



Paper No. 5

ALEXANDER PORAT
BLAKE CASSELS & GRAYDON
INTELLECTUAL PROPERTY GROUP
BOX 25 COMMERCE COURT WEST
TORONTO, ON M5A 1A9
CANADA

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OFFICE OF PETITIONS

In re Application of	:	
Younes et al.	:	
Application No. 60/135,104	:	ON PETITION
Filed: 28 April, 1999	:	
Attorney Docket No. 53921/00079	:	

This is a decision on the petition filed on 3 November, 2000, under 37 CFR 1.183 requesting that the above-referenced provisional application, filed on 28 April, 1999, be converted to a nonprovisional application.

The petition is DENIED.¹

BACKGROUND

The present application papers were deposited as a nonprovisional application under 35 USC 111(a) and 37 CFR 1.53(b) on 28 April, 1999.

On 18 May, 1999, the Office of Initial Patent Examination (OIPE) mailed a Notice of Incomplete Application, stating that these application papers, assigned Application No. 09/300,832, had not been accorded a filing date because the specification did not include at least one claim as required by 35 U.S.C. § 112 and 35 U.S.C. § 111(a).

On 15 July, 1999, a petition was filed under 35 U.S.C. 111(b)(6) and 37 CFR 1.53(c)(2) to treat, i.e., convert, the nonprovisional

¹This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02. The provisions of 37 CFR 1.181(f) do not apply to this decision.

application papers as a provisional application filed under 35 U.S.C. 111(b) and 37 CFR 1.53(c).

The petition was granted in a decision mailed on 22 July, 1999,² and provisional Application No. 60/135,104 was assigned to these application papers, which were accorded a filing date of April 29, 1999, the date of filing these application papers. It should be noted that provisional application papers, then or now, do not require a claim to be accorded a filing date. See 35 USC 111(b) (2).

By operation of 35 U.S.C. § 111(b) (5), provisional application No. 60/135,104 became abandoned on 29 April, 2000, twelve months after its filing date.

The present petition was filed on 3 November, 2000. The petition requests that the provisions of 37 CFR 1.53(c) (3) be waived under 37 CFR 1.183 such that, notwithstanding the abandonment of the provisional application 12 months after its filing date, petitioners be permitted to convert the present provisional application to a nonprovisional application. Petitioners assert that conversion is necessary so that petitioners can establish copendency with another nonprovisional application, No. 09/558,589, filed on 26 April, 2000, and, in that application, claim priority under 35 U.S.C. § 119 to Canadian Application No. 2,236,190, to which petitioners had claimed priority in Application No. 09/300,832.

STATUTE, REGULATION, AND PROCEDURE

35 U.S.C. § 2(b) (2) states, in part, that:

The Office. . . may establish regulations, not inconsistent with law, which--(A) shall govern the conduct of proceedings in the Office;(B) shall be made in accordance with section 553 of title 5, United States Code...

On 29 April, 1999, 35 U.S.C. § 111(b) (5) stated:

Notwithstanding the absence of a claim, upon timely request and as prescribed by the Director, a provisional application may be treated as an application filed under subsection (a). Subject to

²This decision miscaptioned the nonprovisional application number as No. 08/300,832.

section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such

application and shall not be subject to revival after such 12-month period.

35 U.S.C. § 111(b)(5) states:

Notwithstanding the absence of a claim, **upon timely request and as prescribed by the Director**, a provisional application may be treated as an application filed under subsection (a). Subject to section 119(e)(3) of this title, if no such request is made, the provisional application shall be regarded as abandoned 12 months after the filing date of such application and shall not be subject to revival after such 12-month period (emphasis added).

35 U.S.C. § 111(b)(7) states:

A provisional application shall not be entitled to the right of priority of any other application under section 119 or 365(a) of this title or to the benefit of an earlier filing date in the United States under section 120, 121, or 365(c) of this title.

35 U.S.C. § 119(e)(1) states:

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. No application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment

containing the specific reference to the earlier filed provisional application is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application.

37 CFR 1.53(c) (3) states, in pertinent part:

A provisional application . . . may be converted to a nonprovisional application . . . and accorded the original filing date of the provisional application A request to convert a provisional application to a nonprovisional application must also be filed prior to the earliest of:

. . . .
(ii) Expiration of twelve months after the filing date of the provisional application

37 CFR 1.182 states that:

All questions not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(h).

37 CFR 1.183 states, in part:

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 Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interest part, subject to such other requirements as may be imposed.

OPINION

The present petition urges that the rules should be waived because (1) petitioners will not be able to claim priority to the Canadian application if this petition is not granted; (2) the failure to include at least one claim in the originally-filed nonprovisional application was inadvertent, and (3) because the American Inventors Protection Act of 1999 (AIPA), which petitioners maintain permits the Office to grant the requested relief, was not enacted until 29 November, 1999, and that implementing regulations were not published until 20 March, 2000.

Petitioners' arguments have been considered, but are not persuasive.

Under 37 CFR 1.183, the Commissioner may waive requirements of the rules so long as those requirements are not requirements of the statute.³ Petitioners should note that statute, not regulation, controls the 12 month expiration of provisional applications.⁴ The current statutory provision at 35 U.S.C. § 111(b) (5) states that a provisional application may be treated as a nonprovisional application. The provision also states, however, that a provisional application is regarded as abandoned 12 months after the filing date, and shall not be subject to revival after such 12 month period. The statute therefore clearly precludes the revival, and just as clearly precludes the conversion to a nonprovisional application of a provisional application, after 12 months have passed since the filing date of the provisional application. To now permit the requested conversion would impermissibly enable petitioners to avoid the foregoing requirements of law. The USPTO simply lacks the authority or discretion to relax any requirement of law.⁵

Petitioners should also note that the applicable law and regulations in effect prior to the enactment of the AIPA on 29 November, 1999, also do not permit relief, as 35 U.S.C. § 111(b) (5) states that a provisional application is abandoned and not subject to revival after 12 months after the filing date.

³ In re Kruvsman, Inc., 199 USPQ 110 (Comm'r Pats. 1977).

⁴ See 35 U.S.C. § 111.

⁵ See Baxter Int'l, Inc. v. McGaw, Inc., 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998) (the PTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 USC §§ 112, 120); A. F. Stoddard v. Dann, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977) (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

Additionally, assuming, *arguendo*, that relief was not precluded by statute, petitioners have not made a sufficient showing that relief under 37 CFR 1.183 is merited. A grantable petition under 37 CFR 1.183 requires the existence of (1) an extraordinary situation where (2) justice requires waiver of the rules.⁶ Petitioners' predicament arose because petitioners, in their own words, "inadvertently failed to include at least one claim" in the original application papers filed on 28 April, 1999. It is well settled that a party's inadvertent failure to comply with the requirements of the statutes, rules or procedures before the

USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183.⁷

Additionally, petitioners voluntarily chose to convert the original nonprovisional application papers to those of a provisional application. The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of petitioner, and petitioner is bound by the consequences of those actions or inactions.¹ Furthermore, the lack of presentation of a claim with the instant application papers upon the initial deposit of these papers under 35 USC 111(a) and 37 CFR 1.53(b) on April 29, 1999, was a circumstance that was entirely within the control of petitioners, and was likewise a circumstance that could have been avoided by the exercise of reasonable, due care and diligence. 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. Waiver of the rules is not warranted, when a party makes an avoidable mistake in filing papers.⁸

Moreover, the substantial delay in filing the present petition suggests a further lack of diligence on the part of petitioner. Assuming petitioners waited until enactment of the AIPA on 29 November, 1999, and the publishing of implementing regulations on 20 March, 2000, petitioners still had over one month to file a

⁶In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

⁷See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995); see also Nitto Chemical Indus. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994).

⁸Nitto, supra.

timely petition to convert the present provisional application to a nonprovisional application. Petitioners have presented no adequate showing as to why the present petition was not filed until over six months after the provisional application became abandoned. This lack of diligence further mitigates away from granting the requested relief. Equitable powers should be not invoked to excuse the performance of a condition by a party that has not acted with reasonable due care and diligence.⁹ The Office, where it has the power to do so, should not relax the requirements of established practice in order to save a party from the consequences of its own delay.¹⁰

Petitioners' attention is also called to the legislative comments regarding the enactment of the AIPA. Section 4801 of the American Inventors Protection Act of 1999 amended 35 U.S.C. 111(b)(5) effective 29 November, 1999. The U.S. House of Representatives Committee Report contains the following comment regarding Section 4801:

Section 4801 amends section 111(b)(5) of the Patent Act by permitting a provisional application to be converted into a non-provisional application. The applicant **must make a request within 12 months after the filing date of the provisional application** for it to be converted into a non-provisional application (emphasis added).¹¹

It is clear from the legislative history of the AIPA that Congress did not intend that the Office grant, as here, an untimely petition to convert a provisional application from to a non-provisional application. That is, a petition that is filed, as here, more than twelve months after the filing date of the provisional application is untimely as a matter of law, and, as such, is barred.

Accordingly, to grant the requested relief would be contrary to the patent statute, and the underlying Congressional intent, which further militates away from favorably considering the petition.

⁹U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983).

¹⁰ See Ex parte Sassin, 1906 Dec. Comm'r Pat. 205, 206 (Comm'r Pat. 1906), compare Ziegler v. Baxter v. Natta, 159 USPQ 378, 379 (Comm'r Pat. 1968), Williams v. The Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975).

¹¹ 106 H. Rpt. 464, ___ (1999).

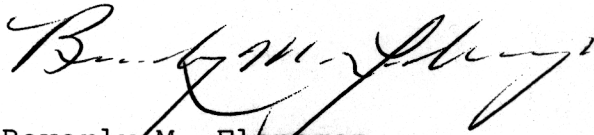
DECISION

In summary, as both the present and former statutory provisions set forth that a provisional application is abandoned 12 months after the filing date, and not subject to revival thereafter, the present provisional application remains abandoned and cannot be revived or converted. The untimely request to convert the above-identified provisional application into a nonprovisional application simply can not now be favorably considered. The USPTO lacks the discretion or the authority to grant the requested relief. The instant application remains a provisional application that is abandoned. The petition is **denied**.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to petitioner. All future correspondence, however, will be mailed solely to the correspondence address of record.

This abandoned provisional application is being returned to the Files Repository.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Douglas I. Wood at (703) 308-6918.



Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Charles E. Van Horn
Finnegan, Henderson, Farabow,
Garret & Dunner, L.L.P.
1300 I Street, N.W.
Washington, D.C. 20005