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In re Application of :
Chung Kee Lee :
Application No. 29/257,745 : DECISION DENYING PETITION
Filed: May 22, 2006 :
Attorney Docket No. CMT-0057 :

OFFICE OF PETITIONS

This is a decision on the "REQUEST FOR RECONSIDERATION REGARDING PETITION FOR ORIGINAL FILING DATE UNDER 37 C.F.R. § 1.53 (e)(2)" filed June 16, 2008, requesting that the above-identified application be accorded a filing date of April 10, 2006.

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

BACKGROUND

The application was deposited on April 10, 2006. However, on May 2, 2006, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application" stating that a filing date had **not** been granted and requiring a complete specification with at least one claim pursuant to 35 USC 112. The "Notice" further stated that the filing date would be the date of receipt of a complete specification.

A petition requesting a filing date of April 10, 2006 was filed on May 22, 2006. Applicant argued that a claim for priority to Korean priority document no. 30-2005-0034288 filing date of October 11, 2005 was present on April 10, 2006. Thus, applicant claimed that the priority document contained a complete specification, including at least one claim. The Office mailed a decision dismissing the petition

on October 2, 2006, which informed applicant that the application as filed was incomplete and not entitled to a filing date.

A second petition was filed on December 4, 2006 in which, applicant continued to advance the same argument that a complete specification including at least one claim was present in the Korean application. Further, applicant stated that the Korean application contained a proper claim in Korea and "the incorporation by reference incorporates the substance (subject matter) of the foreign IP, not just words on paper." The petition was dismissed on April 14, 2008 informing applicant the application was not entitled to the April 10, 2006 filing date. However, a filing date of May 22, 2006 was granted based upon the date a claim pursuant to 35 U.S.C. 112 was submitted.

On the instant request for reconsideration applicant renews the arguments that the application as deposited on April 10, 2006 included a proper claim and that the incorporated priority Korean design application constitutes a proper claim in Korea and "incorporates the substance (subject matter) of foreign IP, not just words on paper." Applicant also maintains that 37 CFR 1.153 has been met with the filing of the drawings and the last sentence of the specification, which recites "the packing container of the present design..."

STATUTE AND REGULATION

35 U.S.C. 111. provides:

(a) IN GENERAL. -

(1) WRITTEN APPLICATION. -An application for patent shall be made, or authorized to be made, by the inventor, except as otherwise provided in this title, in writing to the Director.

(2) CONTENTS. -Such application shall include -

(A) a specification as prescribed by section 112 of this title;

(B) a drawing as prescribed by section 113 of this title; and

(C) an oath by the applicant as prescribed by section 115 of this title.

(3) FEE AND OATH. -The application must be accompanied by the fee required by law. The fee and oath may be submitted after the specification and any required drawing are

submitted, within such period and under such conditions, including the payment of a surcharge, as may be prescribed by the Director.

(4) FAILURE TO SUBMIT. -Upon failure to submit the fee and oath within such prescribed period, the application shall be regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the fee and oath was unavoidable or unintentional. The filing date of an application shall be the date on which the specification and any required drawing are received in the Patent and Trademark Office.

35 U.S.C. 112 provided in pertinent part:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

35 U.S.C. 171 provides:

Whoever invents any new, original, and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided

35 U.S.C. 172 Right of priority.

The right of priority provided for by subsections (a) through (d) of section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs. The right of priority provided for by section 119(e) of this title shall not apply to designs.

37 CFR 1.151 provides:

The rules relating to applications for patents for other inventions or discoveries are also applicable to

applications for patents for designs except as otherwise provided.

37 CFR 1.153 provides:

(a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with § 1.63.

37 CFR 1.57 provides in pertinent part:

(a) Subject to the conditions and requirements of this paragraph, if all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under § 1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s).

(1) The application must be amended to include the inadvertently omitted portion of the specification or drawing(s) within any time period set by the Office, but in no case later than the close of prosecution as defined by § 1.114(b), or abandonment of the application, whichever occurs earlier. The applicant is also required to:

- (i) Supply a copy of the prior-filed application, except where the prior-filed application is an application filed under 35 U.S.C. 111;
- (ii) Supply an English language translation of any prior-filed application that is in a language other than English; and
- (iii) Identify where the inadvertently omitted

portion of the specification or drawings can be found in the prior-filed application.

(2) Any amendment to an international application pursuant to this paragraph shall be effective only as to the United States, and shall have no effect on the international filing date of the application. In addition, no request under this section to add the inadvertently omitted portion of the specification or drawings in an international application designating the United States will be acted upon by the Office prior to the entry and commencement of the national stage (§ 1.491) or the filing of an application under 35 U.S.C. 111(a) which claims benefit of the international application. Any omitted portion of the international application which applicant desires to be effective as to all designated States, subject to PCT Rule 20.8(b), must be submitted in accordance with PCT Rule 20.

(3) If an application is not otherwise entitled to a filing date under § 1.53(b), the amendment must be by way of a petition pursuant to this paragraph accompanied by the fee set forth in § 1.17(f).

(b) Except as provided in paragraph (a) of this section, an incorporation by reference must be set forth in the specification and must:

- (1) Express a clear intent to incorporate by reference by using the root words "incorporat(e)" and "reference" (e.g., "incorporate by reference"); and
- (2) Clearly identify the referenced patent, application, or publication.

(c) "Essential material" may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication, which patent or patent application publication does not itself incorporate such essential material by reference. "Essential material" is material that is necessary to:

- (1) Provide a written description of the claimed invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with

which it is most nearly connected, to make and use the same, and set forth the best mode contemplated by the inventor of carrying out the invention as required by the first paragraph of 35 U.S.C. 112;

- (2) Describe the claimed invention in terms that particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. 112; or
- (3) Describe the structure, material, or acts that correspond to a claimed means or step for performing a specified function as required by the sixth paragraph of 35 U.S.C. 112.

DISCUSSION

Applicant's arguments have been reconsidered but found to be unpersuasive to establish that the above-identified application is entitled to the filing date of April 10, 2006. The application papers presented on April 10, 2006 did not include a claim within the meaning of 35 USC 112. The application papers did not include any language identified as a claim or any language at the end of the specification that the Office can construe as a claim. The filing date of an application for patent is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office.

Further the Office is not convinced that applicant met the requirement of 37 CFR 1.153. In addition to presenting the title of the design and the designation of the particular article, 37 CFR 1.153 requires that a claim is presented in formal terms to the ornamental design for the article as shown or as shown and described. The failure to meet the requirements of 35 USC 111 and 112 preclude a finding that petitioner has met the requirements of 37 CFR 1.153.

Lastly, applicant's argument that the Korean application itself constitutes a proper claim and that the Korean application incorporates the substance of the foreign intellectual property is not convincing. Pursuant to 37 CFR 1.57, where all or a portion of the specification or drawing(s) is inadvertently omitted from an application, but the application contains a claim under § 1.55 for

priority of a prior-filed foreign application, or a claim under § 1.78 for the benefit of a prior-filed provisional, nonprovisional, or international application, that was present on the filing date of the application, and the inadvertently omitted portion of the specification or drawing(s) is completely contained in the prior-filed application, the claim under §1.55 or § 1.78 shall also be considered an incorporation by reference of the prior-filed application as to the inadvertently omitted portion of the specification or drawing(s). While the application as deposited on April 10, 2006 included a priority claim to the Korean application, the portion of the specification, in this instance the claim, was not completely contained in the Korean application. The English translation of the Korean application provided on May 22, 2006 did not contain a claim pursuant to 35 USC 112, second paragraph, which is a requirement for obtaining a filing date in accordance with 35 USC 111(a).

In summary, an incorporation by reference does not solve the problem since the Korean application does not have a claim as considered under U.S. law.

DECISION

The Office has reconsidered the prior decision refusing to accord the above-identified application a filing date of April 10, 2006. For the reasons stated, applicant has not shown that applicant filed a complete design application, including a claim on April 10, 2006. Absent the presence of a claim, the application cannot be afforded a filing date of April 10, 2006. As such the filing date of the application will remain May 22, 2006, the earliest date the Office received a claim pursuant to 35 USC 112.

Any inquiries related to this decision should be directed to Petitions Attorney, Charlema Grant at (571) 272-3215.



Charles Pearson
Director
Office of Petitions