



Paper No. 9

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**OFFICE OF PETITIONS**

In re Application of :  
Donald W. Bogart :  
Application No. 09/891,426 : ON PETITION  
Filed: 27 June, 2001 :  
Attorney Docket No. BOGART-002 :

This is a decision on the petition styled as a request for reconsideration under 37 CFR 1.182, filed on 3 August, 2002, which is treated as a renewed petition under 37 CFR 1.183 requesting that the above-identified application be accorded a filing date of 26 June, 2001, instead of the currently accorded filing date of 27 June, 2001.

The petition is DENIED.<sup>1</sup>

BACKGROUND

The original application papers contained in the United States Patent and Trademark Office (USPTO) file show the papers were stamped in the Office with an "Office Date" stamp of 27 June, 2001. The Office of Initial Patent Examination found the application to be complete for filing date purposes. Therefore, the application was accorded a filing date of 27 June, 2001.<sup>2</sup>

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<sup>1</sup>This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The provisions of 37 CFR 1.181(f) do not apply to this decision.

<sup>2</sup>MPEP 505.

STATUTE AND REGULATION

35 U.S.C. § 21 states in pertinent part:

(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 interruption or emergencies designated by the Director.

35 U.S.C. § 111 states in pertinent part:

(a) In general.

(1) Written Application. An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) Contents. Such application shall include--

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title;

(C) an oath by the applicant as prescribed by section 115 of this title

(3) Fee and oath. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(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(b) states in pertinent part:

( 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.

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 Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interest 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(h).

#### OPINION

The present request for reconsideration requests that the present application be accorded a filing date of 26 June, 2001, rather than the presently accorded filing date of 27 June, 2001, because (1) petitioners will be precluded from obtaining the benefit under 35 U.S.C. § 119 from provisional Application No. 60/213,866 filed on 26 June, 2000; and (2) 26 June, 2001, represents a "reasonable" filing date given the fact that applicant deposited the application with the USPS in first-class mail on 23 June, 2001. It is noted that the petition filed on 8 June, 2002, and dismissed in the decision mailed on 23 July, 2002, petitioners' counsel concedes a "mistaken assumption" that the Certificate of Mailing procedures specified at 37 CFR 1.8(a) applied to papers filed to obtain an application filing date.

Petitioner again asserts that the application was deposited in the USPS via first class mail on 23 June, 2002, but requests a 26 June, 2002, filing date on the grounds that if the application was received on 27 June, 2002, the application must have been deposited not later than 26 June, 2002.

The evidence of record has been carefully considered, but is not persuasive. The record does not adequately show that the application papers in question were filed in the USPTO on 26 June, 2002.

Under 37 CFR 1.183, the Commissioner may waive requirements of the rules so long as those requirements are not requirements of

the statute.<sup>3</sup>

Under 35 U.S.C. § 111, the filing date of an application is defined as the date the specification and drawings are received in the U.S. Patent and Trademark Office. Under 35 U.S.C. § 21, the Commissioner is permitted, but not required, to by rule prescribe that any paper or fee required to be filed in the U.S. 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 designed by the Commissioner.

In this regard, petitioners should note that while Certificate of Mailing Procedures do not apply to application papers filed for the purpose of obtaining a national patent application filing date, the Commissioner has provided by rule at 37 CFR 1.10 a procedure by which application papers which are filed by USPS Express Mail Post Office to Addressee service will be accorded as the filing date the date the application papers were deposited in Express Mail service. In future filings, petitioners may avoid the predicament which has now occurred by filing applications using USPS Express Mail Post Office to Addressee service in accordance with 37 CFR 1.10.

Since there were no postal service interruptions or emergencies designated by the Commissioner on 26 June, 2002, the only basis under the statute for according this application a filing date of 26 June, 2002, would be a showing that the application was deposited with the United States Postal Service on 26 June, 2002.

Applicants admit, however, and the evidence indicates, that the application was not deposited with the United States Postal Service on 26 June, 2002. Rather, by counsel's own admission, the application was deposited in the USPS on 23 June, 2002. Since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute.<sup>4</sup> That is, the USPTO simply lacks the authority or the discretion to relax any

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<sup>3</sup>In re Krusman, Inc., 199 USPQ 110 (Comm'r Pats. 1977).

<sup>4</sup>A.F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977).

requirement of law.<sup>5</sup>

At best, the showing of record reveals an intent to file the application papers on 26 June, 2002. There is no decisional, statutory, or regulatory basis for according as the filing date a date other which the papers were filed in the USPTO simply because counsel believes the requested date is a "reasonable" filing date. Likewise, clerical inadvertence or error leading to a loss of right is not a ground for requesting waiver of the regulations.<sup>6</sup>

In summary, by statute the filing date of a nonprovisional application is the date that a specification and a drawing are received in the USPTO. As petitioners' counsel concedes that the application was not deposited in the USPTO on 26 June, 2002, the application papers are not entitled to a filing date of 26 June, 2002.

Accordingly, to grant the requested relief would be contrary to the patent statute.

Furthermore, assuming, *arguendo*, the USPTO had the authority to grant the requested relief, suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

Petitioner states "the PTO has demonstrated a policy of becoming more 'inventor friendly' in terms of giving greater weight to the substance of the application rather than to issues of mere procedure" and that "the goals of justice are well-served by giving effect to the clear intent of Applicant in filing the application in question."

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<sup>5</sup> See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977) (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

<sup>6</sup> See In Re Kabushiki Kaisha Hitachi Seisakusho, 39 USPQ2d 1319, 1320 (Comm'r Pat. 1994).

Despite petitioner's professed belief that the according of a filing date is an issue of "mere procedure," counsel's persistence in requesting a filing date earlier than 27 June, 2001, belies petitioner's apparent trivialization of the determination of the application's filing date. Furthermore, while the "clear intent" of an applicant is obviously to prosecute his application and ultimately receive a patent, applicant, the procedural framework set forth in the patent laws and rules, including the rules for according an application a filing date, was established to ensure that all applicants and the public are given due process. To ignore the requirements of law would prejudice the rights of other applicants, and, ultimately, the public, and would call into question the validity of any patent issued in contradiction thereof.

Lastly, it is noted in the original petition that petitioner's counsel states that "[the] Applicant did not personally commit the error, and that it would be unfair to penalize Applicant for such an error under these circumstances." Any delay resulting from the mistake(s) of counsel is not unavoidable delay, and that delay is binding on petitioner.<sup>7</sup> Circumstances resulting from petitioner's, or petitioner's representatives', 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.<sup>8</sup> It is well settled that such circumstances are not, *ipso facto*, an "extraordinary situation" much less one where "justice requires" relief. That is, waiver of the rules is not warranted when a party makes an avoidable mistake in filing papers.<sup>9</sup>

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<sup>7</sup> See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982); Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130 (delay resulting from counsel's preoccupation with other matters is not unavoidable delay and is binding on petitioner).

<sup>8</sup> 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).

<sup>9</sup> See Nitto Chemical Industry Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 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 CFR 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 CFR 1.183); Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail"), *aff'd without opinion*, 95 F.3d 1166 (Fed. Cir.1996); Gustafson v. Strange, 227 USPQ

This distinction was addressed long ago by the Seventh Circuit in *Lay v. Indianapolis Brush & Broom Mfg. Co.*<sup>10</sup>

[T]he other assumption is that, if the complainants failed in their application through the negligence of their attorney, the delay would be unavoidable which is wholly unwarranted in the law. It is of the very nature of negligence that it should not be unavoidable otherwise it would not be actionable. The negligence of the attorney would be the negligence of the [client]. The purpose of the statute was to put an end to such pleas, and there would be no limit to a renewal of these applications if every application, however remote, could be considered under the plea of negligence of attorneys, by whom their business is generally conducted.<sup>11</sup>

The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and applicant is bound by the consequences of those actions or inactions.<sup>12</sup>

#### DECISION

In summary, by statute the filing date of an application is set by statute as the day the specification and drawings are (a) filed in USPTO or (b) deposited with the USPS as permitted by regulation. The application papers for the above-identified application, however, were neither in the custody of the USPTO or deposited in the USPS on the requested filing date. Therefore, the USPTO simply lacks the discretion or the authority to grant the requested relief, and assuming, *arguendo*, such discretion or authority does exist, petitioner has not provided adequate grounds for it to be exercised under the circumstances of this

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174 (Comm'r Pats. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); *In re Chicago Historical Antique Automobile Museum, Inc.*, 197 USPQ 289 (Comm'r Pats. 1978) (since Certificate of Mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

<sup>10</sup>120 F. 831 (1903).

<sup>11</sup>Id. at 836.

<sup>12</sup>*Link v. Wabash*, 370 U.S. 626, 633-34 (1962).

case. The filing date of the application remains 27 June, 2002.  
The petition is **denied**.

This application is being forwarded to Technology Center 3600 for  
examination in due course.

Telephone inquiries specific to this matter should be directed to  
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