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OFFICE OF PETITIONS

In re Application of :
Carter-Smith et al. :
Application No. 29/207,288 :
Filed: June 9, 2004 : Decision on Petition
Title of Invention: RING :

This is a decision on the Final Request for Reconsideration of a Decision on Petition, filed March 16, 2006, requesting that the above-identified application be accorded a filing date of June 9, 2004, including two (2) sheets of Figures.

The petition is **DENIED**.

This Decision may be viewed as a final Agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review.

Background:

The application was filed on June 9, 2004. However, on September 9, 2004, the Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application ("Notice") stating that a filing date had NOT been accorded the application because the application was deposited without drawings.

In response to the Notice, Applicant filed a petition on November 8, 2004, wherein Applicant averred that the application as deposited included two sheets of drawings. In support of the assertion, Applicant provided copies of a return-receipt postcard; an Express Mail mailing label, a Declaration of Mercedes F. Dipasupil and that of petitioner Barry S. Wilson.

Applicant was advised that the best evidence of what was filed on [June 9], 2004, was applicant's [stamped] postcard receipt¹.

A review of the return receipt postcard filed with the petition revealed that the postcard did not contain a USPTO stamp indicating receipt of the items listed on the postcard. As such, the postcard failed to provide proof of receipt by this Office of the items listed thereon.

Regarding the declarations of Mercedes F. Dipasupil and petitioner Barry S. Wilson, this Office considered the declarations, but they were not found to be persuasive evidence that the application as-filed included drawing sheets. Applicant was advised that the USPTO file is the official record of the papers originally filed in this application. A review of the official file revealed that no drawings were filed on June 9, 2004, since no such drawings were present in the file. An applicant alleging that a paper was filed in the USPTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Applicant was further advised that the declarations relied upon contained the Declarants' recall of routine events which occurred 5 months earlier and were not more persuasive than the record of what was filed as shown by the official file.

The March 7, 2005 request for reconsideration

Applicant filed a request for reconsideration on March 7, 2005, and offered as additional evidence the declaration of Michael S. Mayor, who putatively "determined the weight of a package of materials that included all of the filing papers for [this application] that were indicated on the transmittal to have been filed on June 9, 2004 including an Express Mail envelope." *Petition* at p.1. Applicant argued that the weight of the package, including the drawings as weighed prior to mailing, was approximately 0.4 ounces more than the weight of the package without the drawings. Further to this, Applicant averred that the package this Office received was approximately 3 ounces, which was much closer to the weight of the package as weighed by Michael Mayor, which putatively included the two drawing sheets. *Petition* at p.2.

¹ "If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all items listed thereon on the date stamped thereon by the USPTO." MPEP § 503.

Applicant also submitted a second declaration of Ms. Dipasupil who declared, *inter alia*, that she recalled including Figures 1 and 2 in the Express Mail envelope, and sealing the envelope for mailing. *Id.*

The March 7, 2005 Request for Reconsideration was dismissed in a Decision mailed April 18, 2005. In the Decision dismissing the March 7, 2005 Reconsideration Request, Applicant was advised that the USPTO file is the official record of the papers actually received or filed, on June 9, 2004. A review of the file revealed that no drawings of Figures 1 and 2 were present in the file other than the copies presented with the March 7, 2005 petition. The declaration of Ms. Dipasupil that Applicant relied upon contained the Declarant's recall of routine events which occurred more than 8 months earlier and were not more persuasive than the record of what was filed as shown by the official file. It was also noted that Applicant's weight analysis was based upon an entry on the Express Mail Label Receipt by the USPS indicating the package weight as being 3 ounces. This evidence presented was not more persuasive than the official file².

The October 17, 2005 request for reconsideration

Applicant filed a second Request for Reconsideration and included the declaration of Ms. Germaine Sarda, who prepared a reconstructed mailing of the application papers putatively filed on June 9, 2004. Ms. Sarda weighed the application papers using Foly & Lardner LLP's mail room scale, both with two sheets of drawings and without two sheets of drawings. The conclusion of this exercise, Applicant contended, was that the mailing without the two sheets of drawings weighed 2.6 ounces, or approximately 13% less than the mailing that included the two sheets of drawings, said weight being 3.0 ounces.

Applicant next took the application papers to the same United States Post Office ("USPS") that the originally filed application papers were mailed from and, using the same USPS clerk and a USPS scale, weighed the application papers. This exercise, Applicant provided, yielded the same results as obtained using Foly & Lardner LLP's mail room scale.

Applicant submitted that the preponderance of the evidence, as evidenced by the petition, demonstrated that the application

² The Decision dismissing the petition noted that the entry by the USPS as to the weight of the package could have easily been the result of rounding (down from 3.1 or up from 2.7) or differences in calibration.

papers filed on June 9, 2004, included two sheets of drawings and the drawings were subsequently lost by this Office.

Applicant's contention was again considered, and in a Decision dismissing the October 17, 2005 petition mailed November 2, 2005, Applicant was informed that his contention was not more persuasive than the Official file. Applicant was informed that he had made no assertion that he followed PTO statutes, PTO rules, the MPEP, or Official Gazette notices in effectuating the filing of this application. Instead, Applicant was attempting to rely upon after-the-fact testing and experimentation involving the putative weight of papers. Applicant had not provided any evidence that would demonstrate that the drawing sheets were filed with this Office on June 9, 2004.

Applicant was advised that there are two methods wherein correspondence will be considered filed on the date of deposit. The first method, under 37 CFR 1.10, provides for the filing of papers and fees by "Express Mail." The second method, under section 503 of the MPEP, provides that [i]f a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item.

The Decision concluded by informing Applicant that the Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987).

The Final Request for Reconsideration

Applicant files the Final Request for Reconsideration and asserts that he did comply with 37 CFR 1.10 in filing the application papers.

To clarify the record, the prior Decision's reference to Applicant's failure to follow PTO statutes, PTO rules, the MPEP, or Official Gazette notices in effectuating the filing of this application, related to Applicant's assertion that two (2) sheets of drawings were present in this Office on June 9, 2004. Applicant was attempting to rely upon after-the-fact testing and experimentation involving the putative weight of papers. Applicant had not provided any evidence that would demonstrate that the drawing sheets were filed with this Office

on June 9, 2004. Regarding the Express Mail mailing of the application papers, in accordance with 35 U.S.C. § 21 and 37 CFR 1.10, Applicant was accorded as filing date the date of deposit of the application papers³ using Express Mail Post Office to Addressee.

Applicant also asserts compliance with the Manual of Patent examining Procedure ("MPEP") § 503. Applicant provides that a return receipt postcard in compliance with the MPEP 503 was filed with the application papers. As noted *supra*, a review of the return receipt postcard filed with the petition revealed that the postcard did not contain a USPTO stamp indicating the receipt of the items listed on the postcard. As such, the postcard failed to provide proof of receipt by this Office of the items listed thereon.

Applicant provides that, as stated in the MPEP 503,

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.
Id.

Applicant asserts that the PTO failed to follow the MPEP and returned the postcard without crossing off any of the drawings, nor were any initials placed on the return-receipt postcard.

A review of the postcard filed with the November 8, 2004 petition confirms that this Office failed to annotate the postcard. However, a review of the Design Patent Application Transmittal form filed with the application papers on June 9, 2004, reveals that this Office stamped the Transmittal Form "The PTO did not receive the following listed item(s): 2 pages of Drawings." Applicant acknowledges that this Office "list[ed] the drawings as allegedly being missing," and that this "argu[ably] complie[s] with the first of the requirements." *Petition* at P.7. In fact, the PTO stamp, a form stamp that leaves a blank space where the PTO employee must enter the items that were not received, demonstrates that the Office checked the

³ The application papers included one (1) sheet of drawing based upon the application having incorporated by reference prior United Kingdom Design Application serial number 3015508, which contained one (1) sheet of drawing.

items listed on the Transmittal Form upon receipt of the application papers and annotated thereon that 2 pages of drawings were not received by this Office on June 9, 2004.

Moreover, as Applicant provides, Applicant "received the postcard from the USPTO in late June 2004, only a few weeks after the filing had been made, indicating that the two sheets of drawings were not received." Petition at p.11; Dipasupil Declaration⁴ at para.4.

Finally, Applicant again introduces evidence consisting of declarations of employees attesting to the inclusion of the drawings in the application papers, supported by evidence of the weight of the papers putatively identical to those filed in this Office on June 9, 2004, with and without the drawings.

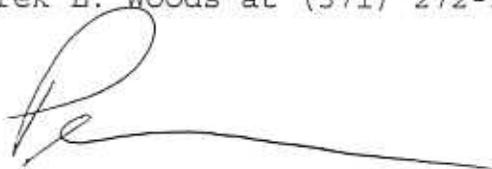
This evidence has been considered, and it is again concluded that the evidence presented is not more persuasive than the official file. The USPTO file is the official record of the papers originally filed in this application. A review of the official file revealed that no drawings were filed on June 9, 2004, since no such drawings were present in the file. Further to this, the official file contains a PTO stamp wherein this Office annotated on the Transmittal Form, that 2 pages of drawings were not received by this Office on June 9, 2004. An applicant alleging that a paper was filed in the USPTO and later misplaced has the burden of proving the allegation by a preponderance of the evidence. Applicant has failed to demonstrate by a preponderance of the evidence that two (2) drawing sheets were filed with this Office on June 9, 2004.

For the above stated reasons, the petition is denied.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (571) 272-3232.



Charles A. Pearson
Director
Office of Petitions



⁴ Mercedes Dipasupil is a Legal Secretary at the firm of Foley & Lardner with 20 years of experience in the intellectual property field.