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OFFICE OF PETITIONS

In re Application of :
Jon Owen NAGY et al. :
Application No. 11/985,290 :
Deposited: November 14, 2007 :
Attorney Docket No. 20061111.002 :

ON PETITION

This decision is in response to the renewed petition under 37 CFR 1.183 filed October 24, 2011 requesting waiver of the requirements of 37 CFR 1.10(d)(3) to accord the above-identified application a filing date of November 13, 2007.

The petition is **DENIED¹**.

BACKGROUND

The above-identified application was deposited with the USPTO on November 15, 2007 and was accorded a filing date of November 14, 2007 based upon the "date in" on the "Express Mail" label in accordance with 37 CFR 1.10.

On November 20, 2007, a petition under 37 CFR 1.10(d) was filed requesting that the application be accorded a filing date of November 13, 2007.

A decision dismissing the petition of November 20, 2007 was mailed February 3, 2010.

On April 3, 2010, a petition requesting waiver of the provisions of 37 CFR 1.10 was filed.

A decision dismissing the petition of April 3, 2010 was mailed January 6, 2011.

On March 7, 2011, a petition requesting reconsideration of the petition decision mailed January 6, 2011 was filed.

A decision dismissing the petition of March 7, 2011 was mailed August 22, 2011.

The instant petition was filed October 24, 2011.

STATUTE AND REGULATION

35 U.S.C. 21 states:

(a) 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 CFR 1.10 states, in pertinent part:

(a)(1) Any correspondence received by the U.S. Patent and Trademark Office (USPTO) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

(2) The date of deposit with USPS is shown by the "date in" on the "Express Mail" label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the USPTO receipt date as the filing date. See § 1.6(a).

(b) Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

(d) 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 the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Director to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;

(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 showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit

of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

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).

MPEP 513(VI) states:

The showing under 37 CFR 1.10(d) must be corroborated by (1) evidence from the USPS, or (2) evidence that came into being after deposit and within one business day of the deposit of the correspondence as "Express Mail." Evidence from the USPS may be the "Express Mail" Corporate Account Mailing Statement. Evidence that came into being within one day after the deposit of the correspondence as "Express Mail" may be in the form of a log book which contains information such as the "Express Mail" number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of entry in the log.

The reason the Office considers correspondence to have been filed as of the date of deposit as "Express Mail" is that this date has been verified by a disinterested USPS employee, through the insertion of a "date-in," or other official USPS notation, on the "Express Mail" mailing label. Due to the questionable reliability of evidence from a party other than the USPS that did not come into being contemporaneously with the deposit of the correspondence with the USPS, 37 CFR 1.10(d) specifically requires that any petition under 37 CFR 1.10(d) be corroborated either by evidence from the USPS, or by evidence that came into being after deposit and within one business day after the deposit of the correspondence as "Express Mail."

A petition alleging that the USPS erred in entering the "date-in" will be denied if it is supported only by evidence (other than from the USPS) which was:

(A) created prior to the deposit of the correspondence as "Express Mail" with the USPS (e.g., an application transmittal cover letter, or a client letter prepared prior to the deposit of the correspondence); or

(B) created more than one business day after the deposit of the correspondence as "Express Mail" (e.g., an affidavit or declaration prepared more than one business day after the correspondence was deposited with the USPS as "Express Mail").

On the other hand, a notation in a log book, entered after deposit by the person who deposited the correspondence as "Express Mail" within one business day of such deposit, setting forth the items indicated above, would be deemed on petition to be an adequate showing of the date of deposit under 37 CFR 1.10(d)(3).

37 CFR 1.10(d)(3) further provides that a party must show that correspondence was deposited as "Express Mail" before the last scheduled pickup on the requested filing date in order to obtain a filing date as of that date.

OPINION

The application was filed November 14, 2007 via USPS Express Mail. Petitioner argues, however, that the application should be accorded a filing date of November 13, 2007 because petitioner arrived at the United States Post Office located at 2535 Midway Dr., San Diego, CA 92110-9998 (Midway Post Office) at 11:30 pm on November 13, 2007 fully expecting that a USPS employee would be present and willing to accept the correspondence associated with Express Mail Number EB078332853US and provide the desired "date-in" clearly marked on the Express Mail mailing label, as based upon past practice, the Midway Post Office accepted Express Mail correspondence during after lobby hours that routinely extended to 12 midnight. However, without public notice the Midway Post Office changed their policy regarding after hour service and only provided full service to 11:00 pm. Petitioner further argues that his reliance on the past actions of a government agency (*i.e.*, acceptance of Express Mail until 12 midnight) to guide activities should be considered reasonable and periodic personal visits or phone calls to a post office to learn otherwise should be considered outside the scope of a due care standard. Furthermore, petitioner states that while USPS employees were present, none would accept the correspondence and provide the desired "date-in" mark. Therefore, petitioner purchased Express Mail postage at 11:55 pm and deposited the correspondence in an Express Mail drop box located at the Midway Post Office. Petitioner cannot state what the last scheduled pick-up time on the drop box was. Additionally, petitioner states the application filing date of November 13, 2007 is necessary for claiming priority under 35 U.S.C. 119(e) to Ser. No. 60/858,849 filed November 13, 2006.

Accordingly, petitioner argues that the application should be accorded the filing date of November 13, 2007, and further requests waiver of 37 CFR 1.10(d)(3) under the provisions of 37 CFR 1.183 to permit the acceptance of the application papers and thus accord the instant application a filing date November 13, 2007, the date correspondence was placed in the Express Mail drop box.

Petitioners' arguments have been carefully considered, but are not found to be persuasive.

The provisions of 37 CFR 1.183 provide that "[i]n 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."

In order for grant of a petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rules. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case, much less that the unfortunate attempt to obtain a filing date by Express Mail of the instant application papers was due to circumstances beyond his control. Petitioner acknowledges that he attempted to file the application at the last moment and that after being refused service by the Midway Post Office after hours he deposited the correspondence in an Express Mail drop box without noting the last scheduled pick-up time. Petitioner should have known that the application may have been timely been filed by using the USPTO's Electronic Filing System. See 1240 *Off. Gaz. Pat Office* 45 (November 14, 2000).

Because the USPTO regulations are published in the Federal Register as required by the Federal Register Act, 44 U.S.C. §1505 (formerly 44 U.S.C. §§5, 7), they are binding, even in the absence of actual knowledge. See *e.g.*, Timber Access Industries Co. v. United States, 213 Ct. Cl. 648, 553 F.2d 1250, 1255 (1977); Andrews v. Knowlton, 509 F.2d 898, 905 (2d Cir.), *cert. denied*, 423 U.S. 873 (1975); United States v. Aarons, 310 F.2d 341, 345-48 (2d Cir. 1962); In re Pacific Far East Line, Inc., 314 F.Supp. 1339, 1348 (N.D. Cal. 1970), *aff'd*, 472 F.2d 1382 (9th Cir. 1973).

However, circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); Stevens v. Tamai, 366F.3d 1325 (Fed. Cir. 2004)(court denying priority due to counsel's admitted failure to follow the Rules of Practice of the USPTO); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 C.F.R. 1.8 not extraordinary situation warranting waiver of a rule). Indeed, it is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

Potential loss of priority rights is not deemed "extraordinary" within the meaning of 37 CFR 1.183. While an applicant may wait until the end of a 35 U.S.C. 119 priority year to file a U.S. application, the applicant does so at his or her peril. Those who file at the end of a statutory bar year (35 U.S.C. 102(b)) or a priority year (35 U.S.C. 119) do not leave any opportunity to overcome any error that might occur in filing the application. The PTO, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence 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). In the instant application, 35 U.S.C. 119 provided enough time for petitioner to properly file the instant application. Unfortunately, petitioner waited until the end of the 35 U.S.C. 119 priority year and failed to timely file this application with the USPTO.

While it is acknowledged that if 37 CFR 1.10(d)(3) is not waived, petitioners' application for patent may lose its right of priority under 35 USC 119, it is not enough to show that a great loss of rights will occur to justify suspension or waiver of the rules under 37 CFR 1.183 simply because the failure to comply with the application submission requirements was an avoidable oversight that could have been prevented by the exercise of due care or diligence, and is, hence, not an extraordinary event within the meaning of 37 CFR 1.183. See, Nitto Chemical Industry Co., Ltd. V. Comer, 37 USPQ2d 1778 (1994). (Commissioner's refusal to waive requirements of 37 C.F.R. 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 C.F.R. 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 C.F.R. 1.183). Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 C.F.R. 1.8 not extraordinary situation warranting waiver of a rule). Rather, as the USPTO did not cause or contribute to petitioner's filing the instant application papers by deposit in an "Express Mail" drop box with an unknown last scheduled pick-up time, as opposed to filing by *e.g.*, the Electronic Filing System, this is a circumstance that is even further removed from an "extraordinary situation" where "justice requires" an extraordinary remedy. See Helfgott & Karras, P.C. v. Dickinson, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

Moreover, no extraordinary circumstance has been shown to have occurred that precluded petitioners from timely depositing the correspondence directly with an employee of the USPS in accordance with 37 CFR 1.10 or electronically via the Electronic Filing System to ensure timely USPTO receipt of the application papers on the desired filing date. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985)(petitioner's failure to take adequate notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO).

Petitioner argues that this is an extraordinary situation because he knowingly placed the application papers in an "Express Mail" box after the last scheduled pickup for that day in order to seek relief from the refusal of an "uncooperative" USPS employee to accept an "Express Mail" package after closure of the "Express Mail" service at the post office before midnight. Petitioner has provided no evidence that the USPS received this package prior to November 14, 2007, *i.e.*, as set forth in 37 CFR 1.10(d)(3) evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. (Petitioner's declaration from Shelley P. Castellino, dated November 19, 2007, is not within one business day of November 13, 2007). While petitioner admits that he arrived at the post office after the last scheduled pickup for "Express Mail", petitioner would have one believe that the failure to timely deposit the application papers was the fault of the "uncooperative" USPS employee when in fact the failure to timely deposit the application papers by "Express Mail" was the fault of petitioner. The

refusal of the USPS employee to give petitioner the desired "date-in" is not an extraordinary situation as one would expect a disinterested USPS employee to refuse acceptance of an "Express Mail" package after the "Express Mail" window closed. Further, petitioner would have one believe that knowingly placing the application papers in an "Express Mail" box after the last scheduled pickup is the exercise of due care or diligence as it would preserve his right to request waiver of the rule. However, the salient issue here is whether or not one who knew that a filing date was required to preserve a 35 U.S.C. 119 priority date would have exercised due care or diligence by depositing the application papers in the "Express Mail" box knowing that it was after the last scheduled pickup, or by, after knowing the "Express Mail" last schedule pickup time had passed, attempting to file the papers timely in another manner, *e.g.*, by the USPTO's Electronic Filing System. Given petitioner's admitted knowledge of an alternative remedy to obtain the desired filing date it is not seen how depositing the application papers after the last scheduled pickup is an avoidable oversight that could have been prevented by the exercise of due care or diligence. Furthermore, knowing that the filing date of this application was critical to preserving a priority date it was petitioner's responsibility to ascertain when the "Express Mail" service at the post office closed. Petitioner states that he has followed all the rules, and further argues that deposit of the application papers after the last scheduled pickup was not a violation of the rule and should be considered a prudent action. Petitioner is reminded that 37 CFR 1.10(d)(3) requires [a] showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. It is clear that these alleged actions are a violation of the procedures set forth in 37 CFR 1.10(d)(3) and as such are not the exercise of due care or diligence. In any event, to waive the requirements of 37 CFR 1.10, without any evidence of timely deposit of the papers in an "Express Mail" box is not an extraordinary situation where justice requires waiver of the rules.

Petitioner also argues the "unavoidable" standard set forth in MPEP 711.03(c)(II)(C)(2). Although the "unavoidable" standard deals with the revival of an abandoned application, petitioner equates that standard with the situation herein. Petitioner argues that he was relying upon the ordinary and trustworthy agencies of mail as usually employed in such important business and further argues that it was through the unforeseen fault or imperfection of the USPS that petitioner did not receive the filing date desired. Unfortunately, the unavoidable standard applies to 37 CFR 1.137 and not 37 CFR 1.183. 37 CFR 1.183 requires 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. No extraordinary situation exists here. Unfortunately, petitioner waited to the end of the priority year to file the instant application and arrived at the post office after the "Express Mail" window had closed. As set forth above, this responsibility must be borne by petitioner.

Petitioner's arguments with respect to Helfgott are misplaced. The decision in Helfgott stated the USPTO did not properly apply PCT Rule 91.1(b). There is nothing in Helfgott that suggests that the USPTO should bear the responsibility of petitioner to timely and properly file an application in accordance with 37 CFR 1.10.

Petitioner further argues that excising the discretionary power of the Director to grant this petition under 37 CFR 1.183 is not precluded in this situation as the papers were deposited with the USPS on the date desired. However, as set forth above, petitioner has provided no convincing evidence which would substantiate petitioner's allegations that the papers were properly deposited with the USPS on the desired date. The provisions of 35 U.S.C. 21(a) provide that [t]he 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 CFR 1.10(d)(3) is a validly promulgated binding regulation to implement the provisions of 35 U.S.C. 21(a) and petitioner has not followed the provisions therein. No postal emergency existed, the evidence of record is that this application was accorded a USPS "Express Mail" "date in" of November 14, 2007, and the USPTO has clearly construed 35 U.S.C. 21(a) to require a postal interruption or emergency, such as a natural disaster, or other similar event which prevents people from accessing the U.S. Post Office. Accordingly, 35 U.S.C. 21(a) precludes the USPTO from considering exigent circumstances; other than those that are USPS interruptions of emergencies, for when a patent application is deemed filed with the USPTO. See Howard Florey Institute v. Dudas, 87 USPQ2d 1913 (EDVa 2008). Petitioner is reminded that no Executive Branch agency may act in derogation of a federal statute. See A.F. Stoddard & Co. v. Dann, 564 F.2d 556, 195USPQ 97 (D.C. Cir 1977).

DECISION

For the above stated reasons, renewed petition requesting that the above-identified application be accorded a filing date of November 13, 2007, rather than the presently accorded filing date of November 14, 2007 is **DENIED**.

Telephone inquiries related to this decision may be directed to the David Bucci at (571) 272-7099.



Anthony Knight
Director
Office of Petitions/
Petitions Officer

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02