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OFFICE OF PETITIONS

In re Application of :
Spencer :
Application No. 13/317,689 :
Filing Date: October 19, 2011 : DECISION ON PETITION
Attorney Docket No.: RAS 005 : UNDER 37 C.F.R. § 1.183
Title of Invention: :
SUPPLEMENTARY VEHICLE SPRING :
ASSEMBLY :

BACKGROUND

This is a decision on the petition filed December 9, 2011, pursuant to 37 C.F.R. § 1.183, requesting that this application receive a filing date of October 14, 2011.

This petition pursuant to 37 C.F.R. § 1.183 is **DENIED**.¹

There will be no further reconsideration of this matter by this Office.

THE RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.1(a) sets forth, in toto:

In general. Except as provided in paragraphs (a)(3)(i), (a)(3)(ii) and (d)(1) of this section, all correspondence intended for the United States Patent and Trademark Office must be addressed to either "Director of the United States Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450" or to specific areas within the Office as set out in paragraphs (a)(1), and (a)(3)(iii) of this section. When appropriate, correspondence should also be marked for the attention of a particular office or individual.

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

37 C.F.R. § 1.6(a) sets forth, *in toto*:

Date of receipt and Express Mail date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted.

37 C.F.R. § 1.10(e) sets forth, *in toto*:

e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Director to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(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";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section 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; and

(4) The petition includes a statement which establishes, to the satisfaction of the Director, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

37 C.F.R. § 1.53(b) sets forth, *in pertinent part*:

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.

37 C.F.R. § 1.183 sets forth, *in toto*:

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).

PROCEDURAL HISTORY AND ANALYSIS

On November 9, 2011, Petitioner submitted a "PETITION TO CORRECT FILING DATE," which was supplemented on November 14, 2011 and November 17, 2011. The petition was treated as a petition pursuant to 37 C.F.R. § 1.10(e),² and was dismissed via the mailing of a decision on December 1, 2011.

The above-identified application was filed on October 19, 2011. With the petition pursuant to 37 C.F.R. § 1.10(e), Petitioner alleged that this application should have been accorded a filing date of October 14, 2011, the date on which it was deposited with the U.S.P.S. Petitioner indicated that on October 14, 2011, he intended to file this application with the USPTO. However, he was unsure as to the mailing address:

² It is noted that the header of the decision contains a typographical error which lists the pertinent section of the C.F.R. as 37 C.F.R. § 1.10(c) (emphasis added).

"I submitted an inquiry on the website for "Express Mail Address" and a screen appeared that did not display an address, but rather displayed a list of items, the title of the second of which read "USPTO Changes Address for Patent Express Mail." I opened this item (a copy is attached as Exhibit C) and saw the changed address. I must have noticed that this was a change made in 2001, but assumed that it would still be a USPTO P.O. Box available for receipt of correspondence. If I had lengthened my inquiry to read "Express Mail Address for filing patent applications" I now know that I would have been given the full proper address."

Petition pursuant to 37 C.F.R. § 1.183, petition 3.

Believing this to be the correct and current mailing address, Petitioner placed this address on an Express Mail label and deposited this application with the U.S.P.S. on October 14, 2011. Unfortunately, this address has been out of date for some time. Consequently, the Express Mail envelope was returned to Petitioner on October 18, 2011, with an indication that the Post Office box in Arlington, Virginia is "vacant."³

With this petition pursuant to 37 C.F.R. § 1.183, Petitioner has included the \$400 fee. However, this petition cannot be granted, as Petitioner has not indicated which Rule he seeks the Office to waive. Moreover, Petitioner has not asserted, much less established, the existence of an extraordinary situation such that justice requires the waiver of any particular Rule.

Assuming arguendo that Petitioner has indicated which Rule he seeks the Office to waive and has asserted the existence of an extraordinary situation, this petition still cannot be granted as it has not been established that justice requires the waiver of any particular Rule. A discussion follows.

It appears that Petitioner seeks the waiver of 37 C.F.R. § 1.10(e), to the extent that the Rule requires mailings to be addressed to the correct address in order for the contents of the same to receive the date of deposit with the Express Mail service of the USPS as the filing date. On pages two and four of this petition, Petitioner argues that he deposited the application with the Express Mail service of the USPS on October 14, 2011, the envelope was returned to him on October 18, 2011, and on October 19, 2011, he placed this envelope into a second envelope and mailed this package to the proper address: therefore the application was "in a continuous delivery stream as it traveled

³ Petition pursuant to 37 C.F.R. § 1.10(e), page 1.

to and from the vacated address and back to the corrected acceptable address."⁴

The Office has determined that justice does not require the Office to waive the requirement that in order to receive the benefit of the Express Mail exception, applications which are deposited with the Express Mail Service of the USPS must be properly addressed.

The address to which correspondence should be sent is clearly set forth in 37 C.F.R. § 1.1(a). As a registered member of the patent bar, Petitioner is expected to know the relevant laws, regulations, and fees pertaining to his practice and under which this Office operates, and he is charged with the responsibility of keeping himself up to date with any changes in these matters. Petitioner has not provided any compelling reason why the Office should relax the requirements of 37 C.F.R. § 1.10(e) so that he may operate outside of its requirements, yet take advantage of the benefit which it confers.

On the second page of this petition, Petitioner has explained that this application was filed on "the final deadline for filing to claim national phase priority of a corresponding PCT application." As such, Petitioner waited until the last day provided in the statute for claiming benefits under 35 U.S.C. 371 to complete the application in final form for filing. While an applicant may wait until the last day to file an application in order to establish continuity, 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) or who delay filing a continuing application until the last possible day for establishing continuity (35 U.S.C. 120 or 121), do not leave any opportunity to overcome any error which might occur in filing the application. The Office, 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.⁵

⁴ It is noted in passing that the delivery stream cannot be characterized as "continuous" if the USPS returned the original envelope to Petitioner.

⁵ In re Dubost, 231 USPQ 887, 889 (Comm'r Pat. 1986). See also In re Harding et al., 211 USPQ 903, 905 (Comm'r Pat. 1980), Ex parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 U.S.P.Q. 378, 379 (Comm'r Pat. 1968).

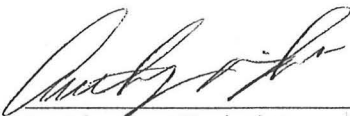
CONCLUSION

The Office of Patent Application Processing (OPAP) will be notified of this decision, and jurisdiction over the application is transferred to OPAP, so that the application may receive further processing.

The filing date will remain October 19, 2011.

Petitioner will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OPAP.

The general phone number for OPAP is 571-272-4000. Telephone inquiries **regarding this decision** should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.⁶



Anthony Knight
Director
Office of Petitions

⁶ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.