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OFFICE OF PETITIONS

In re Application of	:	
Henning, et al.	:	
Application No. 11/381,841	:	DECISION ON PETITION
Filed/Deposited: 26 February 2008	:	
Attorney Docket No. 166034 SAR 605A	:	

This is a decision on the petition (thrice renewed) filed on 4 November 2010, alternatively pursuant to the provisions of 37 CFR §1.181 and 37 CFR §1.182—and properly considered as a petition requesting that the instant application be accorded a filing date of 5 May 2006, in view of the regulations at 37 CFR §1.53; and finally, also seeking waiver of the rules under 37 CFR §1.183.

The petition under 37 CFR §1.181 for invocation of the supervisory authority of the Director is **granted to the extent indicated** in that a review has been made of the file. However, petitioners' request for an earlier filing date under 37 CFR 1.53 is **DENIED**;

The petition under 37 CFR §1.182 is **DENIED**; and

The petition under 37 CFR §1.183 is **DENIED**.

This is a **final agency action** within the meaning of 5 USC §704.

BACKGROUND

The record herein reveals:

Petitioners acknowledged that on 5 May 2006, a single document (a two-page, Fee Worksheet) and corresponding fees were deposited with the United States Patent and Trademark Office (the Office) *via* the Office's electronic filing system (referred to herein as EFS or EFS web). At that time, the Office issued an Electronic Acknowledgment Receipt that reflected receipt by the Office of that document and the associated fees.

Petitioners took no action until 1 November 2006, at which time Petitioners filed into the record an information disclosure statement (IDS). On 26 February 2008, twenty-one (21) months after the original two-page submission, Petitioners filed into the record: a two-page Power of Attorney; a two-page oath/declaration; 13 pages of specification, including therein one page of claims and a one-page abstract.

On 28 February 2008, the Office of Patent Application Processing (OPAP) mailed a Notice of Incomplete Application (the Notice) and indicated therein that the papers as deposited on 5 May 2006, had not been accorded a filing date (to wit: "the specification is missing *** the specification does not include at least one claim. A complete specification as prescribed by 35 USC §112 is required."). (The Notice also indicated that no fully executed oath/declaration was present on filing—however, this element was a "missing part" of the application and not controlling as to a filing date.) OPAP indicated that Petitioners might:

- 1) Accept February 26, 2008 as the filing date of the application;
- 2) Petition that the items necessary to accord a filing date were previously submitted; or
- 3) Petition for an earlier filing date by relying upon an incorporation by reference to a previously filed copending application under 37 CFR 1.57.

OPAP set a two-month period for reply.

On 29 February 2008, the Office mailed a filing receipt according a filing date of 26 February 2008, to the instant application. Thus, the application had been accorded a filing date as 26 February 2008—not of 5 May 2006.

On 3 March 2008, Petitioners submitted a petition pursuant to the regulations at 37 CFR §1.181, §1.182 and seeking waiver pursuant to 37 CFR §1.183, including therewith, *inter alia*, an averment that the entire application was prepared by the attorney of record and he directed his then-assistant to file the application. Petitioners' attorney acknowledged that he received from the Office on 5 May 2006, a two-page Electronic Acknowledgment Receipt that set forth an application number, statement of fees received in the amount of \$1,000.00, and indication of a single file received identified as fee-info.pdf in a file size totaling but 8403 bytes and only two pages in length.

The petition was dismissed on 30 September 2008, for failing to make the showings required.

On 18 December 2008, Petitioners resubmitted a petition pursuant to the regulations at 37 CFR §1.181, §1.182 and sought waiver pursuant to 37 CFR §1.183. The petition was dismissed on 29 September 2009, for failing to make the showings required.

On 14 October 2009, Petitioners renewed the petition pursuant to the regulations at 37 CFR §1.181 and §1.182, and also sought waiver pursuant to 37 CFR §1.183. However, Petitioners made no new showing in any of these regards. The petition was dismissed on 7 September 2010, for failing to make the showings required.

Petitioners renewed the petition on 4 November 2010, and presented the following four (4) arguments:

1. "THE OFFICE FAILED TO FOLLOW ITS OWN RULES AT A CRUCIAL PHASE"
2. "A DESIGN FLAW IN THE ELECTRONIC FILING SYSTEM WAS A FACTOR CAUSING APPLICANTS' ATTORNEY TO BE MISLED."
3. "ACCEPTANCE OF DOCUMENTS FILED SUBSEQUENT TO ORIGINAL FILING DATE VIA EFS IMPLIED TO APPLICANTS' ATTORNEY THAT ORIGINAL FILING DATE WAS VALID."
4. "APPLICANTS WERE DILIGENT IN PETITIONING FOR THE FILING DATE AND AT ALL TIMES DURING THE PETITION PROCESS."

STATUTE, RULES AND PROCEDURE

35 USC 111(a)(4)

(4) FAILURE TO SUBMIT. —Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. 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.

37 CFR 1.53(a) and (b)

(a) Application number. Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes.

(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 USC 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 USC 120, 121 or 365(c) and § 1.78(a).

37 CFR 1.181(a)(1)

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court

37 CFR 1.182

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183

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).

1286 Official Gazette 113, September 17, 2004

C. At the USPTO, the electronic files are checked for technical compliance, virus infection and integrity. Under normal circumstances, the digital signature (part of the public key infrastructure (PKI)) on the document package will prove valid, thus assuring that the files were not altered from the time they were signed. An electronic Acknowledgement Receipt including the Application Number and a Confirmation Number will be produced and sent securely to the applicant as proof of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission. The applicant will retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. The Acknowledgement Receipt serves as an "Electronic Post Card" and is assurance to the applicant in the event evidence of filing is ever needed.

An electronic Acknowledgement Receipt, however, does not guarantee that the application meets all the USPTO requirements for a filing date. For example, if a non-provisional application submission does not include required claims, the filing date will be granted when this omission is corrected by applicant.

What is the force and effect of the Acknowledgement Receipt sent by the USPTO under the EFS?

The electronic Acknowledgement Receipt is not the official filing receipt for the application. The paper Filing Receipt (37 CFR Sec. 1.54), PTO Form-103X, is sent after printing the application in step 8 in Attachment 1 below, and reviewing the submitted application parts for compliance with 35 USC Sec. 111 filing date requirements and will indicate the official filing date. However, the Acknowledgement Receipt establishes the date of successful submission of the associated documents, and is thus a crucial part of the application process in establishing the applicant's filing date.

What is the value of the Acknowledgement Receipt if a problem occurs?

If the printed version of any document received by the EFS is unreadable, and if it cannot be recovered from the stored files received by electronic submission, then the applicant will be promptly notified by phone, fax or e-mail as indicated in the EFS instructions. Even with prompt processing, if the volume of submissions is high the Office review may take place a few days or weeks later. If an error occurs and the application cannot be reconstructed, the applicant may have to resubmit the application and petition for the original filing date. Such events are expected to be rare. Under this scenario, the applicant would present 1) the Acknowledgement Receipt, 2) a paper version and an electronic version (on floppy disk or CD-R) of the files as submitted and 3) a petition verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt will establish that the resubmitted documents were exactly those submitted on the date of receipt.

What is the date of receipt of an application received under the EFS?

The application's "date of receipt" is the date that it is fully and successfully received at the USPTO, as shown on the Acknowledgement Receipt. The date at the USPTO is controlling for the purposes of original patent applications. There is no "certificate of transmission" practice for non-provisional or provisional application e-filings (37 CFR 1.8). However, because of the automated processes involved, applicants can usually "see" their submissions over the Internet in the

Private PAIR (Patent Application Information Retrieval) system a short time after submission, which is a significant reassurance of successful receipt.

DECISION

37 CFR 1.181 and 37 CFR 1.53

As to Petitioners' contention that the office failed to follow its own rules at a crucial phase is not supported by the record.

The record is clear—and Petitioners do not dispute—that immediately upon the 5 May 2006, deposit of the single a two- page Fee Worksheet and fees, the Office issued and Petitioners received an Electronic Acknowledgment Receipt reflecting receipt by the Office of the Fee Worksheet and the fees. No other items were deposited and no other items were listed on the Electronic Acknowledgment Receipt.

Notwithstanding the attempt, Petitioners cannot burden the Office with their own failure to consider the content of the 5 May 2006, Electronic Acknowledgement Receipt, which stated Petitioners' payment of \$1,000.00 and specified only one document received by the Office from Petitioners as follows:

<u>Document Number</u>	<u>Document Description</u>	<u>File Name</u>	<u>File Size (Bytes)</u>	<u>Multi Part</u>	<u>Pages</u>
1	Fee Worksheet (PTO-875)	fee-info.pdf	8403	no	2

Having already indicated that Petitioners received the Electronic Acknowledgment Receipt on 5 May 2006, Petitioners nonetheless complain that the failure to receive further Notice from the Office was prejudicial and that they “did not have a timely opportunity to correct the problem of missing specification and claims”. This is a complaint with which Petitioners persisted across the years, though it was Petitioners and not the Office that failed to attend properly from 5 May 2006, and thereafter to the submission of application materials on 26 February 2008. Whether a Notice of Incomplete Application is normally mailed within 4 – 6 weeks is irrelevant since a receipt was given to petitioners upon submission of the documents on 5 May 2006.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered “unavoidable” due to: (1) the applicant's reliance upon oral advice from Office employees; or (2) the Office's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985); *see also In re Colombo, Inc.*, 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994) (while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Petitioners contend that a design flaw existed in the electronic filing system and was a factor causing applicants' attorney to be misled. The record does not support this claim. Applicants received a receipt that indicated what documents were received. Further, petitioners had access to private PAIR and thus could review the contents of the file wrapper at any time electronically. Petitioners' failure to review the receipt or to access private PAIR does not relieve petitioners of the legal requirement of submitting the application (specification, claims and drawing if necessary to understand the invention) to the US Patent and Trademark Office. As is clear from the record, no actions were taken by the Office to misled applicants as to the true nature of this case.

Petitioners argue that:

The electronic filing system (EFS) was in its infancy at the time this application was filed and the USPTO was trying to encourage applicants to use it rather than the "legacy" system of Express Mailing a patent application with a postcard listing the documents which were Express Mailed. Attorneys were trying to learn how the ES system worked and could be used at the time, and were also trying to train staff to use the system and it worked.

This argument is without merit. At the time the original document was submitted, the procedure for filing via EFS web was set forth in the Official Gazette at 1286 *Off. Gaz. Pat. Office* 113 (17 September 2004):

An electronic Acknowledgement Receipt including the Application Number and a Confirmation Number will be produced and sent securely to the applicant as proof of a successful submission. The Acknowledgement Receipt also lists the files received by the USPTO with the name and the size of each file, and includes a unique Message Digest code that is derived from the submission. The applicant will retain this Acknowledgement Receipt as clear evidence that on the date noted the files were successfully received by the USPTO. The Acknowledgement Receipt serves as an "Electronic Post Card" and is assurance to the applicant in the event evidence of filing is ever needed.

An electronic Acknowledgement Receipt, however, does not guarantee that the application meets all the USPTO requirements for a filing date. For example, if a non-provisional application submission does not include required claims, the filing date will be granted when this omission is corrected by applicant. (Underlining added).

From the inception of the EFS filing system, applicants were instructed to review the acknowledgement receipt received when submitting documents via EFS web. Further, a filing date for applications submitted via EFS web can only be accorded as of the date all requirements of 35 USC 111(a)(4) have been met. In this instance the filing requirements of 35 USC 111(a)(4) were met 26 February 2008.

Petitioners contend that acceptance of documents filed subsequent to original filing date via EFS implied to applicants' attorney that the original filing date was valid. The record does not support this claim.

Petitioners argued:

An additional error on the part of the EFS was to have accepted subsequent papers filed under the assigned serial number, namely an assignment was recorded and an IDS was filed and accepted. Petitioners respectfully suggest that it was reasonable to rely on the fact that subsequent papers were accepted for the belief that the application was properly filed.

In answer to this argument, first, an assignment is properly filed with the Assignment Branch and is not part of the patent application. Thus the fact that an assignment document was accepted has no bearing on the filing requirements of a patent application. The recording of an assignment document is a ministerial act, see Manual of Patent Examining Procedure (MPEP) 301(V), and such assignments are not placed in the application file, MPEP 318. Thus acceptance of an assignment does not prove the filing of an application.

Moreover, whether an application number is assigned to the papers is not indicative of whether the papers are in fact an application. In accordance with 37 CFR 1.53(a), "Any papers received in the Patent and Trademark Office which purport to be an application for a patent will be assigned an application number for identification purposes." Thus the assignment of an application number is not demonstrative of an application having been filed.

Finally, it is not necessary to address the question of diligence in this matter given the basis for this decision.

37 CFR 1.182

A petition under 37 CFR §1.182 is appropriate in the absence of relief being available under another regulatory provision—such as a petition under 37 CFR §1.53 or alternatives as indicated in the Notice mailed 28 February 2008. Accordingly, the petition under 37 CFR 1.182 is denied.

37 CFR 1.183

In order to submit a grantable petition pursuant to 37 CFR § 1.183, Petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). Petitioners have not established, *or even asserted*, that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules. Moreover, Petitioners have not set forth which Rule they wish suspended. In fact, it is not a rule that would be required to be suspended but 35 USC 111(a), the statute. The USPTO is without authority to waive the statute.

The regulations at 37 CFR §1.183 is clear and unambiguous as to the conditions required for their invocation to suspend the rules, to wit: "an extraordinary situation, when justice requires." Petitioners' failure to: (a) review the Electronic Acknowledgment Receipt when received on 5 May 2006, and (b) inquire into the matter for some twenty-two (22) months does not create an "extraordinary situation."

Assuming for arguments sake only that the USPTO could suspend the requirement, it should not relax the requirements of established practice to save an applicant from the consequences of his delay. See *Ex Parte Sassin*, 1906 Dec. Comm'r. Pat 205, 206 (Comm'r Pat. 1906) and compare *Ziegler v. Baxter v. Natta*, 159 USPQ 378, 379 (Comm'r Pat. 1968). Circumstances resulting from applicant's or applicant's counsel's failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interest of justice require the granting of relief. See *In re Tetraflour, Inc.*, 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990). Accordingly, petitioners have not provided an adequate showing of "an extraordinary situation" in which "justice requires" suspension of the requirement for a complete application upon filing. See generally *Nitto Chem. Indus. Co. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers).

CONCLUSION

The petition under 37 CFR §1.181 for invocation of the supervisory authority of the Director is **granted to the extent indicated** in that a review has been made of the file. However, petitioners' request for an earlier filing date under 37 CFR 1.53 is **DENIED**;

The petition under 37 CFR §1.182 is **DENIED**; and

The petition under 37 CFR §1.183 is **DENIED**.

This decision is a final agency action within the meaning of 5 USC §704 for purposes of seeking judicial review. Telephone inquiries regarding this decision may be directed to John J. Gillon, Jr. at (571) 272-3214.

This application is released to the Technology Center for further processing in due course.



Anthony Knight
Director
Office of Petition