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MAY 07 2007

OFFICE OF PETITIONS

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In re Application of :  
Wen Yao Lo :  
Application No. 10/174,973 : DECISION ON RENEWED PETITION  
Filed: June 20, 2002 : UNDER 37 C.F.R. §1.181(A)  
Attorney Docket Number: FP8680 :  
Title: ROADSIDE BARRIER MARKER :  
STRUCTURE :

This is a decision on the renewed petition filed February 6, 2007, pursuant to 37 C.F.R. §1.181(a), to withdraw the holding of abandonment.

The petition is DENIED<sup>1</sup>.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed October 4, 2002, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 5, 2003. A notice of abandonment was mailed on April 21, 2003.

The original petition was filed on August 29, 2006, and was dismissed via the mailing of a decision on December 14, 2006.

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

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With the original petition, Petitioner has asserted that a response was sent via facsimile transmission on January 30, 2003, along with a petition for a one-month extension of time so as to make the response timely. Petitioner included a copy of the response, which contained an associated certificate of facsimile transmission dated January 29, 2003 and signed by the inventor, Mr. Lo, and a copy of the petition for a one-month extension of time. The electronic records have been reviewed, and neither the response nor the fee have been located in the official file of record.

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

37 C.F.R. §1.8(b) sets forth, *in toto*:

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission (emphasis added). If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

37 C.F.R. §1.181(f) sets forth, *in toto*:

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 (emphasis added), except as otherwise provided. This two-month period is not extendable.

#### ANALYSIS

With this renewed petition, Petitioner's representative has indicated that the decision on the original petition contains a typographical error, in that it referred to Mr. Lo as Applicant's "former representative," when in fact,

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there was no involvement of a former representative - the inventor prosecuted this application pro se. The Office regrets this error.

First, the decision on the original petition set forth:

First, 37 C.F.R. §1.181(f) indicates that any petition to withdraw the holding of abandonment which is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely.

The notice of abandonment was mailed on April 21, 2003, and the present petition was not filed until more than three years had passed. As such, the present petition is untimely.

Decision on original petition, page 2.

With this renewed petition, it does not appear that Petitioner has addressed this point. As indicated in the decision on original petition, the filing of a petition more than three years subsequent to the mailing of a notice of abandonment is untimely.

Second, with the original petition, Petitioner asserted that a response to the Office actions was timely submitted. As indicated in the decision on original petition, the certificate of facsimile cannot be accepted. The decision on the original petition set forth:

Secondly, *assuming arguendo* that the present petition was timely filed, Petitioner has failed to establish timely submission of the response. The certificate of facsimile transmission which Petitioner has provided has been reviewed, and it is noted that it was executed by Applicant's former representative (sic), Wen Yao Lo. It does not appear that a statement from this individual has been supplied. As such, Petitioner has not complied with 37 C.F.R. §1.8(b)(3) in that no statement has been provided which attests on a personal knowledge basis or to the satisfaction of the Director as to the previous timely transmission.

Decision on original petition, page 3.

As such, Petitioner was instructed that the certificate of facsimile transmission could not be accepted, since the original petition was incomplete. The requirements of Rule §1.8(b)(3) were not met, in that a statement from the individual who executed the certificate of facsimile transmission was not provided. With this renewed petition, it does not appear that Petitioner has submitted a statement from this individual.

Third, the decision further set forth:

Furthermore, it is not clear why the Applicant, the former representative (sic), and the current representative chose to take no action for such a long period of time. It is equally

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unclear what, after all of this time, prompted Applicant to begin the advancement of the prosecution of this application.

Decision on original petition, page 3.

With this renewed petition however, Petitioner has not addressed why the Applicant, Mr. Lo, chose to wait so long to take action. Mr. Lo purportedly mailed a response to the Office in January of 2003, and apparently did nothing to further the prosecution of this case until retaining Petitioner three years later.

Regarding the actions of Petitioner, it appears that Petitioner assumed responsibility of this application in January of 2006, and did nothing to further the prosecution of the same until filing the original petition eight months later.

Regarding the question of "what, after all of this time, prompted Applicant to begin the advancement of the prosecution of this application", it does not appear that this issue has been addressed.

Petitioner has asserted that attempts were made to contact the Examiner to determine the status of this application between "March 4, 2005 until May 2, 2005<sup>2</sup>." It is noted that a notice of abandonment was mailed to Applicant on April 21, 2003. Both the original petition and the present renewed petition have been reviewed, and neither appears to contain an assertion that the notice of abandonment was not received. As such, Applicant appears to have received the notice of abandonment. Since the notice informed Applicant that the application "is abandoned in view of Applicant's failure to timely file a proper reply to the Office letter mailed on 04 October 2002," it is not clear why the status of the application was unknown, and why telephone calls to the Examiner would have been required to determine the status of the application.

Moreover, Petitioner has not stated who made these calls. In the fourth paragraph of this petition, Petitioner has asserted that he assumed prosecution of this case on January 18, 2006. Since it does not appear likely that the Petitioner would have made these calls more than nine months before assuming prosecution of this application, it does not seem likely that these calls were made by him. Perhaps they were made by the Applicant?

Also, Petitioner has submitted a "log" to support his assertion that an unknown entity attempted to contact the

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<sup>2</sup> Renewed petition, paragraph 4.

Examiner on numerous occasions. The document consists primarily of characters that appear to be Chinese. The deciding official cannot discern the meanings of these characters, and it does not appear that an English translation has been provided. There are numerous entries on this document, dated March 31 - April 26, which contain the notation "left message." There is no indication what numbers were called, or for whom a message was left. There appears to be one entry, dated "5/2," which consists of several Chinese characters, along with the notation "called Examiner." The notation "left message for Examiner" appears on the document only once, and it has been struck out. As such, this log fails to evince that "since March 4, 2005 until May 2, 2005 numerous phone calls have been made to the Examiner and numerous messages have been left repeatedly, questioning the status of this case<sup>3</sup>."

Finally, it is not clear why it was necessary for an unknown entity to telephone the Examiner to determine the status of this application. *Assuming arguendo* that the notice of abandonment was insufficient to place Applicant on notice that his application had gone abandoned, Petitioner will note that the Office's PAIR system makes available the status of patent applications to all Applicants/their representatives via the Internet.

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

The lengthy periods of inaction of exhibited by both Applicant and Petitioner are inconsistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

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<sup>3</sup> Id.

CONCLUSION

Petitioner may wish to consider the submission of a petition under 37 C.F.R. §§1.137(a) and/or (b). However, should Petitioner choose to follow this route, he should address the extremely long period of delay, the issues which have been raised above, and why the Office should not find this period of complete inactivity to constitute an intentional, unreasonable, and undue delay in prosecution. No assurance can be made that any remedy will be forthcoming.

The prior decision which refused to withdraw the notice of abandonment has have been reconsidered. For the above stated reasons, the notice of abandonment will not be withdrawn.

THERE WILL BE NO FURTHER RECONSIDERATION OF THIS MATTER BY THIS OFFICE.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

A handwritten signature in black ink, appearing to read 'Charles Pearson', with a long horizontal flourish extending to the right.

Charles Pearson  
Director  
Office of Petitions  
United States Patent and Trademark Office