



Paper No. 20

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**OFFICE OF PETITIONS**

In re Patent No. 6,496,314	:	
Issue Date: December 17, 2002	:	
Application No. 09/713,335	:	DECISION ON PETITION
Filed: November 16, 2000	:	
For: RECORDING PLAYBACK APPARATUS	:	

This is a decision on the petition filed January 10, 2005, self-styled as a presented under 37 CFR 1.181 requesting continued examination of the above-identified "application", or in the alternative, requesting under 37 CFR 1.183 a reexamination of the above-identified patent at the Director's initiative.

The petition considered under 37 CFR 1.181 is **denied**.

The petition considered under 37 CFR 1.183 is **denied**.

BACKGROUND

In reply to the Notice of Allowance and Issue fee mailed June 9, 2002, the issue fee was duly paid on September 18, 2002.

However, on November 12, 2002, applicants filed *inter alia*, a petition under 37 CFR 1.313(c) to withdraw this application from issue after payment of the issue fee. The petition however appears to have been routed to the Technology Center, rather than to the Office of Petitions which has been delegated the authority to decide a petition filed under 37 CFR 1.313(c).

On December 17, 2002, U.S. patent No. 6,496,314 issued to the instant application, with the petition not having been brought to the attention of an appropriately empowered USPTO official.

On June 22, 2004, patentees filed a petition under 37 CFR 1.181 requesting continued examination of the above-identified "application."

On November 10, 2004, a decision was rendered on the petition under 37 CFR 1.313(c) filed November 12, 2002, and the petition under 37 CFR 1.181 filed June 22, 2004. Both petitions were dismissed on the ground that (1) the patent had duly issued as the petition under 37 CFR 1.313(c) had not been favorably decided by an appropriately empowered USPTO official so as to avert issuance, and (2) as the patent had duly issued, the USPTO had no further jurisdiction of the case. All fees filed with the papers on November 11, 2002, were refunded.

The instant petition was filed January 10, 2005.

#### STATUTE AND REGULATION

35 U.S.C. § 2(b)(2)(A) provides that the Office may establish regulations, not inconsistent with law, which shall govern the conduct of proceedings in the Office.

35 U.S.C. § 151 provides that:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 CFR 1.313 provides that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination

under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For interference.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one or more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

#### OPINION

Petitioners again request that the USPTO, under 37 CFR 1.181 continue the examination of "application" no. 09/713,335. In the alternative, under 37 CFR 1.183, petitioners request that the patent be reexamined at the Director's initiative and without payment of the fee.

As to the petition considered under 37 CFR 1.181:

The status of an application is one of three conditions: (1) pending, (2) patented, or (3) abandoned. See *In re Morganroth*, 6 USPQ2d 1802, 1803 (Comm'r Pats. 1988). In addition, under 35 U.S.C. § 120, proceedings in an application are concluded in three ways: (1) the application may issue as a patent, (2) the application may become abandoned, and (3) proceedings in the application may be terminated. *Id.* As the above-identified "application" is no longer a pending application, but since December 17, 2002, is instead an issued patent, there is no longer a pending "application" which may be subjected to the requested further examination within the meaning of 35 U.S.C. §§ 131, 132, as these statutes expressly require, respectively that examination, or reexamination, be performed on an application. Indeed, as explained in MPEP 1305:

Once the patent has been granted, the U.S. Patent and Trademark Office can take no action concerning it, except as provided in 35 U.S.C. 135, 35 U.S.C. 251 through 256, 35 U.S.C. 302 through 307 and 35 U.S.C. 311 through 316.

This is further reinforced by consideration of a standard principle of statutory construction: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Law 96-517 a specific scheme for the reexamination of a patent (i.e., the specific situation under which the PTO may reexamine the claims of an issued patent is by way of a *proceeding* or via reissue and not by way of an "application"), or alternatively, in 35 U.S.C. § 251, by reissue, another specific scheme for remedying an error in the as-issued specification, drawings, or claims, the creation of other schemes (e.g., 37 CFR 1.181 or 1.183) for further examining the claims in an issued patent would be inconsistent with the patent statute. Thus, the Commissioner's authority to further examine or reexamine the claims of the above-identified issued patent is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 251 through 256, 302 through 307, and 311 through 316. That is, it would be an inappropriate exercise of 37 CFR 1.181 or as explained in more detail below under 1.183 to, in essence, fashion yet another means of examining the claims contained in an issued patent.

As to the petition considered under 37 CFR 1.183:

35 U.S.C. § 303 sets forth in pertinent part that "[o]n his own initiative, and any time, the Director may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title." Petitioner contends that the Director, in consideration of this petition should, *at his own initiative*, review the documents filed November 12, 2002, and order a reexamination. In other words, the petition of January 10, 2005, requests, in essence, that the Office undertake *sua sponte* (or on its own initiative) to consider whether a substantial question of patentability is raised by the references submitted November 12, 2002. *Sua sponte* means: of his or its own will or motion; voluntarily; without prompting or suggestion. See Black's Law Dictionary at 1424 (6th ed. 1990). However, the filing of a paper prompting or suggesting that the Office take action under 35 U.S.C. § 303 on its own initiative i.e., *sua sponte*, is a contradiction in the terms of the applicable statute. Since 37 CFR 1.183 by its express terms cannot be invoked to the contrary of any statute there is no basis given or apparent why waiver of the rules is possible, much less indicated, in this instance. Indeed, 37 CFR 1.520 indicates in pertinent part that: "[n]ormally requests from outside the Office that the Director undertake reexamination on his own initiative will not be considered." While the fact that the petition went undecided prior to issuance, that in of itself is not seen to warrant reexamination on the Director's own initiative, or waiver of the

applicable rules. This is particularly so for the reasons pointed out in the decision of November 10, 2004. That is, the USPTO has long and strongly cautioned those parties, in MPEP 1308, seeking to withdraw an application from issue either hand carry the petition to the Office of Petitions, or submit the petition directly to this office by facsimile transmission, coupled in either instance with a direct telephone call to the Office of Petitions to ensure that a grantable petition will be before a deciding official in this office in sufficient time to avert issuance. This has also been the subject of an Official Gazette Notice in 1999. This same caveat was repeated at 65 *Fed. Reg.* 14865 at 14870 (March 20, 2000) Since petitioner did not heed these clear warnings of published USPTO procedures, he assumed the risk that unfortunately occurred here. However, such was an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus is not an extraordinary situation. Petitioner's failure to heed the notice(s) provided by the *O.G.*, the *F.R.*, and the MPEP, of USPTO procedures regarding where and how to file, and with whom to consult regarding petitions under 37 CFR 1.313(c), should not be permitted to shift his inattention onto the USPTO. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985).

Moreover, petitioner has a suitable remedy on hand for his predicament, that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). That is, petitioner may obtain his requested reexamination of the instant patent claims by himself proceeding under either 35 U.S.C. 251 (reissue, and its promulgating regulations 37 CFR 1.171 et seq.) or under 35 U.S.C. § 301 et seq. (reexamination) and their promulgating regulations (37 CFR 1.550 et seq.)

#### DECISION

For the reasons given above, the petition considered under 37 CFR 1.181 is denied. Likewise, the petition considered under 37 CFR 1.183 is denied.

Telephone inquiries related to this decision should be addressed to Petitions Examiner Brian Hearn at (571) 272-3218.

The above-identified patent file is being returned to the Files Repository.



Charles Pearson  
Director, office of Petitions