



Paper No. 11

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AUG 23 2004

OFFICE OF PETITIONS

In re Application of	:	
Dunn, et al.	:	
Application No. 10/176,761	:	DECISION ON PETITION
Filed: July 19, 2002	:	
Title: DIGITALLY SYNTHESIZED PHASED	:	
ANTENNA FOR MULTIBEAM GLOBAL	:	
POSITIONING	:	
Attorney Docket No. NPO-20031-1-CU	:	

This is a decision on the "Petition for Reconsideration under 37 CFR 1.378(e)" filed July 11, 2003, requesting that the above-identified application be accorded a filing date of June 18, 2002, rather than the presently accorded filing date of July 19, 2002. This petition is properly treated as a request for reconsideration under § 1.53(e)(2).

The petition is **DENIED**. This decision 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 June 18, 2002, application papers in the above-identified application were received in the Office pursuant to 37 CFR § 1.10;
- The Office returned applicants' return postcard receipt, with a notation "incomplete specification, claim, and drawing as it is;"
- On July 19, 2002, applicants responded filing a copy of the application papers as they maintain they were originally filed on June 18, 2002. No petition accompanied this filing. Accordingly, the Office accorded the application a filing date of July 19, 2002, the date of receipt of the specification and drawings;
- Prior to the Office acting on the July 19, 2002 filing, on August 2, 2002, the Office mailed a "Notice of Incomplete Nonprovisional Application" informing applicants that a

filing date had not been accorded the application papers because the specification as filed did not include at least one claim as required by 35 U.S.C. 112.

- On August 28, 2002, petitioner filed the initial petition asserting that the application as filed on June 18, 2002, included the specification, claims and drawings.
- By Decision mailed December 11, 2002, the petition was dismissed for failure to submit persuasive evidence that the papers required for a filing date were present in the application on filing, but were misplaced.
- On January 28, 2003, petitioner filed the first renewed petition.
- By Decision mailed May 13, 2003, the renewed petition was dismissed for failure to submit persuasive evidence that the papers required for a filing date were present in the application on filing, but were misplaced.
- On July 11, 2003, petitioner filed the instant request for reconsideration.

RELEVANT STATUTES AND REGULATIONS

35 U.S.C. 111(a)(4) provides, in pertinent part, that:

The filing date of a nonprovisional 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, in pertinent part, that:

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.

MPEP 503 provides, in pertinent part, that:

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

OPINION

The decision on this petition is guided by 35 U.S.C. 111(a)(4) which provides, in pertinent part, that the filing date of a nonprovisional application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office. By way of placing a notation on both applicant's return postcard receipt and the application transmittal, the Office acknowledged receipt in this application on June 18, 2002 of only a Transmittal (1 page), a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) (1 page), a

Certificate of Mailing under "Express Mail" (1 page), a Declaration and Power of Attorney (2 pages), and an Information Disclosure Statement and accompanying references¹. In order for this application to be entitled to a filing date of June 18, 2002, petitioner has the burden of establishing by a preponderance of the evidence that the application papers received in the Office on June 18, 2002 also included a specification, claims and any required drawings. Petitioner has sought to meet this burden:

- With an itemized return postcard stamped by the Office on June 18, 2002, but noting thereon that "incomplete specification, claim, and drawing as it is;"
- By arguing that the Office had to have received the specification and drawings, as their weighing of the package as the Office maintains it was filed would not constitute the weight of 2 lbs, 12.8 oz shown on the "Express Mail" mailing label. Petitioner contends that to have reached the weight shown on the label, the "Express Mail" package had to have also included the specification and drawings; and
- Providing a statement of patent attorney John Kusmiss, citing his 17 years of patent prosecution experience, that the papers he personally placed in the "Express Mail" envelope included a specification and drawings.

All of the evidence has again been considered, and again not found persuasive. The postcard is consistent with the Office's decision not to accord the application papers received June 18, 2002 a filing date. It is recognized that the clerk making the inscription on the postcard did not specifically denote on the postcard, which items had been received and which items had not been received. A review of the application papers considered present in the application file on June 18, 2002, supports a conclusion that the inscription reflects that the clerk entering the inscription thought that part of the accompanying reference "Functional Description of Signal Processing in the Rogue GPS Receiver" was the specification, claim and drawing, and discerned that as such, these items were incomplete. Regardless, it is clear that the clerk was not able to identify among the papers filed the items petitioner maintains were filed (a complete 30 page specification, 11 pages containing 34 claims and 7 sheets of drawings containing figures 1A-6). The fact that the clerk made note of the incompleteness of the papers received is more persuasive of their absence, than the fact that the clerk did not denote specific papers as missing is of their presence.

The evidence is not persuasive that a mail room clerk lost,

¹ Furthermore, the application papers as scanned did not include a specification and drawing. In addition, assignment documents were received contrary to petitioner's assertion (page 3, last paragraph of renewed petition) that the prior decision did not indicate that assignment documents were not received. The lack of inclusion of assignment documents in the identification of papers present in the application file is attributed to the fact that assignment documents are forwarded to the Assignment Branch for recording and are not retained in the application file.

misplaced, or damaged part of the application package, or that part of the contents did not get scanned into the system, or that the package arrived in damaged condition with part of its contents missing. This notation would have been made on the postcard upon opening of the Express Mail package, and prior to the scanning of the contents. When packages arrive in a damaged condition, Office personnel ordinarily note such condition in the record, such as by retaining in the application file a copy of the mailing envelope bearing a USPS notation that it was damaged in transit. There is no indication in the instant application file that the application papers were received in a condition other than as mailed.

Applicants' independent weight experiment at the Jet Propulsion Laboratory mail room indicates that the Express Mail package deposited on June 18, 2002, excluding the 37 pages of description, claims and drawings, weighed 1 lb, 7.5 ounces (Kusmiss Declaration at para. 1-2, filed January 28, 2003). As petitioners concede in the present renewed petition, 100 sheets weigh approximately 1 pound. Thus, factoring in the additional 37 sheets (i.e., 5.9 oz) should have resulted in an Express Mail package weight of 1 lb, 13.4 ounces². This is nearly a one pound (i.e. 50%) discrepancy with the weight as measured by the USPS. Thus, by applicants' own evidence, the weight measured by the USPS is grossly inaccurate and hence, cannot be relied upon to establish receipt of the missing papers.

Finally, with all due respect to attorney Kusmiss' experience as a patent attorney, his declaration and certificate of mailing are insufficient to overcome the evidence that the application as filed was incomplete. In light of the other evidence, his declaration of his recall of what was placed in the envelope and his signature on the certificate of mailing at least merely support a conclusion that he intended to include a specification and drawings among the papers filed June 18, 2002, not that such specification and drawings were in fact included in the submission. As such, the declaration and certificate of mailing cannot overcome the notation on the postcard receipt, which is made based on a review of the papers received upon opening of the envelope, that the papers as filed were incomplete and thus, not entitled to a filing date. The declaration and certificate of mailing are insufficient, in light of the other evidence and expressly considering the totality of the evidence, to establish that the application as deposited into the Express Mail service included a specification, claims and drawings.

CONCLUSION

Thus, it is concluded that petitioner has not submitted sufficient evidence to establish receipt of a specification, including claims and drawings on June 18, 2002.

The application is being returned to Technology Center 3662 for

² This is a best case scenario, as petitioners indicate that the weight experiment included cardboard protectors and petitioners cannot recall whether such protectors were included in the original mailing.

consideration by the examiner of the amendment filed August 18, 2003.

Telephone inquiries related to this decision may be directed to Senior Petitions Attorney Nancy Johnson at (703) 305-0309.

A handwritten signature in cursive script, appearing to read "Charles A. Pearson". The signature is written in black ink and is positioned above the printed name and title.

Charles A. Pearson
Director
Office of Petitions