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OFFICE OF PETITIONS

In re Application of :
Peter O'Shannessy :
Application No. 11/166,504 : ON PETITION
Filed: June 24, 2005 :
Attorney Docket No. 114374.0001 :

This is a decision on the "RENEWED PETITION UNDER 37 CFR 1.10(d) TO CORRECT FILING DATE", filed June 23, 2006, to accord the above application a filing date of June 23, 2005.

The petition is **DENIED**. This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Procedural History:

- Petitioner filed a petition under 37 CFR 1.10(d) on August 1, 2005. Petitioner argued that the application was filed on June 23, 2005. In support thereof, petitioner supplied a copy of the Express Mail mailing label, bearing a "date accepted" of June 24, 2005, and argued that this label was evidence that came into being within one business day of the actual deposit (June 23, 2005).
- The petition was dismissed in a decision mailed on September 19, 2005. The decision pointed out that petitioner did not submit evidence that came into being within one business day after the deposit, specifically a mail log.
- By renewed petition filed December 7, 2005, petitioner supplied a copy of a log book, with a log entry time of 5:40pm on June 23, 2005, for Express Mail Label No. EV698985201US.

- The petition was dismissed in a decision mailed on March 23, 2006. The decision pointed out that the number of the Express Mail mailing label was not placed on the application papers.
- By renewed petition filed April 11, 2006, petitioner argued that the number of the Express Mail mailing label was placed on the return-receipt postcard, and that the postcard constitutes a part of the application correspondence.
- The petition was dismissed in a decision mailed on June 15, 2006. The decision pointed out that the postcard receipt is not considered a part of the correspondence because it is returned to applicant. In addition, the petition cited MPEP 513(III), which states that to be effective, the Express Mail mailing label number "must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached thereto."

Evidence Presented on Petition:

Petitioner argues that the MPEP does not "differentiate, distinguish or disqualify application papers which are returned to the applicant, such as a postcard." In addition, petitioner points out that there is no controlling authority which holds that a postcard, which is returned to the applicant after receipt by the Patent Office, does not constitute part of the application correspondence. Petitioner cites the Office's attention to Legille et al. V. Tegtmeier, Commissioner of Patents, 382 F. Supp 166 (D.C. 1974). In Legille, the Court acknowledged postcards, by stating "attached to the applications mentioned above were confirmatory receipt postcards. These postcards were receipt dated March 8, 1974 by the Patent Office and returned to plaintiff's attorney." Lastly, petitioner argues that the language of 37 CFR 1.10(e)(3) and 1.10(e)(4) acknowledges that a return postcard receipt is part of the application correspondence. Petitioner brings the Office's attention to the relevant language, which states "the petition includes a copy of the originally deposited paper(s) or fees that constitute the correspondence showing the number of the Express Mail mailing label thereon, a copy of any returned postcard receipt..."

Relevant Rules and Regulations:

37 CFR 1.10(d) states that any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and

(3) The petition includes a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or [evidence] that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

Opinion:

The arguments presented on petition have been considered, but are not persuasive. 37 CFR 1.10(e)(3) and 1.10(e)(4), cited by petitioner to support the concept that a return receipt postcard receipt is part of the application correspondence, actually supports the opposite conclusion. 37 CFR 1.10(e) is applicable to the situation where the Patent Office did not receive correspondence.¹ In that case, an applicant may petition to have the Office consider such correspondence filed in the Office on the date of deposit via USPS Express Mail, provided that (1) the petition is filed promptly; (2) the Express Mail mailing label number was placed on the paper or fees that constitute the correspondence; (3) "The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the Express Mail mailing label thereon, a copy of any returned postcard receipt, a copy of any other official notation by the USPS relied upon to show the date of deposit, and (4) petitioner includes a statement that the copies of the correspondence, Express Mail mailing label, and the postcard receipt are "true copies" of the originally mailed correspondence, Express Mail mailing label, and postcard receipt. It is noted in the sections quoted by petitioner that "correspondence" and "postcard receipt" are listed separately, together with the Express Mail mailing label, supporting the conclusion that these are three separate items. Clearly the Express Mail mailing label is not the correspondence, any more than it is a postcard receipt. Furthermore, it is also noted that 1.10(e)(2) does not require that the Express Mail mailing label number be placed on the postcard receipt, but rather on the correspondence.

With respect to Legille, not only does the case pre-date the Express Mail procedures of 37 CFR 1.10 (as noted by petitioner), but the court merely acknowledged the existence of the postcard receipt practice. The court did not hold that a postcard receipt is part of the application correspondence.

¹ Such is not the case here - the Patent Office did receive petitioner's correspondence. Nevertheless, since 37 CFR 1.10(e) is quoted by petitioner to support his argument that the postcard receipt is part of the application correspondence, the decision will address §1.10(e) insofar as this argument is concerned.

The matter is being forwarded to Group Art Unit 3723 for consideration of the election filed May 3, 2006.

Telephone inquiries concerning this decision may be directed to Petitions Attorney Cliff Congo at (571)272-3207.

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