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OFFICE OF PETITIONS

In re Application of :
Teh et al. : DECISION ON PETITION
Application No. 10/982,650 :
Filed: November 5, 2004 :
Atty Docket No. UMC 2002-1C :

This is a decision on the RENEWED PETITION UNDER 37 C.F.R. § 1.181(a); REQUEST TO RECONSIDER AND WITHDRAW HOLDING OF ABANDONMENT filed November 21, 2006.

The petition is **DENIED**. 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.

BACKGROUND

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed July 29, 2005. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). No reply considered filed and no extension of time considered obtained, the application became abandoned effective October 30, 2005. A courtesy Notice of Abandonment was mailed on February 14, 2006.

By decision mailed June 8, 2006, the initial petition to withdraw the holding of abandonment filed March 6, 2006 was dismissed. The holding of abandonment was held to be proper because the response was not received within the statutory period for response and the paper did not include a proper

certificate of mailing to be considered timely filed as provided by 37 CFR 1.8.

On August 7, 2006, applicants filed a renewed petition. By decision mailed September 25, 2006, the prior decision dismissing the petition was affirmed. Citing MPEP 512, the decision stated that the requirement that the certificate of mailing under 37 CFR 1.8 be signed is well established. Further, the decision pointed out that the language cited by petitioner, as suggestive of a requirement that the certificate be signed, suggests who may sign the certificate. The decision reemphasized that the requirement that the certification be signed is not discretionary.

OPINION

A non-final Office action was mailed in this application on July 29, 2005. This Office action set a three-month period for reply, extendable to six-months or until Monday, January 30, 2006 (with payment of an extension of time fee). On February 2, 2006, the Office received an amendment signed by attorney J. Nicholas Gross and a petition for extension of time and fee authorization. The amendment (which stated that a three month extension of time was enclosed) concluded as follows:

Respectfully submitted,
[signature of Mr. Gross]

J. Nicholas Gross
Registration No. 34,175
Attorney for Applicant(s)

January 30, 2006
[address,
telephone,
fax]

I hereby certify that the foregoing is being deposited with the U.S. Postal Service, postage prepaid, to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 this 30th day of January 2006.

As the closing certification was not signed, no benefit under 37 CFR 1.8 was given to the papers¹. The papers were treated as received on February 2, 2006. See 37 CFR 1.6. As the last date for timely reply was Monday, January 30, 2006, the application became abandoned for failure to file a timely reply to the Office action.

On instant renewed petition, petitioner continues to maintain that his unsigned certificate of mailing is entitled to the benefit of 37 CFR 1.8. Petitioner maintains that the decision of September 25, 2006 is unsupportable. Petitioner contends that:

- The decision is based on a mistaken interpretation of CFR 1.8. There is no requirement in 37 C.F.R. 1.8 for a separate signature on a certificate of mailing;
- The decision fails to point to language in § 1.8, but rather relies on MPEP 512. Petitioner argues that the PTO cannot interpret the MPEP in a manner that is contrary and imposes greater burdens than the Regulations;
- The decision fails to address any of the citations from MPEP 512 noted in his first Petition. Petitioner argues that several areas of the 512 refer to the examples as "suggested formats;"
- The decision fails to cite any authority or give any explanation of why the proffered substitute Certification does not meet the requirements of MPEP 512. Petitioner argues that, instead, the decision states in a conclusory fashion that "... a signed certificate on petition" cannot correct the present error. Petitioner argues that with all due respect that is not the issue: the issue is what is required by 37 CFR 1.8 and MPEP 512 as an adequate certificate for the original mailing.

Petitioner's contentions have been considered, and found unpersuasive.

The regulation at issue, 37 CFR 1.8 provides, in pertinent part, that:

- (a) ... , correspondence required to be filed

¹ The petition for extension of time did not include a certificate of mailing signed or unsigned.

in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

- (1) Correspondence will be considered as being timely filed if:
 - (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;
 - ...
 - (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

It is undisputed that the paper filed is of the type which can obtain the benefit of being considered timely filed based on being mailed in accordance with 37 CFR 1.8. The point of contention is whether to be mailed in accordance with 37 CFR 1.8 the certificate itself must be signed or whether it is sufficient that only the paper on which the certificate is printed be signed. As indicated in the prior decisions, the Office interprets 37 CFR 1.8 as requiring that the certificate be signed.

The prior decisions are based on a proper interpretation of the procedure to obtain the benefit of the certificate of mailing practice pursuant to 37 CFR 1.8 and appropriately relied on MPEP 512 for clarification of the requirements of the rule.

37 CFR 1.8 does not explicitly state that both the certificate of mailing and the paper have to be signed. Nonetheless, the language of the rule supports a conclusion that 37 CFR 1.8 requires the signature of the person who causes the paper to be mailed on the certificate. Subsection (ii) of rule 1.8 requires a certificate and imposes a burden on the person signing the certificate (i.e. the person should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.) The imposition of this burden

(as well as the certification of deposit in the mail on a certain date) would be meaningless if no one had to sign the certificate. Signing of the paper on which the certificate is placed is not sufficient to make the certification. The certificate of mailing is a "paper" within the paper certifying that the substantive paper was mailed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 by the signer of the certificate. Whereas, the substantive paper is signed by the drafter of the paper attesting to the paper's contents. See 37 CFR §10.18. The person signing the certificate is not necessarily the person who drafted the paper. For example, an amendment is often signed by the attorney of record and the certificate of mailing is signed by the secretary or paralegal who placed the amendment in the mail.

It is appropriate to look to the Manual of Patent Examination Procedures (MPEP) for interpretation of this rule and for clarity on the procedure to be followed to comply with 37 CFR 1.8. 35 U.S.C. 2, authorizes the USPTO, subject to the policy direction of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the USPTO. It is acknowledged that the MPEP does not carry the force of law. However, the MPEP does clarify USPTO regulations and chapter 512 entitled Certificate of Mailing or Transmission, in particular, is directed to the procedure to be followed by applicants and by the Office, with respect to 37 CFR 1.8 practice.

The clarification of the rule set forth in the MPEP is consistent with the regulation. It is petitioner's interpretation of 37 CFR 1.8 that is contrary to the rules and regulations. The Office in MPEP 512 has specifically advised applicants that their signature on the paper alone is not sufficient. This section clearly and unambiguously states that both the paper and the certificate must be signed. Again unequivocally, MPEP 512 states:

I. PROCEDURE BY APPLICANT

- (A) The certification requires a signature. Specifically, if the certification appears on a paper that requires a signature, two signatures are required, one for the paper and one for the certification. Although not specifically required by 37 CFR 1.8, it is preferred that the certificate be signed by the applicant, assignee, or registered practitioner.

The decision did address petitioner's citations to MPEP 512 noted in his prior petitions. Petitioner was referred back to section (A) of MPEP 512, quoted above, that states that "it is preferred that the certificate be signed by the applicant, assignee or registered practitioner." Further, it was not disputed that the MPEP 512 provides suggested formats for a certificate of mailing. Nonetheless, the requirement remains regardless of format that the certificate of mailing be signed. The prior decisions did not accept the unsigned certificate of mailing as originally filed or the substitute certificate of mailing.

Further, it is expressly stated that the guidelines set forth in MPEP 512 are not contrary to or inconsistent with 37 CFR 1.8 or with any patent statute. As previously stated, 37 CFR 1.8 already imposes a burden on the person signing the certificate. Further, applicants are already required to sign their papers, pursuant to 37 CFR 1.33(b)² and to attest to their contents pursuant to 37 CFR 10.18. The MPEP does not impose an additional burden in stating that 2 signatures are required. Consistent with the burdens of these regulations and the satisfaction of these burdens, the MPEP clarifies that the certificate itself must be signed and the paper must be signed; a signature on the paper is not a signature on the certificate.

It is noted that the circumstances of the absence of a signature on the certificate of mailing in this instance fall squarely within the prohibition set forth in the MPEP guidelines. The amendment is signed, but the certificate, which follows the close of the amendment, is not signed. Petitioner's arguments about the acceptability of one signature are inconsistent with their own prior practice. It is noted that in this case, a review of the record reveals that with the filing of their preliminary amendment on November 5, 2004, two signatures were provided; a certificate of express mailing set forth at the close of the paper was signed by Anthony Gross and the preliminary amendment itself was signed by attorney Gross. The

² 37 CFR 1.33(b) Amendments and other papers . Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A patent practitioner of record appointed in compliance with § 1.32(b);
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

preliminary amendment itself was signed by attorney Gross. The layout of the signature page is the same layout as that in question (and set forth on page 2 of this decision). Moreover, a review of the postcard for the paper that is at the heart of this dispute reveals that Anthony Gross also mailed this paper. Petitioner's arguments are further diminished by the fact that the omission of a signature on the certificate of mailing was an omission of petitioner's prior practice. In light of the clear procedure to be followed by applicants set forth in the MPEP, it is not proper to give applicants the benefit of 37 CFR 1.8 when they have not followed that procedure.

Finally, with respect to the proffered substitute Certification first presented on petition, the decision did state that "... a signed certificate on petition cannot correct the present error." This is a fact. A signed certificate of mailing proffered as a substitute Certificate on petition is not an adequate certificate for the original mailing. As stated in 37 CFR 1.8(b), the showing required to have correspondence considered timely filed by being mailed in accordance with 37 CFR 1.8(a) includes supplying "an additional copy of the previously mailed or transmitted correspondence and certificate." There is no utility to the submission of a substitute Certification. The issue is whether the original certificate of mailing was in compliance. If it was not in compliance, filing of a substitute Certification is not an option to correct the deficiency. If a paper as originally filed does not satisfy 37 CFR 1.8, the USPTO must use the actual date of receipt in the USPTO as defined in 37 CFR 1.6.

The certificate of mailing on the paper was not signed. Petitioner cannot correct this error in procedure by submitting a signed certificate on petition. Accordingly, it was properly decided in the prior decisions that the paper should not be considered timely filed pursuant to 37 CFR 1.8. Thus, the abandonment of the application stands.

CONCLUSION

The prior decision, which refused to withdraw the holding of abandonment, has been reconsidered, and is affirmed.

Petitioner is not precluded from filing a petition to revive pursuant to 37 CFR 1.137. However, continued delay in filing such a petition, after this final agency decision, may be

determined to be intentional delay and may preclude revival of the application.

Telephone inquiries regarding this decision should be directed to Nancy Johnson, Senior Petitions Attorney, Office of Petitions at 571-272-3219.



Charles Pearson
Director
Office of Petitions