



Patent Abandonment and Revival



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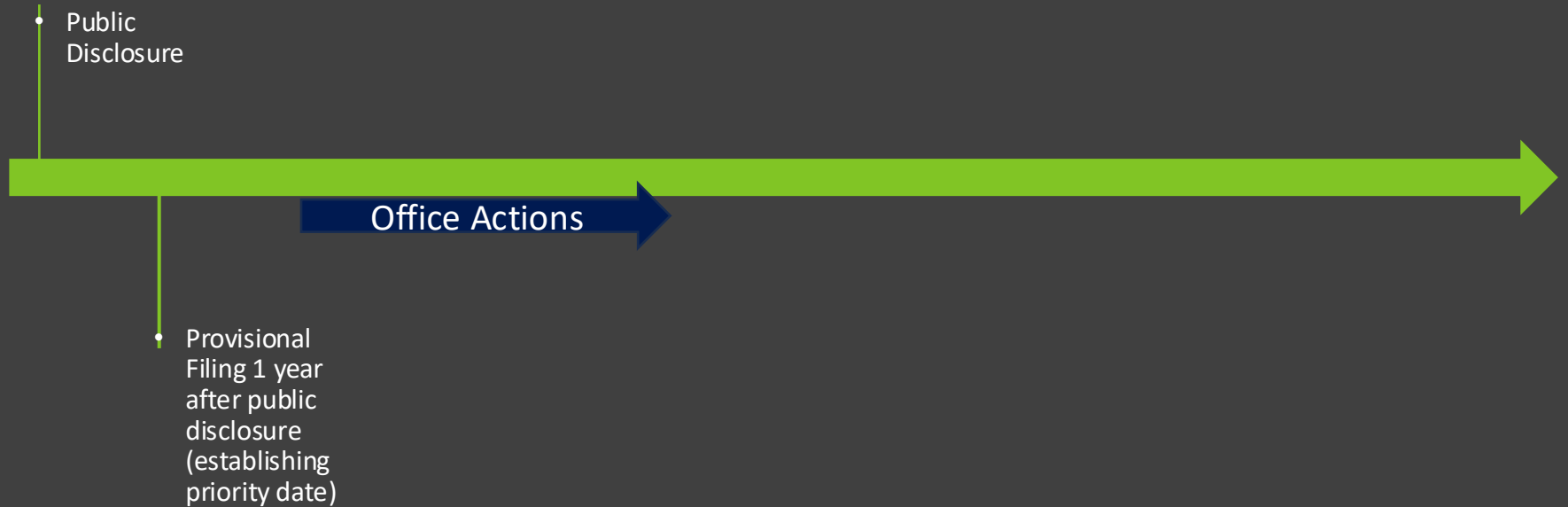
Overview

- General Overview of the Patent Lifecycle
- "Abandonment" – loss of rights over a potentially patentable idea or loss of patented right over an idea
- Abandonment Types
 - Pre-Filing (Statutory)
 - Post-Filing
 - Intentional (Express)
 - May formally abandon or simply cease actions with the USPTO
 - Unintentional (Procedural)
 - May revive

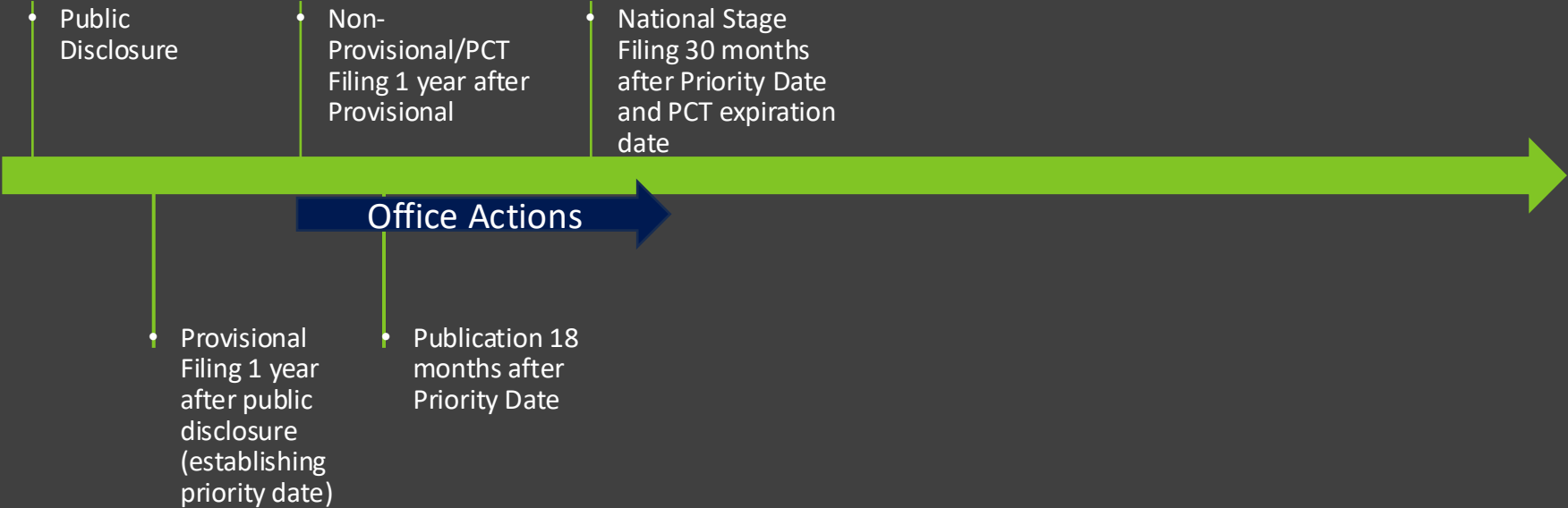
General Patent Lifecycle overview



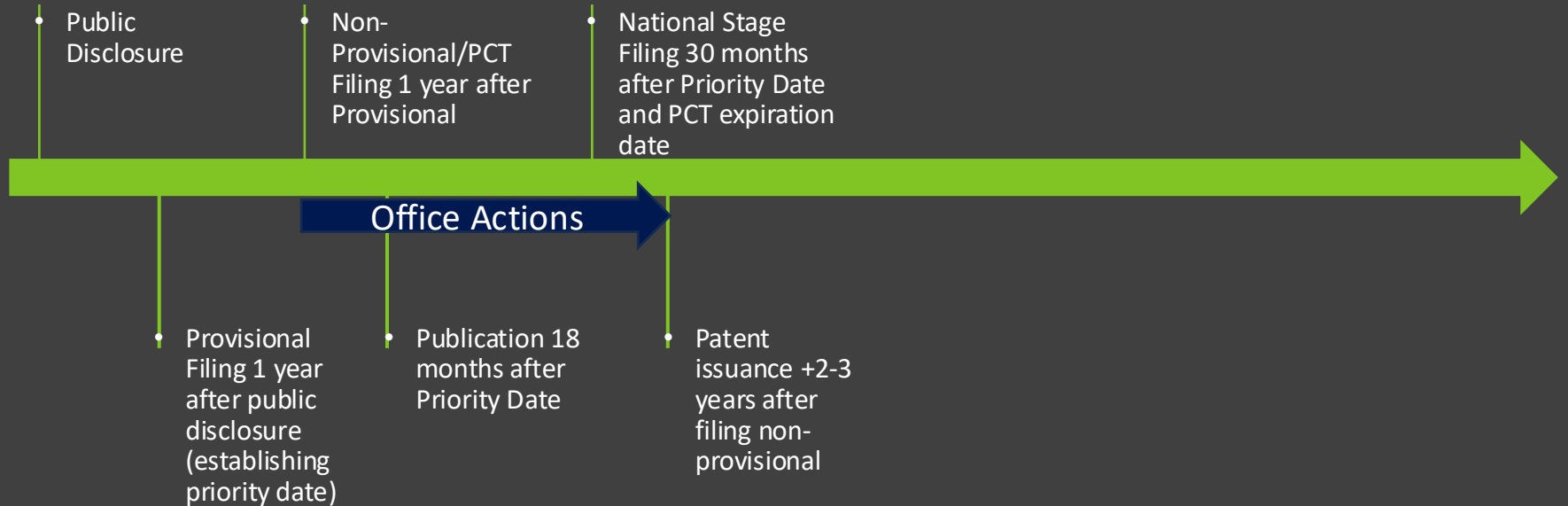
General Patent Lifecycle overview



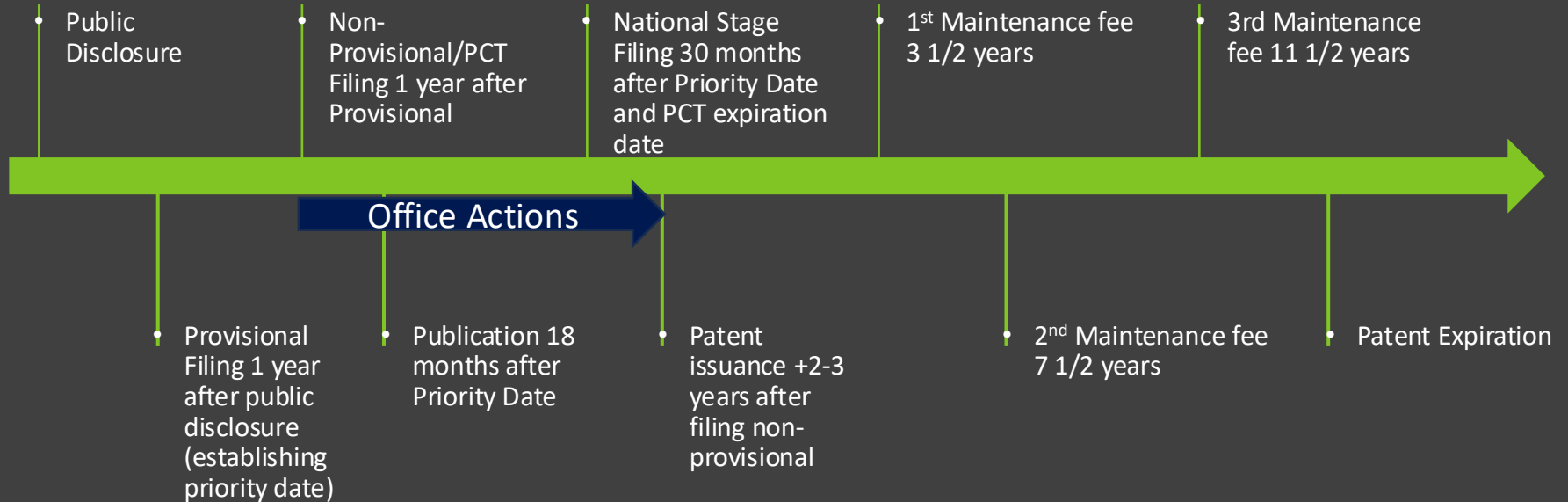
General Patent Lifecycle overview



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General Patent Lifecycle overview

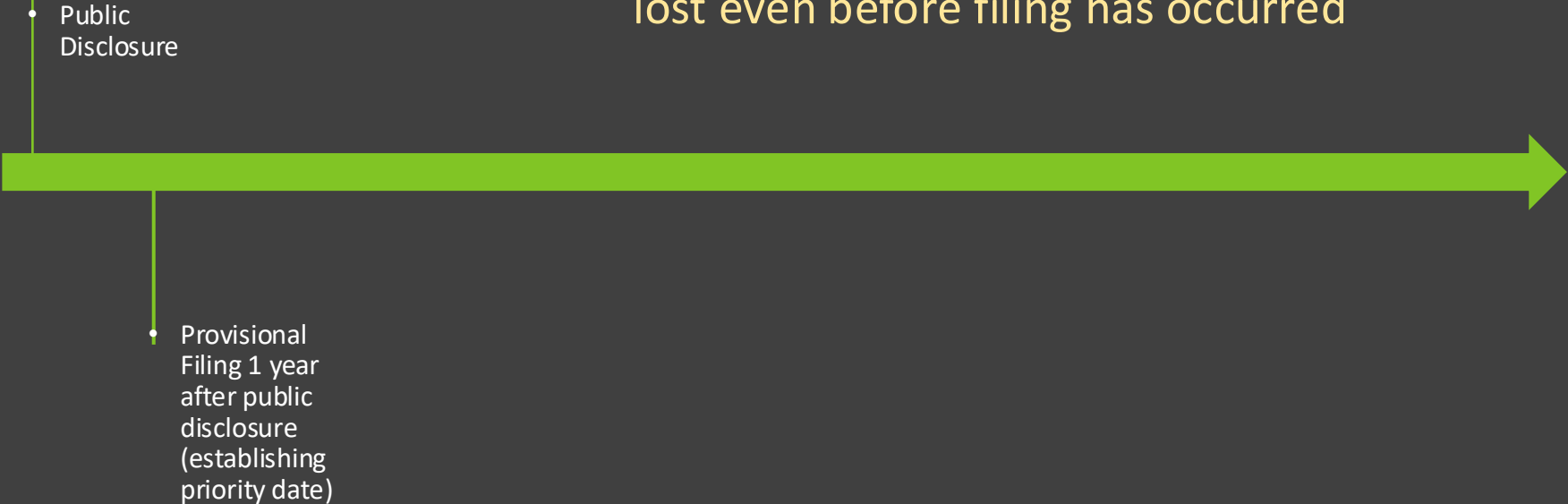


Some Relevant Statutes

- Invention Abandonment
 - 35 U.S.C. § 102 (Pre-Filing)
- International Application Abandonment
 - 35 U.S.C. § 371 (Pre National Phase Filing)
- Prosecution Abandonment
 - 35 U.S.C. §§ 111, 133 (Procedural)
 - 37 C.F.R. §§ 1.134-1.138 (Procedural)
 - MPEP §§ 711-711.03(c) (Procedural)

Patent Lifecycle - Pre-Filing to Provisional

- Rights to potential invention can be lost even before filing has occurred



Public Disclosure

Provisional Filing 1 year after public disclosure (establishing priority date)

Pre-Filing Relevant Statutes 102, 371

- 35 U.S.C. § 102 (Pre-Filing)
 - 102(a) “printed publication, in public use, on sale, or otherwise available to the public before the effective filing date”
 - 102(b) exception made for “disclosure[s] made 1 year or less before the effective filing date”
- 35 U.S.C. § 371 (Pre-Filing)
 - Failure to nationalize the PCT application
 - Occurs 30 months after priority date of PCT application

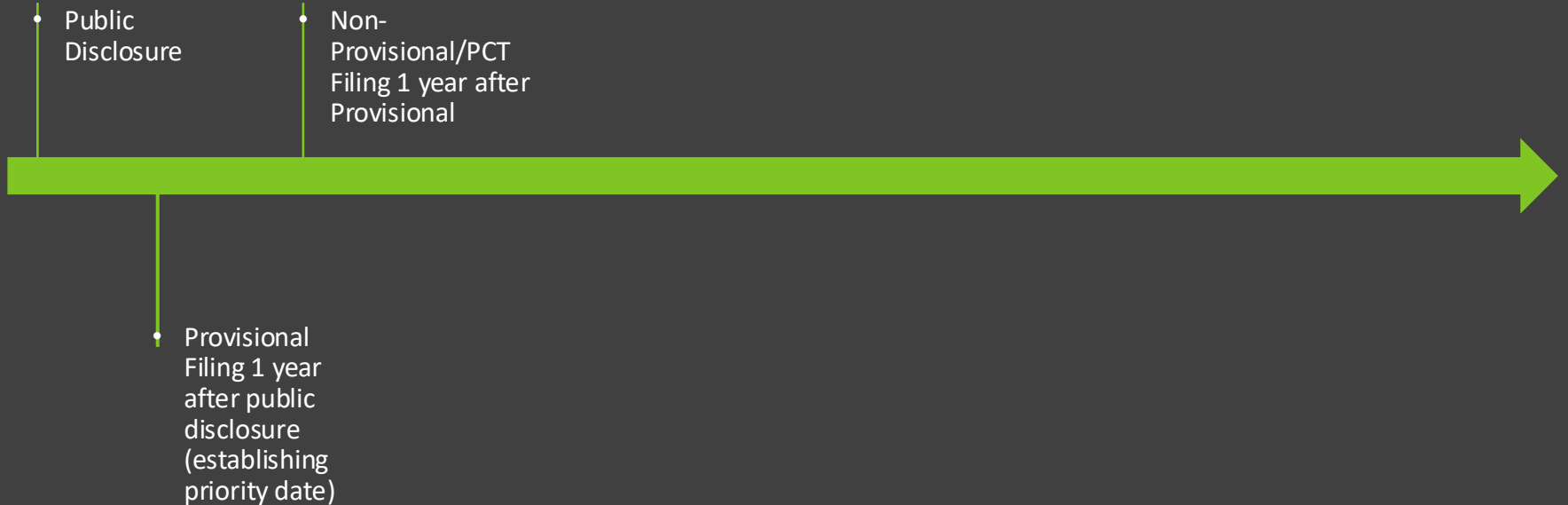
PRACTICE TIPS – Pre-Filing Relevant Statutes

102, 371

- Look out for any of these things prior to filing, although there's a 1-year grace period in the U.S., in other countries there may not be.
 - printed publication
 - in public use
 - on sale
 - otherwise available to the public
- Once these abandonments occur, there's no way of going back.
- PCT Expiration Deadline (371)
 - Rights to U.S. National Stage Application based on the PCT lost after the 30-month expiration date (from priority)
 - If unintentional, may file petition under 37 C.F.R. § 1.78(d) to recapture under delayed filing

Patent Lifecycle – Provisional to Non-Provisional

- Rights to a priority date may be lost

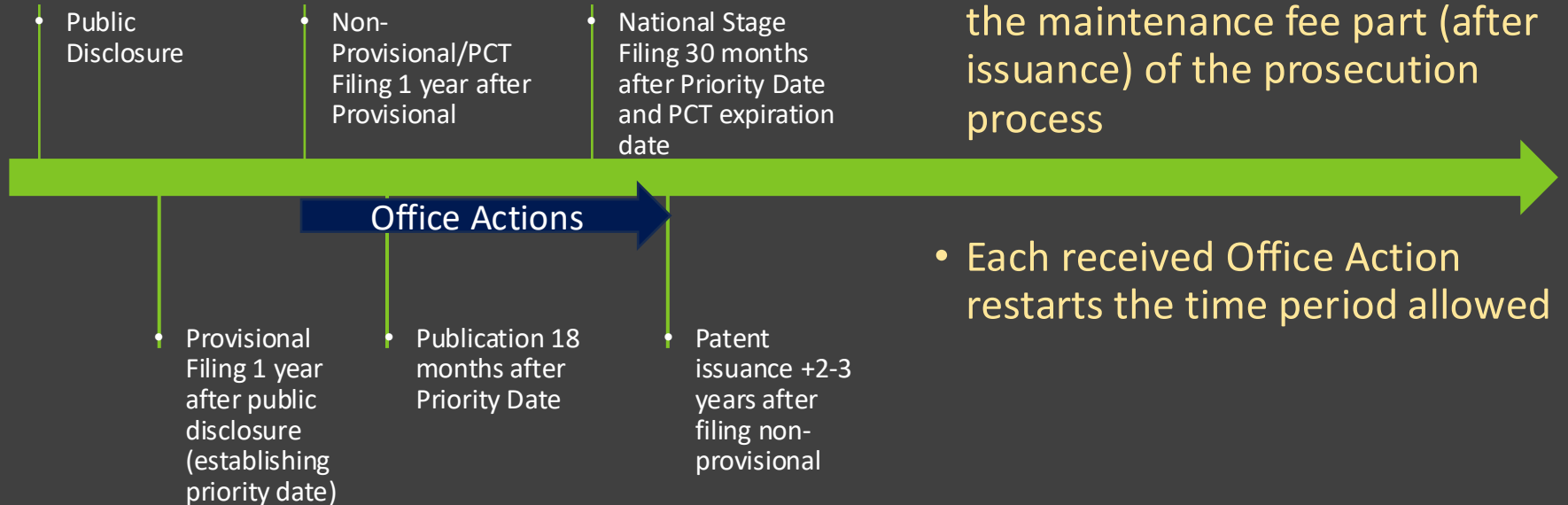


Provisional Abandonment - Relevant Statutes 35

U.S.C. § 111

- Priority Date Abandonment
 - Abandonment under 35 U.S.C. § 111(b) after 12 months after Provisional Filing
- **PRACTICE TIPS**
 - Rights to the Priority Date are lost after provisional abandonment at 12 months if not converted to Non-Provisional or PCT application
 - Loss of the priority date b/c provisionals aren't published
 - If unintentional, may file petition under 37 CFR § 1.78(c) to recapture under delayed filing but there are of course no guarantees

Patent Lifecycle – Post Filing



- Abandonment commonly occurs during this and during the maintenance fee part (after issuance) of the prosecution process
- Each received Office Action restarts the time period allowed

Post Filing Abandonment

- **Intentional** (i.e., express)
- Unintentional

Key Questions - Intentional

- Resources
- Business Changes
 - Commercial viability
 - Business Strategy
- Potential issues – costs related to agreements already made based on the original application
- Finality of Express Abandonment (no going back)

Express Abandonment Relevant Statutes 37

C.F.R. § 1.138, MPEP § 711.01

- **Express Abandonment** under 37 C.F.R. § 1.138
 - (a) Not recognized if not received in time by officials to act
 - (b) Written declaration of abandonment
 - (c) Avoid publication
 - (d) Refund of Search Fees and Excess Claims Fees Paid after December 8, 2004
 - Must file request for refund before 2 months after express abandonment
- **Reasons for Express Abandonment** under MPEP § 711.01
 - After payment of Issue Fee
 - Must include petition to withdraw from issue
 - Avoiding Publication
 - Must be "sufficient time" to avoid publication by Pre-Grant Publication Division
 - For obtaining refund of search fee and excess claim fees
 - Application in interference will lead to adverse judgement (as abandonment of the contest)

PRACTICE TIPS - Express Abandonment Relevant Statutes 37 C.F.R. § 1.138, MPEP § 711.01

- Statutorily set out use cases for:
 - Avoiding publication
 - Receiving a refund of search and excess claim fees
 - Abandonment in favor of a continuation
 - Note: must be early enough for the PTO to act

Post Filing Abandonment

- Intentional (i.e., express)
- **Unintentional**

Common Causes of Unintentional Abandonment

- Missed procedural dates

- OA deadlines
- Issue fee payment deadline
- Maintenance fees
- Response to Restriction
- Entry to National Stage 371

- Other

- Docketing/clerical errors
- Improper withdrawal of counsel
- Change in client instructions without confirmation
- Communication breakdowns between practitioner and applicant

Prosecution Relevant Statutes 35 U.S.C. § 133, 37 C.F.R. §§ 1.134

- Establishing a 6-month statutory response to any action under 35 U.S.C. § 133 (Procedural)
 - 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.
 - **Exceptions** – Nonstatutory deadlines (e.g., Missing Parts, Restriction, Appeal Brief Filings)
- Establishing 6-month time period for reply to Office Actions
 - 37 C.F.R. § 1.134

Prosecution Relevant Statutes 37 C.F.R. §§ 1.135 and 1.136

- **Abandonment for Failure to Reply within Time Period** under 1.135
 - (a) unless otherwise indicated in the Office Action follow 1.134 and 1.136
 - (b) must be complete and proper reply – admission or refusal to admit amendments after final cannot save from abandonment
 - (c) bona fide attempt to advance application to final action may be considered and may be provided 1.134 notification of new time period
- **Extensions of Time** under 1.136
 - (a)(1) No extensions for (i) notified otherwise, (ii) reply brief, (iii) reply to request for oral hearing, (iv) decision by Patent Trial and Appeal Board, or (v) derivation proceeding
 - (b) when cannot be done within the time period, may provide request on or before day reply is due
 - (c) if specified in notice of allowability (1) submitting oath/declaration, (2) submitting formal drawings, and (3) deposit set
 - (d) ex parte reexamination proceedings

PRACTICE TIPS - Prosecution Relevant Statutes

37 C.F.R. §§ 1.135 and 1.136

- File a response to a PTO action within 6 months (in most cases)
- Review the notice/action to determine if deadlines are any different

Prosecution Relevant Statutes MPEP §§ 711-711.01

- Reproduces Abandonment 1.135 and Express Abandonment 1.138 statutes (MPEP § 711)
- **Special Ways** abandonment can be triggered (MPEP § 711.01)
 - Other methods – Continued Prosecution Application (CPA) for design applications
 - Cannot simply cancel all the claims

Prosecution Relevant Statutes MPEP § 711.02

- Failure to Take Required Action During Statutory Period
 - (b) Special Situations
 - (A) Copying claims (is not a response)
 - (B) failure to prosecute
 - (C) dismissal by Court of Appeals
 - (D) interference
 - (E) CPA – addressed under 711.01
 - (F) Improper RCE prior to decision by Board (without fee or submission in application)
 - (G) Improper RCE after final with no response to final Office Action (without fee or submission in application)
 - (H) before payment of issue fee if RCE improperly filed (without fee or submission in application)

PRACTICE TIPS - Relevant Prosecution Statutes

MPEP § 711.02 –

- Take note of these special instances to prevent occurrence

Post Filing Abandonment

- Intentional (i.e., express)
- Unintentional
 - REVIVAL
 - **Petitions for:**
 - **Abandonment**
 - Holding of Abandonment
 - Delayed Claim for Benefit

Revival Relevant Statutes 37 C.F.R. § 1.137

- Revival of Abandoned Application
 - (a) unintentional delay
 - (b) Requirements for petition
 - Required Reply to OA or notice
 - Petition fee under 1.17(m)
 - Any terminal disclaimer (design and utility or plant applications filed before June 8, 1995)
 - Statement that delay between date of required reply due date and filing of grantable petition was unintentional

Revival/Prosecution Relevant Statutes MPEP § 711.03

- Reply Requirement for a petition to revive under 1.137
 - 1. Timely submit copy of specification and any drawings (4 months from filing date OR 16 months from prior filing)
 - 2. Failure to pay issue fee or publication fee
 - 3. failure to provide required drawings
 - 4. reply to nonprovisional application
 - (a) non-final office action
 - Argument or amendment
 - Continuing application
 - (b) final office action
 - Notice of Appeal and fee
 - Amendment that cancels all rejected claims -> prima facie condition for allowance
 - RCE
 - Continuing application
 - (c) appeal brief
 - Appeal brief
 - RCE
 - Continuing application
 - (d) RCE as required reply
 - Must be responsive to last Office Action
 - (e) USPTO may require continuing application or RCE as reply requirement
 - (A) application abandoned for inordinate period of time
 - (B) application contains multiple or conflicting replies
 - (C) reply submitted are questionable as to compliance under 37 CFR 1.111 or 1.113
 - Foreign filing after non-publication request
 - Fee requirement
 - \$2,100 for each petition

PRACTICE TIPS - Revival/Prosecution Relevant
Statutes MPEP § 711.03 and 37 C.F.R. § 1.137 –

- Be sure all replies to actions meet these requirements to prevent accidental abandonment
- When filing for revival of an application, make sure the reply included meets these requirements

Post Filing Abandonment

- Intentional (i.e., express)
- **Unintentional**
 - **REVIVAL**
 - **Petitions for**
 - Abandonment
 - **Holding of Abandonment**
 - Delayed Claim for Benefit

Revival Relevant Statutes MPEP § 711.03

- **Petition to Director** under 37 C.F.R. § 1.181
 - (I) withdraw holding of abandonment
 - Applicant contends that the application was not abandoned (e.g., disagreement regarding incomplete reply and/or controlling dates)
 - (A) failure to receive Office Action
 - 1. Show non-receipt by practitioner
 - 2. Show nonreceipt by Pro Se applicant
 - (B) Based on showing that reply was timely mailed or filed
 - (C) Must be filed within 2 months of receipt of holding of abandonment
 - (II) unintentional delay of payment of issue fees and/or maintenance fees
- May request reconsideration of holding of abandonment under 37 C.F.R. § 1.181(a)
 - (a) Applicant may argue that reply was not incomplete
 - (b) Applicant may argue about date on which reply commenced or ends
 - (c) Petitions Relating to Abandonment
 - Petition to Director 37 C.F.R. § 1.181

PRACTICE TIPS - Revival Relevant Statutes MPEP

§ 711.03

- A “holding of abandonment” is different than “abandonment”
 - Instead, we’re arguing the PTO made a mistake to call this application abandoned
 - Thus, we’re petitioning the director to fix it

Post Filing Abandonment

- Intentional (i.e., express)
- Unintentional
 - REVIVAL
 - Petitions for
 - Abandonment
 - Holding of Abandonment
 - **Delayed Claim for Benefit**

Revival Relevant Statutes MPEP § 711.03

- Petition to accept a delayed claim for benefit to prior-filed provisional application under 35 U.S.C. § 119(e) under 37 CFR 1.78(c)
 - In the case of a late claim for benefit to a provisional
 - the petition must include:
 - Reference to the provisional
 - Petition fee
 - Statement that delay between benefit claim and filing of the benefit claim was unintentional

PRACTICE TIPS - Relevant Revival Statutes MPEP

§ 711.03 –

- In the case of utilizing provisionals as priority claims, make sure to hit the 12-month deadline, but unintentional, can still fix with this petition under 1.78

Key Takeaways

- Docketing is extremely important
- A periodic audit of open cases may be useful
- File petitions as soon as possible
- Know deadline and extension rules
- Maintain evidence of unintentional delay
- Utilize your resources – a practitioner may be able to help keep you up to date on all these items