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OFFICE OF PETITIONS

In re Application of :
Lei et al. :
Application No. 12/319,225 : **DECISION DENYING PETITION**
Filing or 371(c) Date: 01/03/2009 :
Attorney Docket Number: :
100544-5001-US :

This is a decision in reference to the "REQUEST FOR RECONSIDERATION OF RENEWED PETITION TO ACCORD FILING DATE UNDER 37 § CFR 1.10(c)," filed January 11, 2010, requesting that the above-identified application be accorded a filing date of December 31, 2008, rather than the presently accorded filing date of January 3, 2009.

The Petition is DENIED.¹

BACKGROUND

On January 3, 2008 the application was filed.

On April 3, 2009, Applicants filed a petition under 37 CFR 1.10(c), wherein Applicants alleged that the application was deposited in Express Mail service on December 31, 2008.

On April 27, 2009, the petition was dismissed.

On June 29, 2009 a renewed petition was filed.

On July 9, 2009 the renewed petition was granted; however, on November 10, 2009 the decision was vacated and the petition was dismissed.

The present request for reconsideration

Applicants file the present request for reconsideration and provide that four patent applications were present in the same Express Mail Envelope that was deposited with the United States Postal Service on December 31, 2008. Three of the four applications, including the above-identified

¹ This is a final agency action. See, MPEP 1002.02.

application, received a filing date of January 3, 2009; however, one application present in the Express Mail Envelope received a filing date of December 31, 2008. Applicants submit a copy of the return-receipt postcard from this Office, and the stamped Express Mail Certificate, and aver that the date-stamp from this Office establishes a filing date of December 31, 2008 for one of the applications present in the same express mail envelope as the subject application. Applicants also notes that the Express Mail Number listed on the postcard of the application which received the filing date of December 31, 2008, is identical to the Express Mail number listed on the postcard in the present application. Applicants submit that given that one of the applications received a filing date of December 31, 2008, that this Office accept this as evidence that the above patent application was in fact deposited in Express Mail Service on December 31, 2008.

STATUTES AND REGULATIONS

35 U.S.C. 21(a) states:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered filed in the Office on the date on which it was deposited with the United States Postal Service or would have been deposited with the United States Postal Service but for postal service interruptions or emergencies designated by the Director.

37 C.F.R. 1.10 Filing of correspondence by "Express Mail," states

(a)...

(b)...

(c). 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 there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(i) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(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 true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit...

(emphasis added)

OPINION

The placement of the Express Mail label number on a paper ties the paper to a single, identifiable Express Mail receipt. Where questions are later raised concerning the filing date of the paper, the USPTO may require the applicant to supply a copy of the Express Mail receipt identified on the paper in order to verify the mailing date. Where no Express Mail label number is identified on a paper, the USPTO has no way of independently associating the paper with any particular Express Mail receipt.

The difficulty caused by an applicants failure to place an Express Mail label number on a paper is clearly illustrated by this case. Since no Express Mail label number was placed on the application papers prior to mailing, the USPTO has nothing in its control from the filing date of the papers to independently corroborate the applicants' assertion that the application was filed on December 31, 2008.

Simply put, in view of the USPTO regulations and policies, there is no basis to consider a document which itemized the application papers and was returned to the applicants a cover sheet, which is part of the application papers, rather than a postcard, which is not part of the correspondence filed in the Office. As no document containing the Express Mail label is located among the papers in the official IFW file, the requirements of 37 CFR 1.10(c) have not been satisfied.

MPEP 513(III) states, in pertinent part, that to be effective, the 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.

A similar situation was addressed by the U.S. District Court for the Eastern District of Virginia in the recent case of *O'Shannessy v. Doll*.² In *O'Shannessy*, applicant asserted that the Express Mail number, placed on the return receipt postcard, should be considered to be present on the application papers as deposited in the USPTO. In a memorandum opinion, the court agreed with the USPTO's interpretation that the return receipt postcard was not part of "the paper(s) or fee(s) that constitute the corresponaence."³ In pertinent part, the *O'Shannessy* court stated:

² Action No. 1:08cv01 (May 20, 2008).

³ Id.

[I]t is clear that a return receipt postcard serves no purposes other than to provide an applicant with an acknowledgement that the USPTO received his or her application documents and fees filed with the USPTO by utilizing the USPS's "Express Mail" service. Because the USPTO does not retain the postcard, but rather returns it to the applicant, the postcard is not part of "the paper(s) or fee(s) that constitute the correspondence" filed with the agency; its returned to the applicant.⁴

The evidence and arguments considered have been carefully considered, but are not persuasive of Applicants' entitlement to a filing date of December 31, 2008. In order to obtain a filing date under 37 CFR 1.10, however, petitioners must establish to the satisfaction of the Director that the original application papers were properly deposited in Express Mail Service on December 31, 2008. In this case, Applicants have not provided sufficient evidence to support their entitlement to a filing date of December 31, 2008. Accordingly, Applicants have failed to meet their burden.

The previous decision has been reconsidered as requested. However, the petition is denied.

The application file is being referred to the Office of Patent Application Processing for further processing with the presently accorded filing date of January 3, 2009.

Telephone inquiries concerning this matter should be directed attorney Derek Woods at (571) 272-3232.



Anthony Knight
Director
Office of Petitions

⁴ Id.