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**MAILED**

**JAN 05 2012**

**PCT LEGAL ADMINISTRATION**

In re Application of: PRIM, Patrick.	:	
U.S. Application No.: 11/676,926	:	DECISION ON PETITIONS
U.S. Patent No.: 7,650,015	:	UNDER 37 CFR 1.78(a)(3)
Filing Date: February 20, 2007	:	AND 1.55(c))
Attorney's Docket No.: 8042-2-1	:	
For: IMAGE PROCESSING METHOD	:	

This decision is issued in response to the "REQUEST FOR RECONSIDERATION OF PETITION DECISION" filed on 20 May 2011, which requests reconsideration under 37 CFR §§ 1.78(a)(3) and 1.55(c). The petition under 37 CFR 1.78(a)(3) seeks to correct the domestic priority claim in the above-captioned patent to identify the patent as a divisional of U.S. application number 09/792,294, which is a continuation-in-part (CIP) of US. Application number 09/230,502, which is the national stage under 35 U.S.C. 371 of PCT/FR97/01354. The petition under 37 CFR 1.55(c) seeks to add an unintentionally delayed claim of foreign priority to French application FR 9609420.

For the reasons set forth below, the petitions are **DISMISSED** without prejudice.

**1. 37 CFR 1.78(a)(3)**

The above-captioned U.S. patent issued from an application filed after November 29, 2000, and the corrected benefit claim under 35 U.S.C. 120 is submitted after the expiration of the time period specified in 37 CFR 1.78(a)(2)(ii).<sup>1</sup> Under the circumstances present here, the petition is properly considered under 37 CFR 1.78(a)(3). See MPEP section 1481.03.

A grantable petition under 37 CFR 1.78(a)(3) must be accompanied by the following:

<sup>1</sup> It is noted that the addition of the statement identifying U.S. application number 09/230,502 as the national stage of PCT/FR97/01354 is not considered the addition of a new benefit claim that requires a petition under 37 CFR 1.78. See MPEP section 1893.03(c), "a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the international filing date of the international application." See also Broadcast Innovation, L.L.C. and IO Research PTY LTD v. Charter Communications, Inc. and Comcast Corporation, 420 F.3d 1364, 1367 (Fed. Cir., Aug 19, 2005): "Where proper reference to a national stage application exists, no reference to the corresponding PCT application is required because the national stage application effectively has the same U.S. filing date as the PCT application."

- (1) the reference required by 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in 37 CFR 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.

The present petition fails to comply with item (1) above.

37 CFR 1.78(a)(2)(iii) states that the required reference to the prior-filed application(s) “must be included in an application data sheet (37 CFR 1.76) or the specification must be amended to contain such reference in the first sentence(s) following the title.” Petitioner here has filed a Certificate of Correction setting forth the corrected reference to the prior-filed applications; however, petitioner did not include an accompanying amendment to the specification of the application or a supplemental application data sheet. Accordingly, petitioner has not provided the reference to the prior-filed applications in the form required by 37 CFR 1.78.

Petitioner argues that a request for Certificate of Correction may be used in lieu of an amendment or ADS to make the required reference. However, pursuant to the requirements of 35 U.S.C. 120 and Office policy, in the circumstances presented, petitioner must submit both a request for Certificate of Correction and an amendment to the application adding the specific reference to the parent application. *Cf.* the Decision on Petition in 09/792,294, mailed on September 27, 2011. Petitioner is also advised that the amendment included in the instant petition does not comply with 37 CFR 1.121(b)(1)(iii).

Based on the above, the petition under 37 CFR 1.78(a)(3) may not be granted on the present record.

## 2. 37 CFR 1.55(c)

The above-captioned U.S. patent issued from an application filed after November 29, 2000, and the foreign priority claim under 35 U.S.C. 119(a)-(d) or 365(a) directed to French application number FR 9609420 was not submitted prior to the expiration of the time period specified in 37 CFR 1.55(a)(1). Accordingly, this is an appropriate petition under the provisions of 37 CFR 1.55(c).<sup>2</sup>

A grantable petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for foreign priority requires the following:

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<sup>2</sup> As noted in the present petition, pursuant to MPEP section 201.16, a certificate of correction accompanied by a grantable petition under 37 CFR 1.55(c) is permissible for adding an unintentionally delayed foreign priority claim to an issued patent where the foreign priority claim to be added was perfected in a parent application prior to the issuance of the patent.

- (1) the claim under 35 U.S.C. 119(a)-(d) or 365(a) and this section to the prior foreign application, unless previously submitted;
- (2) the surcharge as set forth in 37 CFR 1.17(t);
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1) and the date the claim was filed was unintentional.

The present petition fails to comply with item (1) above.

Pursuant to MPEP section 201.13, a claim for foreign priority must be contained in either an oath or declaration (37 CFR 1.63(c)(2)) or an application data sheet (37 CFR 1.76). Petitioner here has filed a Certificate of Correction setting forth the foreign priority claim; however, petitioner did not include an accompanying oath or declaration or a supplemental application data sheet containing such claim. *Cf.* the Decision on Petition in 09/792,294, mailed on September 27, 2011. Accordingly, petitioner has not submitted the foreign priority claim in an acceptable form.

Based on the above, applicants have failed to satisfy the requirements for a grantable petition under 37 CFR 1.55(c) for acceptance of an unintentionally delayed foreign benefit claim.

### **DECISION**

For the reasons set forth above, the petitions under 37 CFR 1.78(a)(3) and 1.55(c) are **DISMISSED** without prejudice.

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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