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MAILED

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In re Application of :
Anne Rougee et al. :
Application No. 08/245,140 :
Filed: May 17, 1994 :
For: METHOD FOR THE ACQUISITION OF : ON PETITION
IMAGES OF A BODY BY THE :
ROTATIONAL POSITIONING OF A :
RADIOLOGY, NOTABLY AN :
ANGIOGRAPHY DEVICE :

This is a decision on the petition, filed October 30, 1995, requesting reconsideration of the decision of September 29, 1995.¹

The request to accord the above-identified application a filing date of May 12, 1994 is DENIED.

BACKGROUND

The above-identified application was submitted to the Patent and Trademark Office (Office) via the Express Mail service of the U.S. Postal Service in an envelope bearing Express Mail label number TB228778011US. The application was received in the Office on May 18, 1994.

While Express Mail label number TB228778011US contains the date "May 12, 1994" typed thereon in the return address section of the Express Mail label designated as "for customer use," the date entered thereon by an employee of the U.S. Postal Service as the "Date-In" is May 17, 1994. Therefore, the application was accorded a filing date of May 17, 1994.

¹ The decision of September 29, 1995 denied the petition of June 12, 1995, which petition requested that the above-identified application be accorded a filing date of May 12, 1995.

On January 23, 1995, a petition to accord this application a filing date of May 12, 1994 was filed. Petitioners asserted therein that the above-identified application was deposited with the U.S. Postal Service in Express Mail service on May 12, 1994 in compliance with the procedure set forth in 37 CFR 1.10, and, as such, the above-identified application is entitled to the May 12, 1994 date of deposit in Express Mail service as the filing date in accordance with 37 CFR 1.10. The petition of January 23, 1995 included, *inter alia*, (1) a declaration from James E. Nilles (Nilles), counsel for petitioners, (2) a declaration from Diane Schwaiger (Schwaiger) asserting that Schwaiger deposited the above-identified application with the U.S. Postal Service in Express Mail service in an envelope bearing Express Mail label number TB228778011US on May 12, 1994 in compliance with the procedure set forth in 37 CFR 1.10, (3) a copy of the transmittal letter for the above-identified application, which includes a certificate of Express Mailing under 37 CFR 1.10 signed by Schwaiger and certifying that the above-identified application was deposited with the U.S. Postal Service in Express Mail service in an envelope bearing Express Mail label number TB228778011US on May 12, 1994, (4) a copy of Express Mail label number TB228778011US, (5) a copy of the return postcard receipt for the filing of the above-identified application, (6) a copy of two requests for a corrected filing receipt showing a filing date of May 12, 1994, (7) a copy of the filing receipt for the above-identified application showing a filing date of May 17, 1994, and (8) a copy of an Office communication refusing to provide the requested corrected filing receipt for the above-identified application.

The petition of January 23, 1995 was dismissed in the decision of May 26, 1995. The decision of May 26, 1995 indicated that petitioners must submit evidence that the May 17, 1994 "Date-In" is the result of U.S. Postal Service error in the event that petitioners persist in their contention that an error on the part of the U.S. Postal Service resulted in the date "May 17, 1994," rather than "May 12, 1994," being inserted as the "Date-In."

A renewed petition was filed on June 12, 1995, and included, *inter alia*, a copy of the collection schedule for the U.S. Postal Service, Hilltop Station, Milwaukee, WI, a supplemental declaration from Schwaiger, and a declaration from John Fisher (Fisher), the manager of customer services U.S. Postal Service office responsible for collecting mail at the Express Mail Post Box at issue.

The renewed petition of June 12, 1995 was denied in the decision of September 29, 1995. The decision of September 29, 1995 indicated that the evidence of record was inadequate to establish

that the May 17, 1994 "Date-In" was the result of U.S. Postal Service error.

STATUTE AND REGULATION

35 U.S.C. § 21(a) states that:

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

37 CFR 1.10(c) states that:

The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or Federal holiday within the District of Columbia - see § 1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

OPINION

The evidence presented in the petition of January 23, 1995, the renewed petition of June 12, 1995, and the instant request for reconsideration has been carefully considered; however, it is not persuasive that the above-identified application is entitled to a filing date of May 12, 1994.

Petitioners again assert that any discrepancy between the date on the certificate of Express Mailing under 37 CFR 1.10 and the

"Date-In" on the Express Mail label is the result of an error on the part of an employee of the U.S. Postal Service. Petitioners specifically argue that: (1) the presumption that Postal employees discharge their duties in a proper manner is rebuttable (citing *Lequille v. Dann*, 544 F.2d 1, 191 USPQ 529 (D.C. Cir. 1976)), and (2) that the Schwaiger declarations and accompanying exhibits, rather than the Fisher declaration, rebut this presumption. Petitioners further argue that the Office must take the Schwaiger declarations at face value unless there is compelling evidence that the statements are untrue or inaccurate, citing *In re Soni*, 54 F.3d 746, 34 USPQ2d 1684 (Fed. Cir. 1995). Petitioners further submit a second supplemental declaration from Schwaiger accompanied by counsel's application report indicating the above-identified as filed on May 12, 1994, a letter transmitted by facsimile on May 12, 1994 indicating that the above-identified application was filed on May 12, 1994, and a billing invoice indicating that the above-identified application was filed on May 12, 1994.

As the certificate contains one date (May 12, 1994) and the "Express Mail" label contains another date (May 17, 1994), there is a "question regarding the date of mailing" within the meaning of 37 CFR 1.10. In instances in which there is a discrepancy between the date on the certificate and the "Express Mail" label, the "Date In" on the Express Mail receipt shows the actual date of mailing under 37 CFR 1.10. As such, it is petitioners' burden to establish that the May 17, 1994 "Date-In" on the Express Mail receipt is not the correct date of deposit with the U.S. Postal Service of the envelope bearing Express Mail label number TB228778011US and containing the above-identified application.

Petitioners' argument that any discrepancy between the date on the certificate of Express Mailing under 37 CFR 1.10 and the "Date-In" on the Express Mail label is the result of an error on the part of an employee of the U.S. Postal Service is unpersuasive.

Public Law 97-247, 96 Stat. 317 (1982), amended 35 U.S.C. § 21 permitting, but not requiring, the Office to prescribe that any paper or fee required to be filed in the Office be considered filed in the Office on the date on which it was deposited with the U.S. Postal Service. The Office promulgated 37 CFR 1.10 pursuant to the authority provided in 35 U.S.C. § 21.

37 CFR 1.8 provides a procedure by which the timely filing of papers and fees deposited with the U.S. Postal Service may be established without independent corroboration by an employee of the U.S. Postal Service (*i.e.*, established solely by the statement(s) from applicant or his or her counsel). The

suggestion that 37 CFR 1.8 be applicable to application papers deposited the U.S. Postal Service for purposes of obtaining a filing date was considered and expressly rejected. The criticality of an application filing date was considered adequate to justify independent verification by an employee of the U.S. Postal Service of the date of deposit of the application papers with the U.S. Postal Service. See rulemaking entitled "Revision of Patent Procedure," published in the *Federal Register* at 48 *Fed. Reg.* 2696, 2702 (January 20, 1983), and in the Patent and Trademark Office *Official Gazette* at 1027 *Off. Gaz. Pat. Office* 9, 25 (February 1, 1983). Put simply, the insertion by a disinterested employee of the U.S. Postal Service of the date of deposit in the U.S. Postal Service by Express Mail on the Express Mail label of the envelop containing application papers is the *raison d'être* of 37 CFR 1.10.²

Postal employees are presumed to discharge their duties in a proper manner. *Charlson Realty Co. v. United States*, 690 F.2d 434, 442 (Ct. Cl. 1967). Therefore, it is petitioners' burden to establish their contention that the May 17, 1994 "Date-In," rather than a May 12, 1994 "Date-In," on Express Mail label number TB228778011US is the result of an error on the part of an employee of the U.S. Postal Service. In the absence of evidence that an error on the part of any Postal employee caused or contributed to an incorrect date being written as the "Date-In" on Express Mail label number TB228778011US, the showing of record is inadequate to establish that the discrepancy between the date on the certificate of Express Mailing under 37 CFR 1.10 and the "Date-In" on Express Mail label number TB228778011US is the result of an error on the part of an employee of the U.S. Postal Service.

The Fisher declaration does not indicate that: (1) any error on the part of any Postal employee caused or contributed to an incorrect date being written as the "Date-In" on Express Mail label number TB228778011US, or (2) the May 17, 1994 date written as the "Date-In" on Express Mail label number TB228778011US is incorrect. As such, petitioners' assertion that the above-identified application was deposited by Express Mail on May 12, 1994 is not corroborated by any evidence outside the office of

² In promulgating 37 CFR 1.10, the Office also considered other types of mail service (e.g., registered mail and certified mail), but chose the "Express Mail" service since this service provides, *inter alia*, a legible mailing date on the "Express Mail" label for the records of both the applicant and the Office. See "Revision of Patent Procedure," 48 *Fed. Reg.* at 2697, 1027 *Off. Gaz. Pat. Office* 12-13.

submitting counsel. See Honigsbaum v. Lehman, 903 F.Supp. 8, 10 (D.D.C. 1995).

Schwaiger states that she specifically remembers depositing the above-identified application in the Express Mail postbox at 777 East Wisconsin Avenue, Milwaukee, WI no later than 4:45 PM on May 12, 1994.³ That the Office must accept declarations submitted pursuant to 37 CFR 1.132⁴ at face value unless there is compelling evidence that the statements are untrue or inaccurate during patentability determinations (*i.e.*, where the Office bears the burden of establishing unpatentability) is immaterial to the instant petition.⁵ In any event, petitioners' assertion that their evidence is "uncontroverted," is incorrect; the May 17, 1994 "Date-In" on Express Mail label number TB228778011US entered by a disinterested U.S. Postal Service employee is inconsistent with petitioners' assertions regarding the deposit of the above-identified application.

Where there is a question regarding mailing, the person mailing the paper or fee must establish the actual date of mailing by: (1) a copy of the Express Mail receipt showing the actual date of mailing, (2) a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. See "Revision of Patent Procedure," 48 Fed. Reg. at 2697, 1027 Off. Gaz. Pat. Office at 12. As there is a discrepancy between the date of mailing (the "Date-In") on the Express Mail label, and the date Schwaiger asserts that the above-identified application was mailed, the Office is properly

³ Schwaiger dec. submitted with the renewed petition of October 30, 1995, at 1 (¶2).

⁴ While the declarations submitted with the petitions of January 23, 1995, June 12, 1995, and October 30, 1995 are designated as declarations under 37 CFR 1.132, this designation is inappropriate. 37 CFR 1.132 provides for the submission of affidavits or declarations traversing grounds of rejection, not affidavits or declarations submitted in support of a petition. See 37 CFR 1.181(b).

⁵ The relevance of Soni to the instant petition is unclear, inasmuch as Soni involved a patentability determination, where the Office has no discretion in its application of 35 U.S.C. § 103, rather than the practice of filing application papers by mail, where the Office has express statutory authority (35 U.S.C. § 21(a)) to prescribe the procedures for the filing application papers by mail.

requiring adequate corroboration that the above-identified application was deposited in Express Mail on the date asserted.⁶

The copy of the transmittal letter for the above-identified application, which includes a certificate of Express Mailing under 37 CFR 1.10 certifying that the above-identified application was deposited on May 12, 1994, was obviously prepared prior to the deposit of the above-identified application by Express Mail. As such, the copy of the transmittal letter does not adequately corroborate the actual deposit of the above-identified application, but merely evidences an intent to deposit the above-identified application by Express Mail on May 12, 1994.

Petitioners do not assert that the above-identified application was deposited earlier than 4:30 PM on May 12, 1994 (*i.e.*, petitioners do not assert that the above-identified application was deposited prior to the expiration of Schwaiger's normal working hours). The letter transmitted by facsimile on May 12, 1994 indicating that the above-identified application was filed on May 12, 1994, and the billing invoice indicating that the above-identified application was filed on May 12, 1994, were each prepared by Schwaiger and dated May 12, 1994. Thus, petitioners do not appear to contend that the letter transmitted by facsimile on May 12, 1994 and the billing invoice were prepared contemporaneously with, but subsequent to, the deposit of the above-identified application. Rather, it appears that these documents were prepared prior to the deposit of the above-identified application by Express Mail. As such, the letter transmitted by facsimile on May 12, 1994 and billing invoice likewise do not adequately corroborate the actual deposit of the above-identified application, but merely evidence an intent to deposit the above-identified application by Express Mail on May 12, 1994.

The information for the applications listed on the application report includes the application serial number and such applications appear to be listed by serial number, rather than

⁶ In response to objections to the use of affidavits and/or declarations to establish a filing date, the Office indicated that such affidavits or declarations are considered to explain activities that are supported by exhibits (*i.e.*, corroborate evidence). See "Revision of Patent Procedure," 48 *Fed. Reg.* at 2702-03, 1027 *Off. Gaz. Pat. Office* at 27-28. Thus, the Office appropriately requires the submission of corroborative documentary evidence to establish an application filing date.

filing date, order.⁷ This report was obviously not prepared contemporaneously with the deposit of the above-identified application by Express Mail, since the application report must have been prepared subsequent to counsel's receipt of the application serial number assigned by the Office to the above-identified application to include such information thereon. As the documents prepared prior to the deposit of the above-identified application by Express Mail (*i.e.*, the transmittal letter, the letter transmitted by facsimile on May 12, 1994, and billing invoice) indicate that the above-identified application was intended to be mailed on May 12, 1994, counsel's records (*e.g.*, the application report) prepared based upon these documents would likewise be expected to indicate the intended May 12, 1994 date of deposit, regardless of the date that the above-identified application was actually deposited by Express Mail in compliance with 37 CFR 1.10.⁸ As such, that the above-identified application is indicated on the application report as filed on May 12, 1994 does not adequately corroborate the asserted date of deposit of the above-identified application.

The documentary evidence submitted in support of Schwaiger's statements evidences the preparation of the above-identified application for filing in the Office around May 12, 1994. The documentary evidence submitted in support of the instant petition, however, is also consistent with the preparation of the above-identified application for filing in the Office on or before May 12, 1994, and the subsequent deposit of the above-identified application in the U.S. Postal Service by Express Mail on May 17, 1994.

The Schwaiger declarations are the only direct evidence concerning the asserted mailing of the above-identified

⁷ The application immediately preceding the above-identified application is indicated as filed on August 15, three (3) months after the date that the above-identified application is purported to have been deposited by Express Mail. Thus, the application report is not strictly prepared in filing date order.

⁸ Schwaiger's recollection in January of 1995 (*i.e.*, more than seven months after the date of deposit) of the actual date of deposit of the above-identified application by Express Mail is likewise expected to be influenced by the documents indicating the intended date of deposit of May 12, 1994.

application on May 12, 1994.⁹ These declarations were prepared on January 19, 1995, June 7, 1995, and October 26, 1995, more than eight, twelve, and seventeen months after the date in question. That is, notwithstanding that petitioners were notified in May of 1994¹⁰ that the above-identified application was accorded a filing date of May 17, 1994, rather than the desired filing date of May 12, 1994, petitioners delayed for more than seven months before acquiring the evidence now relied upon to establish their entitlement to a filing date of May 12, 1994.

Petitioners assert that the above-identified application was the only application filed by Nilles & Nilles between May 9, 1995 and May 25, 1995.¹¹ Nevertheless, the first statement from Schwaiger was not acquired until more than seven months after May of 1994 (i.e., more than seven months after the filing of the next application on May 25, 1994). It is maintained that a contemporaneously entered date by a disinterested U.S. Postal Service employee at the time of mailing (i.e., in May of 1994) is more reliable than Schwaiger's asserting to actually remember in January of 1995 the precise date the above-identified the date was deposited with the U.S. Postal Service by Express Mail (i.e., that the above-identified application was so deposited on May 12, 1994, rather than May 17, 1994).

In summary, the evidence submitted by petitioners is not as probative as the "Date-In" on the Express Mail label of the mailing date of the envelope bearing Express Mail label number TB228778011US, since Express Mail labels are contemporaneously dated with the corresponding time, and initialed by a disinterested U.S. Postal Service employee at the time of mailing, and are business records routinely maintained by the U.S. Postal Service for later verification of mailing dates. See Nitto Chem. Indus. Co. v. Comer, No. 93-1378, 1994 U.S. Dist. LEXIS 19211, at *8 (D.D.C., March 7, 1994).

⁹ The Nilles declaration submitted with the petition of January 23, 1995 does not assert firsthand knowledge of the actual deposit of the above-identified application with the Express Mail service of the U.S. Postal Service.

¹⁰ Schwaiger specifically asserts that a postcard indicating a filing date of May 17, 1994 for the above-identified application was received in late May of 1994 (Schwaiger dec. submitted with the renewed petition of October 30, 1995, at 3 (¶2c)).

¹¹ Schwaiger dec. submitted with the renewed petition of October 30, 1995, at 2 (¶2a).

Finally, petitioners argument that any discrepancy between the "Date-In" on the Express Mail label and the date on the certificate of Express Mailing is due to circumstances beyond their control is without merit. MPEP 513 cautions applicants that in instances in which there is a discrepancy between the "Date-In" on the Express Mail label and the date on the certificate of Express Mailing, the "Date-In" on the Express Mail label is controlling. See also "Revision of Patent Procedure," 48 Fed. Reg. at 2702, 1027 Off. Gaz. Pat. Office at 25. As such, any applicant choosing to deposit an application in an Express mail receptacle, rather than deliver the application to an open U.S. Postal Service office and observe the "Date-In" entered on the Express Mail label, is on notice that he or she bears the risk that there may be a discrepancy between the "Date-In" on the Express Mail label and the date on the certificate of Express Mailing.¹² Petitioners simply chose to deposit the above-identified application in an Express mail receptacle, rather than deliver the application to an open U.S. Postal Service office.

Accordingly, the above-identified application is not entitled to a filing date of May 12, 1994 pursuant to 37 CFR 1.10(c), due to the discrepancy between the "Date-In" on the Express Mail label and the date on the certificate of Express Mailing, and in view of the other submitted evidence.

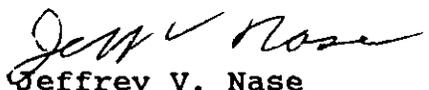
CONCLUSION

For the above stated reasons, the request that the above-identified application be accorded a filing date of May 12, 1994 is DENIED. The petition fee will not be refunded.

Telephone inquiries should be directed to the Office of Petitions Staff at (703) 305-9282.

¹² Specifically, the Office must rely on the actions or inactions of petitioners' duly authorized and voluntarily chosen representatives, and petitioners are bound by the consequences of those actions or inactions. *Link v. Wabash*, 370 U.S. 626, 633-34 (1962). As such representative chose to deposit the above-identified application in an Express mail receptacle, rather than deliver the application to an open U.S. Postal Service office and observe the "Date-In" entered on the Express Mail label, petitioners' must bear the consequences of such action (*i.e.*, that there may be a discrepancy between the "Date-In" on the Express Mail label and the date on the certificate of Express Mailing).

The application file is being forwarded to Examining Group 2600 for examination in due course.

A handwritten signature in cursive script, appearing to read "Jeffrey V. Nase".

Jeffrey V. Nase
Patent Legal Administrator
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

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