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THOMAS M. COESTER ESQ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BLVD.
SEVENTH FLOOR
LOS ANGELES, CA 90025

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OCT 03 2005

OFFICE OF PETITIONS

10/9/05

In re Application of :
Bernstein :
Application No. 09/522,721 :
Filed: March, 2000 :
Atty. Dkt. No.: 5865-1 :

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(a), filed October 28, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned December 27, 2001 for failure to timely reply to the non-final Office action mailed September 26, 2001. The non-final Office action set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were timely requested. Notice of Abandonment was mailed May 23, 2002. A petition under 37 CFR 1.137(a) was filed July 30, 2004 and dismissed August 24, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner 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 unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The petition lacks requirements (1) and (3) set forth above.

As to item (1), as previously indicated, petitioner has failed to submit a proper reply to the outstanding Office action. Any renewed petition must be accompanied by a proper response in the form of an amendment in compliance with 37 CFR 1.121 or a continuation application. Petitioner is advised that in accordance with 37 CFR 1.103, the Office will not suspend action if a reply by applicant to an Office action is outstanding. Accordingly, any renewed petition must consist of a response to the outstanding Office action or a continuation application.

As to item (3), as previously indicated, petitioner has failed to present a showing to the satisfaction of the Commissioner 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 unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887) (the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner continues to attribute the delay in timely submitting a proper response to the non-final Office action to the actions counsel and further indicates that the instant application was allowed to go abandoned in favor of U.S. App. No. 09/630,939, filed August 2, 2000.

As previously indicated, the United States Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. See, Link v. Wabash, 370 U.S. 626, 633-34 (1962). Specifically, applicant's delay caused by mistakes or negligence of a voluntarily chosen representative does not constitute unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Douglas v. Manbeck, 21 USPQ2d (BNA) (1697) (E.D. PA Nov. 7, 1991). Consequently, the delay allegedly caused by counsel does not constitute unavoidable delay. Moreover, that delay is imputed to applicant. Petitioner is further reminded the Patent and Trademark Office is not the proper forum for resolving a dispute between petitioner and petitioner's representative. See, Ray v. Lehman, 55 F.3d 606, 608-09, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995).

Furthermore, petitioner is advised that unavoidable delay is the epitome of unintentional delay. Thus, an intentional delay precludes revival under 37 CFR 1.137(a) ("unavoidable" delay) or 37 CFR 1.137(b) ("unintentional" delay). See, In re Maldague, 10 USPQ2d 1477 at 1478. Hence, a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay. Where the applicant deliberately permits an application to become abandoned, 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. See, In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). 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, Maldague at 1478 and MPEP 711.01(c). Accordingly, abandonment of the instant application in favor of another application is not deemed unavoidable delay within the meaning of 37 CFR 1.137(a).

Any renewed petition must be accompanied by evidence to sufficiently establish that the entire period of delay in responding to the non-final Office action was unavoidable. The instant renewed petition has not advanced the arguments set forth in the previous petition. Petitioner has submitted documents, some of which are duplicates of documents previously

submitted, that do not substantiate petitioner's contention of unavoidable delay.

Petitioner is, however, strongly encouraged to seek counsel. While an inventor may prosecute an application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting an attorney or agent. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402

Petitioner was previously advised to submit a change of correspondence address and was provided with the necessary forms to do so as a courtesy. Petitioner, however, has not submitted the necessary change of correspondence address. Petitioner, therefore, is advised that the United States Patent and Trademark Office does not engage in dual correspondence. **Petitioner is advised that there will be no further dual correspondence.** All future correspondence will be directed to the fee address currently of record until such time as appropriate instructions are received to the contrary.

Further correspondence with respect to this matter should be addressed as follows:

By mail:

Mail Stop Petition

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile:

(571) 273-8300

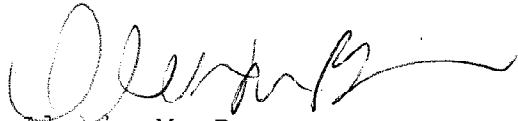
By hand delivery or:

U.S. Patent and Trademark Office
Customer Window, **Mail Stop Petition**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Application No. 09/522,721

5

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.



Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

CC: ELIOT I. BERSTEIN
10158 STONEHENGE CIRCLE
SUITE 801
BOYNTON BEACH, FL 33437-3546