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In re Patent No. 5,751,239  
Issue Date: May 12, 1998  
Application No. 06/640,147  
Filed: May 10, 1984  
Patentee(s) Gunter Wichmann

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ON PETITION

This is a decision on the petition filed August 20, 1998, again requesting that the above-identified application (now U.S. Patent No. 5,751,239) be accorded a filing date of May 9, 1984.

The petition to accord the above-identified application a filing date of May 9, 1984 is **DENIED**.

Petitioner argues that: (1) during the four-year gap between the filing of the above-identified application and the imposition of a secrecy order, the above-identified application was still required to be treated as "secret" due to a classification imposed by the German Government; and (2) the Patent and Trademark Office (PTO) is disregarding the certificate of "Express Mail" on the transmittal letter for the above-identified application and applying the provisions of 37 CFR 1.10 as amended in November of 1996, rather than the provisions of 37 CFR 1.10 in effect in 1984. Petitioner's arguments and the evidence have been reconsidered; however, they are not persuasive that the above-identified application is entitled to a filing date of May 9, 1984.

The rules of practice (37 CFR Part 5) provide for the filing, prosecution and examination of applications under national security classification or secrecy order. In addition, the "secret" classification imposed by the German Government did not prevent petitioner from filing the above-identified application in the PTO in May of 1984 or corresponding with the PTO concerning the above-identified application in May of 1986, December of 1987, July of 1988, February of 1989, March of 1989, May of 1989, and June of 1989. Therefore, petitioner's contention that the "secret" classification imposed by the German Government prevented

petitioner from seeking correction of the filing date of the above-identified application until May of 1998 is untenable.<sup>1</sup> Since petitioner has provided no reasonable justification for the extensive delay in seeking correction of the filing date of the above-identified application, the petition to accord the above-identified application a filing date of May 9, 1984 is properly refused as untimely. See 37 CFR 1.181(f).

Petitioner's contention that the PTO is applying the provisions of 37 CFR 1.10 more stringent than those in effect in May of 1984<sup>2</sup> is likewise misplaced. The PTO will not grant a petition under 37 CFR 1.10 (as in effect in May of 1984) between absent a copy of the "Express Mail" mailing label or other U.S. Postal Service record showing that the "Express Mail" package containing the paper or fee was actually deposited with the U.S. Postal Service on the requested filing date. See Honigsbaum v. Lehman, 903 F. Supp. 8, 10, 37 USPQ2d 1799, 1800 (D.D.C. 1995) (Commissioner's refusal to grant the requested filing date not arbitrary or capricious since the applicant's submissions lacked corroboration by any U.S. Postal Service record showing that the "Express Mail" package containing the paper or fee was actually deposited with the U.S. Postal Service on the requested filing date).<sup>3</sup> Since the instant petition lacks a copy of the "Express Mail" mailing label or other U.S. Postal Service record showing that the above-identified application was actually deposited with the U.S. Postal Service on May 9, 1984, the petition (in addition to being untimely as discussed above) also lacks an adequate showing that the above-identified application is entitled to a filing date of May 9, 1984.

For the above stated reasons, the request that the above-identified application (now U.S. Patent No. 5,751,239) be accorded a filing date of May 9, 1984 is **DENIED**. This decision may be viewed as final agency action. See MPEP 1002.02(b).

Telephone inquiries regarding this decision should be directed to Robert W. Bahr at (703) 305-9282.

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<sup>1</sup> In any event, there is also no justification for the delay between December of 1995 (when the secrecy order for the above-identified application was rescinded) and May of 1998 in seeking correction of the filing date accorded the above-identified application.

<sup>2</sup> 37 CFR 1.10 was amended effective December 2, 1996. See Communications with the Patent and Trademark Office, Final Rule Notice, 61 Fed. Reg. 56439 (November 1, 1996), 1192 Off. Gaz. Pat. Office 95 (November 26, 1996). The petition, however, lacks an adequate showing that the above-identified application is entitled to a filing date of May 9, 1984 under either the current or former provisions of 37 CFR 1.10.

<sup>3</sup> This decision, as well as the enclosed decisions from application No. 08/241,663 and application No. 08/245,140 (both available on the PTO's E-FOIA Web page), were decided under 37 CFR 1.10 as in effect prior to the December 1996 amendment to 37 CFR 1.10.

The file of the above-identified application (now U.S. Patent No. 5,751,239) is being forwarded to Files Repository.

*Manuel C. Ontonales*  
*for*

Stephen G. Kunin  
Deputy Assistant Commissioner  
for Patent Policy and Projects

Enclosures: Decision in application No. 08/241,663  
Decision in application No. 08/245,140