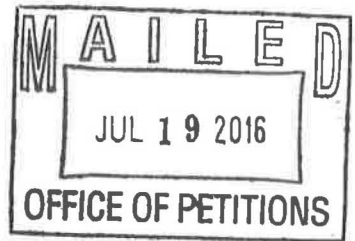




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In re Application of :
Wu et al. :
Application No. 14/258,031 : ON PETITION
Filed: 04/22/2014 :
Attorney Docket No. GDZY01-66USP :

This is a decision in reference to the “RENEWED PETITION UNDER 37 CFR 1.181,” filed on April 15, 2016, requesting withdrawal of the holding of abandonment.

The petition is **DENIED**. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

BACKGROUND

The application became abandoned on July 2, 2014, for failure to timely submit a proper reply to the Notice to File Missing Parts of Nonprovisional Application (“Notice”) mailed on May 1, 2014, which set a two (2) month time limit for reply. On May 12, 2014, a proposed reply was filed. On May 16, 2014, however, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the reply was incomplete, and that the period for reply remained as set forth in the Notice mailed on May 1, 2014. On June 18, 2014, a proposed reply was submitted. On June 20, 2014, however, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the reply was incomplete, and that the period for reply remained as set forth in the Notice mailed on May 1, 2014. Additionally on June 20, 2014, a Response to Request for Corrected Filing Receipt was mailed. On June 27, 2014, a proposed reply was filed. On August 14, 2014, however, a Notice of Incomplete Reply (Nonprovisional) was mailed, stating that the reply was incomplete, and that the period for reply remained as set forth in the Notice mailed on May 1, 2014. On August 19, 2014, a petition under 37 CFR 1.181 was filed. On March 13, 2015, a decision was mailed dismissing the petition. On March 17, 2015, a Notice of Abandonment was mailed. On May 11, 2015, a renewed petition was filed. On July 7, 2015, a decision was mailed dismissing the renewed petition. On August 4, 2015, a petition under 37 CFR 1.181 was filed. On November 9, 2015, a decision was mailed dismissing the renewed petition. On January 8, 2016, a renewed petition under 37 CFR 1.181 was filed. On February 17, 2016, a decision was mailed dismissing the renewed petition.

On April 15, 2016, the subject renewed petition was filed. Petitioner again requests reconsideration of the decision.

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Petitioner asserts:

The Office of Petition does not seem to have addressed the issues presented for review by the Petitioner. The issues presented for review are:

1. Whether the mailing address for each of the inventors provided on the ADS (filed April 23, 2014) is a "mailing address."
2. Whether the Office should clarify its requirement in a Notice when requested by an applicant confused by the Notice.

Petitioner further asserts that

[T]he holding of abandonment is improper because 37 CFR 1.76(c) specifically provides that the applicant may file an updated ADS to make a correction of information until payment of issue fee. Therefore, there is no legitimate reason to rush and hold this application to be abandoned (*sic*) at this moment.

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 1.63(b)(2) states:

Unless the following information is supplied in an application data sheet in accordance with § 1.76, the oath or declaration must also identify: A mailing address where the inventor customarily receives mail, and residence, if an inventor lives at a location which is different from where the inventor customarily receives mail, for each inventor.

37 CFR 1.76(c) states:

Correcting and updating an application data sheet.

(1) Information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63 , § 1.64 or § 1.67 , or otherwise of record, may be corrected or updated until payment of the issue fee by a new application data sheet providing corrected or updated information, except that inventorship

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changes must comply with the requirements of § 1.48 , foreign priority and domestic benefit information changes must comply with §§ 1.55 and 1.78 , and correspondence address changes are governed by § 1.33(a).

(2) An application data sheet providing corrected or updated information may include all of the sections listed in paragraph (b) of this section or only those sections containing changed or updated information. The application data sheet must include the section headings listed in paragraph (b) of this section for each section included in the application data sheet, and must identify the information that is being changed, with underlining for insertions, and strike-through or brackets for text removed, except that identification of information being changed is not required for an application data sheet included with an initial submission under 35 U.S.C. 371.

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

A review of the record reveals that on April 22, 2014, the application was filed with an inventor's oath or declaration signed by inventors Zhiyun Wu, Chungwah Ma, and Shiyu Zou. No application data sheet (ADS) was filed with the original application papers. As such, the record of the application as filed only identified the inventors by name.

On April 23, 2014, an application data sheet was filed. The ADS was not marked up in accordance with 37 CFR 1.76(c), however, to indicate the residence and mailing address of each inventor relative to the information of record.

On May 1, 2014, a Notice to File Missing Parts of Nonprovisional Application was mailed, stating that an ADS or inventor's oath or declaration identifying the mailing address and residence (if the inventor lives at a location which is different from where the inventor customarily receives mail) for each inventor had not been submitted.

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On May 12, 2014, a reply to the Notice mailed on May 1, 2014, was submitted. The reply stated that an ADS "which contains all the necessary information including mailing address of all the inventors" had been submitted on April 23, 2014.

On May 16, 2014, a Notice of Incomplete Reply was mailed, stating that the reply filed on May 12, 2014 was incomplete, and that a new ADS identifying the mailing address and residence (if the inventor lives at a location which is different from where the inventor customarily receives mail) had not been submitted. The Notice stated that the time period set in the Notice mailed on May 1, 2014 remains in effect.

On June 18, 2014, applicants resubmitted the ADS originally filed April 23, 2014. Accordingly, the same deficiency was present: The ADS was not marked up in accordance with 37 CFR 1.76(c), however, to indicate the residence and mailing address of each inventor relative to the information of record.

On June 20, 2014, a Notice of Incomplete Reply was mailed, stating that the reply filed on June 18, 2014 was incomplete, and that a new ADS identifying the mailing address and residence (if the inventor lives at a location which is different from where the inventor customarily receives mail) had not been submitted. The Notice stated that the time period set in the Notice mailed on May 1, 2014 remains in effect. Additionally on June 20, 2014, a Response to Request for Corrected Filing Receipt was mailed noting that a corrected filing receipt could not be issued because the ADS submitted on June 18, 2014 was not properly marked up to show the desired changes to the information already of record as required by 37 CFR 1.76(c).

On June 27, 2014, an ADS was filed. The mailing address of each inventor was marked up in accordance with 37 CFR 1.76(c), but the residence city and state or city and foreign country was not marked up. The changes to the residence city and state were not underlined.

On August 14, 2014, a Notice of Incomplete Reply was mailed, stating that the reply filed on June 27, 2014 was incomplete, and that a new ADS identifying the mailing address and residence (if the inventor lives at a location which is different from where the inventor customarily receives mail) had not been submitted. The Notice stated that the time period set in the Notice mailed on May 1, 2014 remains in effect.

On August 19, 2014, a petition under 37 CFR 1.181 was filed requesting review under 37 CFR 1.181 of the requirement for a corrected ADS.

On March 13, 2015, a decision was mailed dismissing the petition. The decision stated that the ADS submitted June 27, 2014 is improper because the residence information added was not underlined in accordance with 37 CFR 1.76(c)(2).

On March 17, 2015, a Notice of Abandonment was mailed.

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On May 11, 2015, a renewed petition was filed. The renewed petition asserted that the first submission of the ADS in the present application on April 22, 2014 was fully compliant with the rules pursuant to 37 CFR 1.76.

On July 7, 2015, a decision was mailed dismissing the petition. The decision quoted MPEP 601.05(a) which states, in pertinent part, that an ADS submitted after the filing of the application must identify the information being changed (added, deleted, or modified) in the application data sheet in accordance with 37 CFR 1.76(c)(2). The decision stated that the residence information had not been underlined, and that the petition was therefore dismissed.

On August 4, 2015, a renewed petition was filed. The petition asserted, in essence, that the Office had not explained, in the Notice mailed May 1, 2014, or subsequent communications, why a new ADS was required and what actions applicant was required to take to comply with the Notice. The petition also stated that the application should not be held abandoned because an "applicant has the option to correct or update information in the ADS...at any time until payment of the issue fee."

On November 9, 2015, a decision was mailed dismissing the petition. The decision noted that the ADS filed on April 23, 2014 was filed after the filing of the application on April 22, 2014, and was therefore a supplemental ADS, and that all of the information being added (the residence and the mailing address) needed to be underlined, and that since a properly underlined ADS was not timely filed, the application was abandoned pursuant to 37 CFR 1.135 for failure to timely reply to the Notice mailed on May 1, 2014.

On January 8, 2016, a renewed petition was filed, in which applicant argued that the decision mailed on November 9, 2015 was incorrect in stating that the ADS filed on April 23, 2014 was a supplemental ADS because it was the first ADS filed in the application. Petitioner further argued that the prior decision had incorrectly cited MPEP 601.05(b), which applied only to applications filed before September 16, 2012, and that the Office had also failed to provide sufficient guidance to applicant on how to comply with the Notice mailed on May 1, 2014.

On February 17, 2016, a decision was mailed dismissing the petition. The decision again noted that an ADS in compliance with 37 CFR 1.76 was not filed on April 23, 2014, as the residence information being added was not underlined. The decision stated that a properly underlined ADS had still not been filed as the ADS filed on June 27, 2014 was not in compliance with 37 CFR 1.76. The decision further noted that it was applicant's responsibility to timely file a reply in compliance with 37 CFR 1.76, and that the application was properly held abandoned pursuant to 37 CFR 1.135 for failure to timely submit a proper reply to the Notice mailed on May 1, 2014. Lastly, the decision noted although MPEP 601.05(a), rather than 601.05(b), was the applicable section, for an application filed on or after September 16, 2012, a corrected or updated ADS in compliance with 37 CFR 1.76(c) was required by MPEP 601.05(a) and had not been filed. Specifically, the ADS filed April 23, 2014 was filed after the filing date of the application and was not underlined.

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On April 15, 2016, the subject renewed petition was filed.

The showing of record is that an ADS in compliance with 37 CFR 1.76(c) was not filed in that the ADS included changes to the information of record (i.e., adding of the residence), but that the information was not properly marked with underlining for information being added and strikethrough or brackets for text being removed. Specifically, petitioner attempted to add a city and foreign country for the residence but did not underline the information being added.

With regard to petitioner's first contention, petitioner's argument has been considered, but is not persuasive. As noted in the decision mailed on February 17, 2016, MPEP 601.05(a) states that any ADS filed after the filing of the application is a corrected or updated ADS, and must comply with 37 CFR 1.76(c). Section 1.76(c) states that the ADS must identify the information being changed, with underlining for insertions and strike-through or brackets for text removed. The ADS filed April 23, 2014 was not effective to add a residence and a mailing address because it was not marked in accordance with 37 CFR 1.76(c). As the application was filed on April 22, 2014 without an inventor's oath or declaration or an ADS specifying the mailing address and residence (if the inventor lives at a location which is different from where the inventor customarily receives mail) no mailing address or residence was of record. See filing receipt mailed May 1, 2014.

With regard to petitioner's second contention, petitioner asserts that he did not understand why its reply was non-compliant, and that the Office did not fulfill its obligation to adequately explain to applicant why the reply is non-compliant in a manner which is "understandable and clear". In asserting that the Office's Notice was unclear, petitioner asserts that the cases of *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); see also *In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994), discussed in the previous decision, are not applicable to the present situation.

Petitioner's second argument has been carefully considered, but is unpersuasive. While the Office is mindful of the difficulties described by counsel, the failure of the applicant to timely correct all defects in the application is the responsibility of the applicant, not the Office. Despite petitioners' assertion to the contrary, while the Office attempts to notify an applicant of any deficiency in the reply in a manner permitting a timely correction, the Office is under no obligation to do so. See *In re Sivertz, supra*; see also *In re Colombo, Inc., supra*. See, e.g. *B and E Sales Co., Inc. v. The Andrew Jergens Co.*, 7 USPQ2d 1906 (Comm'r Pat. 1988) (stating (in a trademark case) that practitioners are expected to know the rules of practice), citing *In re Sivertz, supra*. Simply put, an applicant is ultimately responsible for ensuring that a proper, complete and timely reply is filed with the USPTO.

Moreover, the Office did inform applicant in the Notices mailed on May 1, 2014, May 16, 2014, June 20, 2014, and August 14, 2014 that a new ADS in compliance with 37 CFR 1.76 or inventor's oath or declaration was required to be filed. As noted before, 37 CFR 1.76(c)(1) states that information in a previously submitted application data sheet, inventor's oath or declaration under § 1.63, § 1.64 or § 1.67, or otherwise of record (that is, the application information that has

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been entered in the USPTO's Patent Application Locating and Monitoring (PALM) system as of the date the corrected or updated ADS is filed), must be corrected in the manner set forth in 1.76(c)(2). Therefore, any ADS filed after the filing of the application is a corrected or updated ADS, and must comply with 37 CFR 1.76(c). Moreover, in the Response to Request for Corrected Filing Receipt mailed on June 20, 2014 the Office noted the requirement under 37 CFR 1.76 that additions to information already of record made in an ADS must be shown with underlining.

Lastly, petitioner's assertion that the application should not be held abandoned despite applicant's failure to comply with the Notice mailed on May 1, 2014 is not persuasive. 37 CFR 1.135(b) states that 35 USC 133 states that if an applicant fails to prosecute the application within the time period given, the application shall be regarded as abandoned. 37 CFR 1.135(b) states 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. The Notice mailed May 1, 2014 set a two month shortened period for submission of a timely and proper reply. Extensions of time were available. Furthermore, applicant was repeatedly notified, in the Notices mailed May 16, 2014, June 20, 2014, and August 14, 2014, that the ADS submitted in reply to the Notice mailed May 1, 2014 was non-compliant, and that a proper and timely reply to the Notice was required to avoid abandonment. Nonetheless, a properly-marked corrected or updated ADS was not timely filed in response to the Notice mailed on May 1, 2014. Therefore, the application is abandoned as a matter of law.

CONCLUSION

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

Nevertheless, petitioner may consider filing a petition to revive the application under 37 CFR 1.137(a). The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A statement that the delay was unintentional is not appropriate if petitioners intentionally delayed the filing of a petition for revival under 37 CFR 1.137(a).

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

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

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Robert A. Clarke

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