



Ladas & Parry
26 West 61st Street
New York, NY 10023

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In re Application of :
Bagaric et al. :
Application No. 29/236,395 : ON PETITION
Filed: September 27, 2005 :
Attorney Docket No. UD051623-9 :

This is a decision on renewed petition under 37 CFR 1.183, filed April 4, 2007, requesting reconsideration of the prior decision refusing to suspend the rules and accord the above-identified application a filing date of August 15, 2005.

The petition under 37 CFR 1.183 is **DENIED**. This decision on the petition under 37 CFR 1.183 is a final agency action within the meaning of 5 U.S.C. 704 for purposes of seeking judicial review. See MPEP 1002.02.

BACKGROUND

On August 15, 2005, petitioners deposited the above-identified application with the United States Patent and Trademark Office. On September 1, 2005, the Office mailed a Notice of Incomplete Nonprovisional Application informing petitioners that the application papers had not been accorded a filing date because the specification did not include at least one claim. Additionally, the Notice of Incomplete Nonprovisional Application required the submission of a properly signed oath or declaration and payment of the statutory basic filing fee, the search fee, and the examination fee.

On September 27, 2005, petitioners filed a petition under 37 CFR 1.53(e), a \$400.00 petition fee, a substitute specification (including a claim), and a statement that the substitute specification contains no new matter.¹ In the petition, petitioners requested that the Office accord the above-identified application a filing date of August 15, 2005. On February 21, 2006, the Office dismissed the petition and accorded the application a filing date of September 27, 2005, the date of receipt of the omitted claim in the USPTO.

¹ On September 28, 2005, petitioner resubmitted a duplicate copy of the petition and accompanying papers originally filed on September 27, 2005.

On February 27, 2006, the Office mailed a Notice to File Missing Parts of Nonprovisional Application, which gave petitioners a two-month extendable period within which to file a properly signed oath or declaration and pay the statutory basic filing fee, the search fee, the examination fee, and a surcharge to avoid abandonment.

On April 21, 2006, petitioners filed a petition under 37 CFR 1.183 to suspend the rules and accord the above-identified application a filing date of August 15, 2005. On February 1, 2007, the Office mailed a decision dismissing the petition under 37 CFR 1.183. The filing of the petition on April 21, 2006, did not toll the period for replying to the Notice to File Missing Parts of Nonprovisional Application. On October 19, 2007, the Office mailed a Notice of Abandonment. Unfortunately, the Notice of Abandonment incorrectly indicated that the application was abandoned for failure to timely reply to the Decision on Petition mailed on February 1, 2007. Rather, the application became abandoned on April 28, 2006, by operation of law, for failure to reply to the Notice to File Missing Parts of Nonprovisional Application within the period for response, including extensions of time.

On April 4, 2007, petitioners filed the present renewed petition under 37 CFR 1.183, requesting reconsideration of the prior decision refusing to suspend the rules and accord the above-identified application a filing date of August 15, 2005.²

STATUTE AND REGULATION

35 U.S.C. 21 provides:

(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.

35 U.S.C. 111 provides:

(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;

² On October 29, 2007, petitioners filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-identified application, which was dismissed by the decision of April 16, 2008. Presently, the application is abandoned.

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

(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.

35 U.S.C. 112 provides:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

37 CFR 1.51 provides:

(a) Applications for patents must be made to the Director of the United States Patent and Trademark Office.

(b) A complete application filed under § 1.53(b) or § 1.53(d) comprises:

(1) A specification as prescribed by 35 U.S.C. 112, including a claim or claims, see §§ 1.71 to 1.77;

(2) An oath or declaration, see §§ 1.63 and 1.68;

(3) Drawings, when necessary, see §§ 1.81 to 1.85; and

(4) The prescribed filing fee, search fee, examination fee, and application size fee, see § 1.16.

37 CFR 1.53 provides:

(b) 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).

37 CFR 1.153 provides:

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

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).

OPINION

Petitioners aver they filed a complete application, including a claim, with the USPTO on August 15, 2005. Specifically, petitioners argue that the drawings filed in this application on August 15, 2005, is the claim. Additionally, petitioners assert that the decision of February 1, 2007, was incomplete because the Office failed to consider whether the drawing is the claim. Petitioners state:

The applicant has maintained since the initial petition of September 27, 2005, that the claim is the drawing. The Federal Circuit has agreed.

The district court construed the..., claim..., to mean..., a... design, as shown in Figures We find no error in the district court's claim construction.”
Contessa Food Products Inc. v. Conagra Inc., 62 USPQ2d 1065, 1068 (Fed. Cir. 2002).

Because the claim of a design means the figures[,] and figures were present in the above application [on] August 15, 2005, the application was then complete with a claim (meaning the figures), the Notice of February 26, 2006, was in error, and the abandonment of the application from April 28, 2006, should be withdrawn, because the Notice needs to be corrected and re-sent for the filing fee alone.

The Office has considered petitioners' arguments, but does not find them persuasive. Specific, the quotation from Contessa Food Prods., Inc. v. Conagra, Inc., 282 F.3d 1470 (Fed. Cir. 2002) (hereafter "Contessa") selected by petitioners, viewed in isolation, seems to support their assertion. However, a closer examination of the facts of Contessa reveals that petitioners' interpretation of the case law is mistaken. Unlike the instant application, the subject application in Contessa contained a single claim on filing, and therefore, was complete. Further, in Contessa, the Federal Circuit Court was asked to determine whether a design patent was infringed and to analyze the scope of the claimed design. The Office notes that the determination of the scope of a claim is distinct from a determination of whether a claim was present on filing an application. More importantly, in Contessa, the Federal Circuit Court did not hold that a drawing submitted on filing was the claim for the purposes of according the application a filing date.

Next, petitioners' contention that Office did not consider its argument that the drawings filed in this application on August 15, 2005, are the claim is without merit. As stated in the previous decision of February 21, 2006, the Office cannot and will not suspend the requirement for a formal written claim. That is, the Office cannot accept the drawings as a claim in order to accord the present application a filing date of August 15, 2005. Both statute, 35 U.S.C. 111, and federal regulation, 37 CFR 1.51, make clear the requirements that an application for patent must include (1) a specification, containing a description, as prescribed by 35 U.S.C. 112 and 37 CFR 1.71, (2) a claim, as prescribed by 35 U.S.C. 112 and 37 CFR 1.75, and (3) a drawing, if necessary under 35 U.S.C. 113 (first sentence) and 37 CFR 1.81(a). The omission of any *one* of these *separate* components makes a design application incomplete, and thus, not entitled to a filing date. See also Litton Systems v. Whirlpool Corp., 728 F.2d 1423, 1427 (Fed. Cir. 1984) ("One of the requirements for a complete application is a claim."). A "claim" defines what the patentee legally asserts is deserving of protection and is distinct from the abstract, specification, and drawings, which describe the patent in detail. See 35 U.S.C. 112. The necessity of a claim, distinct from the drawings, is unqualified. That is, if a drawing was a claim, the statute would be redundant, as every word in the statute is given meaning. Moreover, no rule permits the USPTO to act otherwise, because a claim is not among those "minor informalities" which the USPTO can waive pursuant to 37 CFR 1.183. Absent a definite claim, it is unclear from the specification what petitioners intended to cover.

Furthermore, pursuant to 37 CFR 1.53(h), an application for a patent will not be accepted and placed upon the files for examination until all its required parts are received in the USPTO, except that certain minor informalities may be waived subject to subsequent correction whenever required. MPEP 506 states: "If the nonprovisional application papers filed under 37 CFR 1.53(b) do not include at least a specification containing a description and at least one claim and a drawing, if necessary under 35 U.S.C. 113 (first sentence), or if the submitted application papers are too informal to be given a filing date, the case is held as an incomplete application and the applicant is informed of the shortcomings of the papers." "The Office will not accord the application a filing date until the incompleteness is corrected." Id.

As previously stated,

Also, the Court of Appeals for the Federal Circuit stated in *Litton Systems, Inc. v. Whirlpool Corp.*:

Both statute, 35 U.S.C. 111[(a)], and federal regulations, 37 CFR 1.51[(b)], make clear the requirement that an application for a patent must include. . . a specification and claims. . . .

Therefore, in an application filed under 35 U.S.C. 111(a), a claim is a statutory requirement for accordng a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that "[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application." Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

MPEP 601.01(e).

The requirement for a formal claim in a design application is not "a matter of form by Rule of the Patent Office." *Petition dated April 21, 2006, p. 2*. As indicated above, the requirement for a formal claim is matter of statute. The USPTO is without authority to suspend or waive a requirement of a statute.

Assuming for argument sake only that the USPTO could suspend the requirement, it should not relax the requirements of established practice 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). Circumstances resulting from applicants' or applicants' counsel's failure to exercise due care or to properly apply the patent statutes or rules of practice are not extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pat. 1990). Accordingly, petitioners have not provided an adequate showing of "an extraordinary situation" in which "justice requires" suspension of the requirement for a formal written claim separate from the drawings. See generally Nitto Chem. Indus. Co. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers).

DECISION

The Office has reconsidered the prior decision refusing to suspend the rules and accord the above-identified application a filing date of August 15, 2005. For the reasons stated, petitioners have not shown that they filed a complete design application, including a claim, on August 15, 2005. Accordingly, the above-identified application will retain the filing date of September 27, 2005. The Director will not undertake any further review or reconsideration of the petition to accord the application a filing date of August 15, 2005.

Telephone inquiries should be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211.

A handwritten signature in black ink, appearing to read "Charles A. Pearson". The signature is fluid and cursive, with a long horizontal stroke extending to the right.

Charles A. Pearson
Director
Office of Petitions