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OFFICE OF PETITIONS

In re Application of :
Brian Klock :
Application No. 29/303,937 : DECISION DENYING PETITION
Deposited: February 20, 2008 :
Attorney Docket No. KLWK-1-1003 :

This is a decision on “REQUEST FOR RECONSIDERATION OF DENIAL OF PETITION FOR GRANT OF FILING DATE UNDER 37 C.F.R. 1.53(e)(2)”, filed March 9, 2009, requesting reconsideration of the prior decision refusing to accord the above-identified design application a filing date of February 20, 2008.

The petition under 37 CFR 1.53(e) (2) is **DENIED**. This decision on the present petition 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 February 20, 2008, applicant deposited the above-identified application with the United States Patent and Trademark Office. On March 7, 2008, the Office of Patent Application Processing mailed a “Notice of Incomplete Nonprovisional Application,” informing applicant that the application papers had not been accorded a filing date because the specification did not include at least one claim. The Notice required the submission of a complete specification as prescribed by 35 U.S.C. 112, the statutory basic filing fee, the search fee, the examination fee, and a newly executed oath or declaration covering the items within two months of the date of the Notice or proceedings on the application would be terminated. On June 10, 2008, the Office of Patent Application Processing mailed a Notice of Termination of Proceedings Under 37 CFR 1.53(e), indicating that the proceedings on the above-identified application number were terminated because the application did not meet the requirements of 37 CFR 1.53(b), (c), or (d) to be entitled to a filing date, and the filing error(s) specified in the Notice mailed on March 7, 2008, were not timely corrected.

On July 2, 2008, applicant filed a “PETITION FOR GRANT OF FILING DATE UNDER 37 C.F.R. 1.53(e)(2)”, requesting that the Office accord the above-identified application a filing date of February

20, 2008. On January 5, 2009, the Office mailed a decision dismissing the petition and indicating that the application is incomplete and not entitled to a filing date. On March 9, 2009, applicant filed the present petition under 37 CFR 1.53(e)(2), requesting reconsideration of the prior decision refusing to accord the above-identified application a filing date of February 20, 2008.

STATUTE AND REGULATION

35 U.S.C. 111 provides:

(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 Director.

(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 Director.

(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 Director 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.

35 U.S.C. 112 provides, in pertinent part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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.

35 U.S.C. 171 provides:

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

37 CFR 1.151 provides:

The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

37 C.F.R. 1.153 provides:

(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. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

DISCUSSION

Applicant renews his argument that the above-identified application as filed contained a proper claim for a design application - "The ornamental design for a motorcycle windshield as shown", and thus, should have been accorded a filing date of February 20, 2008.

Applicant cites to 37 CFR 1.153 as governing the requirements for a design patent application. Additionally, applicant cites to 37 CFR 1.154(b) and MPEP 1503.01 for guidance on the elements of a design patent and their preferred arrangement. Applicant states:

[T]he design patent claim in the subject application: "The ornamental design for a motorcycle windshield, as shown" precisely tracks the language required by [37 CFR 1.153]. Such language is unique in style and form, and is easily identified as a design patent claim language (and could not reasonably be interpreted as any other part of the application).

...

It should be noted that the provisions of 37 CFR 1.154 are phrased as *desirable* sections and specification arrangements. Accordingly, design patent applications wherein the elements appear in a different order do not fail to comply with the requirements of 37 CFR 1.153.

...

In the subject application, the claim to "The ornamental design for a motorcycle windshield as shown" is placed prominently below the Title of the specification, and is clearly directed to the motorcycle windshield referred to in the Title as "A Flared

Windshield for a Motorcycle” and referenced in the drawing description as “a flared windshield.” See the subject Application, page 1.

This claim clearly conforms to the requirements of 37 CFR 1.153(a) as being a claim “*to the ornamental design for the article (specifying name) as shown,*” and it is presented in a form that precisely mirrors the form set forth in this regulation.

The claim's language is not “misdescriptive, inaccurate or unclear,” and therefore clearly conforms to the requirements of 35 U.S.C. 112, second paragraph, and is well within the interpretive latitude required by MPEP 1503.01.

...

Accordingly, the subject application contained, upon filing, a proper design patent claim that conforms, both in substance and form, with the requirements of 35 U.S.C. 112, second paragraph[□], 37 CFR 1.153 and MPEP 1503.01.

Petition dated 03/09/09, pp. 3-7.

Furthermore, applicant asserts that the Office of Petitions, in its previous decision dismissing the initial petition, failed to interpret properly 35 U.S.C. 111(a)(2) as read with 35 U.S.C. 112, second paragraph. Applicant argues:

Indeed, 35 U.S.C. 111(a)(2) does indeed provide that an application shall include *inter alia* “a specification as prescribed by section 112 of this title.” However, what is believed to be the relevant portion of Section 112, second paragraph provides only 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.”

Applicant respectfully submits that Section 112, second paragraph does not expressly state that an application is not entitled to a filing date if an application does not *conclude with a claim*[□], nor does it provide that an application is not entitled to a filing date if the claim(s) does/do not *particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention*.[□] This language is simply reiterated in 37 C.F.R. 1.75(a).

The only rule that directly denies an applicant a filing date for failing to include a claim in the specification is 37 C.F.R. 1.53, and that developed through decisional precedent, apparently interpreting both 35 U.S.C. 111(a) and 37 C.F.R. 1.51. However, 37 C.F.R. 1.51 speaks only to what a complete application comprises, not directly addressing when a filing date is to be accorded.

...

Applicant respectfully submits that the subject term has *no other reasonable interpretation* than as a design patent claim, even without the words “I claim,” “we claim” or “what is claimed is,” which is readily implied by its form and construction.

...

This phrase has no other arguable meaning or interpretation. Its placement beneath the heading Brief Description of the Drawings in no way alters its meaning. The term does not serve to describe the drawings and if anything is merely misplaced. Indeed, the term refers to the ornamental design *as shown*, even in advance of the balance of the section that describes each figure. The term thus is clearly out of order in context, nothing more; and its placement still does not alter its clear meaning and import.

Petition dated 03/09/09, pp. 8-9, 11-12.

Applicant has provided a list of design patent applications which applicant states contain claim language consistent with the contested language in this application. As further support for applicant's argument, applicant notes that the Examiner in Application No. 29/303,294 amended the same language for accuracy by inserting the words "I CLAIM:" in advance of the noun phrase "The ornamental design for a motorcycle windshield, as shown." Applicant states: "This evidence indicates that the subject noun phrase was clearly and unequivocally recognized as being a design patent claim by the Patent Examiner herself *even without it being placed at the end of the specification, and notwithstanding its placement below the heading Brief Description of the Drawings.*" *Petition dated 03/09/09, p. 14.*

The Office has considered applicant's arguments but does not find them persuasive. At the outset, the issue is not the form of a design claim, but rather whether the application papers as deposited included a claim. The form of a design claim is set by rule pursuant to 37 CFR 1.153. However, the requirement that a design application must include a claim to be entitled to a filing date is set by statute. The Office notes that:

35 U.S.C. 111(a) (2) requires that an application for patent include, *inter alia*, "a specification as prescribed by section 112 of this title," and 35 U.S.C. 111(a)(4) provides 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." 35 U.S.C. 112, first paragraph, provides, in part, that "[t]he specification shall contain a written description of the invention," and 35 U.S.C. 112, second paragraph, provides that "[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." . . .

Therefore, in an application filed under 35 U.S.C. 111(a), a claim is a statutory requirement for according a filing date to the application. 35 U.S.C. 162 and 35 U.S.C. 171 make 35 U.S.C. 112 applicable to plant and design applications, and 35 U.S.C. 162 specifically requires the specification in a plant patent application to contain a claim. 35 U.S.C. 111(b)(2), however, provides that "[a] claim, as required by the second through fifth paragraphs of section 112, shall not be required in a provisional application." Thus, with the exception of provisional applications filed under 35 U.S.C. 111(b), any application filed without at least one claim is incomplete and not entitled to a filing date.

If a nonprovisional application does not contain at least one claim, a "Notice of Incomplete Application" will be mailed to the applicant(s) indicating that no filing date has

been granted and setting a period for submitting a claim. The filing date will be the date of receipt of at least one claim. *See In re Mattson, 208 USPQ 168 (Comm'r Pat. 1980)*. An oath or declaration in compliance with 37 CFR 1.63 and 37 CFR 1.64 referring to the claim being submitted is also required.

MPEP 601.01(e).

A review of the record reveals that the application as deposited on February 20, 2008, did not contain a claim as required by statute. The application does not include any language identified as a claim or any language at the end of the specification that the Office can construe as a claim. As applicant failed to meet the basic statutory requirement under 35 U.S.C. 111(a) that the application must include a claim to be entitled to a filing date, any discussion of whether applicant has meet the requirements of 37 CFR 1.153 is unnecessary.

The Office disagrees with applicant's contention that the language referred to by applicant is easily identified as a design claim and could not reasonably be interpreted as any other part of the application and that its placement under the heading Brief Description of the Drawings in no way alters its meaning. As acknowledged by applicant, the language does not include the word "claim" and does not appear at the end of the specification as required by 35 U.S.C. 112, second paragraph. Moreover, the language appears as a sentence below the heading of Brief Description of the Drawings and is considered part of the brief description.

Additionally, the Office does not find the list of design patent applications provided by applicant supportive of applicant's arguments. Specifically, a review of these design patent applications reveals that the claim language on filing appeared at the end of the specification and contained a form of the word "claim". For example, in Application No. 29/322,984, now Patent No. D586,974, the claim language contained the words "we claim"¹ and appeared at the end of the specification on page 2 of 2. In Application No. 29/318,616, now Patent No. D586,975, the claim language contained the words "I claim" and appeared as the last sentence of the one-page specification. In Application No. 29/261,959, now Patent No. D586,978, the claim language contained the phrase "What is claimed"² and appeared at the conclusion of the specification on page 2 of 2. Unlike the language that applicant argues is a claim in the present design application, the language and its placement in Application Nos. 29/322,984, 29/318616, and 29/261,959 clearly identify it as a claim.

Lastly, applicant's assertion that Application No. 29/303,294, in which the Examiner amended the language by inserting "I CLAIM:" before "The ornamental design for a motorcycle windshield, as shown", serves as evidence that the contested language is "clearly and unequivocally recognized as being a design patent claim" is without merit. The Office has withdrawn Application No. 29/303,294 from issue and mailed a Notice of Incomplete Nonprovisional Application, indicating that the application is not entitled to a filing date because the specification does not include a claim.

¹ "WE CLAIM: The ornamental design for a forklift truck, as shown and described."

² "What is claimed is: The ornamental design for a LOUVER ASSEMBLY as shown and described."

DECISION

The Office has reconsidered the prior decision refusing to accord the above-identified application a filing date of February 20, 2008. For the reasons stated, applicant has not shown that applicant filed a complete design application, including a claim, on February 20, 2008. Absent the presence of a claim, the application cannot be afforded a filing date of February 20, 2008. As applicant has failed to submit a claim in this design application to date, the application is incomplete and not entitled to a filing date. The Director will not undertake any further review or reconsideration of the petition.

Telephone inquiries should be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211.

A handwritten signature in black ink, appearing to read 'Charles A. Pearson', with a long horizontal flourish extending to the right.

Charles A. Pearson
Director
Office of Petitions