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OFFICE OF PETITIONS

In re Application of :  
Lei et al. :  
Application Number: 12/319223 : DECISION DENYING PETITION  
Filing Date: 01/03/2009 :  
Attorney Docket Number: 100544- :  
5004-US :

This is a decision in reference to the "RENEWED PETITION TO ACCORD FILING DATE UNDER 37 C.F.R. § 1.10(c)," filed on September 4, 2009, requesting that the above-identified application be accorded a filing date of December 31, 2008, rather than the currently-accorded filing date of January 3, 2009.

The petition is DENIED.<sup>1</sup>

BACKGROUND

On January 3, 2009, the application was filed.

On April 7, 2009, a petition under 37 CFR 1.10(c) was filed, requesting that the application be accorded a filing date of December 31, 2008, rather than the currently-accorded filing date of January 3, 2009.

On May 7, 2009, the petition was dismissed.

On July 7, 2009, a renewed petition was filed.

On August 4, 2009, the renewed petition was dismissed.

On September 4, 2009, the subject twice renewed petition was filed.

Petitioners again aver that the application was deposited in "Express Mail" Post Office to Addressee service, in accordance with 37 CFR 1.10, on December 31, 2008. Specifically, petitioners

<sup>1</sup> This is a final agency action. See MPEP 1002.02.

assert that the Express Mail number was present on the correspondence as originally filed, because the Express Mail number was present on the return receipt postcard. In support, petitioners provided, with the renewed petition filed on July 7, 2009, a copy of USPS Express Mail Customer Label No. EV533740290US. The Customer Label shows a "date-in" and an official USPS postmark date of December 31, 2008. Petitioners further provided a copy of an itemized return receipt postcard containing the "Express Mail" number listed above as well as the application number, and itemizing the application elements filed.

The prior petitions were dismissed on May 7, 2009, and August 4, 2009, for lack of placement of the "Express Mail" label number on the application papers as filed, as required by 37 CFR 1.10(c). Specifically, a review of the application papers in the Official file revealed that the "Express Mail" had not been placed on the correspondence prior to the original mailing by "Express Mail."

On September 4, 2009, the subject twice renewed petition was filed. Petitioners again assert that the application is entitled to a filing date of December 31, 2008. Petitioners additionally argue that the document containing the "Express Mail" number is a "cover that itemized each of the separate papers" and is, therefore, a part of the correspondence as originally filed as required by 37 CFR 1.10(c).

#### STATUTES AND REGULATIONS

35 U.S.C. 21(a) states:

The Director may by rule prescribe that any paper or fee required to be filed in the Patent and Trademark Office will be considered to be filed in the Office on the date on which it was deposited with the United States Postal Service but for postal interruptions or emergencies designated by the Director.

37 C.F.R. 1.10 Filing of correspondence by "Express Mail."

(a)...

(b)...

(c). Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between

the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Director to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

**(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and**

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit...

(emphasis added)

#### OPINION

Petitioners again argue that the postcard containing the Express Mail number is a part of the correspondence filed in the Office, which was received on January 3, 2009.

At the outset, a search of the Image File Wrapper (IFW) for the subject application reveals that no document containing the Express Mail number referenced above is located therein. The IFW is the official record of the application. Petitioners' assertion that the Express Mail number is included in the application papers is not more persuasive than the contents of the official IFW file. As such, the showing of record is that petitioner failed to place the Express Mail label number on the originally filed specification and claims, drawings, and transmittal sheet.

The placement of the Express Mail label number on a paper ties the paper to a single, identifiable Express Mail receipt. Where questions are later raised concerning the filing date of the paper, the USPTO may require the applicant to supply a copy of the Express Mail receipt identified on the paper in order to verify the mailing date. Where no Express Mail label number is

identified on a paper, the USPTO has no way of independently associating the paper with any particular Express Mail receipt.

The difficulty caused by an applicant's failure to place an Express Mail label number on a paper is clearly illustrated by this case. Since no Express Mail label number was placed on the application papers prior to mailing, the USPTO has nothing in its control from the filing date of the papers to independently corroborate the applicants' assertion that the application was filed on December 31, 2008.

Further, petitioner's argument that the "Express Mail" label number was placed on a "cover" which was "securely attached to the itemized papers," is not convincing. Neither the application transmittal sheet, nor any other papers received with original disclosure, contain the Express Mail label number. The only document which contains the Express Mail number is the postcard, which was returned to the applicant. If, as alleged by petitioners, this document was a cover sheet, rather than a return receipt postcard, it would not have been returned to the applicants, but would be retained a part of the application file.

Simply put, in view of the USPTO regulations and policies, there is no basis to consider a document which itemized the application papers and was returned to the applicant a cover sheet, which is part of the application papers, rather than a postcard, which is not part of the correspondence filed in the Office. As no document containing the Express Mail label is located among the papers in the official IFW file, the requirements of 37 CFR 1.10(c) have not been satisfied.

MPEP 513(III) states, in pertinent part, that to be effective, the number must be placed on each separate paper and each fee transmittal either directly on the document or by a separate paper firmly and securely attached.

A similar situation was addressed by the U.S. District Court for the Eastern District of Virginia in the recent case of *O'Shannessy v. Doll*.<sup>2</sup> In *O'Shannessy*, applicant asserted that the Express Mail number, placed on the return receipt postcard, should be considered to be present on the application papers as deposited in the USPTO. In a memorandum opinion, the court agreed with the USPTO's interpretation that the return receipt postcard was not part of "the paper(s) or fee(s) that constitute the

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<sup>2</sup> Action No. 1:08cv01 (May 20, 2008).

correspondence.”<sup>3</sup> In pertinent part, the *O’Shannessy* court stated:

[I]t is clear that a return receipt postcard serves no purposes other than to provide an applicant with an acknowledgement that the USPTO received his or her application documents and fees filed with the USPTO by utilizing the USPS’s “Express Mail” service. Because the USPTO does not retain the postcard, but rather returns it to the applicant, the postcard is not part of “the paper(s) or fee(s) that constitute the correspondence” filed with the agency; its returned to the applicant.<sup>4</sup>

In view of the above, the petition is denied.

#### CONCLUSION

The evidence and arguments presented have been carefully considered, but are not persuasive of applicants’ entitlement to a filing date of December 31, 2008. In order to obtain a filing date of December 31, 2008 under 37 CFR 1.10, however, petitioners must establish to the satisfaction of the Director that the original application papers were properly deposited in Express Mail service on December 31, 2008. In this case, applicants have not provided sufficient evidence to support their entitlement to a filing date of December 31, 2008. Accordingly, applicants have failed to meet their burden.

The previous decision has been reconsidered as requested. However, the petition is denied.

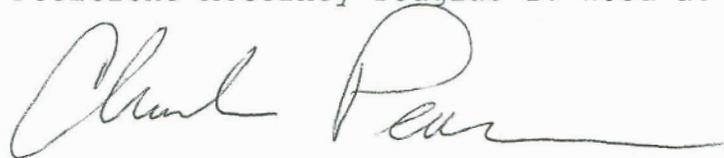
This application file is being forwarded to the Office of Patent Application Processing for further processing with the presently accorded filing date of January 3, 2009.

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<sup>3</sup> Id.

<sup>4</sup> Id.

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

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

Charles A. Pearson  
Director  
Office of Petitions