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**COPY MAILED**

**DEC 01 2009**

**OFFICE OF PETITIONS**

In re Application of :  
Mitchell R. SWARTZ :  
Application No. 07/339,976 : **ON PETITION**  
Filed: April 18, 1989 :  
Attorney Docket No. N/A :

This is a decision on the petitions under 37 CFR 1.181(a)(3), filed December 23, 2008, which is being treated as a petition under 37 CFR 1.181(a)(3) requesting the Director exercise his supervisory authority and overturn the decision of the Petitions Examiner, dated December 10, 2008, which refused to withdrawal of the holding of abandonment of the above-identified application. This is also a decision on the petitions under 37 CFR 1.181(a)(3) filed April 28, 2008 and May 12, 2008 requesting that the Director exercise his supervisory authority and overturn the decisions of the Director, Technology Center 3600 (Technology Center Director) dated May 20, 2008 and April 11, 2008.

The petition to withdrawal the holding of abandonment is **DENIED**<sup>1</sup>.

The petitions to overturn the decisions of the Technology Center Director are **DISMISSED AS MOOT**.

**RELEVANT BACKGROUND**

Given the voluminous number of petitions and petition decisions only the portions of prosecution relevant to the abandoned status of this case are set forth below.

On May 31, 1994 an appeal brief was filed.

On March 29, 1996, a Notice on Non-Compliance with 37 CFR 1.192(c) was mailed.

On April 26, 1996, applicant fled a second Appeal Brief.

On April 17, 1997, an Examiner's Answer was mailed.

On May 29, 1997, a reply Brief was filed.

On August 23, 2006, the case was remanded back to the examiner from the Board of Patent Appeals and Interferences.

On October 2, 2006, a second Examiner's Answer in response the remand was mailed.

On October 30, 2006, the case was remanded for a second time back to the examiner from the Board of Patent Appeals and Interferences.

On December 31, 2006, a second Reply Brief in response the second Examiner's Answer was filed.

On November 9, 16, 17, 20, and 21, 2006, applicant filed petitions under 37 CFR 1.181.

On March 28, 2007, a final Office action was mailed in view of a petition decision by the Technology Center Director to reopen prosecution, which was unfortunately not mailed until April 4, 2007.

On April 4, 2007, a decision on the petitions was mailed.

On August 27, 2007, a third Appeal Brief was filed.

On November 27, 2007, a Notification of Non-Compliant Appeal Brief was mailed.

On December 27, 2007, a fourth Appeal Brief was filed.

On December 28, 2008, a petition under 37 CFR 1.181 was filed.

On February 5, 2008, a Notification of Non-Compliant Appeal Brief was mailed. This Notification was subsequently vacated in the letter of March 6, 2008.

On March 3, 2008, an Advisory Action was mailed.

On March 3, 2008, a response the February 5, 2008 Notification of Non-Compliant Appeal Brief was filed.

On March 13, 2008, a petition under 37 CFR 1.181 was filed.

On March 20, 2008, a decision denying the petition of December 28, 2007 was mailed.

On March 26, 2008, a Notice of Abandonment was mailed.

On April 10, 2008, a decision denying the petition of March 13, 2008 was mailed dismissing the appeal as appellant failed to timely file a corrected Appeal Brief in accordance with 37 CFR

41.37(c) and 37 CFR 41.37(d), in response to the Notice of Non-Compliant Appeal Brief mailed November 27, 2007.

On April 28, 2008, a petition requesting review of the Technology Center Director's decision of March 20, 2008 was filed.

On May 1, 2008, a petition under 37 CFR 1.181 requesting withdrawal of abandonment of the instant application was filed.

On May 12, 2008, a petition requesting review of the Technology Center Director's decision of April 11, 2008 was filed.

On December 10, 2008, a decision dismissing the petition of May 1, 2008 was mailed.

On December 23, 2008, a petition requesting review of the petition decision of December 10, 2008 was filed.

#### **STATUTE, REGULATION, AND EXAMINING PROCEDURE**

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, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

37 CFR 1.135 states:

(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. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is

requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 41.33(d)(1) states:

An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made. (2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.37(c)(2) states:

A brief shall not include any new or nonadmitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

37 CFR 41.37(d) states:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

MPEP 1205.02 states:

An exception to the requirement that all the items specified in 37 CFR 41.37(c)(1) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant pro se, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a pro se appellant which does not contain all of the items, (i) to (x), specified in 37 CFR 41.37(c)(1) will be accepted as long as it substantially complies with the requirements of items (i) through (iv) and (vii) through (x).

If in his or her brief, appellant relies on some reference, he or she is expected to provide the Board with a copy of it in the evidence appendix of the brief.

### OPINION

Inasmuch as this application is no longer a pending application, the requests for administrative review of the decisions of the Technology Center Director mailed March 20, 2008 and April 11, 2008 are moot.

Petitioner specifically requests that the Director overturn the Petitions Examiner's decision of December 10, 2008 and (1) withdraw the holding of abandonment and (2) accept the reply brief filed December 27, 2007.

This application was held abandoned for failure to timely file a corrected Appeal Brief in accordance with 37 CFR 41.37(c) and 37 CFR 41.37(d), in response to the Notice of Non-compliant Appeal Brief mailed November 27, 2007. A Notice of Abandonment was mailed on March 26, 2008.

Petitioner states that a proper reply was in fact filed. However, a review of the record, especially the petition decision of March 20, 2008, the petition decision of April 11, 2008, and the Notice of Non-Compliant Appeal Brief of November 27, 2007, confirms that a proper reply was not timely filed on or before December 27, 2007.

A proper reply to the Notice of Non-Compliant Appeal Brief of November 27, 2007 should have incorporated correction of informalities listed in the Notice of Non-Compliant, which included:

1. 37 CFR 41.37 states: "A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal." Contrary to this requirement there are numerous references relied upon in the appeal that are not of record. The following is a partial listing of the pages in the Brief containing said new evidence: pages 43, 44, 51, 52, 56, 58, 59, 97, 104, 107, 110, 128, 136, 144, 146, 150, 153, 155, 159, 167, 172, 180, 182, 185, 194, 196, 200-202, 209, 250, 259, 275, 319, 327, 328, 334, 335, 365, 368, 376, 381, 385-387, 389, 391, 408, 413, 416, 426, 427, 435, 437, 441, 449, 454, 475, 477, 479, 483, 485, 487, 492, 495, 496, 500, 534, 555, 570, 577, 579, 590, 592, 595, 620, 630, 637, 638, 641-645, 682, 687, 691, 692, 694, 697, 713, 717, 728, 734, 737, 739, 743, 751, 756, 763, 764, 768, 775, 777, 782, 784, 818, 826, and 831.

2. The examiner also notes that the Summary of Claimed Subject Matter is NOT concise. Some of the details should be placed in an Appendix rather than in the body of the Brief.

3. The Grounds of Rejection contains several extraneous matter, e.g., "Issues 1.192C(6)(V), "whether the specification is patentable under 35 USC 112, first Paragraph", "Relevant Issues From The First and Second Appeal Briefs," etc. Again, these items should be placed in an Appendix rather than in the main body of the Brief.

Applicant's reply brief filed on December 27, 2007 failed to include all the required corrections and is therefore, not a proper reply. For example, with respect to item 1 above, changes were not made to pages 43, 51 52, 56, 58, 59, 97, 107, 110, 136, 144, 150, 167, 180, 182, 194, 196, 201, 209, 250, 259, 275, 327, 328, 334, 335, 368, 376, 385-387, 416, 426, 427, 435, 437, 449, 477, 479, 483, 485, 492, 500, 534, 570, 577, 579, 592, 595, 637, 638, 641, 643-645, 682, 687, 691, 692, 697, 713, 728, 734, 751, 756, 763, 768, 777, , and 831; and with respect to item 3 above, whether or not the Office can deny entry of amendments. Accordingly, in accordance with 37 CFR 41.37(d), *supra*, the appeal was correctly dismissed and the application held abandoned.

Absent evidence to establish that the reply received by the USPTO on December 27, 2007 was a proper reply or that a proper reply was received by the USPTO on or before December 27, 2007, the petition requesting withdrawal of the holding of abandonment cannot be granted.

For the reasons set forth above, the Petition Examiner's decision to refuse petitioners' requests to: (1) withdrawal the holding of abandonment; and (2) accept the reply brief filed December 27, 2007 is not shown to be in clear error.

### DECISION

A review of the record indicates that the Petitions Examiner did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of December 10, 2008. The record establishes that the Petitions Examiner had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Petitions Examiner of December 10, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of December 10, 2008 will not be disturbed. The petition is denied.

Petitioner may wish to consider filing a petition under 37 CFR 1.137(a) or (b) to revive the application.



Charles Pearson  
Director, Office of Petitions

<sup>1</sup> This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02