Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE SHILA MORGANROTH
Serial No. 05/842,108
January 6, 1988
***1** Filed: October 14, 1977

For: Methods of Selectively Altering Hair Color

George H. Mortimer, Esq.

3684 North Little Rock Terrace

Provo, Utah 84601

James E. Denny

Deputy Assistant Commissioner for Patents

DECISION ON RECONSIDERATION

This is a decision on applicant's petition to reconsider the ORDER DISMISSING PETITION TO REVIVE mailed June 25, 1987 (hereinafter, ORDER). Applicant sought to revive the above-identified application in order to achieve copendency of the application with a proposed Rule 60 (37 CFR 1.60) 'continuing' application. Applicant's petition to revive was dismissed on the ground that the Patent and Trademark Office (PTO) has no jurisdiction to revive the application and, hence, lacks authority to consider the petition.

The reasons the PTO has no jurisdiction to revive the application are discussed in detail in the ORDER. In short, the PTO's jurisdiction does not extend to the present situation where the 'termination of proceedings' in the application occurred when the judgment of the district court became final and the only way in which the pendency of the application could have been maintained would have been to postpone the finality of that judgment by taking appropriate action in the district court (e.g., by the timely filing of a notice of appeal in the district court).

In her petition to reconsider the ORDER, applicant suggests that the PTO has jurisdiction to revive the application because the purpose for revival is only to achieve copendency with the proposed 'continuing' application as opposed to enabling her to appeal the adverse decision of the district court. However, applicant's purpose is irrelevant to the issue of jurisdiction.

Applicant urges that instead of the timely filing of a notice of appeal in the district court, the filing of a continuation application in the PTO, if that action 'had been taken during the time for filing a notice of appeal, would be another appropriate response to the decision dismissing applicant's complaint.' However, that action would not have extended the pendency of the present application--it would simply have

obviated the need to maintain the pendency of the application beyond the time for appeal. Of course, had applicant's action been timely, the desired copendency would have been achieved. Applicant's argument to the effect that the timely filing of a notice of appeal 'would not have given applicant an opportunity to cancel those claims [the claims which were before the district court] from the continuation application and submit new ones in it . . .' is not well taken. Indeed, the timely filing of a notice of appeal in the district court would have extended or maintained the pendency of the present application so that the proposed continuation application and amendment could have then been filed in the PTO during that pendency.

***2** Applicant correctly asserts that the Commissioner has authority after dismissal of a civil action to determine the status of the application involved. It does not follow, however, that the Commissioner (PTO) has jurisdiction to change the status so determined, where the status resulted, as in the present case, from the judgment of the district court, where no claims were allowed, and where the only action which could have prevented (or delayed) the abandonment or termination of proceedings would have to have been taken in the district court and not in the PTO.

Finally, applicant compares the present factual situation to that involved in In re Bryan, 2 USPQ 2d 1215 (Comm'r. Pat. 1986), cited in the ORDER, and argues 'that the principle followed in Bryan is directly applicable here.' Applicant overlooks the fact that Bryan is readily distinguishable from the present case for the reason indicated in the footnote cited in the ORDER, id., at 1218 n.3. There is no reason for treating the final judgment of the district court here any differently from a mandate received from the U.S. Court of Appeals for the Federal Circuit. In either case, relief from the effect of the court's final judgment, if any is to be had, must be sought in the court, not in the PTO.

Applicant's petition for reconsideration has been carefully considered, but is not persuasive for the reasons set forth above. Accordingly, the petition for reconsideration is denied.

6 U.S.P.Q.2d 1802

END OF DOCUMENT