



28 JUL 2010

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

NIXON & VANDERHYE, PC  
901 North Glebe Road, 11<sup>th</sup> Floor  
Arlington, VA 22203

In re Application of:	:	
TOUITOU et al.	:	DECISION ON PETITION
U.S. Application No.: 12/078,317	:	UNDER 37 CFR 1.183
Filing Date: 28 March 2008	:	
Attorney's Docket No.: JSP-4110-104	:	
For: COMPOSITIONS FOR NASAL	:	
DELIVERY	:	

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. 60/724,904.

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

**BACKGROUND**

On 11 October 2005, applicants filed U.S. provisional application no. 60/724,904 in the United States Patent and Trademark Office (USPTO).

On 15 October 2006, applicants filed international application no. PCT/IL2006/001187 in the Israeli Receiving Office (RO/IL) claiming priority to provisional application no. 60/724,904. RO/IL was closed for business from October 8-14, 2006.<sup>1</sup>

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. PCT/IL2006/001187 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.

<sup>1</sup> 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.

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.*

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. 60/724,904 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.

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.<sup>2</sup> 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.

---

<sup>2</sup> 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.

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

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.

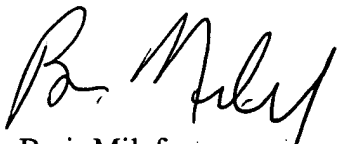
Petitioners' cite to the Caterpillar decision as deciding a "similar issue". However, Caterpillar did not involve a PCT provision that expressly permits a national office to impose conditions under its national law.

### 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.



Boris Milef  
PCT Legal Examiner  
Office of PCT Legal Administration  
571 272-3288

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

TOUITOU et al.

Atty. Ref.: GPK-4110-104

Serial No. 12/078,317

TC/A.U.: 1615

Filed: March 28, 2008

Examiner: Unassigned

For: COMPOSITIONS FOR NASAL DELIVERY

\* \* \* \* \*

February 8, 2010

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RENEWED PETITION**

Applicants respectfully request reconsideration of the Office of PCT Legal Administration's Decision of December 7, 2009 (Decision), denying the benefit of priority that was recognized in this present application's parent, PCT App. No. PCT/IL2006/001187 (the PCT '187 application).

For at least the reasons stated below, Applicants request application of Rule 183 – rather than Rule 181 as noted in the Decision – and request that, in the interests of justice and fairness, 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. The Director's current interpretation – i.e., that PCT Rule 80.5 has no effect in the United States in these circumstances – appear neither in any portion of the MPEP nor any other publicly available statement of the USPTO regarding

the Patent Cooperation Treaty. Thus, it is unjust and contrary to the PCT (e.g. Articles 27 and 47) to disregard PCT Rule 80.5. And just as the Director retroactively deems days that the USPTO is closed due to inclement weather to be a “Federal holiday within the District of Columbia,”<sup>1</sup> the Director should treat the set of days that the Israeli PCT Receiving Office was closed due as a “Federal holiday within the District of Columbia” for the limited purpose of recognizing the priority claim in the above-identified application.

In addition, the Director’s Decision is in direct conflict with PCT Articles 27 & 47, and the Director is not entitled to ignore PCT Rule 80.5 under these circumstances.

Applicants reiterate that this priority claim was submitted concurrently with the filing of the above-identified application, e.g., in the Oath and in the Preliminary Amendment. Thus, the priority claim was timely.

## **I. Timeline**

Applicants reproduce the salient timeline relative to this request for reconsideration. The timeline appears to be uncontested by the Director:

---

October 11, 2005: U.S. Provisional App. No. 60/724,904 (the ’904 provisional) filed in the USPTO<sup>2</sup>

---

<sup>1</sup> (See, e.g., Closing of the Patent and Trademark Office on Monday, December 21, 2009, 1350 OG 248 (January 19, 2010).)

<sup>2</sup> Irrespective of the Decision and this Renewed Petition, U.S. App. No. 60/724,904 filed on October 11, 2005, (the ’904 provisional) may serve as evidence of invention in the United States, if necessary.



---

October 8-14, 2006: Israeli Patent Office (and PCT Receiving Office) closed.

There was a federal, religious holiday in Israel (Sukkoth) from October 8, 2006, to October 12, 2006. Friday, October 13, 2006, and Saturday, October 14, 2006, were weekend days in Israel. Thus, October 15, 2006, was the first subsequent, secular business day that the Israeli Patent Office was open after October 11, 2006.<sup>3</sup>

---

October 15, 2006: PCT App. No. PCT/IL2006/001187 (the PCT '187 application) filed in Israeli Receiving Office, claiming the benefit of priority to U.S. App. No. 60/724,904

---

March 28, 2008: U.S. App. No. 12/078,317 (the '317 application) filed in the USPTO, claiming the benefit of priority to the PCT '187 application and the benefit of priority therethrough to the '904 provisional<sup>4</sup>

---

## II. The Decision

Applicants understand the Decision to rest solely on the ground that “the 12-month date in the present case (i.e., 11 October 2006) did not fall on a ‘Saturday, Sunday, or Federal holiday within the District of Columbia’, the extension under sec. 119(e)(3) does not apply, and consequently, petitioners have not satisfied the conditions under 35 U.S.C. 119(e) for obtaining the benefit of the filing date of provisional application 60/724,904.” (Decision at 3.)

Applicants further understand that the Director has not challenged the application of PCT Rule 80.5 to the priority determination made by the Receiving Office for the '187 PCT application. That is, Applicants understand the Director's decision as solely affecting the '317 application.

---

<sup>3</sup> (See <http://www.wipo.int/pct/en/filing/closingdates/2006/pdf/il.pdf>.)

<sup>4</sup> The '317 application's claim to the benefit of priority to U.S. App. No. 60/907,340 is not at issue here.

**III. The Director Should Waive the Interpretation of the Rules in These Circumstances And Treat the Timely Filing in the Israeli Receiving Office as if Filed on a Day the USPTO Were Itself Closed**

The present Decision creates an anomalous and unjust situation where the perfected priority claim is valid in every other country except the United States. This is especially true because the MPEP indicates that PCT Rule 80.5 governing closures would be honored. Similarly, the present Decision creates an unjust situation in comparison to other applications where extensions to the 12-month period are granted for days that are not Saturdays, Sundays, or Federal holidays within the District of Columbia.

Accordingly, Applicants request application of Rule 183, which states: “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.” The present circumstances present an extraordinary situation, and the Director’s Decision disproportionately affects foreign applicants for patents that reasonably rely upon international rules in filing international applications.

**A. Applicants Could Not Have Filed the PCT ’187 Application in the United States Receiving Office**

Applicants are residents and citizens of Israel. None are residents or citizens of the United States. Thus, under PCT Rule 19.1 and 35 U.S.C. § 361, the PCT ’187 application could not have been filed in the United States. Rather, it was filed, as allowed by PCT Rule 19.1, in the Israeli Receiving Office.

There is no question that the priority claim was timely made and recognized by the Israeli Receiving Office. There is no question that the International Bureau recognized the PCT '187 application's priority claim to the '904 provisional. And there is no question that the Israeli Receiving Office was closed on October 11, 2006, and that the next secular, business day fell on October 15, 2006.

Accordingly, the 12-month period fell on a day when the office was closed. Under PCT Rule 80.5, the period for filing a timely priority claim to the '904 provisional "expire[d] on the next subsequent day."

**B. The Director Has Not Indicated That Rule 80.5 Has No Applicability to Certain PCT Applications Designating the United States**

Chapter 1800 of the MPEP does not indicate in any portion that Rule 80.5 will be disregarded in any circumstances. To the contrary, the only indication in the MPEP is that the Director will honor the Rule, expressly stating "See PCT Rule 80.5 for guidance on periods which expire on a non-working day." MPEP § 1834.02. Thus, the only indication is that Rule 80.5 would be recognized. And there is no statement that would undercut reliance on Rule 80.5.<sup>5</sup> Similarly, there is no indication that any priority claim recognized by the International Bureau would be not recognized by the Director under a constrained interpretation of U.S. law. *See* PCT Article 27(1) ("No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and

---

<sup>5</sup> Applicants are similarly unaware of any Notice or Order issued by the Director that would indicate that PCT Rule 80.5 has no effect in certain PCT applications.

the Regulations.”); PCT Article 47(1) (“The details for computing time limits referred to in this Treaty are governed by the Regulations”); *see also Caterpillar Tractor Co. v. Comm’n of Patents & Trademarks*, 650 F. Supp. 218, 219 (E.D.Va. 1986) (holding that the USPTO’s application of restriction practice, rather than international principles relating to unity of invention, to applications filed under the PCT as contrary to the PCT and thus contrary to law).

The inequity of the absence of advance warning is manifest. Applicants relied upon PCT Rule 80.5 in filing the PCT ’187 application. The priority claim was recognized by the International Bureau.

Furthermore, the United States has made certain reservations under the PCT as authorized by PCT Article 64, but none relate to PCT Rule 80.5.<sup>6</sup> The United States’ only reservations, declarations, notifications, and incompatibilities are limited to:

- PCT Article 64(3)(a), which relates to publications
- PCT Article 64(4)(a), which relates to effective prior art date
- PCT Rule 20.1(d), which relates to the USPTO acting as a Receiving Office
- PCT Rule 26.3ter(b), which relates to the USPTO acting as a Receiving Office
- PCT Rule 26.3ter(d), which relates to the USPTO acting as a Receiving Office
- PCT Rule 49.5(1), which relates to transmittal to the USPTO acting as a Designated Office of information not in English and in need of translation

---

<sup>6</sup> These reservations appear – along with declarations, notifications and incompatibilities – at [http://www.wipo.int/pct/en/texts/reservations/res\\_incomp.html](http://www.wipo.int/pct/en/texts/reservations/res_incomp.html). *See also* MPEP § 1803.

- PCT Rule 49*ter*.1(g), which relates to the restoration of priority under PCT Rule 26*bis*.3 by the Receiving Office in an application where the USPTO acts as a Designated Office
- PCT Rule 49*ter*.2(h), which relates to the restoration of priority under PCT by the USPTO acting as a Designated Office

None of these Articles or Rules subject to reservations of the United States relates to a priority dates recognized by the International Bureau and that was not restored. The priority claim was not subject to the restoration provisions of the PCT.

Accordingly, the USPTO has made no reservation to the reasonable provisions of PCT Rule 80.5, which does not require a patent applicant to file a document with a Receiving Office on a day that that Receiving Office is closed. Moreover, the only indication pre-dating the Director's Decision affecting the priority claim in the PCT '187 application is that the Director would recognize and follow PCT Rule 80.5. *See* MPEP § 1834.02.

**C. The Director Has the Authority to Extend the 12-Month “Deadline”**

The Director routinely deems non-holidays to be holidays for the purposes of Title 35. For example, the Patent Act plainly states: “When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.” 35 U.S.C. § 21(b).

This language mirrors the language in § 119(e).

This statutory language, however, has been interpreted liberally. For example, any filing that would have been due on Saturday, December 19, 2009, would have been timely if filed on Tuesday, December 21, 2009:

In view of the official closing of the Federal Government offices in the Washington, D.C. metropolitan area, including the United States Patent and Trademark Office (USPTO), on Monday, December 21, 2009, the USPTO will consider Monday, December 21, 2009, to be a “Federal holiday within the District of Columbia” under 35 U.S.C. § 21(b) and 37 C.F.R. §§ 1.6, 1.7, 1.9, 2.2(d), 2.195 and 2.196. Any action or fee due on Monday, December 21, 2009 (or the preceding Saturday (December 19, 2009) or Sunday (December 20, 2009)) will be considered as timely for the purposes of, e.g., 15 U.S.C. §§ 1051(b), 1058, 1059, 1062(b), 1063, 1064, 1126(d), or 35 U.S.C. §§ 119, 120, 133 and 151, if the action is taken, or the fee paid, on the next succeeding business day on which the USPTO is open, that is, Tuesday, December 22, 2009. 37 C.F.R. §§ 1.7(a) and 2.196.

(Closing of the Patent and Trademark Office on Monday, December 21, 2009, 1350 OG 248 (January 19, 2010) (emphasis added).)<sup>7</sup> Monday, December 21, 2009, was not a Federal holiday within the District of Columbia, even though the Director “considered” it to be one for limited purposes.<sup>8,9</sup>

---

<sup>7</sup> Similarly, the snowstorm on February 5-6, 2010, closed the federal government, including the USPTO on today, February 8. In an abundance of caution, the present Renewed Petition is being filed today rather than tomorrow.

<sup>8</sup> Legal public holidays within the District of Columbia are defined by statute:

(a) The following are legal public holidays:

New Year’s Day, January 1.

Birthday of Martin Luther King, Jr., the third Monday in January.

Washington’s Birthday, the third Monday in February.

Memorial Day, the last Monday in May.

Independence Day, July 4.

Labor Day, the first Monday in September.

Columbus Day, the second Monday in October.

Veterans Day, November 11.

Thanksgiving Day, the fourth Thursday in November.

Moreover, even § 119(e) and § 21(b) refer to the “next succeeding secular or business day.” The days that the Israeli Receiving Office was closed for a religious holiday, and applying PCT Rule 80.5 to allow filing on the next secular day would be consistent with the statutory instruction to honor religious holidays. There is no statutory bar precluding the Director from honoring the closure of a non-U.S. Receiving Office due to a national, religious holiday. The priority claim of the above-identified application should be recognized here.

Disallowing the priority claim in this instance would work an injustice disproportionately borne by foreign citizens and residents who reasonably rely on PCT Rule 80.5. (This is especially true for Israeli applicants, whose weekend falls on Fridays and Saturdays, not Saturdays and Sundays.)

---

Christmas Day, December 25.

\* \* \*

(c) January 20 of each fourth year after 1965, Inauguration Day, is a legal public holiday for the purpose of statutes relating to pay and leave of employees as defined by section 2105 of this title and individuals employed by the government of the District of Columbia employed in the District of Columbia, Montgomery and Prince Georges Counties in Maryland, Arlington and Fairfax Counties in Virginia, and the cities of Alexandria and Falls Church in Virginia. When January 20 of any fourth year after 1965 falls on Sunday, the next succeeding day selected for the public observance of the inauguration of the President is a legal public holiday for the purpose of this subsection.

5 U.S.C. § 6103.

<sup>9</sup> WIPO even recognizes the USPTO’s closure on December 21, 2009:  
<http://www.wipo.int/export/sites/www/pct/en/filing/closingdates/2009/pdf/us.pdf>

And lastly, application of Rule 183 would prevent the anomalous situation where a priority claim to a U.S. provisional application is recognized in all other countries except the United States.

Because the Director has authority to consider any day a “Federal holiday within the District of Columbia,” Applicants request the Director consider October 11-13, 2006, to be Federal holidays within the District of Columbia for the limited purpose of recognizing the priority claim of the ’317 application that was endorsed by the Israeli Receiving Office and the International Bureau.

#### **IV. Disregarding PCT Rule 80.5 Conflicts With PCT Articles 27 & 47**

PCT Article 27(1) plainly provides that “[n]o national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.” And PCT Article 47(1) states that “[t]he details for computing time limits referred to in this Treaty are governed by the Regulations.” That is, the “national” law referred to in Article 8 is subject, under PCT Articles 27 and 47, to the receiving office closure rule expressed in Rule 80.5. Accordingly, the present disregard of PCT Rule 80.5 conflicts with the United States’ treaty obligations under the PCT.

PCT Article 8(b) states, in relevant part:

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.



PCT Article 80.5, however, does not change the priority claim itself. The Rule pertains to the form and contents of an international application and specifically relates to closures of certain offices. PCT Rule 80.5 merely permits filing of any document to the next succeeding business day – this is, in effect, the PCT equivalent of 35 U.S.C. § 21:

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;
- (ii) on which ordinary mail is not delivered in the locality in which such Office or organization is situated;
- (iii) which, where such Office or organization is situated in more than one locality, is an official holiday in at least one of the localities in which such Office or organization is situated, and in circumstances where the national law applicable by that Office or organization provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day; or
- (iv) which, where such Office is the government authority of a Contracting State entrusted with the granting of patents, is an official holiday in part of that Contracting State, and in circumstances where the national law applicable by that Office provides, in respect of national applications, that, in such a case, such period shall expire on a subsequent day;

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

As noted in Section III.A., Applicants are Israeli citizens and residents. They could not file in the USPTO Receiving Office, and the filing was timely in the Israeli Receiving Office, because PCT Article 47 and PCT Rule 80.5 permit filing an international application on “the next subsequent day” on which the Israeli Receiving Office was open. PCT Article 47 and PCT Rule 80.5 do not permit a Designated Office

to disregard a closure of a Receiving Office, particularly not in a way that disrespects the spirit and intent of the PCT and Paris Convention.

A similar issue arose previously with respect to restriction practice. Early on in the PCT's existence, the USPTO issued restriction requirements – rather than rejections based on unity of invention principles – in national phase entries from PCT applications. As now, PCT Rule 13 required that an “international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept (‘requirement of unity of invention’).” *Caterpillar Tractor Co. v. Comm’n of Patents & Trademarks*, 650 F. Supp. 218, 218 (E.D.Va. 1986). This PCT Rule trumped the USPTO's rules regarding restriction practice, with the court specifically holding that the USPTO's attempts to reconcile its Treaty obligations with restriction practice constituted an “unreasonable interpretation.” *Id.* at 220. (The *Caterpillar* decision is now reflected in 37 C.F.R. § 1.499 as explained in MPEP 1889.03(d).)

Because the Director's Decision conflicts with the treaty obligations of the PCT, the decision must be reversed.

## **V. Conclusion**

For at least the foregoing reasons, Applicants request reconsideration of the Office of PCT Legal Administration's Decision of December 7, 2009. Although Applicants urge reversal of the Decision, Applicants request that, in the event the Decision is maintained, the Decision remain without prejudice to further consideration.

TOUITOU et al.  
Serial No. 12/078,317

It is believed that no petition fee is necessary. Nevertheless, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:                     /Gordon P. Klancnik/  
Gordon P. Klancnik  
Reg. No. 50,964

GPK:lmj  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100