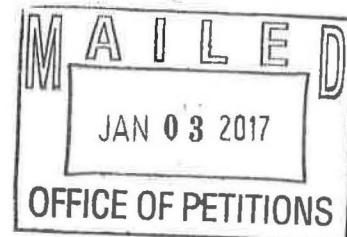




UNITED STATES PATENT AND TRADEMARK OFFICE



Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Application of :
Solomon Zaromb :
Application No. 12/150,909 :
Filed: 05/01/2008 : DECISION ON PETITION
For: APPARTUS AND METHODS FOR : TO WITHDRAW HOLDING OF
GENERATING HYDROGEN BY : ABANDONMENT
REACTING ALUMINUM WITH WATER :
AND APPLICATIONS THEREOF :

This is a decision on the twice renewed petition to withdraw the holding of abandonment filed on July 18, 2016.

The petition is **DENIED**.

Background

The application became abandoned on June 13, 2014, for failure to timely submit the issue fee in response to the Notice of Allowance and Fee(s) Due mailed on March 12, 2014, which set a three (3)-month statutory period for reply. On June 12, 2014, a request to change the inventorship in accordance with 37 CFR 1.48(a) was filed, along with a micro-entity statement signed only by inventor Zaromb, and payment of the issue fee in the micro-entity amount. On June 26, 2014, however, the Office mailed a Response to Request for Corrected Filing Receipt, stating that the request to correct inventorship under 37 CFR 1.48(a), which was filed after the first Office action on the merits, was deficient because it was not accompanied by the fee set forth at 37 CFR 1.17(d) or a statement that the request to correct or change the inventorship was due solely to the cancelation of claims in the application. On August 13, 2014, a Notice of Abandonment was mailed.

On September 3, 2014, a petition to withdraw the holding of abandonment was filed, accompanied by a renewed 37 CFR 1.48(a) request, and a statement that the request to change the inventorship is due solely to the cancelation of those claims in which the inventor to be removed, Joseph R. Stetter, had participated in.

On September 10, 2014, a corrected Filing Receipt was mailed correcting the inventorship. On September 28, 2015, a decision was mailed dismissing the petition to withdraw the holding of abandonment. The petition was dismissed because the Rule 48 request was not grantable at the time the issue fee payment was submitted.

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On November 30, 2015, a renewed petition was filed. Petitioner asserted that the statement concerning the cancellation of claims was included in the request under 37 CFR 1.48 filed on June 12, 2014 by facsimile. In support, petitioner provided a copy of an Auto-Reply Facsimile Transmission report showing that six (6) pages were received by the USPTO on June 12, 2014 at 9:30 PM.

On May 24, 2016, a decision was mailed dismissing the renewed petition. The petition was again dismissed because petitioner had failed to provide evidence that a statement concerning the cancellation of claims was included in the Request Under 37 CFR 1.48 filed on June 12, 2014 by facsimile. Furthermore, petitioner had not provided evidence that the request was timely sent with a certificate of transmission pursuant to 37 CFR 1.8. Petitioner was advised that if he had evidence that a certificate of transmission was submitted with the papers filed on June 12, 2014, such evidence could be filed with a renewed petition.

On July 18, 2016, the subject renewed petition was filed. Petitioner again asserts that a complete request under 37 CFR 1.48 was filed on June 12, 2014. Petitioner argues that the "Auto-Reply Facsimile Transmission" form dated June 12, 2014 confirms that five pages were received. Petitioner further asserts that a Certificate of Transmission is submitted with the petition. A review of the record reveals that a document entitled "Certificate of Faxed Transmission under 37 CFR 1.8" is enclosed with the renewed petition.

Law and Regulation

35 U.S.C. 133 states:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto.

37 CFR 1.8(a) states, in pertinent part:

Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

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...

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d) ; and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

37 CFR 1.48(c) states:

Any request to correct or change the inventorship under paragraph (a) of this section filed after the Office action on the merits has been given or mailed in the application must also be accompanied by the fee set forth in § 1.17(d), unless the request is accompanied by a statement that the request to correct or change the inventorship is due solely to the cancelation of claims in the application.

37 CFR 1.135 states, in pertinent part:

(a) If an applicant of a patent application fails to reply 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 reply as the condition of the application may require.

Opinion

Petitioner's argument has been considered, but is not persuasive. With regard to the Auto-Reply Facsimile Transmission form showing that papers, including the page entitled, "REQUEST TO CORRECT INVENTORSHIP UNDER 1.48A" were received on 6/12/2014 at 9:30 PM, the previous decision mailed May 24, 2016 explained why this form was not persuasive evidence that a proper request under 37 CFR 1.48 was timely received.

Further, the "Certificate of Faxed Transmission under 37 CFR 1.8" is not persuasive evidence of compliance with 37 CFR 1.8(a).

1.8(a) states:

Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed

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in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); or

(C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on, the following:

(i) Relative to Patents and Patent Applications—

(A) The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d);

(B) Papers filed in trials before the Patent Trial and Appeal Board, which are governed by § 42.6(b) of this title;

(C) Papers filed in contested cases before the Patent Trial and Appeal Board, which are governed by § 41.106(f) of this title;

(D) The filing of an international application for patent;

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(E) The filing of correspondence in an international application before the U.S. Receiving Office, the U.S. International Searching Authority, or the U.S. International Preliminary Examining Authority;

(F) The filing of a copy of the international application and the basic national fee necessary to enter the national stage, as specified in § 1.495(b).

(G) The filing of a written declaration of abandonment under § 1.138;

(H) The filing of a submission under § 1.217 for publication of a redacted copy of an application;

(I) The filing of a third-party submission under § 1.290;

(J) The calculation of any period of adjustment, as specified in § 1.703(f); and

(K) The filing of an international design application.

(ii) [Reserved]

(iii) Relative to Disciplinary Proceedings—

(A) Correspondence filed in connection with a disciplinary proceeding under part 11 of this chapter.

(B) [Reserved]

37 CFR 1.8(a)(1)(ii) requires that the certificate accompany the correspondence. There is nothing in the record to indicate that the “Certificate of Faxed Transmission under 37 CFR 1.8” was sent with papers transmitted by facsimile on June 12, 2014. Rather, this certificate appears to have been created after June 12, 2014: Pages 1-4 and 6 of the facsimile received between 6:39pm and 6:40pm located in the official file do not include the certificate of transmission. The paper supplied on July 20, 2016, which is asserted to comprise Page 5 of the facsimile sent on June 12, 2014, the statement that the inventorship was due solely to the cancellation of claims that inventor Stetter had participated in, also does not include the certificate of transmission. Therefore, none of the 6 pages received in the USPTO or asserted to have been sent but not received in the USPTO between 6:39 and 6:40 pm on June 12, 2014 contain a certificate of transmission. Because the “Certificate of Faxed Transmission under 37 CFR 1.8” was not filed with the papers transmitted by facsimile on June 12, 2014, the certificate does not comply with 37 CFR 1.8(a)(1)(ii).

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Petitioner relies on 37 CFR 1.8(b)(2) as a basis to establish that the statement concerning the cancellation of claims was timely filed on June 12, 2014. However, it is noted that 37 CFR 1.8(b)(2) first requires that the correspondence satisfy the requirements of 37 CFR 1.8(a). As noted above, petitioner has failed to provide a certificate that complies with 37 CFR 1.8(a). Accordingly, petitioner's reliance on 37 CFR 1.8(b)(2) is misplaced.

For at least the reasons noted above, petitioner has not provided sufficient evidence to establish that the statement concerning the cancellation of claims was included in the request under 37 CFR 1.48 submitted on June 12, 2014.

As a proper 37 CFR 1.48 request was not filed on June 12, 2014, the micro entity statement was required to be signed by both inventors, or the issue fee was required to be paid in the small entity amount. As a proper reply was not filed, the application was properly held abandoned for failure to timely reply to the Notice of Allowance and Fee(s) Due.

37 CFR 1.135(b) is manifest that prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. As a proper and timely reply to the Notice was not filed, the case was properly held abandoned.

Conclusion

As petitioner has failed, despite repeated attempts, to provide any persuasive arguments meriting withdrawal of the holding of abandonment, the petition is **DENIED**.

Nonetheless, petitioner may still file a petition to revive the application under 37 CFR 1.137(a), accompanied by the required fee.

The prior decision, which refused to withdraw the holding of abandonment, has been reconsidered, and is affirmed.

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 petitioner filing a petition to revive the application under 37 CFR 1.137(a).

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Telephone inquiries concerning this matter may be directed to Attorney Advisor Douglas I. Wood at (571) 272-3231.

/Charles Kim/
Director
Office of Petitions