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OFFICE OF PETITIONS

In re Application of :
Roman I. PANKIW et al. :
Application No. 11/567,944 : **ON PETITION**
Filed: July 31, 2007 :
Attorney Docket No. 270262.105NP :

This is a decision on the renewed petition filed March 29, 2010, requesting reconsideration of the petition for grant of the filing date of December 7, 2006 for the above-identified application.

BACKGROUND

On December 7, 2006, an attempt at filing the instant application was made, the submission consisting of a two-page fee worksheet and an authorization to charge deposit account 50-3325 for the utility filing, search, and examination fees in the instant application. On July 31, 2007, petitioners filed a petition and petition fee, as well as arguments in favor of an earlier filing date of December 7, 2006 and supporting documentation including 28 pages of specification, a one-page abstract of the disclosure, and nine pages of drawing figures. Petitioners asserted that despite repeated attempts to obtain a filing receipt for the instant application, one could not be generated because the application could not be located.

A decision dismissing that petition was mailed January 28, 2010 because petitioners were unable to establish within the meaning of 37 C.F.R. 1.53(b) and 35 U.S.C. 111(a)(4) that papers comprising an application, namely a specification including at least one claim and drawings, if required for understanding of the invention, were received in the U.S. Patent and Trademark Office on December 7, 2006.

Petitioners now come forward with additional arguments in favor of according a filing date of December 7, 2006 to the instant application.

STATUTE, REGULATION & POLICY

35 U.S.C. 2(b)(2) states, in part:

[(b) SPECIFIC POWERS – The Office -]

- (2) may establish regulations, not inconsistent with law, which —
- (A) shall govern the conduct of proceedings in the Office;
- (B) shall be made in accordance with section 553 of title 5;
- (C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

35 U.S.C. 111(a)(4) states, in part:

“The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.”

35 U.S.C. 119(e)(1) states, in pertinent part:

(e)(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

35 U.S.C. 363 states, in part:

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

35 U.S.C. 364(b) states:

(b) An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Director of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with.

37 C.F.R. 1.53 states, in pertinent part:

(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 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 C.F.R. 1.57(a) states, in pertinent part:

(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).

PCT Article 11(1) states, in pertinent part:

(1) The receiving Office shall accord as the international filing date the date of receipt of the international application, provided that Office has found that, at the time of

receipt:

- (i) the applicant does not obviously lack, for reasons of residence or nationality, the right to file an international application with the receiving Office,
- (ii) the international application is in the prescribed language,
- (iii) the international application contains at least the following elements:
 - (a) an indication that it is intended as an international application,
 - (b) the designation of at least one Contracting State,
 - (c) the name of the applicant, as prescribed,
 - (d) a part which on the face of it appears to be a description,
 - (e) a part which on the face of it appears to be a claim or claims.

The Legal Framework for EFS-Web in effect on December 7, 2006 states, in pertinent part:

“What is the date of receipt of an application received under the EFS-Web?”

35 USC 111(a)(4) states in part (emphasis added):

The filing date of an application shall be the date on which the specification and any required drawing are **received in the Patent and Trademark Office**.

Thus, the filing date of an application is the date of receipt of the application in the USPTO. Further, the USPTO is located in the Eastern Standard Time zone. Accordingly, the date of filing of an application officially submitted through EFS-Web will be the date in the Eastern Standard Time zone at the time of submission. As such, the submission’s “date of receipt”, as shown on the Acknowledgement Receipt, is the Eastern Standard Time date that the documents are fully, successfully, and officially received at the USPTO as indicated by pressing the Submit Button on the Confirm and Submit screen. This date is controlling for filing date purposes of your newly filed application. There is no “certificate of transmission” practice for new application e-filings (37 CFR 1.8).

DISCUSSION

Petitioners continue to advance arguments in favor of according a filing date of December 7, 2006 to the instant application. However, 35 USC 111(a)(4) is unambiguous in its reading as it applies to according a filing date to an application.

Although the minimum requirements of the statute to accord a filing date to the instant application were not met until July 31, 2007, petitioners now argue that an earlier filing date should be accorded to the instant application because “the USPTO was in possession of petitioner’s specification (including claims) and any required drawings on December 7, 2006 by virtue of Petitioner’s U.S. provisional applications, U.S. 60/748,239 (US ‘239)(Exhibit C) filed on December 7, 2005 and U.S. 60/789, 905 (US ‘905) filed on April 6, 2006 (Exhibit D).” See Petition at page 2. This argument is unpersuasive. The filing of a provisional application is a separate matter from the filing of a nonprovisional application and is addressed by a different

section of the patent statutes and patents rules. Each application type has its own filing requirements that must be met.

At best, it appears that petitioners are attempting to avail themselves of the procedure under 37 C.F.R. 1.57(a). If all or a portion of a specification or drawings is inadvertently omitted 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). However, as the instant application did not include a specification or Application Data Sheet (ADS) upon filing on December 7, 2006, a priority claim was not present. Therefore, relief under 37 C.F.R. 1.57(a) may not be obtained.

Petitioners further argue that petitioners will suffer inequitable loss of patent rights due to purported USPTO error. In particular, petitioners argue that the USPTO did not provide specific notice to petitioners that the electronically filed application of December 7, 2006 was defective or incomplete, and/or that the USPTO failed to maintain its computer system for a reasonable user to adequately operate and to understand whether an application has been electronically filed correctly and completely. As previously stated in the decision dismissing petition, mailed January 28, 2010, petitioners were, in fact, promptly notified of the documents received by the USPTO via Electronic Acknowledgement receipt generated at the time the documents were filed. Petitioners' apparent failure to review this document does not shift the burden for failure to secure the desired filing date to the USPTO. Petitioners' attention is once again directed to the electronic acknowledgement receipt generated moments after filing at 3:02:59 pm on 07-DEC-2006. In the "Application Details" section, filing of only a two-page file titled "fee-info.pdf" is evidenced. The electronic acknowledgement receipt includes the following language warning applicants of the effect of the Receipt and a clear indication of what was received in this submission:

"This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application."

If petitioners' had reviewed the acknowledgement receipt after filing, petitioners would have recognized which documents were filed with the submission on December 7, 2006 and supplied

the missing documents as follow-on papers in the instant electronic record on even date or re-filed the instant application by Express Mail Post Office to Addressee service as a safeguard against losing the desired filing date. Petitioners' attempts to shift the burden to the USPTO for petitioners' loss of patent rights is inappropriate as the responsibility for meeting the filing deadlines set forth in 35 U.S.C. 119(e) resides wholly with petitioners.

As provided in 35 U.S.C. 2 (b)(2), the USPTO may establish regulations not inconsistent with law to, *inter alia*, to facilitate and expedite the processing of patent applications. Therefore, the USPTO is without authority to waive the laws enacted by the Congress and therefore the requirements of the statute(s) in its business of according filing dates to patent applications.

Petitioners further argue that the USPTO failed to correct and provide notice of system errors (presumably relating to new application filings in EFS-Web). Petitioners present announcements of new software releases that petitioners allege "fix" known problems that existed on December 7, 2006 however petitioners further argue that there are no contemporaneous public notices by the USPTO cautioning users of the problems prompting system upgrades. Petitioners point to notices released on July 8 and October 31, 2007 which guidance regarding system upgrades that permit users to view the status of documents as they are uploaded and that give users more helpful warning messages when attaching documents (for upload). Petitioners assert that the existing warning messages were inadequate for the users to know whether or not their attachments were uploaded.

Again, petitioners' arguments are unpersuasive. It is first noted that enhancements and system upgrades to EFS-Web are not evidence of a system that is broken or fails to function. Rather, such enhancements support the USPTO 2007-2012 Strategic Plan, and at least one of the USPTO's goals, enhanced automation. Petitioners' arguments that the existing warning messages were inadequate for the users to know whether or not their attachments were uploaded are speculative and similarly unpersuasive. Again, it is noted that EFS-Web was functioning properly at the time of the attempted submission of the instant application. At that time, petitioners were in receipt of the most compelling piece of evidence as to what documents were received by the USPTO on December 7, 2006 – the Electronic Acknowledgement Receipt – yet petitioners apparently failed to review or appreciate the content thereof. Having been issued this receipt, petitioners cannot be heard to complain that they were not made aware of which documents were received by the Office on December 7, 2006.

Petitioners further argue that denial of the instant petition to accord the earlier filing date of December 7, 2006 is against public policy. Petitioners argue that the grant of the instant petition would preserve the patent rights of the petitioner and certain rights of the DOE. Petitioners speculate that, *inter alia*, the commercial value of the invention without protection under the Patent Laws may not be sufficient for petitioner to continue development and commercialization of the invention, thereby depriving the general public of the advanced technology at the soonest possible moment or possibly not at all (Petition, at paragraph C, pg. 10). As noted above, the USPTO is without the authority to waive the laws enacted by the Congress. Therefore, uniform application of the law, as here, is well within the interest of Public Policy.

Petitioners additionally argue that they will suffer damage or injury if the instant petition is not granted. Petitioners point to two reports published by the DOE in April and June of 2006, respectively. Petitioners speculate that the failure to accord the desired filing date to the instant application causes petitioners to fail to meet the statutory requirements of 35 U.S.C. 102(b) by filing an application more than one year from the public disclosure of petitioners' invention. As has been repeatedly stated in this decision, 35 USC 111(a)(4) is unambiguous and the requirements thereof cannot be waived. It is unfortunate that petitioners' did not complete the filing requirements of this application prior to expiry of the provisional application to which petitioners desired to claim priority within the almost six remaining months following publication of the last report by DOE.

Last, petitioners argue that there is an inequitable loss of patent rights due to a purported lack of harmony between U.S. patent law and the Patent Cooperation Treaty (PCT). Petitioners argue that abandoned international applications under the PCT can be revived, but that domestic provisional applications under 35 U.S.C. 111(b)(5) cannot be revived. Petitioners speculate that most applicants in filings accepted under 35 U.S.C. 371 are foreign applicants and therefore, it is against public policy to treat foreign entities more favorably than U.S. entities. Assuming for the sake of argument that there is some unfairness in the patent statutes, petitioners' argument is with the U.S. Congress since the USPTO does not have the authority to waive a requirement of the statutes. However, upon reviewing petitioners' argument there does not appear to be a lack of harmony in the law.

First, 35 U.S.C. 363 specifically provides "An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title." The International Application and a filing under 35 U.S.C. 371 therefore have the same filing date. The mere submission of filing fees, as were filed in the instant application on December 7, 2006, would have been insufficient to, at the least, meet the requirements of PCT Article 11(1) for obtaining a filing date in an international application since under Article 11(1), an applicant would have to provide a specification and a claim in order to obtain a filing date. Second, 35 U.S.C. 364(b), specifically provides that "An applicant's failure to act within prescribed time limits in connection with requirements pertaining to a pending international application may be excused upon a showing satisfactory to the Director of unavoidable delay, to the extent not precluded by the treaty and the Regulations, and provided the conditions imposed by the treaty and the Regulations regarding the excuse of such failure to act are complied with." However, as provided by 35 U.S.C. 111(b)(5), no request to treat application 60/748,239 as a filing under 35 USC 111(a) was made during the 12-month pendency of the provisional application. Therefore, according to 35 U.S.C. 119(e), as an application for patent under section 111(a) or section 363 of this title was not filed within 12 months after the date on which the provisional application was filed, the instant application shall not be entitled to the benefit of the earlier-filed provisional application.

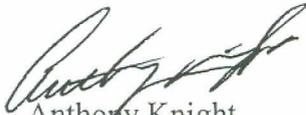
CONCLUSION

Accordingly, the petition is DENIED.

This decision is a final agency action within the meaning of 5 USC 704 for purposes of seeking judicial review.

At the writing of this decision on petition, the instant application is abandoned by operation of law for failure to prosecute¹. Thus, no further action will be undertaken in this application and the application remains in abandoned status.

Any inquiries related to this decision should be directed to B. Dayoan at (571) 272-3209.



Anthony Knight
Director
Office of Petitions

cc: Meyer, Unkovic & Scott LLP
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¹ 35 U.S.C. 133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.