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OFFICE OF PETITIONS

In re Application of :
Bagaric et al. :
Application No. 29/236,396 : ON PETITION
Filed: 16 September, 2005 :
Atty Docket No. UD 051622-1 :

This is a letter in reference to the "RENEWED PETITION and REPLY TO LETTER DISMISSING PETITION" filed on 11 August, 2006, which is treated as a twice renewed petition under 37 CFR 1.53 requesting that the above-identified design application be accorded a filing date of 15 August, 2005. This is also a decision on the concurrently-filed petition under 37 CFR 1.183.

The petition under 37 CFR 1.53 is DENIED.¹

The petition under 37 CFR 1.183 is DISMISSED as moot.

Petition Under 37 CFR 1.53.

BACKGROUND

The application was deposited on 15 August, 2005, without a claim. Accordingly, on 1 September, 2005, Initial Patent Examination Division mailed a Notice of Incomplete Provisional Application stating that the specification did not include at least one claim, and that a claim in accordance with 35 U.S.C. § 112 was required. One (1) page of specification include a claim was filed on 16 September, 2005. The petition filed on 13 March, 2006, was dismissed on 27 April, 2006. The renewed petition filed on 15 May, 2006, was dismissed on 31 July, 2006.

In the present renewed petition, petitioners again assert that a claim was present in the Office on 15 August, 2005.

¹This 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.

Specifically, petitioners assert that statement on the transmittal letter filed with the original application papers stating that the papers enclosed included "1 Pages of Specification including claim" constitutes a claim for purposes of obtaining a filing date.

Specifically, petitioners cite *Brookhill-Wilk I, LLC v. Intuitive Surgical, Inc.*,² as persuasive evidence that the word "claim" in the transmittal letter must be treated as a claim for filing date purposes.

Petitioners further state:

The claim commences on a separate physical sheet as required by 37 CFR 1.75(h). That the separate physical sheet is "included" in the Transmittal is immaterial, as is any excuse from 37 CFR 1.75 the Patent Office may accept for designs according to the Manual of Patent Examining Procedure. The petitioner followed the Rules and should not be denied a filing date for doing so.

STATUTE AND REGULATION

35 USC 112 states, in pertinent part:

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.

37 CFR 1.53(b) states, in pertinent part:

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.

37 CFR 1.75 Claim(s).

² 67 USPQ 2d 1132 (Fed. Cir. 2003).

(a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

...

37 CFR 1.153. Title, description and claim, oath or declaration.

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. **The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described..**

(emphasis added)

OPINION

Petitioners' argument has been considered, but is not persuasive.

As stated previously, a review of the one (1) page of specification received on 15 August, 2005, reveals that no claim is included thereon, contrary to what was stated on the transmittal letter.

Petitioner's reliance upon *Brookhill-Wilk* is misplaced. At the outset, the situation in *Brookhill-Wilk* is readily distinguishable from the present facts: The court in *Brookhill-Wilk*³ was determining the scope of a utility patent claim, not whether or not a design claim was present for filing date purposes. Furthermore, the *Brookhill-Wilk* court did not address whether the Office may specify the format for a design application claim.

To this end, 37 CFR 1.153 specifically sets forth the form of a design application claim. As such, the mere appearance of the word "claim" in design application papers does not mean that a proper claim for filing date purposes is present.

Petitioners' argument, if accepted, that whether or not the claim complies with 37 CFR 1.75 is "immaterial," is tantamount to

³ Id. at 1136.

asserting that any and all defects in the presentation of the claim must be overlooked by the Office. This position is clearly inconsistent with 35 USC 112 and is untenable, as this argument, if taken to its ultimate conclusion, is essentially that the Office may not enforce laws and regulations concerning the format of patent applications.

In short, despite petitioners' assertion to the contrary, petitioners clearly neither include a claim with the application nor follow the applicable laws or rules. Moreover, petitioners' concurrent argument that any failure to follow the rules should be excused is similarly unpersuasive.

To this end, assuming, *arugendo*, that the USPTO were to give some latitude to petitioners in the presentation of their claim, the papers presented so deviate from the regulations and established practice of the Office that they do not comply with 35 USC 112. Simply put, the papers submitted on 15 August, 2005, did not particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Lastly, with regard to petitioners' intent to file a claim, the mere fact that petitioners intended to file a claim does not mean that they, in fact, filed a claim in accordance with the laws and USPTO rules. It is applicant's responsibility to follow the laws, regulations, and procedures of the USPTO when filing a design patent application.

As stated previously, the showing of record is that the first formal claim was received with the papers filed on 16 September, 2005. As such, the application has been properly accorded a filing date of 16 September, 2005.

DECISION

In summary, it is clear that petitioner has not filed a claim in compliance with 35 USC 112 or 37 CFR 1.153 in this design application. The showing of record is nothing that could be construed as a design claim was filed until 16 September, 2005. As such, the filing date of the application remains 16 September, 2005. The petition is **denied**.

Petition Under 37 CFR 1.183

It is noted on the last page of the present renewed petition that petitioners state that they have demonstrated "good intent" to file a claim, and "[s]uch good intent . . . supported by some fact of claim, should . . . be . . . excused under 37 CFR 1.183."

The fee for a petition under 37 CFR 1.183 is \$400.00. As no fee was paid, and no authorization charge a deposit account presented, the petition cannot be treated on the merits. Patent fees and charges payable to the United States Patent and Trademark Office are required to be paid in advance; that is, at the time of requesting any action by the Office for which a fee or charge is payable.⁴

As such, the petition will be **dismissed as moot**.

This application is being referred to the Office of Initial Patent Examination for further processing with a filing date of 16 September, 2005.

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.



Charles A. Pearson
Director, Office of Petitions

⁴ 37 CFR 1.22