May 4, 2015, applicant filed the present petition. It appears that applicant is requesting the following relief: (1) "to eliminate the ... Pre-Appeal argument that supports the rejection"; (2) waive the rules under 37 CFR 1.183 and enter the amendment filed on May 22, 2014, in response to the final rejection; (3) withdraw the holding of abandonment; and (4) allow the application after "having fulfilled all the requirement[s] asked by the examiner". See *Petition 05/04/15*, p. 11.

The USPTO has carefully reviewed the written record and applicant's arguments in the petition. However, the Office does not find sufficient evidence to support the relief requested.

Regarding applicant's first request, the Office does not find sufficient evidence to support the "removal" of the Pre-Appeal argument in support of the rejection. The filing of the Pre-Appeal Brief Request for Review is designed to allow applicants who think there is a clear deficiency in the prima facie case in support of a rejection to file the request at the same time that they file a notice of appeal. Upon receipt of a properly filed request, a Technology Center Art Unit supervisor designates a panel of examiners experienced in the field of technology to review the applicant's remarks and the examiner's rejections.

In this case, the panel members reviewed the rejection(s) identified by applicant in the request, as well as the application and the appropriate evidence in support of the rejections to the extent necessary. The panel decided that there was an issue for appeal present in the record. The Office mailed a decision stating that the application remained under appeal because there was at least one actual issue for appeal. Furthermore, the Examiner simply provided a statutory explanation of why applicant's Patent 5,367,122 could be used in the rejection of the current application. The panel followed the procedures set forth in Pre-Appeal Brief Request for Review. Applicant has not presented sufficient facts based in the patent rules or statutes that support the necessity to remove the Pre-Appeal argument.

Regarding applicant's second argument, the Office will grant a petition under 37 CFR 1.183, if an applicant demonstrates that (1) an extraordinary situation exists where (2) justice requires waiver of the rules. In this instance, the facts presented do not establish that either condition exists. The Office notes that amendments filed **on or after** the date of filing a brief pursuant to 37 CFR 41.37 may be admitted only to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding or rewrite dependent claims into independent form. See 37 CFR 41.33(b) and MPEP 1206(I).

In this case, applicant did not file the amendment on May 22, 2014, to only cancel claims or rewrite dependent claims into independent form in accordance with 37 CFR 41.33(b). Rather, the amendment of May 22, 2014, added new claims 1-14, and therefore, the amendments were not admitted. Accordingly, applicant has not shown that an extraordinary situation exists to merit the granting of the requested relief. It is well-established that a party's inadvertent failure to comply with the requirements of the rules or procedures of the USPTO is not considered an extraordinary situation where justice requires waiver of the rules. See *Honigsbaum v. Lehman*, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

Regarding applicant's third request to withdraw the holding of abandonment, the abandonment of the application was caused by applicant's failure to pay the appeal forwarding fee. As stated in the decision of March 16, 2015:

As indicated above, page 7 of the Examiner's Answer mailed June 27, 2014, specifically advised applicant of the requirement to pay the appeal forwarding fee within two months from the date of the Examiner's Answer (i.e. the time period permitted by 37 CFR 41.45(a)) in order to avoid dismissal of the appeal. Furthermore, Section 1208.01 of the Manual for Patent Examination Policy and

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rule 37 CFR 41.45 set forth the requirement and timing for paying the appeal forwarding fee.

Furthermore, the Office and the examiner acted within the scope of the patent regulations and statutes in dismissing the appeal and issuing a Notice of Abandonment. In the event that an appellant fails to pay the appeal forwarding fee within the time period permitted by 37 CFR 41.45(a), the appeal is dismissed by rule. The rules and regulations further provided that if no allowed claims remain in an application, the application will be abandoned. Therefore, the record reveals that applicant's failure to pay the appeal forwarding fee in a timely manner resulted in the dismissal of the appeal and the abandonment of the application. See MPEP 1208.01 and 1215. Accordingly, the application is properly held abandoned.

*Petition, 03/16/15, pp. 1-2.*

Regarding applicant's fourth request to allow the application. The Office does not agree that applicant has fulfilled all of the requirements set forth in the rejections. Moreover, the application is currently abandoned and must be revived by petition, accompanied by a petition fee and an appropriate reply before examination can proceed.

A second renewed petition pursuant to 37 C.F.R. § 1.181(a) was filed on June 24, 2016, and was dismissed via the mailing of a decision on January 31, 2017. A corrected decision was mailed on February 10, 2017.

A third renewed petition pursuant to 37 C.F.R. § 1.181(a) was filed on April 10, 2017, and was dismissed via the mailing of a decision on May 26, 2017.

With this fourth renewed petition pursuant to 37 C.F.R. § 1.181(a), Petitioner makes accusations regarding Office practice.

The decision on the third renewed petition pursuant to 37 C.F.R. § 1.181(a) mailed on May 26, 2017 set forth on page 5, *in pertinent part*:

As was set forth on page Petitioner's arguments have been carefully considered, but have not been found to be persuasive, for it is controlling that **this application went abandoned for failure to submit the Appeal Forwarding Fee within two months from the date of mailing of the Examiner's Answer. The propriety of a rejection, objection, or other requirement set forth in an Office action is not relevant to an applicant's burden to timely submit the Appeal Forwarding Fee** (emphasis included). Put another way, this application went abandoned due to Petitioner's failure to submit the Appeal Forwarding Fee, and Petitioner's contention that the Examiner should not have issued various rejections to the claims is not relevant to the abandonment of this application.

If Petitioner is of the opinion that various claim rejections were issued in error, the proper manner of addressing this concern is the appeals process. Petitioner is not in a position to file a notice of appeal followed by an appeal brief, receive an Examiner's Answer, fail to pay the Appeal Forwarding Fee, and later argue that the holding of abandonment should be withdrawn because he does not agree with the Examiner's rejections of his claims.

It is noted there are only two ways by which Petitioner can prevail under 37 C.F.R. § 1.181(a). In order to establish that the holding of abandonment should be withdrawn, Petitioner would need to both assert and establish that either:

- he failed to receive the Examiner's Answer, or
- the Appeal Forwarding Fee was timely submitted to the USPTO.

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With this fourth renewed petition pursuant to 37 C.F.R. § 1.181(a), Petitioner has not argued that he failed to receive the Examiner's Answer, or the Appeal Forwarding Fee was timely submitted to the USPTO. It is further noted Petitioner has not argued that the Appeal Forwarding Fee was not due. In short, Petitioner has not established that the application is not in fact abandoned, and that the holding of abandonment should be withdrawn.

It follows this petition may not be appropriately granted, and the holding of abandonment will not be withdrawn.

It is noted that Petitioner has also requested relief under 37 C.F.R. § 1.183, however an assertion that a particular Rule should be waived has not been located in Office records.<sup>2</sup> If Petitioner seeks the waiver of a particular Rule, he should file a petition pursuant to 37 C.F.R. § 1.183 and an assertion that an extraordinary situation exists, such that justice requires the waiver of a particular section of the C.F.R. Petitioner must specify which Rule it is that he seeks to be waived.

#### CONCLUSION

In summary, there is nothing to establish the petitioner timely paid the appeal forwarding fee or that the appeal forwarding fee was not due. As such, the holding of abandonment was proper and will not be withdrawn.

This decision represents the conclusion of the consideration by the United States Patent and Trademark Office (USPTO) of petitioner's request to withdraw the holding of abandonment. This decision does not prejudice the applicant from filing a petition to revive an abandoned application pursuant to 37 CFR 1.137(a) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m), currently \$850 for a small or micro entity; and (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 37 CFR 1.137(a) was unintentional. A blank form is enclosed.

Note that a petition to revive pursuant to 37 CFR 1.137(a) may also be filed via ePetition, which automates the petition process and allows petitioners to directly input the requisite information into a secure Web interface and immediately receive an ePetition decision. See <https://www.uspto.gov/patents-application-process/applying-online/epetition-resource-page>.

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<sup>2</sup> It is noted that the fee associated with the filing of a petition pursuant to 37 C.F.R. § 1.183 was received on May 4, 2015. A petition was filed on this date, which requested, *inter alia*, the withdrawal of the holding of abandonment.

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Telephone inquiries regarding this decision should be directed to Attorney Advisor Paul Shanowski at (571) 272-3225.<sup>3</sup>

/ROBERT CLARKE/

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for Patent Examination Policy

Encl. USPTO form PTO/SB/64

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<sup>3</sup> Petitioners will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. *See* 37 C.F.R. § 1.2. As such, Petitioners are reminded that no telephone discussion may be controlling or considered authority for any of Petitioners' further action(s).