



Paper No. 13

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OFFICE OF PETITIONS

In re Application of
Starner
Application No. 09/376,047
Deposited July 22, 2002
Attorney Docket No. 99-0402498
For: TEDDY BEAR PLUSH TOY AND GAME
COMBINATION

DECISION ON PETITION

This is a decision on the petition entitled, "PETITION TO ACCORD FILING DATE UNDER 37 CFR 1.53," filed January 21, 2003. The petition will be treated as a request for reconsideration of the December 20, 2002 dismissal of petitioner's request under 37 CFR 1.53(e) to accord a July 30, 1999 filing date to the above-identified application.

The petition is **denied**.¹

BACKGROUND

Application papers were filed on July 30, 1999. The Office mailed a filing receipt to petitioner on September 7, 1999. The filing receipt stated that the above-identified application had been accorded a July 30, 1999 filing date and that the filing contained 0 sheets of drawings and 1 claim. Petitioner filed three status requests over the course of three years. On July 10, 2002, the Office mailed a Notice of Incomplete Nonprovisional Application (Notice). The Notice informed petitioner that no filing date had been accorded to the application because the application lacked a specification, at least one claim, and drawings.

Applicant filed a petition under 37 CFR 1.53(e) on July 22, 2002 (certificate of mailing date July 16, 2002,) requesting that the Office accord a filing date of July 30, 1999 to the above-identified application. The petition was dismissed on September 6, 2002 because petitioner did not submit the required petition fee. Applicant filed a second petition on September 10, 2002, requesting that the Office accord a filing date of July 30, 1999 to the above-identified application. The petition was dismissed on September 20, 2002 for failure to provide adequate evidence that a specification, at least one claim, and drawings were filed on July 30, 1999. Applicant filed a third petition on October 30, 2002, requesting that the Office accord a filing date of July 30, 1999 to the above-identified application. The petition was again dismissed on December 20, 2002 for failure to provide adequate evidence that a specification, at least one claim, and drawings were filed on July 30, 1999.

¹ Petitioner is advised that this is a final agency action. See MPEP § 1002.02.

With the instant petition, applicant requests "that the Office accord the serial number (09/376,047) and filing date assigned (JULY 30, 1999) to the application as reflected by the filing receipt mailed from the USPTO on September 7, 1999."

STATUTE

35 U.S.C. § 111 states in pertinent part that:

(a) IN GENERAL.-

...

(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; ...

...

(4) FAILURE TO SUBMIT -...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 states in pertinent part that:

The specification shall contain a written description of the invention....The specification shall conclude with one or more claims....

35 U.S.C. § 113 states in pertinent part that:

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.

ANALYSIS AND OPINION

With the instant petition, applicant requests "that the Office accord the serial number (09/376,047) and filing date assigned (JULY 30, 1999) to the application as reflected by the filing receipt mailed from the USPTO on September 7, 1999." In addition, petitioner presents evidence that petitioner believes "...indicates that it is more likely than not that the application was filed on July 30, 1999...."

As will be discussed below, a review of the Office file for the application and all other available Office resources indicates that the Office did **not** receive a specification, at least one claim, and drawings on July 30, 1999. An applicant alleging that a paper was filed in the Office and later misplaced has the burden of proving the allegation by a preponderance of the evidence. It is the Office's position that July 22, 2002 is the earliest date that a specification, at least one claim, and drawings were present in the Office. Since July 22, 2002 is the earliest date that the application

complied with 35 USC 111(a)(4), July 22, 2002 is the filing date of the application. Petitioner maintains a complete application was filed on July 30, 1999 and desires a July 30, 1999 filing date. In order to prevail, petitioner must prove by a preponderance of the evidence, with evidence that the Office recognizes, that a specification, at least one claim, and drawings were filed on July 30, 1999.

Petitioner requests that the Office accord a filing date of July 30, 1999 to the above-identified application because (1) a filing receipt was issued stating a filing date of July 30, 1999 for the above-identified application, (2) a foreign filing license was granted on September 7, 1999 for the above-identified application, (3) the check for the filing fee submitted on July 30, 1999 was negotiated, (4) the original transmittal letter indicating an application having five sheets of drawings, one independent and seven dependent claims was signed by Mary Trent and dated June 14, 1999, (5) inventor David Starner signed small entity status documents and a power of attorney/declaration between June 14, 1999 and June 18, 1999 and (6) petitioner recalls filing a complete application.

Regarding (1) and (2), petitioner requests that the Office accord a filing date of July 30, 1999 to the above-identified application based in large part on the fact that, on September 7, 1999, the Office mailed petitioner a filing receipt that stated the filing date of the application was July 30, 1999.²

This request on its face is very logical. However, as pointed out in the December 20, 2002 decision on petition, the September 7, 1999 filing receipt was mailed in error.

There is a PTO generated stamp on the original itemized application patent transmittal letter found in the application file that states: "The PTO did not receive the following listed item(s): specification, drawings, information disclosure statements." This fact indicates that the specification, claims, and drawings were not misplaced in the PTO, since the PTO employee who opened the envelope and reviewed the original filing recognized that applicant intended to file "a certified copy of a utility application" and "5 sheets of drawings" and found that a specification and drawings were missing. The annotation is evidence that a specification and drawings were never filed. A copy of the first page of the transmittal letter containing the annotation is enclosed.

A review of Office computer records for this application supports the Office's conclusion that the application was incomplete when filed. Patent Application Location and Monitoring (PALM) shows the field for "Application Received" as "07/30/99." There is no date listed in the "Filing Date" field. The Office did not accord a filing date to the application. In addition, the official application file does not contain a specification and drawings. In short, all available Office records do not contain any evidence that a specification, including at least one claim, and drawings were filed on July 30, 1999. This fact supports the Office's position that the filing receipt was mailed in error.

Examining the September 7, 1999 filing receipt in the best possible light to petitioner, *assuming arguendo*, the validity of the September 7, 1999 filing receipt, petitioner still would not be able to sustain a July 30, 1999 filing date for the above-identified application. The filing receipt states that 0 drawings were received on July 30, 1999. 35 U.S.C. § 113 states in pertinent part that:

The applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.

² In addition, the receipt stated that, if required, a foreign filing license was granted on 09/07/09.

35 U.S.C. § 111(a)(4) states in pertinent part that:

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.

The September 7, 1999 filing receipt states that no drawings were filed on July 30, 1999. Given the subject matter of the invention, it is highly unlikely that the application would receive a filing date without drawings included. Thus, even accepting the validity of the September 7, 1999 filing receipt, petitioner would not be entitled to a July 30, 1999 because no drawings were present in the Office on that date.

35 U.S.C. § 111(a)(4) states, “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.” It is well settled that the use of “shall” in a statute is the language of command, and where the directions of a statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. V. U.S. Int’l Trade Comm’n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). In the best case scenario for petitioner, since drawings were not received on July 30, 1999, the Office was statutorily prohibited from granting a July 30, 1999 filing date to the application.³ Therefore, the Office should not have mailed a filing receipt that listed July 30, 1999 as the filing date for the application.

Taking the argument further, again *assuming arguendo* that the September 7, 1999 filing receipt were valid, the Office acknowledged receipt of 0 drawings and 1 claim. Petitioner states that he filed an application containing 8 claims and 8 drawings. There is a dramatic discrepancy between what petitioner states he filed on July 30, 1999 and what the Office claimed to receive on July 30, 1999, as enumerated in the September 7, 1999 filing receipt. Petitioner knew or should have known of this discrepancy when petitioner received the September 7, 1999 filing receipt.

An 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 [222 USPQ 273] (Fed. Cir. 1984) (involving trademark registration application); In re Swiseco Foods Ltd., 25 USPQ2d 1552, 1553 (Comm’r of Patents & Trademarks 1992) (same). It is incumbent upon an applicant to prosecute his invention with continuing diligence and an acute awareness of the statute. BEC Pressure Controls Corporation v. Dwyer Instruments, Inc., 380 F.Supp. 1397, 1399, 182 USPQ 190, 192 (D.C. N.Ind. 1974).

The September 7, 1999 filing receipt contains the following language, “...If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination’s Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon.”

Petitioner filed a number of status requests in the three years between the deposit of the application papers and the July 10, 2002 mailing of a Notice of Incomplete Nonprovisional Application. However, inquiring about the status of an application is not equivalent to pointing out errors in a filing receipt. It was petitioner’s responsibility to resolve the inconsistencies of which he was or should have been aware when he received the September 7, 1999 filing receipt.

³ It is the Office’s position that a specification was not received, either.

As stated in the December 20, 2002 dismissal, "While it is regrettable that the Office delayed such a long time in sending a Notice of Incomplete Nonprovisional Application, the delay does not shift the burden of proof on the Office to show what wasn't filed. Rather, the burden of proof continues to be on the petitioner to prove papers were filed and later misplaced."

Regarding (3), the fact that the check for the filing fee was negotiated in August 1999 is not probative of what papers were filed on July 30, 1999. Each component of an application/filing is viewed separately. Just because the Office received an envelope with a check inside, it does not necessarily mean a specification and drawings were in the envelope, also.

Regarding (4), the original utility transmittal letter signed by Mary Trent states five sheets of drawings, 8 claims, 1 independent claim, and a certified copy of a utility application, *inter alia*, were mailed to the Office. The listing of papers on an application transmittal is not sufficient evidence that a paper so listed was actually filed in the Patent and Trademark Office. At best, the utility transmittal letter shows what petitioner intended to file.

Even if the Office were to accept the assertions found in the utility transmittal letter, "a copy of a utility application" does not equate to "a specification." The Office has no way of knowing what exactly "a copy of a utility application" is. Therefore, if the Office were to break from established policy and view the utility transmittal letter as valid evidence of what was filed on July 30, 1999, petitioner could not prove a specification was filed on July 30, 1999 relying on it.

The reality of the situation is that a PTO employee reviewed the July 30, 1999 filing and found that a specification and drawings were missing. This is clearly marked on the utility transmittal letter.

Regarding (5), the fact that Inventor David Starner signed a small entity status document and a power of attorney/declaration between June 14, 1999 and June 18, 1999 does not provide any insight into what was filed on July 30, 1999, besides the small entity status document and power of attorney/declaration.

Regarding (6), the attorney of record submitted a declaration with the October 30, 2002 petition. It contains the declarant's recall of routine events which occurred more than 3 years earlier. The declaration is not more persuasive of what was actually mailed than the contents of the official record.

The best evidence of what was filed on July 30, 1999, is applicant's postcard receipt. The Office established a practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice, which was long ago established and is well publicized, requires that any paper for which a receipt is desired be filed in the Office with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See section 503, Manual Of Patent Examining Procedure (MPEP 503).

Unfortunately, petitioner has not provided a date stamped itemized postcard receipt.

Petitioner has not proved by a preponderance of the evidence that a complete application was filed on July 30, 1999. Therefore, the application is entitled to a filing date of July 22, 2002, which is the date the Office received a specification required by 35 U.S.C. 112 and drawings required by 35 U.S.C. 113.

CONCLUSION

The decision of December 20, 2002 and September 20, 2002 have been reconsidered, but for the reasons given in the previous decisions and noted above, the request under 37 CFR 1.53(e) to accord a July 30, 1999 filing date to the above-identified application is **denied**. The application will retain a July 22, 2002 filing date.

After the mailing of this decision, the application will be forwarded to Technology Center 3700 for examination in due course.

Telephone inquiries related to this decision should be directed to Senior Petitions Attorney E. Shirene Willis (703) 308-6712.

A handwritten signature in cursive script, appearing to read "Charles Pearson".

Charles Pearson
Director, Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

BF/BH