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OFFICE OF PETITIONS

In re Application of :
Chrisan Surendran Samuel et :
al. :
Application No. 11/133,763 : DECISION ON SECOND RENEWED
Filing Date: May 21, 2005 : PETITION UNDER 37 C.F.R.
Attorney Docket Number: 087520- : \$1.183
000000US :
Title: PREVENTION OF FIBROSIS :
FOLLOWING CARDIAC INJURY :

Background

This is a decision on the second renewed petition filed August 2, 2006, pursuant to 37 C.F.R. §1.183, requesting that 37 C.F.R. §1.10 be waived so that Petitioner may receive a filing date which precedes the date on which his application was mailed.

The application was deposited on May 21, 2005 along with a Utility Application Transmittal sheet which bears Express Mail label EV606078565US, a declaration, claims, an abstract, drawings, and an Application Data Sheet (ADS).

The original petition was submitted on October 31, 2005, and was dismissed via the mailing of a decision on November 18, 2005. A renewed petition was filed on January 17, 2006, which was dismissed via the mailing of a decision on March 3, 2006. It is

noted that the present second renewed petition was accompanied by a three-month extension of time.

With the original petition, Petitioner indicated that on May 20, 2005, at 5:55 PM, a courier who is employed by Petitioner's law firm (identified only as "Mr. R.") left the firm with the above-identified application in his bag. Mr. R. boarded the Bay Area Rapid Transit (BART) with the intent of traveling to the post office, so that the application could be mailed via first class mail, so as to secure a filing date of May 20, 2005. Mr. R. then fell asleep while on the train, and he awoke when the train approached his stop. Mr. R. then left the patent application on the seat of the train when he debarked. Mr. R. then suffered an acute panic attack, and Petitioner asserted that due to this panic attack, the courier was "not of sufficiently sound mind and judgment to ensure in any way that the application be filed by other means¹."

Petitioner learned of these events the following morning, at which time the application papers were re-dated, and filed with the USPS on May 21, 2005.

Applicable Statutes and Rules

35 U.S.C. 21(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.

35 U.S.C. 111 (a) (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 C.F.R. § 1.10(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

1 Original petition, page 3.

the United States Postal Service (USPS) will be considered filed with the USPTO on the date of deposit with the USPS.

37 C.F.R. § 1.53 Application number, filing date, and completion of application.

(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 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. 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 U.S.C. 120, 121 or 365(c) and § 1.78(a).

(1) A continuation or divisional application that names as inventors the same or fewer than all of the inventors named in the prior application may be filed under this paragraph or paragraph (d) of this section.

(2) A continuation-in-part application (which may disclose and claim subject matter not disclosed in the prior application) or a continuation or divisional application naming an inventor not named in the prior application must be filed under this paragraph.

§ 1.183 Suspension of rules.

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(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

Analysis

In order to submit a grantable petition under 37 CFR 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not established that either condition exists in this case.

With the decision on the original petition, it was indicated that it was not clear what other action Petitioner would have had the courier undertake after he had left the application on the train:

Petitioner comments that this panic attack "prevented him (Mr. R) from employing any rational means for ensuring that the subject application be timely filed²." However, on a Friday night after the close of business hours with him on the ground and his bag on the train, proceeding to the lost and found office seems to be the best course of action he could have undertaken at that point. It is not clear what alternate course of action Petitioner believes Mr. R. should or would have taken, had his mind not been "overwhelmed with confusion, disorientation and panic³."

On the sixth page of this renewed petition, Petitioner has set forth that Mr. R. could have either used a public pay phone in the train station to make a collect call to the law firm, or he could have used the phone in the BART agent ticket booth. It is noted that with this second renewed petition, Petitioner has not explicitly set forth that there was anyone at the law firm after the close of normal business hours on a Friday evening to answer the phone. As such, even if Mr. R. would have telephoned the firm, it appears that he would have called an empty office.

Petitioner further speculates that Mr. R. could have contacted "many of the firm's attorneys [who] live within a small geographic distance of the office." It is noted that Petitioner has not set forth that Mr. R. had in his possession a roster of the home phone numbers and/or addresses of the firm's attorneys, nor has he set forth that Mr. R. had personal knowledge of this information at the time.

Petitioner additionally asserts that Mr. R. could have waited at the station, "for news of the retrieval of his bag⁴." It is not clear why this would not have resulted in an identical outcome. On the sixth and seventh pages of the original petition, Petitioner indicated that in a voice mail, the BART Clerk indicated that although the bag had been located on May 20, 2005, it would not be available until the next morning. Hence, even if Mr. R. had waited at the train station, he would not have been able to retrieve the bag until the passing of the May 20, 2005 deadline.

2 Original petition, page 4.

3 Id.

4 Second Renewed petition, page 7.

Petitioner asserts that "a reasonable person...would have attempted to contact the Firm to ask for help and instructions. It is highly likely that the subject application would have been filed timely had Mr. R. telephoned the Firm⁵." However, with no people at the firm after hours on a Friday night, and without the home addresses/phone numbers of the Firm's attorneys, it is not clear why Petitioner would arrive at this conclusion.

Moreover, the decision of November 18, 2005 also addressed the matter of the cause of the filing delay:

Furthermore, since the PTO did not cause or contribute to Petitioner's filing delay, this case is even further removed from consideration as one where "justice requires" equitable relief⁶. 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 §1.183⁷. Rather, as petitioner failed to properly deposit his application with the USPS in accordance with the requirements of 37 C.F.R. §1.10(a)(1), this is not an "extraordinary situation" where "justice requires" an extraordinary remedy.

With this second renewed petition, Petitioner has set forth that "Mr. R's inability to deliver the application was a direct result of his mental illness: an extraordinary situation⁸." As set forth in footnote thirteen of the decision on the original petition, "it is noted in passing that page 4 of the Bernstein report makes it clear that Petitioner did not suffer from a panic attack until after the bag had been left on the train." As set forth on the fifth page of the decision on the original petition,

⁵ *Id.* at 5.

⁶ See *Helfgott & Karras, P.C. v. Dickinson*, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000).

⁷ See *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); *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); *Gustafson v. Strange*, 227 USPQ 174 (Comm'r Pats. 1985) (Counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule).

⁸ Second renewed petition, page 7.

The application was not deposited with the USPS because the courier fell asleep on a train and forgot to gather his belongings before departing the train. There is nothing extraordinary about this situation. Had the courier, an agent of the Petitioner, remained awake and retained dominion over his possessions, the loss would not have occurred. Remaining awake and remembering to take his items with him were circumstances which were entirely within his control, and the dispossession of the bag containing the application which resulted in the failure to secure the desired filing date for this application could have been avoided by the exercise of reasonable care and diligence. Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence.

U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

Petitioner admits that accidents which could have been prevented by the exercise of ordinary care or diligence do not give rise to extraordinary situations, and that a party's inadvertent failure to comply with Office rules does not rise to the level of an extraordinary situation⁹. On the eighth page of the second renewed petition, Petitioner sets forth:

Mr. R.'s actions, after loss of his possessions, (emphasis added) were not the result of his not being duly attentive, but his complete inability to formulate and carry through a rational course of action. That is, it is not the loss of Mr. R.'s bag that the Petitioner submits is an 'extraordinary situation,' but the acute panic attack that ensued and the resulting inability to follow a rational, coherent means to recover the bag was extraordinary.

Petitioner's assertion misses the point. It was the inattentiveness of his courier that resulted in the loss of the bag. Had his courier stayed awake, and not left his bag on the train, the bag would not have been lost. The loss of the bag is what resulted in the failure to deposit this application with the USPS in a timely manner, and not any event which occurred subsequent thereto. Therefore, even if the Office were to accept Petitioner's assertion that the courier suffered an acute panic attack which impaired his ability to think in a rational manner, this does not change the fact that the courier appears to have been of sound mind and clear judgment at the time of his dispossession of the application. In summary, Petitioner has asserted that the courier suffered a mental impairment, however this disability occurred subsequent to the courier's loss of the

⁹ Second renewed petition, pages 7-8.

present application. But for the failure of Petitioner's agent to remember to take his bag with him when he exited the train, the application would have been timely filed.

It follows that it was the actions of his agent, and not the PTO, which caused the delay in filing, and as such, this case is even further removed from consideration as one where justice requires equitable relief.

Regarding the case of Sturzinger v. Commissioner of Patents, 181 USPQ 436 (DC DC 1974), Petitioner has asserted on second renewed petition that this case stands for the proposition that the filing date this application should receive is not the date on which it was deposited with the Office, but rather the date on which the applicant intended to deposit it with the Office¹⁰. Such is not the case.

Petitioner's representative has asserted that the court in Sturzinger accorded the application a filing date of the date on which the applicant intended to file the application, but this is inaccurate.

As set forth on pages 6-7 of the decision on the original petition:

Petitioner would have the Office assign the date on which he intended (emphasis included) to file the application with the USPS as his filing date. However, in Sturzinger, the Plaintiff neither sought nor received the date of March 23, 1971 as his filing date, the date on which he intended (emphasis included) to file the application with the Office. **The date which the Plaintiff both sought and received was the date on which the package was received by the PTO** (emphasis added). With the present application, the date which the application received as a filing date was the date on which the application was deposited with the PTO (pursuant to 37 C.F.R. §1.10(a)(1), filing an application with the USPS will be considered as filed with the USPTO if the Applicant utilizes the "Express Mail Post Office to Addressee" service of the USPS). As such, it would appear that the PTO accorded Petitioner the same treatment by the PTO as the Court awarded the Plaintiff in the case cited by Petitioner, however **Petitioner would have the Office provide a disparate filing practice** (emphasis added).

In Sturzinger, the applicant deposited the application with the USPS on March 23, 1971, and the mail was stolen subsequent to the deposit, *while in the custody of the USPS*. A substantially similar application (but including a photocopy of the declaration) was later deposited directly with the Office on April 13, 1971. An original declaration was subsequently filed with the Office on July 12, 1971, and the Office accorded this date as the filing date of the application. The court awarded the date of April 13, 1971 - the date on which an incomplete set of papers were received

¹⁰ Second renewed petition, pages 8-10.

in the Office. This contrasts with the present set of facts, as Petitioner would have the Office accord a filing date of the day before any papers were received in the Office.

The present set of facts is further distinguished from the situation in Sturzinger, as Sturzinger involved the "theft or loss of documents from the mails,"¹¹ and it is well settled that patent applicants are entitled to rely upon the ordinary and trustworthy agency of the mail¹². With the present set of facts, the application was not stolen from the Post Office after it was deposited with the same, but rather it was left behind on a train because the courier fell asleep and forgot to gather his belongings when he awoke.

Finally, the decision of November 18, 2005 indicated the following:

35 USC 111(a) (4) conditions the filing date as "the date on which the specification and any required drawing are received in the Patent and Trademark Office." 35 USC 21(a) includes a deposit with the USPS via the USPS Express Mail service in the definition of "received in the Patent and Trademark Office."

The granting of Petitioner's request for a filing date of May 20, 2005 - the day before "the specification and any required drawing" were received in the PTO - would require the waiver of 35 USC 111(a) (4), and this cannot be done, for a Rule cannot be relaxed in contravention of any Law.

Regarding the waiver of a statute, Petitioner has asserted that "in cases of postal service interruptions or emergencies, patent applications are granted the filing dates they would have received, but for the service interruption or emergency"¹³.

35 U.S.C. § 21(a) sets forth, *in toto*:

(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.

11 Sturzinger at 437.

12 In re Katrapat, AG, 6 U.S.P.Q. 2d 1863, 1866 (1988). See also Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887); In re Matullath, 38 App. D.C. 497, 514-15 (1912); Winkler v. Ladd, 221 F.Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), *aff'd*, 143 USPQ 172, 172 (D.C. Cir. 1964).

13 Petition, page 11.

Petitioner would have the Office consider the courier's "medical emergency...be considered an emergency so designated by the Director."¹⁴ As set forth above, the acute panic attack did not result in the failure of the present application to receive the filing date which Petitioner would prefer - it was the courier's abandonment of his bag which resulted in the delay in depositing the present application with the USPS. This event was entirely within the control of the courier, an agent of Petitioner's representative, and as such, it does not rise to the level of an emergency.

Finally, Petitioner has asserted that since the application spent the night under the exclusive control of the BART station, "the BART lost and found was a proxy for the U.S.P.S," and as such, the "stated goals of Rule 10 were satisfied"¹⁵.

Rule §1.10 sets forth that any correspondence that is received by the Office will be considered filed with the USPTO on the date of deposit with the USPS, when the correspondence is deposited with the USPS and is delivered to the Office by the "Express Mail Post Office to Addressee" service of the USPS. Petitioner has further submitted that the rationale behind the implementation of the rule is that the date of deposit with the USPS is "verified by a *disinterested* (emphasis included) USPS employee"¹⁶. In the present situation, the correspondence was deposited not with the USPS, but rather was left behind on a train, found by the woman who had been sitting next to the courier¹⁷, and eventually deposited with the BART lost and found department by an unspecified means. Petitioner cannot rely on Rule §1.10 to have the application accorded a filing date that is prior to the date on which the correspondence was deposited with the USPS.

Conclusion

The petition is **DENIED**¹⁸.

The application will retain a filing date of May 21, 2005.

¹⁴ Id.

¹⁵ Id. at 13..

¹⁶ Second renewed petition, page 12.

¹⁷ Bernstein report, page 3.

¹⁸ 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.

THERE WILL BE NO FURTHER RECONSIDERATION OF THIS MATTER BY THIS OFFICE.

Telephone inquiries should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

A handwritten signature in cursive script, appearing to read "Charles Pearson". The signature is written in black ink and is positioned above the typed name and title.

Charles Pearson
Director
Office of Petitions
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