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Paper No. 26      **MAILED**

MAR 04 2009

In re Application of :  
Michael REED et al. :  
Application No. 08/113,955 :  
Deposited: August 31, 1993 :  
Attorney Docket No. E4800.001P00 :

OFFICE OF PETITIONS  
ON PETITION

This is in response to the renewed petitions filed October 6, 2008, under 37 CFR 1.53(b) again requesting that the above-identified application be accorded a filing date of August 31, 1993, under 37 CFR 1.182 requesting the specification be amended to include a benefit claim for priority to application Serial No. 07/426,917, now U.S. Patent 5,241,671, and under 37 CFR 1.183 requesting waiver of the requirements of 37 CFR 1.53 and 1.181(f). This is also a decision on the petition under 37 CFR 1.47(a) filed October 6, 2008, and supplemented on October 15, 2008 and November 14, 2008, requesting the declaration be accepted without the signatures of all of the inventors.

The petitions are **DENIED**<sup>1</sup>.

**BACKGROUND**

The above-identified application was deposited with the USPTO on August 31, 1993. On September 14, 1993, a letter was mailed by Application Division requiring page 1 of the specification and stating that the filing date would be the date of receipt of the omitted page and further required an oath of declaration in compliance with 37 CFR 1.63, \$710 for the basic filing fee, \$1,446 for additional claims and the \$130 surcharge, if necessary. In response to the September 14, 1993 letter, a petition and an unsigned preliminary amendment was filed October 29, 1993. The petition did not include any of the fees required in the Office letter of September 14, 1993. On February 16, 1994, a decision dismissing the petition was mailed and indicated: (1) MPEP 608.01 sets forth that an application is considered incomplete, if it omits one or more pages of the specification; (2) since the application, as deposited, omitted page 1 of the specification, the application is *prima facie* incomplete; (3) that while the petition argued that the omitted page was unnecessary for an understanding of the claimed subject matter, the petition was not accompanied by an oath or declaration by the inventors as required by MPEP 608.01; (4)

if the inventors agree that page 1 is unnecessary for an understanding of their invention, the application may be accorded a filing date of August 31, 1993, upon the filing of a request for reconsideration, accompanied by an oath or declaration in compliance with 37 CFR 1.63 by the inventors including a statement that their invention is adequately disclosed in, and they wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for purposes of an original disclosure and filing date; and (5) requiring a request for reconsideration to be filed within two (2) months of the date of the decision in order to be considered timely and that failure to file a timely response will result in return of the application to Application Division for processing as an incomplete application under 37 CFR 1.53(c). As applicant failed to submit the required omissions a Notice of Abandonment under 37 CFR 1.53 was mailed March 23, 1995.

A petition, filed November 1, 2007, requesting: (1) waiver of the requirements of 37 CFR 1.181(f); (2) that this application is given a filing date of August 31, 1993; (3) the extension of time fee tendered February 28, 2004 be reallocated; and (3) the application be amended to delete page 1 and insert a benefit claim was dismissed in the decision of August 6, 2008.

The instant petitions request: (1) waiver of the requirements of 37 CFR 1.181(f); (2) that this application be given a filing date of August 31, 1993; (3) the extension of time fee tendered February 28, 2004 be reallocated; (4) the application be amended to delete page 1 and insert a benefit claim; and (5) acceptance of the declaration without all of the inventors signatures.

### STATUTE AND REGULATION

As the instant application was deposited with the USPTO on August 31, 1993 one must look to the statutes, rules, and procedures in effect at the time of the deposit of the application, *i.e.*, MPEP Fifth Edition Rev. 15. Petitioner cannot rely upon later promulgated statutes, rules, and procedures to support his assertions that a filing date of August 31, 1993 be granted to the instant application.

At the time of filing of the instant application –

35 U.S.C. 111 stated:

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. Such application shall include (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed section 115 of this title. The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawings are submitted, within such period and under such conditions, including payment of a surcharge, as may be prescribed by the Commissioner. Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is show to the satisfaction of the Commissioner that the delay in submitting the fee and

oath was unavoidable. 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 120 stated:

An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States, or as provided by section 363 of this title, which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

37 CFR 1.14(b) stated:

Except as provided in § 1.11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a U.S. patent, or in an application in which the applicants has filed an authorization to open the complete application to the public, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant.

37 CFR 1.22(b) stated:

All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

37 CFR 1.47(a) stated in relevant part:

If a joint inventor refuses to join in an application for patent or cannot be found or reached after a diligent effort, the application may be made by the other inventor or on behalf of himself or herself and the omitted inventor. The oath of declaration in such an application must be accompanied by a petition including proof of the pertinent facts and by the required fee (§ 1.17(h)) and must state the last known address of the omitted inventor.

37 CFR 1.53(b) stated:

The filing date of an application for patent filed under this section is the date on which: (1) a specification containing a description pursuant to §1.71 and at least one claim pursuant to §1.75; and (2) any drawing required by §1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by §1.41.

No new matter may be introduced into an application after its filing date (§1.118). If all the names of the actual inventor or inventors are not supplied when the specification and any required drawing are filed, the application will not be given a filing date earlier than the date upon which the names are supplied unless a petition with the fee set forth in §1.17(i)(1) is filed which sets forth the reasons the delay in supplying the names should be excused. A continuation or divisional application (filed under the conditions specified in 35 U.S.C. 120 or 121 and §1.78(a)) may be filed pursuant to the section, §1.60 or 1.62. A continuation-in-part may be filed pursuant to this section or §1.62.

37 CFR 1.53(d) stated:

If an application which has been accorded a filing date pursuant to paragraph (b) of this section does not include the appropriate filing fee or an oath or declaration by applicant, the applicant will be so notified, if a correspondence address has been provide and given a period of time within which to file the fee, oath, or declaration and to pay the surcharge as set forth in §1.16(e) in order to prevent abandonment of the application. A copy of the "Notice to File Missing Parts" form mailed to applicant should accompany any response thereto submitted to the office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in §1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of.

37 CFR 1.78(a) stated:

An application may claim an invention disclosed in a prior filed copending national application or international application designating the United States of America. In order for an application to claim the benefit of a prior copending national application, the prior application must name as an inventor at least one inventor named in the later filed application and disclose the named inventor's invention claimed in at least one claim of the later filed application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, the prior application must be (1) complete as set forth in §1.51, or (2) entitled to a filing date as set forth in §1.53(b) and include the basic filing fee set forth in §1.16; or (3) entitled to a filing date as set forth in §1.53(b) and have paid therein the processing and retention fee set forth in §1.21(l) within the time period set forth in §1.53(d). Any application claiming the benefit of a prior filed copending national or international application must contain or be amended to contain in the first sentence of the specification following the title a reference to such prior application, identifying it by serial number and filing date or international application number and international filing date and indicating the relationship of the application. Cross-references to other related applications may be made when appropriate. (See §1.14(b).)

MPEP 201.07 stated:

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned or patented. The

continuing application may be filed under 37 CFR 1.53, 37 CFR 1.60 or 37 CFR 1.62. The applicant in the continuing application must include at least one inventor named in the prior application. The disclosure presented in the continuation must be the same as that of the original application, i.e. the continuation should not include anything which would constitute new matter if inserted in the original application.

At any time before the patenting or abandonment or termination of proceeding on his or her earlier application, an applicant may recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner.

MPEP 201.11 stated:

Under certain circumstances an application for patent is entitled to the benefit of the filing date of a prior application which has at least one common inventor. The conditions are specified in 35 U.S.C. 120.

There are four conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120:

1. The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or original application); the disclosure of the invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *In re Ahlbrecht*, 168 USPQ 293 (CCPA 1971).
2. The continuing application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application.
3. The continuing application must contain a specific reference to the prior application(s) in the specification.
4. The continuing application must be filed by an inventor or inventors named in the previously filed application.

#### COPENDENCY

Copendency is defined in the clause which requires that the second application must be filed before (a) the patenting, or (b) the abandonment of, or (c) the termination of proceedings in the first application.

And further stated:

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

MPEP 202.02 stated:

The inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

MPEP 608.01 stated:

Applications filed without all pages of the specification are not given a filing date since they are "prima facie" incomplete. The filing date is the date on which the omitted pages are filed. If the oath or declaration for the application was filed prior to the submission of all pages of specification, the submission of any omitted pages must be accompanied by a supplemental oath or declaration referring to the specification originally deposited, as amended to include the pages originally omitted. If the oath or declaration for the application was not filed prior to the submission of the omitted pages, the oath or declaration when filed, must include a specific reference to pages originally omitted. If any applicant believes that the omitted pages of the application are not necessary for an understanding of the subject matter sought to be patented, applicant may petition to have the application accepted without the omitted pages. Any petition must be accompanied by the petition fee (37 CFR 1.17(h)) and an amendment canceling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support and renumbering the pages present in consecutive order. Also, if the oath or declaration for the application was filed prior to the date of the amendment and petition, the amendment must be accompanied by a supplemental declaration by the applicant stating that the invention is adequately disclosed in, and desire to rely on, the application as thus amended for purposes of an original disclosure and filing date. If the oath or declaration for the application was not filed prior to the date of the petition and amendment, the oath or declaration, when filed, must include a specific reference to the amendment cancelling from the specification all incomplete sentences and any claims which depend upon the omitted pages for disclosure and support.

37 CFR 1.14(a)(1)(iv) states:

*(iv) Unpublished abandoned applications (including provisional applications) that are identified or relied upon.* The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an

application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b)).

37 CFR 1.181(f) states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

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

Petitioner argues: (1) the instant petitions are timely; (2) the copendency requirements of 35 U.S.C. 120 have been met; (3) petitioner was not alerted to the lack of a priority claim in the above-identified application; (4) examination of the child application proceeded even though the instant application did not have a benefit claim; (5) the child application indicated that benefits under 35 U.S.C. 120 were being claimed to the parent application via the instant application; and (6) USPTO practice has since changed with respect to incomplete applications.

In the August 6, 2008 decision on petition it was noted that: (1) 37 CFR 1.181(f) permits the dismissal of a petition not filed within two months of the mailing date of the action or notice from which relief is requested; (2) the instant petitions appear to complain about the petition decision mailed February 16, 1994; (3) as over 13 years 8 months passed between that action and the instant petitions, the instant petitions are dismissed as untimely; and (4) as noted in *Korsinsky v. Godici*, 2005 U.S. Dist. LEXIS 20850, (S.D.N.Y. 2005), by operation of regulation, the Commissioner was entitled to dismiss Korsinsky's petition as untimely.

In the instant renewed petitions petitioner argues, with respect to the dismissal of the petition under 37 CFR 1.181, that: (1) 37 CFR 1.181 is permissive in nature to permit consideration of petitions filed long after a decision or notice is rendered; (2) it was believed that because of the

filing of a continuing application a response to the petition decision of February 16, 1994 was no longer required; (3) the notice that first made petitioner aware of a copendency problem occurred on October 5, 2007; (4) the USPTO's granting of a filing date in a later filed application which claimed benefit of the instant application were a waiver of requirements in the instant application or lulled petitioner into a false sense of security so relief should be granted as recognized in 1059 *Off. Gaz. Pat. Office* 4 (August 26, 1985); and (5) the decision of *Korsinsky v. Godici, supra* does not apply.

Despite petitioners arguments to the contrary there is no reason to consider the instant petitions as being timely filed. Petitioner was thrice put on notice, not only in the letter mailed by Application Division on September 14, 1993 but also in the petition decision mailed February 16, 1994, that the above-identified application did not have a filing date and was further made aware by such petition decision what was required in order to obtain a filing date. The Notice of Abandonment provided even further notice of the lack of a filing date. Moreover, petitioner was given two (2) months from the mailing date of the February 16, 1994 petition decision to file a request for reconsideration. Petitioner chose not to file a request for reconsideration and received a Notice of Abandonment under 37 CFR 1.53 which was mailed March 23, 1995. To now state that petitioner was first notified of the lack of such filing date on October 5, 2007 is misplaced. The fact that petitioner chose to file a later filed application which claimed benefit of the above-identified application has no bearing on the timeliness of the instant petitions. Additionally, there is no reasonable basis to conclude that actions in one application would act to waive requirements in another and given the fact that petitioner was thrice put on notice of the lack of filing date in the above-identified application there is no indication that the USPTO "lulled Applicant into a false sense of security." Indeed 1059 *Off. Gaz. Pat. Office* 4 does set forth very limited circumstances where a 37 CFR 1.183 waiver of the requirements of 37 CFR 1.137(b) would be grantable; however, this requirement: the Office performed a positive, documented and Official act which could lead a reasonable individual to conclude that the action or inaction was proper and this conclusion was a contributing factor in the applicant's failure to realize the true abandoned status of his application in time to file a petition under one of the above noted subsections is immaterial to the situation here where applicant was informed of both the lack of a filing date in and the abandoned status of this application. The action here was nothing like the discontinued practice of filing of a File Wrapper Continuing case under 37 CFR 1.62, where the Office used the papers in the copending prior application for the newly filed application, which the Office would not process if there was no copendency. Moreover, it is reasonable to expect a registered practitioner to know and apply the rules of practice and thus understand that an application must have a filing date in order to provide the proper continuity required for a proper benefit claim. A party applying for a patent must comply with the applicable rules established by Congress and the United States Patent and Trademark Office. The applicant must be "vigilant and active" in complying with the conditions for obtaining a patent. *Woodbury Patent Planning-Mach. Co. v. Keith*, 101 U.S. 479, 485 (1879). The applicant has the burden of ensuring that papers are filed timely and of inquiring into potential problems during the application process. See *in re Holland Am. Wafer Co.*, 737 F.2d 1015, 1018-19 [22USPQ 273](Fed. Cir. 1984)(involving trademark registration application); *In re Swissco Foods Ltd.*, 25 USPQ2d 1552, 1553 (Comm'r of Patents & Trademarks 1992)(same). And although the PTO may notify

applicants about irregularities, it has no obligation to do so. See *In re Patent No. 4,461,759* 16 USPQ2d 1883 (Comm'r of Patents & Trademarks 1990). Petitioner's arguments with respect to the applicability of *Korsinsky* are not well taken as the facts of this application parallel those of *Korsinsky* in that, in *Korsinsky*, a petitioner deliberately chose a course of action, then later when petitioner realized, due to infringement, the error of that previous decision, he decided to choose an opposite course of action, and the petition was dismissed as untimely. Here, petitioner chose not to respond to an outstanding petition and thus, did not receive a filing date, then years later when the filing date became important, due to litigation, petitioner decided to choose the opposite course of action. In view of the above, the petitions under 37 CFR 1.47(a), 37 CFR 1.53(b), 37 CFR 1.182, and 37 CFR 1.183 are denied as being untimely.

Petitioner's argument with respect to the petition under 37 CFR 1.53(b) that "since a proper Declaration was filed in the child application and since a filing date is being sought for the above-captioned application simply for continuity purposes, that there would not be a requirement for obtaining a signed Declaration for the same disclosure simply because it has a different serial number assigned thereto" is not well taken because the petition decision of February 16, 1994 required an oath or declaration as required by MPEP 608.01, *supra*. There is no reasonable basis to assume a declaration filed in a child application would cure the defects of the parent application. Moreover, an oath or declaration is a requirement of 35 U.S.C. 111 and as such the USPTO has no authority to waive such requirement.

Furthermore, with respect to the petition under 37 CFR 1.53(b), the requirements of the Office letter mailed September 14, 1993, the petition decision mailed February 16, 1994, and MPEP 608.01 (Fifth Edition Rev. 15) have yet to be met and, in any event, were not timely met. That is, petitioner did not timely proffer the required fees of \$710 for the basic filing fee, \$1,446 for additional claims and the \$130 surcharge nor has petitioner provided either: (1) an oath or declaration by the inventors as required by MPEP 608.01, *supra*; or (2) if the inventors agree that page 1 is unnecessary for an understanding of their invention, the application may be accorded a filing date of August 31, 1993, upon the filing of a request for reconsideration, accompanied by an oath or declaration in compliance with 37 CFR 1.63 by the inventors including a statement that their invention is adequately disclosed in, and they wish to rely on, the application as amended on October 29, 1993, without page 1 of the specification for purposes of an original disclosure and filing date. Accordingly, no filing date can be granted and the petition is denied.

Petitioner further argues that the copendency requirements of 35 U.S.C. 120 have been met and therefore an amendment to the first sentence of the specification setting forth the benefit claim should be entered. The instant application was deposited with the USPTO on August 31, 1993; however, as the instant application was never accorded a filing date and does not contain a specific reference to the prior application(s) in the specification, the requirements of 35 U.S.C. 120 and 37 CFR 1.78(a) have not been met. Therefore, the requested amendment to the specification will not, and in any event cannot, be made.

Next, petitioner requests reallocation of the fees paid in the instant application. Despite petitioner's statement that the fees should be reallocated in view of a blanket fee authorization,

no blanket fee authorization was given. The only authorization given was one to charge extension of time fees. Specifically, the petition for extension of time filed February 28, 1994 stated "In the event that a further petition for an extension of time is required to be submitted at this time, applicant(s) hereby petition(s) under 37 CFR 1.136(a) for an extension of time for as many months as are required to ensure that the above-referenced application does not become abandoned." While the petition for extension of time also states "the commissioner is authorized to charge any fee or additional amounts due in connection with this communication", this communication was a request for an extension of time and to construe it as a response to the letter of September 14, 1993, or the petition decision of February 16, 1994, and as a request to pay a basic statutory filing fee, additional claim fees, and the required surcharge would be wholly inappropriate. The declaration of Jon D. Grossman (Grossman), the attorney who signed the request for extension of time, does not indicate that such was intended and in view of Grossman's failure to respond to the petition decision of February 16, 1994 it is clear that there was no intent to pay the fees due. Moreover, at the time of filing of the instant application 37 CFR 1.22(b) required fees to be itemized in each individual application in such a manner that it is clear for which purpose the fees are paid. In the instant application there was no request to pay any fees other than an extension of time fee. Therefore, no reallocation of fees will be undertaken. Furthermore, as the requested filing date of August 31, 1993 cannot be given, and proceedings have been terminated in the instant application, no filing, retention, additional claim, or surcharges will be accepted at this time.

Petitioner further requests waiver of the Rules under 37 CFR 1.183 as the rule provides for suspension of the rules "[i]n an extraordinary situation, when justice requires" such a waiver. Petitioner argues that because the procedural errors were of minor procedural consequence (*i.e.*, the Declaration and Petition under 37 CFR 1.47 could have been filed in the instant application, rather than the continuation child application had the PTO alerted petitioner in a timely fashion of the problems in the child application claim of priority benefits under 35 U.S.C. 120). The issue at hand is not whether petitioner was alerted to the fact that the instant application did not claim benefit to the parent application nor is it what actions petitioner may have taken in another application; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence herein. As such the granting of a filing date petition in a child application and the examination of such child application are irrelevant to the actions taken in the instant application. As set forth in MPEP 202.02 (Fifth Edition Rev. 15) the inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier date. In the instant application, a review of the record indicates that this application was not filed in accordance with 35 U.S.C 111 and 37 CFR 1.53(b) and accordingly was not granted a filing date. Moreover, petitioner was on notice that the application was not accorded a filing date and was apparently aware of that fact as evidenced by their filing of a petition on October 29, 1993 requesting a filing date be granted. As such, petitioner knew or should have known that a benefit claim to the instant application was improper under 35 U.S.C. 120 and 37 CFR 1.78(a). It is again noted that a party applying for a patent must comply with the applicable rules established by Congress and the United States Patent and Trademark Office. The applicant must be "vigilant and active" in complying with the conditions for obtaining a patent. *Woodbury, supra*. The applicant has the burden of ensuring

that papers are filed timely and of inquiring into potential problems during the application process. *See in re Holland Am. Wafer Co., supra; In re Swissco Foods Ltd., supra.* And although the PTO may notify applicants about irregularities, it has no obligation to do so. *See In re Patent No. 4,461,759, supra.*

It is further argued that petitioner acted with due care and was not unaware of rules or procedures as evidenced by petitioners' filing of two separate applications (referred to as "sandwich" applications) on the same day. However, it is not in depositing of the application in which petitioner failed to exercise due care but, rather, it is in the filing of a grantable petition in response to the petition decision of February 16, 1994 in order to obtain a filing date where petitioner failed to exercise due care and properly apply the patent statutes or rules of practice. As set forth above, petitioner knew or should have known that a lack of a filing date precluded a benefit claim and that filing a continuation application did not relieve petitioner of the requirement of obtaining a filing date in the instant application in order to have a proper benefit claim as the inclusion of parent information in the heading does not necessarily indicate claims are entitled to benefit of an earlier filing date. *See MPEP 202.02, supra.*

Circumstances resulting from petitioners', or petitioners' counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. *See, In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).* Accordingly, failure to know and properly apply the rules of practice before the USPTO is not a basis for seeking waiver of the rules under 1.183.

While petitioner has argued forcefully that equitable considerations require that the application be granted a filing date of August 31, 1993 the facts presented do not lead to a finding that an extraordinary situation exists. Petitioner states that the general public could not have relied on a belief that priority benefits were not being claimed because the public was not aware of any errors in the application since the application was not publicly available. Despite petitioners' contentions [t]he file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent. *See 37 CFR 1.14(a)(1)(iv), supra.* In this case U.S. Patent 6,546,399 identified the instant application. Petitioner has neither shown nor alleged that the general public will not be harmed by the granting of the desired filing date in their long-abandoned application. There is no mention of those who may have acted in reliance on the lack of a filing date and the abandoned status of the instant application. Accordingly, petitioner has not shown that "justice requires" waiver of the requirements of the rules for obtaining a filing date and therefore, the petition under 37 CFR 1.183 is denied. *See, In re Application of Fischer, 6 USPQ2d 1573 (Comm'r Pat. 1988).*

Furthermore, with respect to the petition under 37 CFR 1.47(a), the declarations submitted are not in compliance with MPEP 608.01 (Fifth Edition Rev. 15) and in any event are untimely. Accordingly, the petition under 37 CFR 1.47(a) is denied.

**DECISION**

The requirements of 35 U.S.C. 111 and 35 U.S.C 120 have not been met. Accordingly, the requested filing date of August 31, 1993 cannot be given. Petitioner is reminded that no Executive branch agency may act in derogation of a federal statute. *See A.F. Stoddard & Co. v. Dann*, 564 F.2d 556 (D.C. Cir. 1977).

For the above stated reasons, the petitions pursuant to 37 CFR 1.47(a), 37 CFR 1.53(b), 37 CFR 1.182, and 37 CFR 1.183 are denied.

After mailing of this decision, this application is being returned to the Files Repository.

As a petition under 37 CFR 1.47(a) was filed, the petition fee of \$400 set forth in 37 CFR 1.17(f) is required. As petitioner submitted a petition fee of \$130 petitioners' Deposit Account No. 50-2929 will be charged an additional \$270.

Telephone inquiries concerning this decision should be directed to the David Bucci at (571) 272-7099.



Charles Pearson  
Director  
Office of Petitions

Cc: Hershkovitz & Associates, LLC  
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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