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UNITED STATES PATENT AND TRADEMARK OFFICE

28 JUL 2010

2140 Req to Recon
DOCKETED ON DECISION

DUE DATE Sept. 28, 2010

Commissioner for Patents
United States Patent and Trademark Office
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time

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DOCKETED BY LG MP

In re Application of:

U.S. Application No.:

Filing Date:

Attorney's Docket No.: JSP-4110-104

For:

DECISION ON PETITION
UNDER 37 CFR 1.183

This decision is in response to the "Renewed Petition" filed 08 February 2010 under 37 CFR 1.183 requesting the Office to recognize a benefit claim to prior-filed U.S. provisional application no. "

For reasons below, the petition is **DISMISSED**, without prejudice.

BACKGROUND

On 11 October 2005, applicants filed U.S. provisional application no. in the United States Patent and Trademark Office (USPTO).

On 15 October 2006, applicants filed international application no. in the Israeli Receiving Office (RO/IL) claiming priority to provisional application no. RO/IL was closed for business from October 8-14, 2006.¹

On 28 March 2008, applicants filed the present application under 35 U.S.C. 111(a) claiming benefit under 35 U.S.C. 120 and 365(c) to international application no. and benefit under 35 U.S.C. 119(e) to provisional application no. 60/724,904. The USPTO mailed a filing receipt that included the benefit claim to the international application but did not include the benefit claim to the provisional application.

On 17 March 2009, applicants filed a request for corrected Filing Receipt to add the provisional claim.

¹ October 8-12 was a national religious holiday in Israel (Sukkoth). Further, because RO/IL is closed every Friday and Saturday, RO/IL was closed on October 13 (Friday) and 14.

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On 25 March 2009, the USPTO mailed a "Response to Request for Corrected Filing Receipt" refusing the request because the provisional application was "filed over a year prior to the filing date of this application."

On 20 April 2009, applicants filed a petition for corrected filing receipt.

On 07 December 2009, a decision was mailed dismissing the petition. The decision held that the benefit claim to the provisional application failed to comply with the provisions of 35 U.S.C. 119(e).

On 08 February 2010, applicants filed the present petition under 37 CFR 1.183 considered herein.

RELEVANT AUTHORITY

35 U.S.C. 119(e)

*(1) An application for patent filed under section 111(a) or section 363 of this title for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in a provisional application filed under section 111(b) of this title, by an inventor or inventors named in the provisional application, shall have the same effect, as to such invention, as though filed on the date of the provisional application filed under section 111(b) of this title, if the application for patent filed under section 111(a) or section 363 of this title is filed not later than 12 months after the date on which the provisional application was filed and if it contains or is amended to contain a specific reference to the provisional application. ****

(3) If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

35 U.S.C. 363

An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office except as otherwise provided in section 102(e) of this title.

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PCT Article 8

- (2)(a) *Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.*
- (b) *The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.*

PCT Rule 80.5 Expiration on a Non-Working Day or Official Holiday

If the expiration of any period during which any document or fee must reach a national Office or intergovernmental organization falls on a day:

(i) *on which such Office or organization is not open to the public for the purposes of the transaction of official business;*

the period shall expire on the next subsequent day on which none of the said four circumstances exists.

DISCUSSION

Petitioners request the USPTO to recognize the benefit claim to provisional application no. [redacted] and present two arguments in support thereof. Specifically, Petitioners argue: 1) in the interest of justice, the Director should "waive and suspend the interpretation of the rules in the [present] application such that PCT Rule 80.5 regarding closure of the RO/IL is recognized," and 2) the prior decision conflicts with PCT Articles 27 and 47. These arguments are addressed below.

I. Waiver under 37 CFR 1.183

Petitioners request that, in the interest of justice, the Director "waive and suspend the interpretation of the rules in the above-identified application such that PCT Rule 80.5 regarding closure of the Israeli Receiving Office is recognized." Petitioners present several arguments as to why non-recognition of the provisional claim in the present case is unfair to applicants.

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37 CFR 1.183 provides:

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(f). (Emphasis added).

It is clear from the wording of §1.183 that the Director's waiver authority is not unbounded. Waiver authority is only applicable to requirements of the "regulations in this part", i.e., the regulations contained in Part 1 of Title 37 of the Code of Federal Regulations (CFR). Furthermore, a requirement cannot be waived if it is a statutory requirement.

In the present case, Petitioners have not identified any requirement of any regulation contained in the CFR to be waived. Nor was the prior decision refusing recognition of the provisional claim based on any controlling U.S. regulation. Rather, as clearly indicated in the prior decision, the conclusion reached therein was based on the statutory requirements of 35 U.S.C. 119(e), which apply to international applications designating the United States.² The requirements of §119(e) are clear. Section 119(e)(1) requires an application filed under § 363 (i.e., an international application designating the United States) to be filed "not later than 12 months after the date on which the provisional application was filed." An extension of this 12-month period is provided in § 119(e)(3). However, this extension is limited to cases where the 12-month date falls on a Saturday, Sunday, or Federal holiday within the District of Columbia. Because the relief requested on petition requires waiver of a statutory requirement, the petition cannot be granted.

Petitioners argue that the Director has authority to treat the Israeli national holiday and normal RO/IL Friday closure as a "Federal holiday within the District of Columbia." The statutory construction advanced by Petitioners does not fall within the plain meaning of the statute. Nor have Petitioners cited any authority to support such a sweeping proposition. The instances identified by Petitioners where the Director has declared a day to be a "Federal holiday within the District of Columbia" have been instances where the USPTO was closed. See also 37 CFR 1.9(h) ("A Federal holiday within the District of Columbia as used in this chapter means any day, except Saturdays and Sundays, when the Patent and Trademark Office is officially closed for business for the entire day."). The USPTO was open for business on October 11-13, 2006.

² 35 U.S.C. 119(e)(1) states: "An application for patent filed under *** section 363 *** shall have the same effect, as to such invention, as though filed on the date of the provisional application ***". International applications designating the United States are filed under 35 U.S.C. 363.

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It is also noted that, contrary to Petitioners' assertion, applicants could have filed their international application in the RO/US on October 11, 2006 (i.e., the 12-month date) and have that date accorded as the international filing date under PCT Article 11. The fact that all applicants are residents and nationals of Israel only means that the international application would have been transmitted by the RO/US to the International Bureau as the receiving Office pursuant to PCT Rule 19.4. Such transmittal would not affect the international filing date. In addition, the application could have been filed directly with the International Bureau. See PCT Rule 19.1(a)(iii).

II. No Conflict with PCT Articles 27 & 47

Petitioners further argue that "disregarding PCT Rule 80.5 conflicts with PCT Article 27 & 47." Contrary to Petitioners' assertion, PCT Rule 80.5 has not been disregarded. Rather, Rule 80.5 simply doesn't apply in determining whether a U.S. national phase application is entitled to benefit of a prior-filed U.S. provisional application. In the U.S. national phase of an international application, the conditions for obtaining benefit to a U.S. provisional application are governed by U.S. national law. This conclusion is based on the provisions of PCT Article 8(2)(b), which state:

*Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed *** the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State. (Emphasis added)*

With regard to the meaning of "national law", PCT Article 2(x) states:

(x) references to "national law" shall be construed as references to the national law of a Contracting State or, where a regional application or a regional patent is involved, to the treaty providing for the filing of regional applications or the granting of regional patents;

Consequently, it is clear from the above that U.S. national law, i.e., 35 U.S.C. 119(e), governs the conditions for and effect of a priority claim to a U.S. provisional application in a U.S. national phase application. Through enactment of §119(e), Congress has clearly spoken as to what conditions must be satisfied in order for an international application designating the United States to obtain benefit of a prior filed U.S. provisional application.

Petitioners' assertion that "national law" used in Article 8(2)(b) is subject to Rule 80.5 distorts the meaning of this term and is not consistent with the definition of "national law" in Article 2(x) that this term is to be construed as a reference to the "national law of a Contracting State." Furthermore, Petitioners' reliance on Article 27(1) is unfounded, as this provision only prohibits a national office from imposing requirements relating to the form or contents of the international

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application that are "different or additional to those which are provided for in this Treaty and the Regulations." Since Article 8(2)(b) delegates to the national office the authority to set conditions for recognition of domestic benefit claims, the conditions of §119(e) are not different from or additional to those provided under the PCT or the PCT Regulations. Nor does Article 47(1) help Petitioners, as this provision merely provides that "[t]he details for computing time limits referred to in this Treaty are governed by the Regulations." Article 47 does not contravene the clear authority given to a national office under Article 8(2)(b) to set its own conditions for domestic priority.

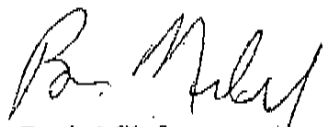
Petitioners' cite to the Caterpillar decision as deciding a "similar issue". However, Caterpillar did not involve a PCT provision that expressly permits a national office to impose conditions under its national law.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.183 is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.183." No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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