



Paper No. 6

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**OFFICE OF PETITIONS  
A/C PATENTS**

In re Application of  
Bhargava  
Application No. 09/311,038  
Filed: April 1, 1999  
Attorney Docket No. 98-378

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: DECISION DENYING  
: PETITION  
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This is a decision on the renewed petition filed August 15, 2000, and supplemented February 1, 2001, requesting that the above-identified application papers be accorded a filing date of August 20, 1998, under the provisions of 35 U.S.C. § 21(a) and 37 CFR 1.10(e).

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

#### BACKGROUND

The instant application papers were filed April 1, 1999, along with a petition requesting a filing date of August 20, 1998, which is purported to be the date that the original, but non-received, application papers were deposited as Express Mail Post Office to Addressee service of the United States Postal Service (USPS), under Express Mail Label No. EM3300885434US.

The petition was dismissed in the decision of July 11, 2000. Since the original correspondence was never received by the USPTO, the decision treated the petition as having been filed under the remedial provisions of 37 CFR 1.10(e). The decision acknowledged that the copy of the application papers supplied with the petition had

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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.

affixed thereto Express Mail label number No. EM3300885434US, but noted the lack, *inter alia*, of a copy of the Express Mail mailing label No. EM3300885434US showing a "date-in" of August 20, 1998, or any other official notation by the USPS to support the date of deposit, as deficiencies in the showing.

The instant renewed petition was filed August 15, 2000. The petition acknowledges that petitioner is unable to provide a copy of the Express Mail mailing label showing a "date-in" of August 20, 1998, or, due to the passage of time, any other official USPS notation bearing that date for that Express Mail label number, in support of the allegations made in the petition, but includes declarations by counsel Barry L. Kelmachter(Kelmachter) his secretary, Ms. Nicole Porto (Porto), and his bookkeeper, Ms. Nancy Reid (Reid).

#### STATUTE AND REGULATION

35 U.S.C. § 6 (1998) stated in pertinent part, that:

[The Commissioner] may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 21(a) (1998) stated:

The Commissioner may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered to be filed in the Office on the date on which it was deposited with the United States Postal Service but for postal interruptions or emergencies designated by the Commissioner.

35 U.S.C. § 111(1998) provided 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 Commissioner.

(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; 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 Commissioner.

(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 Commissioner 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** (emphasis added).

37 CFR 1.6 (1998) stated in pertinent part that:

(a) Date of receipt and Express Mail date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) The Patent and Trademark Office is not open for the filing of correspondence on any day that is a Saturday, Sunday, or Federal holiday within the District of Columbia. Except for correspondence transmitted by facsimile under paragraph (a)(3) of this section, or filed electronically under paragraph (a)(4) of this section, no correspondence is received in the Office on Saturdays, Sundays, or Federal holidays within the District of Columbia.

(2) Correspondence filed in accordance with §§ 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

37 CFR 1.10(a) (1998) stated in pertinent part that<sup>2</sup>:

Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See § 1.6(a).

37 CFR 1.10(b) (1998) stated:

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<sup>2</sup> As revised, 61 *Fed. Reg.* 56349 (Nov. 1, 1996), effective December 2, 1996.

Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked. The paper(s) or fee(s) that constitute the correspondence should also include the "Express Mail" mailing label number thereon. See paragraphs (c), (d) and (e) of this section.

37 CFR 1.10(e) (1998) stated that<sup>3</sup>:

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail";
- (3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, **a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit**, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the

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<sup>3</sup> Added, 61 *Fed. Reg.* 56349 (Nov. 1, 1996), effective December 2, 1996. Because the USPTO regulations are published in the *Federal Register* as required by the Federal Register Act, 44 U.S.C. §1505 (formerly 44 U.S.C. §§5, 7), they are binding, even in the absence of actual knowledge. See, e.g., *Timber Access Industries Co. v. United States*, 213 Ct. Cl. 648, 553 F.2d 1250, 1255 (1977); *Andrews v. Knowlton*, 509 F.2d 898, 905 (2d Cir.), *cert. denied*, 423 U.S. 873 (1975); *United States v. Aarons*, 310 F.2d 341, 345-48 (2d Cir. 1962); *In re Pacific Far East Line, Inc.*, 314 F.Supp. 1339, 1348 (N.D. Cal. 1970), *aff'd*, 472 F.2d 1382 (9th Cir. 1973).

correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS (emphasis added).

37 CFR 1.53(b)(1998) provided that:

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)(emphasis added).

#### OPINION

Petitioner requests reconsideration in that petitioner again alleges that the instant application papers, and their accompanying itemized postcard receipt, were entrusted to the USPS using the Express Mail Post Office to Addressee service of the United States Postal Service (USPS), under Express Mail Label No. EM3300885434US, on August 20, 1998. The petition is accompanied by a declaration from counsel Barry Kelmachter, who asserts that (1) he prepared the instant application papers on August 20, 1998, (2) he requested his secretary Ms. Porto to file the instant application papers using the Express Mail procedure on that date, (3) on February 20, 1999, he learned that neither a serial number nor a filing receipt for the application papers had been received, (4) he instructed Porto to search for the customer copy of the returned Express Mail label from the USPS or an itemized postcard receipt from the USPTO, but her search was uneventful, and (5) due to the six month limit of the USPS for Express Mail label record keeping, no USPS records could be obtained to confirm delivery to the USPTO. Likewise, Porto provides a declaration asserting that (1) on August 20,

1998, she deposited the instant application papers having affixed thereto Express Mail label number No. EM3300885434US, along with an itemized postcard receipt, in the Express Mail Post Office to Addressee service of the USPS, (2) she cannot now locate either the Express Mail label or the returned itemized postcard for the papers in question, or the returned check for the filing fees, within the firm's records, (3) she has no further knowledge as to what happened to the instant application after it was entrusted to the USPS, and (4) the instant application papers are a true copy of those purported to have been deposited on August 20, 1998 under the Express Mail procedure. Reid declares (1) that counsel's firm issued check No. 12096 on August 20, 1998, to cover filing fees for a divisional application, and (2) that check No. 12096 has never been negotiated or returned.

The evidence of record has been carefully considered, but is not persuasive. The record does not adequately prove that the papers for this application were in fact entrusted to the USPS within the meaning of 35 USC 21(a) and 37 CFR 1.10 on August 20, 1998. Under the terms of 37 CFR 1.10(a), the date of deposit with the USPS is shown by the "date-in" on the Express Mail mailing label or other official USPS notation. Due to the absence in the record of a true copy of the Express Mail label, or other USPS notation showing a date of deposit of these papers with the USPS of August 20, 1998, petitioner lacks any corroborative or direct evidence to support the contention that the instant papers should be accorded a filing date of August 20, 1998.<sup>4</sup> Since petitioner has not proved that he can obtain the purported date of deposit of the application papers as Express Mail on August 20, 1998, under the provisions of 35 USC 21(a) and 37 CFR 1.10, then the earliest filing date that can be accorded the instant application papers is the date of receipt of the specification and drawings at the USPTO: April 1, 1999. See 35 USC 111(a)(4); 37 CFR 1.53(b).

At best, the record shows that petitioner's counsel intended to mail the application papers on August 20, 1998 by the Express Mail Post Office to Addressee service of the USPS. However, the patent statute at 35 USC 21(a) does not afford a filing date to application papers that were intended to have been entrusted to the USPS; rather, the

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<sup>4</sup> The criticality of an application filing date was considered adequate to justify independent verification by an employee of the USPS of the date of deposit of the application papers with the USPS. See rulemaking entitled "Revision of Patent Procedure," published in the *Federal Register* at 48 *Fed. Reg.* 2696, 2702 (January 20, 1983), and in the Patent and Trademark Office *Official Gazette* at 1027 *Off. Gaz. Pat. Office* 9, 25 (February 1, 1983). Put otherwise, the insertion by a disinterested employee of the U.S. Postal Service of the date of deposit in the U.S. Postal Service by Express Mail on the Express Mail label of the envelop containing application papers is the *raison d'être* of 37 CFR 1.10.

statute only accords a filing date to application papers that have in fact been entrusted to the USPS on the date in question. The best evidence of the date the correspondence was entrusted to the USPS is the Express Mail label customer receipt, or another USPS notation that was made by a disinterested USPS employee.<sup>5</sup>

The patent statute and the regulations before the USPTO provide a remedy for the very situation that is asserted to have arisen herein. That is, 37 CFR 1.10(e) provides a mechanism whereby correspondence that is entrusted to the Express Mail service of the USPS, but is never received at the USPTO, may nevertheless be accorded as the filing date the "date-in" that is placed on the correspondence by a USPS employee. However, to obtain relief under the rule, the party must supply a copy of the Express Mail label, having the "date-in" thereon, which affords direct evidence that the correspondence was entrusted to the USPS on the date in question. As noted above, since petitioner has not supplied a true copy of the Express Mail label, or other USPS notation for the correspondence in question that is dated August 20, 1998, petitioner simply cannot obtain his requested relief under the patent statute and the regulation. 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, where applicant failed to produce an Express Mail customer receipt, 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 is not an extraordinary situation under 37 CFR 1.183)

The declaration of Mr. Kelmachter, executed on August 11, 2000, and the declaration of Ms. Porto, executed on August 11, 2000, and the declaration of Ms. Reid, executed February 1, 2001, have been carefully considered but are not persuasive that the instant patent application papers were in fact entrusted to the Express Mail Post Office to Addressee service of the USPS on August 20, 1998. A party alleging that correspondence was entrusted to the USPS and later misplaced has the burden of

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<sup>5</sup> In promulgating 37 CFR 1.10, the Office also considered other types of mail service (e.g., registered mail and certified mail), but chose the "Express Mail" service since this service provides, *inter alia*, a legible mailing date on the "Express Mail" label for the records of both the applicant and the Office. See "Revision of Patent Procedure," 48 *Fed. Reg.* at 2697, 1027 *Off. Gaz. Pat. Office* 12-13.

proving the allegation by a preponderance of the evidence. However, there are no USPS records that have been adduced in support of the petition. Furthermore, there are no USPTO records showing that the papers for this application were received at the USPTO any earlier than April 1, 1999. While Kelmachter and Porto assert that the Express Mail package prepared on August 20, 1998, contained the instant patent application papers, these declarations were executed long (about one year) after the Express Mail package in question was purportedly prepared on August 20, 1998. Neither Kelmachter nor Porto states that he or she has any specific recollection, personal knowledge, or remembrance that the patent application papers were entrusted to the USPS on the date alleged in the petition.<sup>6</sup> Indeed, it is unclear how any individual routinely involved in the day-to-day preparation of papers for filing in the USPTO can recall the specific action(s) pertaining to, and contents of, a particular Express Mail package purportedly prepared and mailed 12 months earlier. As the court observed in Nitto at 1781, "the affidavits are hardly as probative of the actual date of mailing as are Express Mail receipts." Likewise, since nothing submitted on the record herein by petitioner is corroborated by any showing outside of counsel's office, the record is properly regarded as unpersuasive. See Honigsbaum at 10, 37 USPQ2d at 1800.<sup>7</sup> The Reid declaration, as it has no direct bearing on the issue of the deposit *vel non* of the application papers as Express Mail on August 20, 1998, does not ease petitioner's burden in this matter.

The statements of the declarants do not supply adequate *direct* evidence bearing on the issue as to whether the instant application papers were actually entrusted to the Express Mail service of the USPS on the date alleged. Instead, they merely recount, in essence, the usual procedures in place at counsel's firm for filing a patent application by the Express Mail procedure, which is simply not persuasive. Cf. Krahn v. Commissioner, 15 USPQ2d 1823, 1825 (D.C. E Va 1990) (the usual and ordinary procedures in effect at counsel's firm, even where demonstrably followed, do not provide the direct evidence necessary to show the paper was timely entrusted to the

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<sup>6</sup> It is also noted that neither the Kelmachter nor the Reid declaration asserts firsthand knowledge of the actual deposit of the above-identified application papers with the Express Mail service of the USPS on August 20, 1998.

<sup>7</sup> In response to objections to the use of affidavits and/or declarations to establish a filing date, the USPTO indicated that such affidavits or declarations are considered to explain activities that are supported by exhibits (*i.e.*, corroborate evidence). See "Revision of Patent Procedure," 48 Fed. Reg. at 2702-03, 1027 Off. Gaz. Pat. Office at 27-28. Thus, the USPTO appropriately requires the submission of corroborative documentary evidence to establish an application filing date.

USPS, in the absence of a copy of a certification under 37 CFR 1.8). Further, a party's lack of making or maintaining adequate business records to support a contention that a paper was actually entrusted to the USPS does not warrant relief. Krahn, Id. An Express Mail label, or other USPS notation for the instant patent application and referencing Express Mail Label No. EM3300885434US with a USPS date of August 20, 1998, which would provide the necessary *direct* evidence to support the allegations made in the petition, has not been produced by petitioner. Even if the usual and ordinary procedures in place at petitioner's counsel's firm were demonstrably followed in this instance, such would not provide the necessary direct evidence that the instant application papers were entrusted to the USPS on August 20, 1998. Krahn, id.

Further, that a party fails, as here, to make or maintain adequate business records to prove a purported date of mailing of correspondence to the USPTO does not warrant relief. Krahn, Id. In this regard, the declaration of Porto (at ¶ 4) suggests that Porto did not deal directly with an employee of the USPS, and, as such, failed to immediately obtain the Express Mail customer directly from the USPS employee; rather, Porto indicates that she checked "all Express Mail receipts returned by the U.S. Postal Service."<sup>8</sup> However, the USPTO has long recommended to those who mail correspondence by the Express Mail procedure to deal directly with a USPS employee when the obtention of a filing date is critical.<sup>9</sup> In view of 37 CFR 1.10(b), petitioner knew, or should have known, of the risks attendant a failure to deal directly with USPS personnel. Having forgone the opportunity to deal directly with an employee of the USPS, or alternately, having forgone the opportunity to adequately make or maintain evidence of such a direct dealing, petitioner cannot now be heard to complain about the consequences arising from a lack of corroborating evidence from the USPS.

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<sup>8</sup> The USPS mails the customer copy of the Express Mail mailing label to the customer's address when, for example, the Express Mail package is deposited in an Express Mail drop box, or the customer copy is otherwise unclaimed. See e.g., Honigsbaum at 10, 37 USPQ2d at 1800.

<sup>9</sup> See e.g., the following "Helpful Hint" from 1065 *Off. Gaz. Pat. Off.* 33 (April 29, 1986): "In view of the above, it is recommended that where the filing date of a paper or fee is critical, e.g., the filing of a patent application, and particularly when the deposit by "Express Mail" is being made late in the business day, the correspondence should be personally delivered to a Post Office where receipt of the "Express Mail" package by the Postal Service on the date indicated in the certificate of mailing by "Express Mail" can be immediately obtained from a Postal Service clerk."

OPINION

For the reasons given above, petitioner has not met his burden of proof to establish that the instant application papers were entrusted to the Express Mail Post Office to Addressee service of the USPS on August 20, 1998, such that petitioner avail himself of the remedial provisions of 35 USC 21(a) and its promulgating regulation 37 CFR 1.10. The filing date of this application remains April 1, 1999, the earliest date the record reasonably shows its receipt at the USPTO. The petition is **denied**.

The application is being forwarded to the Office of Initial Patent Examination for further processing as an application filed under 35 USC 111(a) and 37 CFR 1.53(b), with a filing date of April 1, 1999.

Telephone Inquiries related to this decision should be related to Senior Petitions Examiner Brian Hearn at (703) 305-1820.

  
Manuel A. Antonakas, Director  
Office of Petitions