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PETITIONS OFFICE

In re Application of
Richard J. Lindeman
Application No. 08/241,663
Filed: May 11, 1994
For: ELECTRICAL CONNECTORS

:
: DECISION ON SECOND
: REQUEST FOR
: RECONSIDERATION
:

This is a decision on the second request for reconsideration filed September 5, 1995, again requesting that application No. 07/647,865 be accorded a filing date of January 29, 1991, rather than the presently accorded filing date of January 30, 1991. Application No. 08/241,663 is a continuation application filed under 37 CFR 1.62 based on application No. 07/647,865. Therefore, the file of application No. 07/647,865 has been wrapped into the file of Application No. 08/241,663.

On April 18 and May 2, 1994, a petition was filed requesting the earlier filing date on the basis that application No. 07/647,865 was deposited in Express Mail service on January 29, 1991, pursuant to the requirements of 37 CFR 1.10. However, the petition was denied in a Decision mailed August 8, 1994, because the date of deposit in Express Mail shown by petitioner's Express Mail receipt was January 30, 1991, and because petitioner admitted that the application was deposited in an Express Mail drop box after the last scheduled pick-up for the day (see Lund declaration filed April 18, 1994, ¶ 6). The original decision was reconsidered in a Decision mailed June 29, 1995. However, the earlier filing date was again denied.

Petitioner's present request again argues that the PTO has limited the grant of a filing date under 37 CFR 1.10 to the date of acceptance by the United States Postal Service (USPS) which is contrary to the plain meaning of the language found in 37 CFR 1.10 and that the evidence of record establishes that the application was actually deposited in Express Mail service on January 29, 1991.

The arguments made in the request filed on September 5, 1995, have been carefully considered, but are not persuasive that any error was made in the previous decisions.

Petitioner's attention is again directed to the actual language of 37 CFR 1.10. Section 1.10 reads, in-part, as follows:

(a) Any paper or fee to be filed in the Patent and Trademark Office can be filed utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed in the Office on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service....

(b) Any paper or fee filed by "Express Mail" must...include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee.

(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a)...without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified....

49 Fed. Reg. 552 (Jan. 4, 1984) (emphasis added).

The actual language of the rule is consistent with the language of 35 U.S.C. 21.

Section 1.10(c) states that the paper or fee will be accorded the certificate date as the filing date for the paper or fee unless there is a question present concerning the date of mailing, i.e., the date of deposit identified in the certificate of mailing by Express Mail will be accepted as "the date the paper or fee is shown to have been deposited as 'Express Mail'" as set forth in 37 CFR 1.10(a) unless there is a question present concerning the date of mailing. The section goes on to state that the PTO may require a copy of the Express Mail receipt showing the actual date of mailing. Thus, the language of the rule itself explicitly

states that the PTO considers the Express Mail receipt to be evidence showing the date the paper or fee was deposited in Express Mail service. The reasons why the rule was drafted using this language was explained in the final rulemaking originally published in 1983. Therefore, the importance of the Express Mail receipt should have been obvious to petitioner from a reading of the rule itself.

Petitioner had the option of depositing the application in Express Mail service on or before January 29, 1991, at a USPS window. Had petitioner done so, petitioner could have immediately verified that the date shown on the customer receipt was the correct date and any error on the receipt could have been corrected. Unfortunately, in this case, petitioner delayed the final preparation of the application until the very last day for obtaining continuity with a prior application (see admission made in the Lund declaration filed May 3, 1994, ¶¶ 4 and 5). While an applicant may wait until the last day to file an application in order to establish continuity, the applicant does so at his or her peril. Those who file at the end of a statutory bar year (35 U.S.C. 102(b)) or a priority year (35 U.S.C. 119) or who delay filing a continuation or divisional application until the last possible day for establishing continuity (35 U.S.C. 120 or 121), do not leave any opportunity to overcome any error which might occur in filing the application. The PTO, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See *Ex parte Sassin*, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r. Pat. 1906) and compare *Ziegler v. Baxter v. Natta*, 159 USPQ 378, 379 (Comm'r. Pat. 1968).

For the record, the Office has not conceded in any of the previous Decisions and does not presently concede that the application was actually deposited in Express Mail service on January 29, 1991. To the contrary, the most probative evidence of the date of deposit in Express Mail service is petitioner's Express Mail receipt which shows a date of deposit of January 30, 1991. Thus, the PTO concludes that the application was actually deposited in Express Mail on January 30, 1991. Therefore, there is no error in the filing date presently accorded application No. 07/647,907.

The previous decisions have been reconsidered as requested, but the result is the same. The petition is again denied.

The application is being returned to Examining Group 3200 to await applicant's response to the final Office action mailed August 8, 1995.

Telephone inquiries specific to this matter should be directed to Senior Legal Advisor John F. Gonzales at (703) 305-9282.



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