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OFFICE OF PETITIONS

In re Application of :
Griffis, et al. :
Application No.: 12/927,210 : ON PETITION
Filed: February 3, 2011 :
Attorney Docket No.: xAA-20 :

This is a decision on the “Request for Supervisory Review of Decision on Petition under 37 CFR 1.181 to Preserve the November 8, 2010 Filing Date and Accept At Least One Late Claim”, filed August 15, 2011.

The petition is **DENIED**¹.

BACKGROUND

The application was deposited on November 8, 2010. On November 30, 2010, the Office of Patent Application Processing mailed a Notice of Incomplete Non-Provisional Application stating, in pertinent part, that the application had not been accorded a filing date because the application did not contain a specification that included at least one claim. A “Petition to Accept at Least One Claim” was filed on February 3, 2011. The petition was treated under 37 CFR 1.53, and dismissed by a decision mailed March 28, 2011. On April 25, 2011, a “Request for Reconsideration and Renewed Petition to Preserve the November 8, 2010 Filing Date and Accept At Least One Late Claim under 37 CFR 1.17(f), 1.53(e), 1.57(a), 1.78(a)(1) & (2), and 1.115”, was filed. The petition was treated under 37 CFR 1.57 and dismissed by a decision mailed June 15, 2011. The subject “Request for Supervisory Review of Decision on Petition under 37 CFR 1.181 to Preserve the November 8, 2010 Filing Date and Accept At Least One Late Claim”, was filed on August 15, 2011.

STATUTES AND REGULATIONS

35 U.S.C. § 112 states, in pertinent part, that:

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for the purpose of seeking judicial review. See MPEP 1002.02.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

37 CFR 1.53(b) states:

(b)*Application filing requirements - Nonprovisional application.* The filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim § 1.53 pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date. A continuing application, which may be a continuation, divisional, or continuation-in-part application, may be filed under the conditions specified in 35 U.S.C. 120, 121 or 365(c) and § 1.78(a).

37 CFR 1.57 states:

(a)Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1)The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

(i)Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;

(ii)Supply an English language translation of any prior-filed application that is in a language other than English; and

(iii)Identify where the inadvertently omitted portion of the specification or drawings can be found in the prior-filed application.

37 CFR 1.183 states:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

PETITIONER'S ARGUMENT

Petitioner maintains that the application is entitled to a filing date of November 8, 2010.

Petitioner concedes that no claims accompanied the original application papers, but requests that

the claims filed February 3, 2011, be considered as part of the original disclosure deposited November 8, 2010, and the application be accorded a filing date of November 8, 2010.

Petitioner further argues that the application transmittal sheet filed November 8, 2010, contained what should be construed as a preliminary amendment containing a priority claim under 37 CFR 1.78 to a non-provisional application containing the omitted claims. Petitioner notes that there is a typographical error in the application number cited in the priority claim, but states that the first page of the application transmittal sheet reflects the correct application number to which priority is claimed. Because a priority claim under 37 CFR 1.78 was present on filing to a non-provisional application that contained the omitted claims, petitioner concluded that, pursuant to 37 CFR 1.57, the omitted claims contained in that non-provisional application should be incorporated by reference and the subject application considered complete as of November 8, 2010, and the same filing date accorded. Petitioner finally asserts that as a matter of good faith and justice, the Office should suspend the applicable rules and accord the application a filing date of November 8, 2010, notwithstanding the filing errors conceded by petitioner.

OPINION

Petitioner's arguments as set forth in the instant petition have been considered, but are not persuasive as petitioner does not establish that either at least one claim was present on November 8, 2010, or that the subject application made, on filing, a priority claim under 37 CFR 1.78 to a prior-filed application that completely contained the omitted claim(s). The subject application is not entitled to a filing date of November 8, 2010, as the specification did not contain at least one claim on that date and a priority claim under 37 CFR 1.78 to a prior-filed application that completely contained the omitted claims was not present on November 8, 2010. It is again noted that the priority claim under 37 CFR 1.78 may be corrected by way of a petition under 37 CFR 1.78, however, for the purposes of a petition under 37 CFR 1.57 the omitted items must be completely contained in the prior-filed application to which the subject application claims priority under 37 CFR 1.78 on filing, whether that priority claim is made in the first paragraph of the specification, or as the specification is amended by preliminary amendment on filing, or in an ADS. The subject application did not, on filing, make a priority claim under 37 CFR 1.78 to a prior-filed application that completely contains the omitted claims. Neither did the subject application contain at least one claim on November 8, 2010. The application is, therefore, not entitled to a filing date of November 8, 2010, but is entitled to a filing date of February 3, 2011, as this was the date the claims were filed and the application complete under 37 CFR 1.53.

The petition under 37 CFR 1.57 is also denied. As a threshold matter, the applications must be co-pending. Provisional application serial number 60/377,323 was filed on April 30, 2002, and thus expired on April 30, 2003. *See* 35 USC 111(b)(5). The present application papers were first submitted on November 8, 2010, well beyond one year from the filing date of the provisional application. Finally, the provisional application did not contain a claim. Further, as to the transmittal letter filed November 8, 2010, it is concluded that only "Section XI" of the transmittal letter can be construed as a preliminary amendment that makes a priority claim under 37 CFR 1.78. However, the proposed amendment does not reference the proper application

serial number that contained the omitted claim. The application, as it was filed, is not able to satisfy the requirements of 37 CFR 1.57. The petition under 37 CFR 1.57 is, therefore, denied.

Petitioner's assertion that, as a matter of fairness, the Office should forgive the filing errors of applicant, and accord the application a filing date of November 8, 2010, is unpersuasive. Pursuant to 37 CFR 1.183, the Office may, in an extraordinary situation, suspend or waive a requirement of the rules that is not also a requirement of the statute. It is noted that the requirement that a filing date for an application is the date on which the specification and at one least claim is received is a requirement of the statute, specifically 35 U.S.C. 112. As the United States Congress has mandated when a patent application is considered filed, the Office has no authority to waive or suspend that requirement. This is a precedence upheld in Howard Florey Institute v. Dudas, 87 USPQ2d 1913 (E.D. Va. 2008), in which the United States District Court determined that, even in the face of an otherwise extraordinary situation, the Office has no authority to waive or suspend a requirement of the rules that is also a requirement of the statutes. Accordingly, petitioner's argument unavailing as the Office has no authority to waive or suspend the requirement that at least one claim be present in order to accord an application a filing date as this requirement is a requirement of the statute, as well as the governing rules.

For the reasons stated above, the petition is **DENIED**. Therefore, the application will not be accorded a filing date of November 8, 2010, but will retain the filing date of February 3, 2011.

The application file is being directed to the Office of Patent Application Processing for further review.

Telephone inquiries concerning this matter may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Anthony Knight
Director
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