



Paper No. 15

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OFFICE OF PETITIONS

In re Application of
Webber et al.
Application No. 09/478,140
Filed: January 5, 2000
Attorney Docket No.: 5181-43401

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: DECISION DENYING PETITION
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This is a decision on the renewed petition filed December 17, 2002, to withdraw the holding of abandonment.

The petition is **DENIED**.

BACKGROUND

The above-identified application papers were deposited on January 5, 2000. The Office of Initial Patent Examination (OIPE) found the papers to be complete for purposes of according a filing date, and assigned application No. 09/478,140 to these papers.

However, on February 16, 2000, OIPE mailed a Notice indicating that while a filing date had been assigned to the application papers, the oath or declaration was missing or unsigned, which along with the late completion surcharge had to be filed within TWO Months of the Notice, or as extended under 37 CFR 1.136(a), to avoid abandonment of the application.

In timely reply, on April 20, 2000 (accompanied by an executed Certificate of Mailing under 37 CFR 1.8, bearing a date of execution of April 17, 2000, as April 16, 2000, was a Sunday), applicant filed a document styled as a declaration and the surcharge. The declaration and power of attorney, a copy of that which executed the parent application, named joint inventors Webber and Joshi, but was signed only by Joshi.

The application was inadvertently placed on the files for examination and in due course the application was allowed. In reviewing the file for printing as a patent, the Office of Publications noted the missing signature on the declaration and referred the application to this office.

A Notice of Abandonment was mailed November 26, 2001, from this office which indicated that the basis for the holding was applicant's failure to supply an oath or declaration that

included the signature of Webber, in reply to the Notice of February 16, 2000. Applicant was invited to show that the USPTO had in fact timely received an oath or declaration signed by Webber, by way of a stamped postcard receipt showing USPTO receipt of "two" declarations on April 20, 2000, or in the alternative supply a copy of a declaration from the parent application executed by Webber, or one newly executed by Webber, along with a petition to revive under 37 CFR 1.137.

A petition to withdraw the holding of abandonment was filed August 1, 2002. Petitioner contended that the transmittal letter of April 20, 2000, and the enclosed copy of the itemized postcard receipt date stamped April 20, 2000, showed USPTO receipt of a "combined Declaration and Power of Attorney," which had been executed by both inventors. Petitioner further noted the lack of any concurrent USPTO indication that his reply of April 20, 2000, was deficient.

The petition was dismissed in the decision of October 9, 2002. The decision noted that the itemized postcard receipt was consistent with the contents of this file. That is, the single declaration of record signed by Webber is a combined declaration and power of attorney, and while counsel contended the combined declaration and power of attorney was executed in counterpart [i.e., each inventor signed one copy] and was mailed to the USPTO in counterpart, the itemized postcard receipt simply does not acknowledge USPTO receipt of a combined declaration and power of attorney executed in counterpart.

The instant petition was filed December 17, 2002.

STATUTE, REGULATION and EXAMINING PROCEDURE

On April 20, 2000, USC 111 provided in pertinent part:

- (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 Commissioner.
 - (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 Commissioner.
 - (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 Commissioner 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. (emphasis added)

On April 20, 2000, 35 USC 115 stated in pertinent part:

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof for which he solicits a patent: and shall state of what country he is a citizen.

On April 20, 2000, 35 USC 116 stated in pertinent part:

When an invention is made by two or more persons jointly, **they shall apply for patent jointly and each make the required oath except as otherwise provided in this title**...If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor.(emphasis added)

On April 20, 2000, MPEP 503 stated in pertinent part¹:

If a receipt of any item (e.g., paper or fee) filed in the PTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard identifying the item. The PTO will stamp the receipt date on the postcard and place it in the outgoing mail. 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.

¹ *Manual of Patent Examining Procedure* (MPEP), 7th Ed. Rev. 1 (Feb. 2000). The MPEP has no binding force on the courts, but it commands notice as an official interpretation of statutes and regulations with which it does not conflict. Patent attorneys, examiners, and the public commonly rely on the MPEP as a guide in procedural matters. *In re Kaghan*, 387 F.2d 398, 401, 156 USPQ 130, 132 (CCPA 1967); *Syntex v. U.S. Patent and Trademark Office*, 882 F.2d 1570, 1571 n.3, 11 USPQ2d 1866, 1867 n.3 (Fed. Cir. 1989); *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1439, 221 USPQ 97, 107 (Fed. Cir. 1984).

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, applicant identifier, application number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., **and the number of pages being submitted**. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, **number of pages of oath/declaration**, number of pages of cover sheet (provisional application).(emphasis added)

The postcard receipt will not serve as prima facie evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as prima facie evidence of receipt of those items(emphasis added).

OPINION

Petitioner requests reconsideration of the holding of abandonment and asserts that he filed the requisite declaration(s) executed in counterpart. That is, petitioner asserts, the evidence of record including the postcard receipt shows that the declaration(s) executed in counterpart were received at the USPTO.

The arguments are not persuasive. The Office file wrapper is the official record of the papers originally filed in this application. A review of the official file reveals that the only papers relevant to the issue that were received at the USPTO on April 20, 2000, were 3 pages of a document captioned "Declaration For Patent Application (executed in counterpart)," that named Webber and Joshi as joint inventors, gave a power of attorney, and specified a correspondence address but was signed only by Joshi. A document captioned "Declaration For Patent Application (executed in counterpart)" that named Webber and Joshi as joint inventors, gave a power of attorney, and specified a

correspondence address, and was signed by Webber, other than that filed with the petition of August 1, 2002, is clearly lacking from the file, and cannot be located.²

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. The evidence submitted does not warrant a conclusion that any document also signed by Webber was actually received in the Patent and Trademark Office on April 20, 2000.

As to the transmittal letter, that, at best, evidences applicants' intent to file "a combined Declaration and Power of Attorney" on April 20, 2000, but cannot evidence what was received at the USPTO. The relevant document received April 20, 2000 was in fact a "combined declaration [under 37 CFR 1.63] and power of attorney [pursuant to 37 CFR 1.31]", but it was only signed by Joshi. Thus, the transmittal letter, even construed in a light most favorable to petitioner, simply does not provide adequate evidence to support any conclusion that a declaration(s) signed by both Joshi and Webber was filed by applicants, much less received by the USPTO on the date in question.

Indeed, the Office has a well established and well-publicized practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice 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).

In this regard, the copy of the postcard receipt proffered with the petition only establishes receipt at the USPTO of "[a] Combined Declaration and Power of Attorney," which is consistent with the file record contents as of April 20, 2000, which as noted above show USPTO receipt on that date of a "combined declaration and power of attorney" signed only by Joshi. While petitioner argues that the postcard identifies receipt of a "declaration executed in counterpart," as correctly noted in the decision of October 9, 2002, (at 2) the postcard is entirely silent as to itemizing, or receipt of, two combined declarations and powers of attorney, much less two combined declarations and powers of attorney

² The declaration required by 37 CFR 1.63 is independent of any power of attorney given by the inventor pursuant to 37 CFR 1.31, or the requirement in 37 CFR 1.33 for applicant to specify an address to which USPTO correspondence will be sent. Nevertheless, applicants often satisfy more than one of these rules by the use of, as here, a *combined* declaration *and* power of attorney which may also specify the correspondence address.

executed in counterpart; or any mention of the word counterpart. While petitioner contends that his interpretation of the itemized postcard receipt of "a combined declaration and power of attorney," which document was itself styled as executed in counterpart, evidences USPTO receipt of the two copies executed in counterpart, as petitioner was previously apprised counsel's arguments cannot take the place of evidence lacking in the record. See In re Scarbrough, 500 F.2d 312, 182 USPQ 298 (CCPA 1974). Indeed, the itemization on the postcard did not even list the number of pages of the combined declaration and power of attorney. But see MPEP 503. Petitioner is reminded that the degree of itemization and specificity on the postcard is a circumstance that is entirely within his control when the postcard is prepared. Since the instant postcard receipt at issue did not adequately itemize either the number of pages of the declaration and power of attorney; or did not itemize that two combined declarations and powers of attorney, or did not itemize that the declarations were signed in counterpart, it will not be accepted as *prima facie* evidence of receipt of a declaration signed by Webber on April 20, 2000.

Petitioner points to the lack of any earlier USPTO communication indicating that the reply of April 20, 2000 was deficient, as "some level of credible evidence that the submitted Declaration was not insufficient and included the signatures of both signatures." To the extent the lack of an earlier outgoing USPTO communication constitutes some level of credible evidence on this matter, such just as credibly evidences that OIPE failed to notice the omitted signature of Webber on the combined declaration and power of attorney that was received on April 20, 2000. While the USPTO regrets that applicant was not notified in time of his filing error to avoid abandonment of this application, the situation may be nevertheless remedied under 37 CFR 1.137. As correctly noted in the decision of October 9, 2002 at 2, it was, ultimately, applicants responsibility to ensure that a timely and proper reply to the Notice was received at the USPTO.

The patent statute at 35 USC §§ 111(a)(2)(c) and 115 specifically requires an oath or declaration as a statutory requisite of an application for patent, and 35 USC 116 requires that *each joint inventor* must make the required oath. Furthermore, 35 USC 111(a)(3) sets forth that, as was done here, the Commissioner shall give an applicant Notice that his application lacks the statutorily required oath or declaration, and 35 USC 111(a)(4) sets forth that, as here, when applicant receives such notice but does not supply the statutorily required oath or declaration executed by all the joint inventors, the application becomes abandoned by operation of the law.

The failure to timely and properly reply to the Notice, or provide adequate business records showing that a timely and proper reply was in fact received at the USPTO, was a circumstance within the control of petitioner. As noted in Brenner v. Ebbert, 398 F.2d 762, 765, 157 USPQ 609, 611 (D.C. Cir. 1968), *cert. den.* 159 USPQ 799:

The Constitution requires notice reasonably designed to forewarn against approaching default; but it does not insure against the effects of a mistaken response to timely notice knowingly received.

It follows that petitioner had received the reasonable notice required so as ensure a timely and full response to the Notice. That petitioner failed to timely and adequately respond by including all necessary declarations, or can not now provide adequate evidence of such, is unfortunate, but such failure does not operate to save this application from abandonment (35 USC 111(a)(4)), nor was the failure to properly reply a circumstance beyond the control of petitioner in the exercise of reasonable care and diligence. See Brenner, supra.

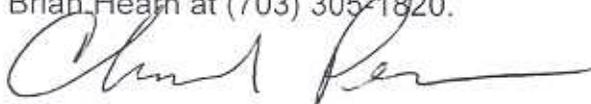
DECISION

For the reasons given above, the holding of abandonment is proper and will not be disturbed. This application remains abandoned. The petition is **denied**.

This decision may be regarded as a final agency action within the meaning of 5 USC § 704 for purposes of seeking judicial review. See MPEP § 1002.02. The USPTO will not further consider or reconsider this matter.

Petitioner is not unduly prejudiced by this decision, as he may seek revival under 37 CFR 1.137.

Any questions concerning this decision may be directed to Senior Petitions Examiner Brian Hearn at (703) 305-1820.



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