UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 22

LERNER AND GREENBERG PA
POST OFFICE BOX 2480
HOLLYWOOD FL 33022-2480

COPY MAILED
AUG 23 2004
OFFICE OF PETITIONS

In re Patent No. 6,445,699 B1
Issue Date: September 3, 2002
Application No. 09/382,529
Filed: August 25, 1999
Attorney Docket No. GR 97P1227P

:DECISION DENYING PETITION
:AND VACATING CERTIFICATE OF
:CORRECTION

This patent is before this office for a decision on the renewed petition under 37 CFR 1.55(a), filed December 16, 2002, which is being treated as a petition under 37 CFR 1.55(a) to accept a claim for the benefit of priority to German Priority document No. 19707489.5 after payment of the issue fee. This, in turn, requires a review of the favorably treated request for a Certificate of Correction under 37 CFR 1.322(a) filed October 1, 2002.

The petition under 37 CFR 1.55(a) is **DENIED**.

The request for a Certificate of Correction under 37 CFR 1.322(a) is **DENIED**.

The Certificate of Correction issued January 7, 2003, is hereby **vacated** and a corrective Certificate of Correction will be issued in due course.

BACKGROUND

The above-identified application was filed August 25, 1999, as a continuation under 35 U.S.C. §§ 111(a), 365(c) and 37 CFR 1.53(b) of Patent Cooperation Treaty (PCT) application PCT/DE/98/00467 filed on February 17, 1998, which in turn claimed benefit of German priority document No. 19707489.8 filed on February 25, 1997.

Applicant's declaration under 37 CFR 1.63, filed on November 8, 1999, in reply to a Notice of Missing Parts, claimed benefit of both the above-noted domestic and foreign prior applications, respectively.

The Office actions of May 9, 2000, (see Summary, under "Priority under 35 U.S.C. § 119", and at 2, ¶ 1), October 25, 2000, (see Summary, under "Priority under 35 U.S.C. § 119", June 20, 2001, (see Summary, under "Priority under 35 U.S.C. § 119"), December 17, 2001, (see Summary, under "Priority under 35 U.S.C. §§ 119 and 120"), and the Notice of Allowability of April 9, 2002 (at 2, ¶ 1), all noted that applicant had not filed the requisite copy of the German document required by 35 U.S.C. § 119(b).

The issue fee was timely paid on July 19, 2002, in reply to the Notice of Allowance of April 9, 2002, with an executed certificate of mailing under 37 CFR 1.8 of July 9, 2002.

On August 15, 2002, applicant filed a communication captioned as a "claim for priority", and the fee required by 37 CFR 1.55 and 1.17(i). Applicant noted that as the file of the German application had been destroyed, a certified copy was unavailable to applicant,. Nevertheless, applicant requested that the USPTO accept the proffered cover sheet of the priority document, and grant the claim for foreign priority.

The patent issued on September 3, 2002.

The communication captioned as a "claim for priority" was properly treated as a petition under 37 CFR 1.55(a) and was dismissed in the decision of October 28, 2002. The decision noted that the version of the statute (35 USC 119) applicable to the above-identified application required that the certified copy of the priority document be filed in the USPTO prior to issuance, that the claim for priority could not be perfected within the meaning of the statute if the certified copy could not, as here, be produced, and that the cover sheet of the document was not acceptable in lieu of the certified copy of the document itself, noting that 37 CFR 1.4(f) required a certified copy of the original foreign application, and not merely its cover sheet or a copy *per se*.

On October 1, 2002, applicant filed a request for a Certificate of Correction under 37 CFR 1.322(a), asserting that the certified copy of the priority document had been filed in the USPTO on August 15, 2002, as evidenced by an enclosed copy of an itemized postcard receipt, and, as such, the Foreign Application Data filed on the as-printed patent contained an error as it failed to include an acknowledgment of the priority claim.

The instant petition seeking reconsideration of the adverse decision of October 28, 2002, was filed December 16, 2002.

In the interim, a Certificate of Correction was unfortunately issued on January 3, 2003, notwithstanding the controlling prior adverse decision of October 28, 2002, and without a favorable decision on the outstanding renewed petition.

STATUTE, REGULATION, AND EXAMINING PROCEDURE[1]

35 U.S.C. § (2)(b)(2) provides, in pertinent part, that:

> The Office...may establish regulations, not inconsistent with law, which...
>
> (A) shall govern the conduct of proceedings in the Office.

On August 25, 1999, 35 U.S.C. § 119(b) stated:

No application for patent shall be entitled to this right of priority unless a claim therefor **and a certified copy of the original foreign application, specification, and drawings upon which it is based are filed in the Patent and Trademark Office before the patent is granted**, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. **The Commissioner may require** a translation of the papers filed if not in the English language and **such other information as he deems necessary** (emphasis added).

35 U.S.C. § 254 provides that:

Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Director may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Director may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

On August 25, 1999, 37 CFR 1.55(a) stated:

> An applicant in a nonprovisional application may claim the benefit of the filing date of one or more prior foreign applications under the conditions specified in

---

[1]Manual of Patent Examining Procedure (MPEP), 8th Ed., Rev. 1 (Feb. 2003).

35 U.S.C. 119(a) through (d) and 172. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by Section 1.63. The claim for priority and the certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (Section 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other situations, before the patent is granted. If the claim for priority or the certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in Section 1.17(i).
If the certified copy is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate.

37 CFR 1.322 states:

(a)(1)The Director may issue a certificate of correction pursuant to 35 U.S.C. 254 to correct a mistake in a patent, incurred through the fault of the Office, which mistake is clearly disclosed in the records of the Office:

(i)At the request of the patentee or the patentee's assignee;
(ii)Acting *sua sponte* for mistakes that the Office discovers; or
(Iiii)Acting on information about a mistake supplied by a third party.

(2) (i)There is no obligation on the Office to act on or respond to a submission of information or request to issue a certificate of correction by a third party under paragraph (a)(1)(iii)of this section.
(ii)Papers submitted by a third party under this section will not be made of record in the file that they relate to nor be retained by the Office.

(3) If the request relates to a patent involved in an interference, the request must comply with the requirements of this section and be accompanied by a motion under § 1.635.

(4) The Office will not issue a certificate of correction under this section without first notifying the patentee (including any assignee of record)at the correspondence address of record as specified in § 1.33(a)and affording the patentee or an assignee an opportunity to be heard.

(b)If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Director may issue a corrected

patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

37 CFR 1.325 states:

Mistakes other than those provided for in §§ 1.322, 1.323, 1.324, and not affording legal grounds for reissue or reexamination, will not be corrected after the date of the patent.

MPEP 1895.01 states in pertinent part:

A claim for foreign priority under 35 U.S.C. 119(a)-(d) must be made in the continuing application in the same manner as a claim for foreign priority under 35 U.S.C. 365(b) in a national stage application. In the same manner as with a national stage application, a foreign priority claim is proper if (1) a claim for foreign priority was made in the international application, and (2) the foreign application was filed within 12 months prior to the international filing date. **A certified copy of any foreign priority document must be provided by the applicant if the parent international application has not entered the national stage under 35 U.S.C. 371 (the photocopy received from the International Bureau cannot be used).** If the parent international application has entered the national stage under 35 U.S.C. 371, the applicant, in the continuing application, may state that the priority document is contained in the national stage application(emphasis added).

OPINION

WITH RESPECT TO THE CLAIM FOR FOREIGN PRIORITY:

Petitioner does not contend that 35 U.S.C. § 119 as amended by the AIPA (1999) is applicable to the facts of this case, as the filing date of the above identified application predates the amended form of the statute.[2] Rather, petitioner relies upon 35 U.S.C. § 119(b)(1994) for the proposition that while the statute provides the Director with the

---

[2] While the American Inventors Protection Act of 1999 (P.L. 106-113) included specific language in section 4503 that amended 35 USC 119, section 4508 specifically provides that those amendments apply only to applications filed I year after enactment; *i.e.*, only to those applications filed on or after November 29, 2000. 37 CFR 1.55(a) (effective November 29, 2000) which promulgates those provisions, likewise does not apply to the instant patent, or its application. See 65 *Fed. Reg.* 57024 (Sept. 20, 2000).

authority to require a certified copy of the foreign application, such certification "may be required by the Director to include a copy of the specification and drawings. Emphasis is placed on the word "may." Petitioner acknowledges that "it is factually and legally impossible for applicant to obtain a certified priority document that includes the specification and drawings", and as such, petitioner asserts that the USPTO should accept the certification (*i.e.*, the cover sheet) from the German Patent Office that the corresponding application upon which the claim at issue is predicated was indeed filed and thus the "framework" of § 119 has been satisfied.

Nevertheless, the requested relief simply cannot be granted in this instance. While petitioner is correct that 35 U.S.C. § 119(b) (1994), second sentence, requires that a certification by the foreign patent office must show the date of the application and of the filing of the specification and other papers, the first sentence of § 119(b)(1994) clearly makes the priority claim also contingent upon, *inter alia*, (1) the claim for the right of priority, (2) a certified copy of the original foreign application, specification and drawings, and (3) that both items 1 and 2 are received in the United States Patent and Trademark Office before the patent is granted. Thus the clear language of the statute requires the certified copy of the application, specification, and drawings upon which the claim is based, in addition to the certification by the foreign patent office as to date of the foreign application and of the filing of the specification and other papers. Clearly, the above-noted conditions 2 and 3 were not satisfied in this instance.

Contrary to petitioner's urging, the certification *per se* by the foreign patent office that the German application existed is not the certified copy of the application that includes the specification, and drawings, and as such, the certification *per se* can not trump the express requirement for the satisfaction of items 2 and 3 noted above. See Fourco Glass Co. v. Transmirra Prods. Corp., 353 U.S. 222, 228-29, 113 USPQ 234, 237 (1957) ("specific terms prevail over the general ih the same or another statute which otherwise might be controlling"). Otherwise, the mere fact of certification that the foreign application existed would render the requirement of § 119(b)(1994), first sentence, for a certified copy of the original foreign application, specification, and drawings moot. However, it is a well settled tenet of statutory construction that every word in a statute must be given effect. Federal Savings & Loan Association v. De La Cuesta, 458 U.S. 141, 163 (1982) (all parts of a statute should be given effect if possible); American Textile Manufacturers Institute, Inc. v. Donovan, 452 U.S. 490, 513 (1981) (same); Reiter v. Sonotone Corp., 442 U.S. 330, 339 (1979) ("In construing a statute we are obliged to give effect, if possible, to every word that Congress used.").

While it is unfortunate for petitioner that the original priority document has been destroyed and a certified copy of the German application, specification, and drawings cannot be produced, the USPTO lacks both the authority and the discretion to accept

the proffered cover sheet in lieu of the entire certified copy of the foreign application, specification, drawings, and other papers required by § 119(b), first sentence(1994). Contrary to petitioner's urging, the USPTO simply lacks the authority or discretion to relax any requirement of law. See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120);A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute). Thus, in the absence of the timely filed certified copy of the application, specification, and drawings of the German priority document required by § 119(b)(1994), the USPTO simply cannot acknowledge applicant's claim for foreign priority.[3]

WITH RESPECT TO THE REQUEST FOR A CERTIFICATE OF CORRECTION:

Petitioner points to the claim for foreign priority in the declaration under 37 CFR 1.63 filed in the USPTO on November 8, 1999, resubmits a copy of the paper captioned "claim for priority" originally filed on August 15, 2002, and further asserts that the certified copy of the priority document was received in the USPTO on August 15, 2002, as shown by the enclosed copy of the postcard receipt dated August 15, 2002, *i.e.*, both items were received prior to issuance on September 3, 2002. As such, petitioner asserts there is an error in the as-printed patent in failing to acknowledge the claim for benefit of the foreign filing, and proffers a Certificate of Correction to correct the alleged error.

---

[3] As the court noted in Brenner v. State of Israel, 400 F.2d 789, 790, 158 USPQ 584, 585 (D.C. Cir. 1968): "There is force in [the USPTO's] contention that section 119 is a mandatory provision which specifically and without equivocation prohibits the granting of a priority right unless its procedural requirements are fulfilled. We also understand the purpose which arguably underlies these stringent requirements, i.e., all the information which a potential infringer or copier may need in order presently to ascertain his rights should be collected in one place where it can be easily be found and evaluated." Here, the destruction of the German application file by the German Patent Office such that a certified copy concededly cannot be provided to the USPTO defeats the underlying purpose of § 119(b)(1994), and USPTO acceptance of the priority claim in the absence of the certified copy of the German application, specification, and drawings would improperly evade the stringent requirements of the statute.

However, as correctly noted in the decision of October 28, 2002, and also for the reasons given above, since the certified copy of the German priority document cannot be produced, much less has been shown to have been received in the USPTO prior to issuance of the above-identified patent, the patently correctly issued without acknowledging the foreign priority claim.

Petitioner's contention that the certified copy of the priority document in question was received at the USPTO on August 15, 2002, is not convincing. Indeed, petitioner concurrently acknowledged in the "claim for priority" on August 15, 2002, that "no certified copy of the corresponding priority document was available to applicant" owing to the unfortunate destruction "of the entire file" by the German Patent Office. An appropriately itemized postcard receipt will serve as *prima facie* evidence of receipt at the USPTO of the documents enumerated thereon on the date in question. See MPEP 503. However, the copy of the postcard receipt for this application merely sets forth applicant's intent to file a copy of the prior German application. Inspection of the copy of the postcard receipt for this application shows that the USPTO merely acknowledged receipt of applicant's intended filing; but that the USPTO did not acknowledge receipt of the German application, the specification, and drawings of the German application on August 15, 2002. That is, the postcard receipt did not separately and specifically itemize application, specification, and drawings of the prior German application that were being submitted. As set forth in MPEP 503, a postcard receipt will **not** serve as *prima facie* evidence of receipt of any item that is not adequately itemized on the postcard, and specifically sets forth that a receipt bearing a general indication of the filing of an application will not, as here, serve as evidence of receipt of any missing pages. The contents of this file are the official records of what the USPTO received on August 15, 2002. The only part of the German priority document that was received on August 15, 2002, that can be located in the file is the cover page. Thus, since the postcard receipt in question did not separately list the contents of the German application allegedly being filed, but merely that an application was being filed, the instant postcard cannot be relied upon as evidence that the missing certified application, specification, and drawings in question were received at the USPTO on August 15, 2002.

Furthermore, while the parent PCT application (copy of record) was published with an indication that priority to the same German priority application had been claimed by applicant, such did not relieve applicant of his statutory obligation to file herein a certified copy of that German application, specification drawings, and other papers, as

required by § 119(b)(1994), first sentence.[4] Since the above-identified application was filed under 35 USC §§ 111(a), 365(c), and 37 CFR 1.53(b) as a continuing application of the parent PCT application, and did not constitute a national stage filing of the parent PCT application under 35 USC 371, applicant was obligated as a condition of claiming benefit herein of the German application, to timely file in the USPTO a certified copy of the German priority application. See MPEP 1895.01, subpart F, under the caption "Continuation, CIP, Or Division of International Application filed under 35 U.S.C. 111(a)."[5]

As noted in MPEP 201.16, where, as here, the requirements of § 119(b)(1994) have not been satisfied in the application prior to issuance, and the requirements of 37 CFR 1.55 likewise have not been met, a Certificate of Correction does not lie, and the priority claim can only be perfected, if at all, by way of seeking reissue. As there is no adequate showing that (1) there is a mistake in the above-identified patent , which was (2) incurred through the fault of the Office, and (3) such mistake is clearly disclosed in the records of the Office, the USPTO has no basis in the patent statute or the rules of practice before the USPTO to issue the requested Certificate of Correction. See 35 U.S.C. § 254.

WITH RESPECT TO THE CERTIFICATE OF CORRECTION OF JANUARY 7, 2003

For the reasons given in both sections above, the request for the Certificate of Correction filed October 1, 2002, lacks any reasonable basis in the record for favorable treatment. The issuance of the Certificate of Correction on January 7, 2003, is facially

---

[4] There is no evidence in the record showing that the parent PCT application ever entered the national stage in the United States within the meaning of 35 U.S.C. § 371. The differences between, as here, a national application filed under 35 U.S.C. § 111(a) and a national stage application filed under 35 U.S.C. § 371, and what is respectively required to perfect a claim for foreign priority are further discussed in MPEP §§ 1895-1896.

[5] The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. In re Kaghan, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); Syntex v. U.S. Patent and Trademark Office, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); Litton Sys., Inc. v. Whirlpool Corp., 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

inconsistent with the contents of the administrative record of this file, the patent statute, the rules of practice, and the MPEP. The Certificate of Correction of January 7, 2003, incorrectly certifies that all of the the stringent requirements of § 119(b)(1994) have been fulfilled herein. As such, the Certificate of Correction of January 7, 2003, cannot be permitted to stand.

DECISION

Since the request for acknowledgment of the claim for foreign priority of the German application cannot be granted without the certified copy of the application, specification, drawings, and other papers, which had to be filed prior to issuance, petitioner's request is **denied**. Likewise, for the same reasons, as petitioner has failed to show there is an error in the issued patent, incurred by the Office and which error is disclosed by the records of the USPTO, the request for a Certificate of Correction is **denied**. The Certificate of Correction of January 7, 2003 is **vacated**.

The Certificate of Correction issued January 7, 2003, will be subject to a corrective Certificate of Correction in due course, indicating that no Certificate of Correction properly issued on that date. The following erratum will be duly published in the Official Gazette:

> All reference to the Certificate of Correction for Patent No. 6,445,699 B1 appearing in the Official Gazette of January 7, 2003, should be deleted since no Certificate of Correction was properly issued.

This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 701 *et seq*. for purposes of seeking judicial review. See MPEP 1002.02. The USPTO will not further consider or reconsider this matter.

This patent file is being forwarded to Certificate of Correction Branch for further processing consistent with this communication.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy