IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Pirim		Docket No.:	8042-2-1
Application No.:	11/676,926		Examiner:	Seth MANAV
Patent No.:	7,650,015		Art Unit:	2624
Filed:	02-20-2007		Confirmation No.:	9051

For: IMAGE PROCESSING METHOD

Mail Stop PCT,
Commissioner for Patents,
Office of PCT Legal Administration
P.O. Box 1450
Alexandria, Virginia 22313-1450

REQUEST FOR RECONSIDERATION OF PETITION DECISION

Sir:

A Petition to Accept Unintentionally Delayed Priority Claims under 37 C.F.R. §§ 1.55(c) and 1.78(a)(3) was filed on August 20, 2010. A decision on the Petition was mailed on April 05, 2011.

Please reconsider the decision in view of the following remarks.

Remarks

    The Diagram below summarizes the pertinent facts, which are stated, in full, in the original petition.

Priority
Claim
Omitted
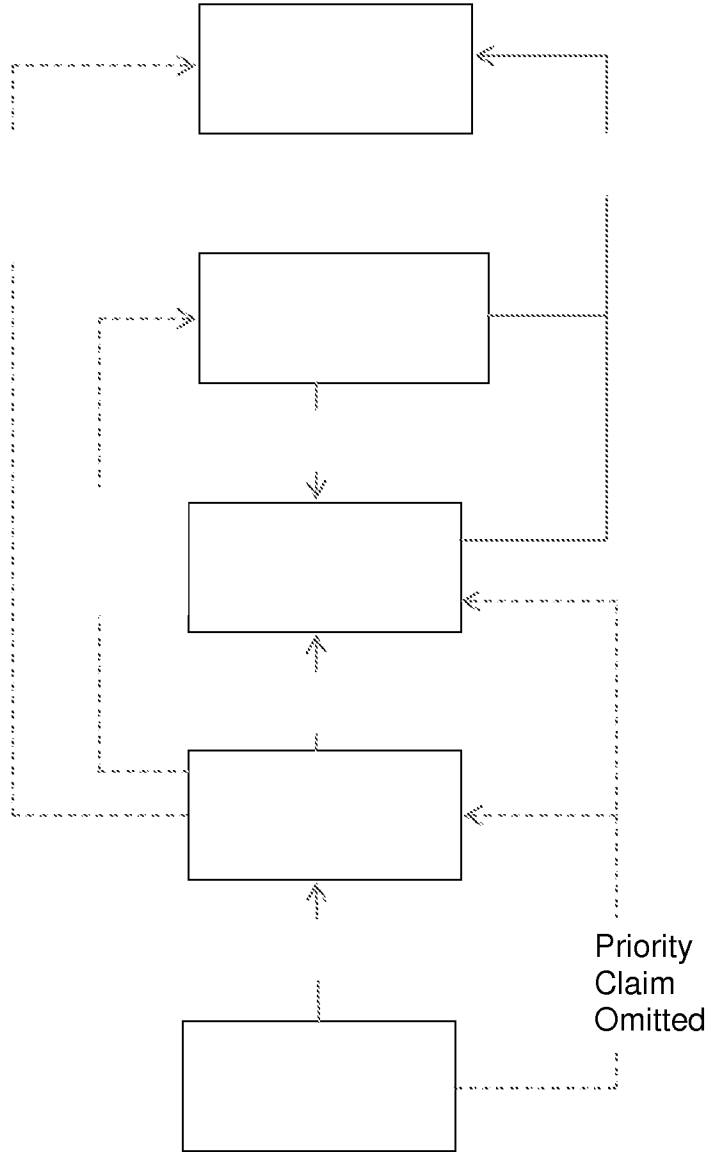
Domestic Priority Claim - 37 C.F.R. §1.78(a)(3)

    The decision acknowledges that the petition is correctly filed under 37 C.F.R. §1.78(a)(3), which states:

        If the reference required by 35 U.S.C. 120
        and paragraph (a)(2) of this section is presented after
        the time period provided by paragraph (a)(2)(ii) of this

section, the claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed copending nonprovisional application or international application designating the United States of America may be accepted if the reference identifying the prior-filed application by application number or international application number and international filing date was **unintentionally delayed**. A petition to accept an unintentionally delayed claim under 35 U.S.C. 120, 121, or 365(c) for the benefit of a prior-filed application must be accompanied by:

      (i) **The reference required** by 35 U.S.C. 119(a) – (d) or 365(a) or paragraph (a)(2) of this section to the prior-filed application, unless previously submitted;

      (ii) The **surcharge** set forth in § 1.17(t); and

      (iii) **A statement that the entire delay** between the date the claim was due under paragraph (a)(2)(ii) of this section and the date the claim was filed **was unintentional**. The Director may require additional information where there is a question whether the delay was unintentional.

The decision states:

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

(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 decision interprets 1.78(a)(3)'s reference to 1.78(a)(2) as a requirement that "an accompanying amendment to the specification of the application or a supplemental application data sheet" (Decision at p. 2) is needed. More specifically, the decision cites to 1.78(a)(2)(iii), which states, "[i]f the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the

specification must contain or be amended to contain such reference in the first sentence(s) following the title."

It is respectfully submitted the decision interprets 1.78(a)(3) incorrectly. As explained in MPEP §1481.03:

> Where 35 U.S.C. 120 and 365(c) priority based on an international application is to be asserted or corrected in a patent via a Certificate of Correction, the following conditions must be satisfied:
> (A) all requirements set forth in 37 CFR 1.78(a)(1) must have been met in the application which became the patent to be corrected;
> (B) it must be clear from the record of the patent and the parent application(s) that priority is appropriate (see MPEP § 201.11); and
> (C) the patentee must submit with the request for the certificate copies of documentation showing designation of states and any other information needed to make it clear from the record that the 35 U.S.C. 120 priority is appropriate. See MPEP § 201.13(b) as to the requirements for 35 U.S.C. 120 priority based on an international application.
> If all the above-stated conditions are satisfied, **a Certificate of Correction can be used to amend the patent to make reference to a prior copending application**, or to correct an incorrect reference to the prior copending application. Note *In re Schuurs*, 218 USPQ 443 (Comm'r Pat. 1983) which suggests that a Certificate of Correction is an appropriate remedy for correcting, in a patent, reference to a prior copending application. Also, note *In re Lambrech*, 202 USPQ 620 (Comm'r Pat. 1976), citing *In re Van Esdonk*, 187 USPQ 671 (Comm'r Pat. 1975).

Therefore, there is no requirement for a separate paper specifying amendments to the claims. Changes to an issued patent, are made with a Certificate of Correction. Favorable reconsideration of the petition filed on August 19, 2010 is respectfully requested.

Foreign Priority Claim - 37 C.F.R. §1.55(c)

37 C.F.R. §1.55(c) provides that:

> (c) Unless such claim is accepted in accordance with the provisions of this paragraph, any claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) not presented within the time period provided by paragraph (a) of this section is considered to have been waived. If a claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country (or intellectual property authority), and the day, month, and year of its filing was unintentionally delayed. A petition to accept a delayed claim for priority under 35 U.S.C. 119(a)-(d) or 365(a) must be accompanied by:
>
> (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** set forth in § 1.17(t); and
>
> (3) A **statement that the entire delay** between the date the claim was due under paragraph (a)(1) of this section and the date the claim was filed **was unintentional**. The Director may require additional information where there is a question whether the delay was unintentional.

The decision states:

> A grantable petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for foreign priority requires the following:
>
> (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 decision incorrectly concludes that the petition does not comply with 1.55(c)(1), alleging MPEP §201.13 requires that "a claim for foreign priority must be contained in either an oath or declaration … or an application data sheet." (Decision at p. 3). MPEP §201.13 actually states, "[a] priority claim need not be in any special form and may be a statement signed by a registered attorney or

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