



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

Paper No.

Michael G. Gilman
424 Lantana Park
Lexington KY 40515

MAILED

MAR 24 2010

OFFICE OF PETITIONS

In re Application of :
Borsa et al. :
Application No. 12/455,355 : DECISION ON SECOND RENEWED
Filing Date: June 1, 2009 : PETITION UNDER
Attorney Docket Number: 4624- : 37 C.F.R. § 1.183
005 :
Title: PROCESS FOR THE :
PREPARATION OF ESTERS OF :
DIACEREIN WITH HYALURONIC ACID :
AND PHARMACEUTICAL COMPOSITIONS :
CONTAINING SUCH ESTERS :

Background

This is a decision on the second renewed petition filed on November 9, 2009, pursuant to 37 C.F.R. § 1.183. Petitioner has requested the waiver of Rule 1.6(d)(3), which prohibits the filing of "a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date"¹ via facsimile transmission.

In short, on May 5, 2009, Petitioner believed that it was imperative to obtain a filing date prior to May 9, 2009, and that the submission of this application via facsimile transmission would be the best way to accomplish this goal,² unaware of the prohibition against submitting an application on original deposit via facsimile transmission.³ A filing date was not accorded, due to this prohibition. Petitioner later submitted the application via Express Mail and obtained a filing date of June 1, 2009, pursuant to 37 C.F.R. § 1.6(2). Petitioner seeks to have this

¹ See also Rule 1.8(a)(2)(i)(A).

² Original petition, page 2, and renewed petition, pages 2-3.

³ Original petition, pages 1-2, and renewed petition, page 3.

application accorded a filing date of May 5, 2009, the date on which it was submitted via facsimile transmission. Alternatively, Petitioner seeks to have the May 5, 2009 submission treated as a filing of a provisional application.

A discussion follows.

Applicable Rules

37 C.F.R. §§ 1.6(a)(2) and (4) set forth, *in toto*:

(a) Date of receipt and Express Mail date of deposit. Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(2) Correspondence filed in accordance with § 1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service.

(4) Correspondence may be submitted using the Office electronic filing system only in accordance with the Office electronic filing system requirements. Correspondence submitted to the Office by way of the Office electronic filing system will be accorded a receipt date, which is the date the correspondence is received at the correspondence address for the Office set forth in § 1.1 when it was officially submitted.

37 C.F.R. § 1.6(d)(3) sets forth, *in toto*:

(d) Facsimile transmission. Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the United States Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See § 1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the United States Patent and Trademark Office. The application number of a patent application, the control number of a reexamination proceeding, the interference number of an interference proceeding, or the patent number of a patent should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and, if submitted, will not be accorded a date of receipt in the following situations:

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in § 1.8(a)(2)(i)(A) through (D) and (F), and § 1.8(a)(2)(iii)(A), except that a continued prosecution application under § 1.53(d) may be transmitted to the Office by facsimile;

37 C.F.R. § 1.8(a)(2)(i)(A) sets forth, *in toto*:

The filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date, including a request for a continued prosecution application under § 1.53(d);

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

[47 FR 41278, Sept. 17, 1982, effective Oct. 1, 1982; revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003]

Procedural History and Analysis

An original petition was filed on July 24, 2009 along with the petition fee, and was dismissed via the mailing of a decision on September 1, 2009, which set forth, *in pertinent part*:

In order to submit a grantable petition under 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has implied that an extraordinary situation exists, and has alleged that justice requires waiver of the rule.⁴ However, the record does not support a finding that this situation presents an extraordinary situation, such that justice requires waiver of the rule.

Rule 1.6(d)(3) prohibits the filing of "a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date"⁵ via facsimile transmission.

Petitioner was faced with a situation where he believed that he had only 5 days to secure a filing date.⁶ Applicants can receive a filing date on the same day on which they file the application, should they avail themselves of Express Mail practice (37 C.F.R. § 1.6(a)(2)) or Electronic Filing (37 C.F.R. § 1.6(a)(4)). There is nothing extraordinary about a practitioner who finds himself faced with a deadline, and as such, the rules provide two methods by which an applicant may receive a filing date on the same date that the application is either deposited with the USPS or filed electronically.

It follows that justice does not require the waiver of Rule 1.6(d)(3). Patent practitioners have two methods by which they can obtain a filing date on the same day on which they file the application. Petitioner chose a method that is both outside of these two established avenues and is explicitly prohibited. As a

⁴ Petition, pages 2-3.

⁵ Rule 1.8(a)(2)(i)(A).

⁶ Petition, page 2.

registered member of the patent bar, Petitioner is expected to know the relevant regulations pertaining to his practice and under which this Office operates, and he is charged with the responsibility of keeping himself up to date with any changes in these matters. The commission of an error that stems from a failure to be aware of a publicized Office practice does not give rise to a situation where justice requires the waiver of the rule.^[7]

Decision on original petition, pages 3-4.

A renewed petition was filed on September 10, 2009, where Petitioner provided, *inter alia*, evidentiary support for his assertion that the application was submitted to the Office via facsimile transmission on May 5, 2009, and a copy of the paper he received from the Office's Application Assistance Unit, explaining the prohibition against the deposit of a new application via facsimile transmission.

The renewed petition was dismissed via the mailing of a decision on September 28, 2009, which set forth, *in pertinent part*:

...it is clear that Petitioner did not attempt to file this application via facsimile transmission until the date which Petitioner deemed to be critical was fast approaching. While an applicant may wait until the last day to file an application in order to establish continuity, the applicant does so at his or her peril, as he/she does not leave any opportunity to overcome any error which might occur in filing the application. The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay.⁸

In summary, Petitioner waited until just two [sic: four] days before the date which he deemed to be critical, and deposited this application with the Office in a manner that is expressly prohibited by Rule 1.6(d)(3). It follows that the record does not support a finding that an extraordinary situation is present, such that justice requires waiver of Rule 1.6(d)(3).

Decision on renewed petition, page 4.

With this second renewed petition, Petitioner has asserted that should the Office deny Petitioner's request to accord this application a filing date of May 5, 2009, this will result in "this application having an official filing date that is 27 days

7 In re Dubost, 231 USPQ 887, 889 (Comm'r Pat. 1986). See also In re Harding et al., 211 USPQ 903, 905 (Comm'r Pat. 1980), Ex parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 U.S.P.Q. 378, 379 (Comm'r Pat. 1968).

8 Id.

after one year from the date on which the subject matter of this application was published" and "[t]hat is an extraordinary situation warranting the Director's intervention."⁹ This assertion misses the point, as it focuses on the consequences of Petitioner's erroneous action with the question of whether Petitioner's situation (which came about as a direct result of his erroneous manner of submitting an application to the Office) constitutes an extraordinary situation such that justice requires the waiver of the Rules.

The Office concludes that this situation does not constitute an extraordinary situation such that justice requires the waiver of the Rules.

Regarding the existence of an extraordinary situation, there is nothing extraordinary about a registered practitioner who is faced with a deadline, and has limited time to secure a filing date: the Office has publicized the two methods by which a practitioner may secure the date of submission as the filing date (Express Mail practice and EFS-Web). Moreover, there is nothing extraordinary about a practitioner who failed to act in concert with published regulations.

Regarding the question of whether justice requires the waiver of the prohibition against securing a filing date via facsimile transmission, with this second renewed petition, Petitioner has included a letter from his client dated April 30, 2009, which indicates that it was imperative for this application to be filed by "the 9th of May 2009 (18 months form (sic) the Italian publication plus one year)." As such, it is clear that Petitioner's client waited until the end of the time period for claiming benefits under 35 U.S.C. 119 was fast approaching to complete the application in final form for filing and to submit it to his American representative for filing with the Office. While an applicant may wait until the last day to file an application, the applicant does so at his or her peril. Those who file at the end of a statutory bar year (35 U.S.C. 102(b)) or a priority year (35 U.S.C. 119) or who delay filing a continuing application until the last possible day for establishing continuity (35 U.S.C. 120 or 121), do not leave any opportunity to overcome any error which might occur in filing the application, such as what occurred in the present situation. The Office, where it has the power to do so, should not relax the

⁹ Second renewed petition, page 4.

requirements of established practice in order to save an applicant from the consequence of his delay.¹⁰

Finally, with this second renewed petition, Petitioner has requested the alternate relief of treating the facsimile submission of May 5, 2009 as a provisional application. Treating the submission of May 5, 2009 as a provisional application would not overcome the prohibition against the filing of an application via facsimile transmission - Rules 1.6(d)(3) and 1.8(a)(2)(i)(A) prohibit "[t]he filing of a national patent application specification and drawing or other correspondence for the purpose of obtaining an application filing date,"¹¹ and a provisional application is a national patent application within the meaning of Rule 1.8(a)(2)(i)(A). As such, were the Office to treat the facsimile submission of May 5, 2009 as a provisional application, the result would remain the same.

Conclusion

This second petition under 37 C.F.R. § 1.183 is DENIED.¹²

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹³



Charles Pearson
Director
Office of Petitions
United States Patent and Trademark Office

¹⁰ In re Dubost, 231 USPQ 887, 889 (Comm'r Pat. 1986). See also In re Harding et al., 211 USPQ 903, 905 (Comm'r Pat. 1980), Ex parte Sassin, 1906 Dec. Comm'r. Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 U.S.P.Q. 378, 379 (Comm'r Pat. 1968).

¹¹ 37 C.F.R. § 1.8(a)(2)(i)(A).

¹² This decision is a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of seeking judicial review. See MPEP § 1002.02.

¹³ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).