UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAILED

AUG 27 2009

OFFICE OF PETITIONS

In re Application of	:	
Someya Yukimichi	:	
Application No.11/693,417	:	DECISION ON PETITION
Filed: March 19, 2008	:	
Attorney Docket No. 305844US28	:	

This is a decision on the Renewed Petition Under 37 CFR 1.181, filed November 24, 2008 which is being treated as a renewed petition requesting that the above-identified application be accorded a filing date under 37 CFR 1.53(e) of March 29, 2007. In the alternative, petitioner requests a filing date of March 19, 2008, the date the original petition was filed with a copy of the application.

The Petition for the March 29, 2007 filing date is **DENIED**[1].

The Petition for the March 19, 2008 filing date is **GRANTED**.

BACKGROUND

The instant application was allegedly submitted on March 29, 2007. No filing date was granted. The file shows that petitioner filed an Electronic Patent Application Fee Transmittal form on March 29, 2007. A total of $1,130 in filing fees were provided and these fees were processed on March 30, 2007. An Electronic Acknowledgement Receipt (Receipt) was sent out the same day as the fee filing, March 29, 2007, indicating receipt of the $1,130 fees. The Receipt did not acknowledge that any papers other than the fees were received on that day.

A petition under 37 CFR 1.53(e) was filed March 19, 2008 and dismissed in a decision mailed April 11, 2008.

A renewed petition was filed May 14, 2008 and dismissed in a decision mailed September 22, 2008.

---

[1] 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.

The instant renewed petition was filed November 24, 2008.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 USC 111(a) states:

> (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 the 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 drawings 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.

MPEP 503 states:

> It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).
>
> Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO.

The Electronic Acknowledgement Receipt form states:

> This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

OPINION

Petitioner asserts that a complete patent application was uploaded to the PTO server on March 29, 2007 and that the application was electronically deposited at the PTO on that date. Petitioner further asserts that the application was lost after upload and "disappeared in the electronic ether." Petitioner admits that the electronic filing software in use at the time could allow the filer to complete the filing process and be issued a serial number even if the uploaded application was not included with the electronic filing.

Extensive review of the PTO EFS Web files does not show any evidence of the filing of a complete application, the only submission was the filing fee.

Petitioner argues that the PTO has subsequently altered the electronic filing software and thus implies from this that the software in place at the time of filing was somehow flawed. Petitioner makes multiple references in the various petitions filed to a software flaw or "bug". The software, when initially deployed, worked when used as instructed. Other applications filed using the electronic filing software were successfully filed.

On March 19, 2007 petitioner electronically filed $1,130 in filing fees. On the same day the PTO electronically mailed an Electronic Acknowledgement Receipt which indicated the PTO had received only the filing fees with no other application papers acknowledged. This should have been a clear notice to petitioner that there was a problem in the filing of the application and petitioner should have taken immediate action to clarify the application filing problem. The petition filed May 14, 2008 indicates on page 5 that the Receipt was not reviewed by anyone in the law firm and thus the incomplete filing was not discovered in a timely manner.

The statute (35 USC 111(a)(4) provides that a specification and any required drawings are necessary requirements to obtain a filing date. In the present instance, a specification and drawings were simply not received at the USPTO prior to March 19, 2008.

DECISION

A review of the record indicates no error on the part of the PTO's electronic filing system. Petitioner was given clear and immediate notice that the filing of the application was incomplete but failed to take action on the Notice. The first petition was filed almost one year after the initial filing of the incomplete application. As such, the petition for a filing date of March 29, 2007 is **DENIED**.

Petitioner requests in the alternative (foot note on page 4 of the instant petition) that the application be granted a filing date of March 19, 2008. This was the date a complete application was filed along with the first petition. The request for a filing date of March 19, 2008 is **GRANTED.**

Telephone inquires concerning this decision should be directed to Carl Friedman at 571-272-6842.

This application is being forwarded to the Office of Patent Application Processing for processing of the application with a filing date of March 19, 2008.

Charles Pearson
Director, Office of Petitions