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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91181621
Party	Plaintiff StonCor Group, Inc.
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Signature	/CHARLES N. QUINN/
Date	03/02/2009
Attachments	StonCor Reply to Applicant Motion - 91181621.pdf (10 pages)(81624 bytes) Declaration - Charles N Quinn - 91181621.pdf (20 pages)(164911 bytes) Declaration - Deanna M McGregor - 91181621.pdf (23 pages)(264490 bytes)

Applicable Law

The controlling law is *Pumpkin, Ltd.*², which adopted the United States Supreme Court's *Pioneer Investment Services Co.*³ analysis of cases involving excusable neglect under Federal Rule of Civil Procedure 6(b)(2). In *Pioneer* the Supreme Court established four factors to be considered in evaluating whether there was excusable neglect in a given case:

1. Danger of prejudice to the non-movant
2. Length of the delay and impact on the proceedings.
3. Reason for the delay, including whether it was within the reasonable control of the movant.
4. Whether the movant acted in good faith.

The Supreme Court went on in *Pioneer* to hold that “although inadvertence, ignorance of the rules, or mistakes construing the rules do not usually constitute ‘excusable’ neglect, it is clear that ‘excusable neglect’ under Rule 6(b) is a somewhat ‘elastic concept’ and is not limited strictly to omissions caused by circumstances beyond the control of the movant”... The Supreme Court further said that the determination of whether neglect is excusable is “at bottom an equitable one, taking account of all relevant circumstances surrounding the party’s omission”.⁴

In deciding excusable neglect cases, several of the Courts of Appeals have held that the third *Pioneer* factor, namely the reason for the delay including whether it was within the reasonable control of the movant, is the most important of the *Pioneer* factors.⁵

Argument Summary -- StonCor’s Motion Should Be Granted Because StonCor’s Evidence Rebuts Les Pierres’ Contentions, All of Which Are Limited to *Pioneer* Factor Number 3

Les Pierres’ opposition is based wholly on the third *Pioneer* factor. StonCor’s evidence effectively and completely refutes Les Pierres’ allegations, innuendos, and suggestions

² *Pumpkin Ltd. V. The Seed Corps.*, 43 USPQ2d 1582 (TTAB 1997).

³ *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et. al.*, 507 U.S. 380 (1993).

⁴ *Pioneer*, 507 U.S. at 392.

⁵ *Weinstock v. Cleary, Gottlieb, Steen & Hamilton*, 16 F3f501, 503 (2d Cir. 1994); *City of Chanute, Kansas v. Williams Nat. Gas. Co.*, 31 F.2d 1041, 1046 (10th Cir. 1994); *Thompson v. E.I. DuPont de Nemours & Co., Inc.*, 76 F.3d 530, 534 (4th Cir. 1996).

respecting StonCor's reasons for failing to take testimony during the required period. StonCor's evidence clearly establishes StonCor's counsel's debilitating illness, and the unavailability of any other lawyer with the necessary background and experience to prepare for and to take the deposition testimony. These factors were completely out of StonCor's control. Hence, the requirements of the third *Pioneer* factor, on which all of Les Pierres' contentions are based, are met and StonCor's motion should be granted.

Pioneer Factor #1

Les Pierres makes no allegation of prejudice to Les Pierres that would result from grant of StonCor's motion. The mere passage of time is not normally considered to be prejudicial to an applicant, absent something like the loss of a potential witness, death of a party and the like⁶. Les Pierres gives no hint of any such event. Les Pierres' papers are silent with respect to the issue of prejudice, which is the first *Pioneer* and *Pumpkin* factor.

Pioneer Factor #2

Les Pierres' presents no discussion of delay or adverse impact on the proceedings from grant of StonCor's motion. Les Pierres is silent respecting the second *Pioneer* and *Pumpkin* factor.

Pioneer Factor #4

Les Pierres makes no assertion of bad faith on the part of StonCor. Les Pierres is silent respecting this fourth of the *Pioneer* and *Pumpkin* factors.

Pioneer Factor #3

Les Pierres focuses entirely on *Pioneer* and *Pumpkin* factor three, namely the reason for the delay and whether it was within the reasonable control of StonCor. Les Pierres makes essentially two arguments: First, that StonCor's counsel Mr. Quinn was purportedly in the office

⁶ *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002) citing *HKG Indus., Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156 (TTAB 1998)

during the time that he was supposedly sick and, by implication, was really not so sick that he could not have taken StonCor's testimony-in-chief during the required period. Second, that there were other attorneys in Mr. Quinn's office that could have substituted for him and taken the testimony during the required period. These contentions are addressed separately below.

StonCor's Counsel Mr. Quinn's Condition Prevented Him from Taking Testimony

Les Pierres contends in paragraphs one through fifteen of its opposition that Mr. Quinn signed and filed a number of papers in the United States Patent and Trademark Office during the period when he was ill. From this Les Pierres argues by implication that Mr. Quinn was not so ill that he could not have taken the deposition testimony during the required time.

Les Pierres' implications regarding Mr. Quinn's illness are wrong. During the extremely severe part of Mr. Quinn's illness, he was at home experiencing alternating fever and chills, severe body aches, and continuous discharge of thick, heavy mucus that prevented him from sleeping for more than an hour at a time without awakening. During this period⁷ he did not come into the office at all. Rather, during this extremely severe portion of his illness Mr. Quinn was confined to bed and, as a result, he was unable to prepare and take a testimonial deposition during that time and would have been unable to brief a colleague to take the deposition, had a qualified colleague been available⁸.

After the most extremely severe part of Mr. Quinn's illness had passed, on some days he did come into the office for short periods, when he felt he had to and he was able⁹.

With respect to the papers addressed in Les Pierres' numbered paragraphs 1, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14 and 15, it is correct that Mr. Quinn applied his signature to those papers in accordance with the requirements of 37 CFR 1.4(d)(4)(ii)(A). However any inference that Mr.

⁷ December 12 through December 21; ¶ 8 Quinn Declaration attached.

⁸ ¶ 8, Quinn Declaration attached.

⁹ ¶ 9, In. 2, Quinn Declaration attached.

Quinn spent any significant amount of time in the office, on any of those seven days¹⁰, which is the inference Les Pierres would have this Board draw, is incorrect. As clearly set forth in Mr. Quinn's declaration, on the days when he was ill and yet still could bring himself to go into the office, he would sleep on the train coming into the office, would go to the office and minimize his time there, and upon leaving would sleep on the train going home. He did not spend full days in the office. His illness would not permit him¹¹.

During the period of his illness that he was, on intermittent days, able to come into his office, Mr. Quinn was not able to concentrate for more than a few minutes on any single matter. The aching he experienced throughout his body, together with a heavy cough resulting from the continued heavy discharge of mucus, made concentration for any extended period of time impossible. As a result Mr. Quinn could not prepare for and take any testimonial deposition during this time, which extended through the end of the testimony period for StonCor Group, Inc¹².

Here is an example of Les Pierres' wrongful implication that Mr. Quinn was active in his office during his illness, from which Les Pierres would have this Board infer that StonCor's prior submissions were incorrect and misleading: Les Pierres states¹³ "Also on December 22, 2008, Mr. Quinn **signed and filed** a new trademark application" (emphasis added). This is incorrect. Mr. Quinn's paralegal, Ms. McGregor, filed the application for Mr. Quinn; Mr. Quinn only reviewed and inserted his signature onto the electronic application papers in accordance with the requirements of 37 CFR 1.4(d)(4)(ii)(A). For Les Pierres to imply that Mr. Quinn did anything more than review and sign those papers electronically, and further to imply that Mr. Quinn was capable of preparing for and conducting a testimonial deposition for StonCor, is wrong. Les Pierres makes the same wrongful implications in its numbered paragraphs 1, 4, and 6 through 15,

¹⁰ The days in question were December 10, 22, 23, 24, 29, 31 and January 7.

¹¹ ¶ 11, Quinn Declaration attached.

all of which should be disregarded for the reasons stated in this paragraph above and in the accompanying Quinn declaration.

Les Pierres¹⁴ is wrong in contending that Mr. Quinn signed and filed a request for an extension of time on 17 December 2008. Mr. Quinn was not in the office that day. He was home in bed. As set forth in the accompanying declaration of Ms. McGregor, she acted on her own in signing that paper with Mr. Quinn's name and filing that paper over what was purportedly Mr. Quinn's signature. Ms. McGregor has subsequently been instructed that this was improper and should not ever be done again.¹⁵

Les Pierres¹⁶ is wrong in contending that Mr. Quinn participated in a telephone conference with opposing counsel on 17 December 2008. As set forth in Ms. McGregor's declaration and corroborated by a letter sent to Mr. Quinn by Gordon Hill, Esquire, the attorney with whom Ms. McGregor communicated on 17 December 2008, there was no communication between Mr. Quinn and Mr. Hill on 17 December 2008 because, as noted above, Mr. Quinn was not in the office that day; he was in bed.

Les Pierres was fooled by some loose language in the stipulated extension prepared by Mr. Hill, the lawyer with whom paralegal Ms. McGregor spoke that day. Mr. Hill filed the stipulated extension in connection with opposition 91182060; a copy of the stipulated extension that Mr. Hill drafted and filed is attached as Exhibit "E" to Les Pierres' papers.

Mr. Hill has confirmed that he did not speak with Mr. Quinn on 17 December, in a 25 February letter to Mr. Quinn, correcting the misimpression that Mr. Hill had spoken with Mr. Quinn on 17 December. The misimpression Les Pierres drew resulted from the language Mr. Hill used in the stipulated extension he drafted and filed in opposition 91182060. A copy of Mr.

¹² ¶ 8 and 9, Quinn Declaration attached.

¹³ ¶ 5, Les Pierres' opposition.

¹⁴ ¶ #2, Les Pierres' opposition.

¹⁵ Remedial measures are being taken with respect to that application and the paper that Ms. McGregor submitted therein.

Hill's 25 February 2009 letter to Mr. Quinn is attached to Ms. McGregor's accompanying declaration as Exhibit 1.

From the foregoing and from the accompanying declarations and the exhibits attached to them, it is clear that Les Pierres' assertion "Mr. Quinn was actively working on a wide variety of trademark matters, including matter for Opposer, during this period" is wrong. The implication Les Pierres would have this Board draw, that StonCor's motion and accompanying papers were incorrect and misleading as respecting Mr. Quinn's condition, is unsupported by the evidence and is flat out wrong.

Pinch Hitters for Mr. Quinn were not available

Ignoring the value of experience in representing a client, Les Pierres takes the position that other attorneys in Mr. Quinn's law firm's Philadelphia office Intellectual Property Group could have taken the deposition testimony¹⁷. None of those attorneys who were available at the time have ever represented a client through the testimonial phase of a trademark opposition proceeding. Mr. Quinn has represented StonCor in twenty trademark oppositions before this Trademark Trial and Appeal Board and in thirty-seven other trademark opposition, cancellation and nullification proceedings around the world, all as a part of StonCor's trademark enforcement program¹⁸. No other attorney in Mr. Quinn's firm has had any substantial role in the StonCor trademark enforcement effort. Significantly, none of the other available attorneys in the Philadelphia office Intellectual Property Group of Mr. Quinn's firm has ever taken a testimonial deposition in a trademark opposition proceeding. There were no pinch hitters available to substitute for Mr. Quinn while he was ill¹⁹. Les Pierres' contention that substitutes were available is wrong.

¹⁶ ¶ #3, Les Pierres' opposition.

¹⁷ Pgs. 6-9, Les Pierres' opposition.

¹⁸ ¶ 2-5 Quinn declaration.

¹⁹ ¶ 29, Quinn declaration.

Not only was substitute counsel unavailable, it should be kept in mind that preparing for and taking a testimonial deposition is quite different from preparing for and taking the ordinary discovery deposition. In the testimonial deposition, the lawyer is trying to make his client's case through direct examination of one or more witnesses called on behalf of the client. In the ordinary discovery deposition, the lawyer, in much the manner of cross-examination, is exploring for weaknesses in the opponent's case and many times will be deposing a witness employed by or at least favorably inclined towards the lawyer's client's opponent. Consequently, experience in taking the ordinary discovery deposition may not be so applicable in taking a testimonial deposition of the type at issue here.

Les Pierres contends that Mr. Brant, a young attorney in Mr. Quinn's office, could have taken the deposition. Mr. Brant has less than one year of experience and has never attended, much less taken, a deposition²⁰.

Les Pierres further makes much of the fact that the marks asserted by StonCor in opposition 91177161, the opposition proceeding in which Mr. Brant drafted a reply brief for Mr. Quinn's approval, are the same marks that StonCor is asserting in the instant proceeding. This is to be expected. StonCor asserts its house mark "STONHARD" and its family of "S T O N" marks against any party seeking to register a mark that StonCor considers to be excessively close to any of its marks. Accordingly, it is not surprising that the same marks are being asserted against Les Pierres as were asserted in opposition 91177161 against Stonel, Inc.

Summary and Prayer for Relief

This is not a case like *Old Nutfield*²¹, where there was undue delay (more than four months) in filing the motion; StonCor's motion was filed 23 days after the close of the period.

²⁰ ¶ 16, Quinn declaration.

²¹ *Old Nutfield Brewing Co. v. Hudson Valley Brewing Co.*, 65 USPQ2d 1701 (TTAB 2002)

Nor is this a case like *HKG Indus., Inc.*²². where the movant failed to supply any explanation as to why other attorneys, named on the power of attorney as authorized to represent the movant, could not have assumed responsibility upon principal counsel's unavailability due to his death. StonCor has shown that there was no other qualified counsel available to substitute for Mr. Quinn when he fell ill.

Here, the failure to take testimony resulted from circumstances wholly outside of StonCor's control. No one chooses to become ill. Certainly Mr. Quinn did not chose to do so. While excusable neglect is not limited "to omissions caused by circumstances beyond the control of the movant", in this case the cause of the omission was entirely beyond StonCor's control. Mr. Quinn's health was outside of StonCor's control, as was the unavailability of substitute counsel. When an equitable determination is made and all of the relevant circumstances are taken into account, as required by *Pioneer* and *Pumpkin*, Les Pierres' numerous wrongful implications should be disregarded and StonCor's motion for reopening of its period for testimony should be granted

To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of declaration and/or any accompanying papers herewith, please charge all such fees to Deposit Account 50-1943.

Respectfully submitted,

Date: 1 March 2009

/Charles N. Quinn/
CHARLES N. QUINN
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²² *HKG Indus., Inc. v. Perma-Pipe, Inc.*, 49 USPQ2d 1156 (TTAB 1998)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

StonCor Group, Inc.,	:	
	:	
Opposer,	:	
	:	Opposition No. 91181621
v.	:	
	:	Ser. No. 76650832
Les Pierres Stonedge Inc.,	:	
	:	
Applicant.	:	

CERTIFICATE OF SERVICE

I, Charles N. Quinn, of full age, by way of certification, state that a copy of StonCor's Reply to Les Pierres' Opposition to StonCor's Motion to Reopen StonCor's Testimony Period-in-Chief, Declaration of Charles N. Quinn (with two Exhibits) and Declaration of Deanna M. McGregor (with two Exhibits) was sent to applicant's counsel on the date set forth below via electronic mail and by first class mail, postage prepaid, addressed as follows:

James R. Menker, Esquire
Holley & Menker, P.A.
P.O. Box 331937
Atlantic Beach, FL 32233
jmenker@holleymenker.com, lgreer@holleymenker.com,
eastdocket@holleymenker.com

Date: 2 March 2009

/CHARLES N. QUINN/
Charles N. Quinn

2. I have represented StonCor Group, Inc. in intellectual property matters since the early 1980's. A major portion of that representation has been devoted to protecting and enforcing StonCor's house mark "STONHARD" and StonCor's collection of product marks that commence with the letters "S T O N", such as "STONSHIELD", "STONKOTE", "STONLUX", "STONCLAD" and others. Part of the trademark protection and enforcement effort involves writing protest letters to third parties using objectionable marks. Another part involves instituting trademark opposition proceedings, trademark nullification proceedings and other proceedings against marks that are considered to be excessively close to any of StonCor's "S T O N" marks, anywhere in the world that StonCor is commercially active.

3. In the 2005-2006 timeframe StonCor instituted a more rigorous program of trademark enforcement whereby our law firm subscribes, on behalf of StonCor, to two watching services that inform us of publication of marks the watching services believe might be of interest to StonCor for opposition purposes. I review those watch service notices and advise StonCor on a weekly or more frequent basis as respecting marks that appear to be possible candidates for opposition, cancellation or other proceedings.

4. Since instituting this trademark enforcement program, I have filed twenty trademark oppositions on behalf of StonCor in the United States Patent and Trademark Office. I have been the principal attorney for StonCor in every one of those trademark oppositions. Internationally, I have filed, in conjunction with offshore associate counsel, forty-three trademark opposition, cancellation, or nullification actions against trademarks perceived to be excessively close to one or more of StonCor's marks. Those proceedings have been filed in the European Community Trademark Office, the Benelux Trademarks Office, and in the national trademark offices of Canada, France, Germany, Portugal, Spain, Denmark, Indonesia, Hong

Kong, Japan, Korea, China, India, South Africa, the United Arab Emirates, Australia and Ecuador. In each of those foreign trademark opposition, cancellation or nullification proceedings, I have represented StonCor and have instructed and worked with a local, on-site colleague in conducting the trademark opposition, cancellation or nullification proceeding in that particular country. As a result of my representation of StonCor in all of these trademark opposition, cancellation or nullification proceedings, I have developed substantial knowledge of StonCor's business, the StonCor trademark portfolio, the arguments likely to be brought by opponents, the evidence available to StonCor to prove its case, and the like.

5. No other attorney in our office has had any significant involvement in the StonCor trademark enforcement program. Few other attorneys in our office even know of the existence of the domestic oppositions or of the offshore opposition and nullification proceedings. As a result of my representation of StonCor over the past twenty years and especially in connection with the trademark enforcement program over the past several years, I have developed a body of knowledge that no other attorney has respecting StonCor's trademark enforcement program.

6. In my practice, I work closely with Ms. Deanna McGregor, an intellectual property paralegal in our Philadelphia office. Typically, as respecting trademark and trademark opposition matters in the United States Patent and Trademark Office, I provide instructions to Ms. McGregor with respect to a particular task relative to any trademark application or proceeding before the Trademark Trial and Appeal Board. She then prepares a paper in accordance with my instructions, I review the paper, and after my review and my insertion of my electronic signature, namely /Charles N. Quinn/, as authorized by 37 CFR 1.4(d)(2), she files the paper electronically in the United States Patent and Trademark Office in compliance with 37

CFR 1.4(d)(4)(ii)(A). For example, in the case of a trademark registration application based on intent to use the mark, I will specify to Ms. McGregor the client name, which is normally the applicant, the mark, and the goods or services for which the mark is to be registered. Ms. McGregor will then prepare the electronic version of the trademark registration application and, after my review and my insertion of my electronic signature, will file that application in my name pursuant to my authorization.

7. In my declaration of 30 January 2009, in describing my illness, I should have addressed the fact that I also have a heart condition, namely a variety of irregular heartbeat for which the clinical name is “neurocardiogenic syncope”, and that I am under the care of an electrocardiologist, Dr. Peter Koey, whose office is in the Lankenau Hospital Medical Building, in the Philadelphia suburb of Wynnewood, Pennsylvania (610-649-6980). For that condition I take a drug for which the generic name is Sectrol; I take this drug two times a day. Because of the need to take Sectrol in order to regulate my heartbeat, other medications that I can take, that do not adversely interact with Sectrol, are limited. One category of drugs that I cannot take are nasal decongestants such as Nyquil. Moreover, while the Sectrol generally seems to do an effective job of controlling and regulating my heartbeat when I am otherwise healthy, whenever I have an infection such as the type I had during this past December and January, the neurocardiogenic syncope problem is much more likely to manifest itself. When that problem does manifest itself, my heart rate slows precipitously and sometimes I lose consciousness for from about twenty to about thirty seconds. I have had this condition for nine years and will need to live with it for the rest of my life. Because of the neurocardiogenic syncope problem, whenever I have an infection such as I had in December and January, or even a moderately severe cold, I must be careful to not over exert myself and to not become too fatigued.

8. During the December-January period that I was ill, I had been instructed by my attending physician Dr. Sebring, who is identified in my 30 January declaration, to get as much bed rest as possible¹. During the most extremely severe part of the illness, I had alternating fever and chills, my body ached from head to toe, and I experienced extraordinary, continuous discharge of thick, heavy mucus from my sinuses. The discharge was so large in volume that I would wake up about once an hour each night, choking on my own mucus. Each time that I woke I would need to go into the bathroom, use a nasal irrigator to flush the mucus out of my nasal cavity, cough up the mucus that was caught in my throat, and then return to bed. After about one hour of sleep, I would awaken once more choking on my mucus and I would need to repeat the flushing and coughing procedure. That portion of the illness lasted about ten days and included the longest period during which I did not come into the office², from December 12 through December 21. I was confined to bed during that time. As a result of my physical condition, and my confinement to bed, there was no way that I could prepare for and take a testimonial deposition or brief anyone else to do so.

¹ Throughout the paper filed by Les Pierres in opposition to the motion to reopen StonCor's testimony-in-chief the implication is made that I was not sick or at least was not as sick as contended in StonCor's motion. To refute that implication, I have attached to this declaration as Exhibit "1" photocopies of two of the bottles of the prescription medications Dr. Sebring prescribed for me to help me to recover from the illness. The copies are not particularly clear since it is difficult to photocopy a round surface onto a flat piece of paper. The labels are glued onto the bottles and cannot be removed therefrom. However, I believe the labels are sufficiently clear in the photocopy as to evidence the medication that was prescribed and the time in which it was prescribed for me.

² Ms. McGregor submitted a declaration in connection with a time extension request solicited in opposition 91177161 due to my illness. A portion of her declaration is quoted in footnote 2 on page 7 of Les Pierres' paper. In that footnote Les Pierres contends that the McGregor declaration assertion, as to the dates of my illness, is inconsistent with StonCor's 30 January motion to reopen and my accompanying declaration. That inconsistency resulted from a misstatement that I made in my declaration accompanying the 30 January motion as to the date that I was taken ill, namely that I was taken ill on Tuesday 9 December when I actually was taken ill one week earlier, on Tuesday 2 December. The misstatement was erroneously carried over into StonCor's 30 January motion. I found the misstatement as to the date in the course of reviewing my records while preparing this declaration and the accompanying reply. The misstatement was corrected in the declaration and in StonCor's 30 January motion by submission of corrective pages on 20 and 27 February. With the submission of the corrective pages there is no inconsistency as between the McGregor declaration and StonCor's 30 January motion, as asserted in footnote 2 on page 7 of Les Pierres' paper. For the convenience of the Board and for completeness, a copy of Ms. McGregor's declaration submitted in opposition 91177161 is attached to this declaration as Exhibit 2.

9. After the most extremely severe part of the illness had passed, I came into the office for very short periods, when I felt that I had to and I was able. I reside in Exton, Pennsylvania. To come into the office in Philadelphia requires a fifteen minute drive to the Exton station that serves both Amtrak and SEPTA (Southeastern Pennsylvania Transit Authority), followed by a train ride that can be as short as fifty minutes and as long as one and one-half hours, depending on the train schedule, the number of persons on the train, the type of equipment used on that particular train, other train traffic and the like. Once I arrive in downtown Philadelphia, I have a walk of about fifteen minutes from the train station to my office. In the morning the train ride is typically on the order of fifty minutes; in the evening, the train ride is closer to one and one-half hours. During the period that I was ill, when I came into the office, I tried to come late in the morning and I would sleep on the train from Exton to Philadelphia. I would ask the conductor when I boarded the train to awaken me so that I could detrain at SEPTA's Suburban Station in downtown Philadelphia. I would try to leave the office to go home as soon as possible and I would sleep on the train from Philadelphia to Exton, asking the conductor when I boarded the train to be sure to awaken me so that I could detrain at Exton. (When I was ill, my wife took me to the train station and met me there when I came home, because I was continuously so fatigued.) During the period of my illness that I was able to come into the office, I was not able to concentrate for more than a few minutes on any single matter. The aching that I experienced throughout my body together with a heavy cough resulting from the continued heavy discharge of mucus, made concentration for any extended period of time impossible. Moreover, everyone in the office hearing my cough stayed far away from me. The commuting experience only added to the fatigue and aches that I felt. With the body aches and difficulties in concentration that I was experiencing, even after the most extremely severe part of

my illness had passed well into January I still was unable to even consider preparing for and taking a testimonial deposition.

10. On the days that I came into the office for short periods when I was ill, I would consult with and instruct Ms. McGregor as to what seemed to be needed to be done that day. Many times she would already have prepared a required paper. If she had not, as soon as she had prepared the required paper, I had reviewed it and had inserted my signature, and I had given her any other required instructions, I would leave to go home.

11. With respect to the papers addressed in paragraphs 1 and 4 through 15 in Les Pierres' opposition to StonCor's motion to reopen the testimony period, it is not correct that I personally filed all of those papers. It is correct that I inserted my electronic signature and authorized the filing of those papers. However, any inference that I was in the office all day or even a substantial part of the day on any of the days those papers were filed is wrong. I minimized my time in the office on those days, to the greatest extent possible.

12. The assertion that I was in the office all day and that I personally prepared and filed papers on 17 December and consulted with opposing counsel that day in another case, as set forth in paragraphs 2 and 3 of Les Pierres' opposition to StonCor's motion to reopen the testimony period, is wrong.

13. With specific reference to the assertion set forth in Les Pierres' paragraph 2 that on 17 December I signed and filed a request for an extension of time to file an allegation of use in connection with a pending trademark registration application, that is not true. I was home in bed that day. The accompanying declaration of Deanna McGregor sets forth the true and correct facts regarding the signing and filing of that request for an extension of time, specifically in paragraphs 9 through 11 of Ms. McGregor's declaration.

14. Les Pierres' assertion in paragraph 3 that I participated in a telephone conference with Gordon Hill, Esquire, opposing counsel in another case, on 17 December 2008 is also not true. For the true and correct facts respecting our office personnel dealings with Mr. Hill that day please refer to paragraph 8 of Ms. McGregor's accompanying declaration and to Exhibit "1" attached thereto, which is a record-correcting letter from Mr. Hill noting that I did not have any telephone discussion with him on 17 December 2008.

15. Les Pierres implies in its paragraphs bridging pages 6-8 that other attorneys in the Fox Rothschild Intellectual Property Department in Philadelphia could have taken StonCor's testimony in support of StonCor's case-in-chief during the relevant time period. This is incorrect. Les Pierres' Exhibit S is a photocopy of a web page from the Fox Rothschild website listing the members of the Fox Rothschild Intellectual Property Department located in Philadelphia. There are good and valid reasons why none of these individuals would have been able competently to prepare for and to take the deposition testimony-in-chief for StonCor in this matter. Respecting Messrs. Alexis Barron, Frank T. Carroll, Gary Hecht, Robert Henrie³, Jimmie Johnson, Joseph Posillico, and Mss. Lisa Lane and Tara Rachinsky, these individuals were all part of an IP boutique firm, Synnesvedt & Lechner, that merged into Fox Rothschild in the late fall of 2008. These individuals were not even located in our Philadelphia office until the 1st of December. None of them had or have any knowledge of StonCor as a business entity or as a client. None of them had any knowledge of StonCor's trademarks, the StonCor trademark enforcement program, this opposition proceeding, or any of the other trademark oppositions and other proceedings brought on behalf of StonCor as a part of StonCor's trademark enforcement program. All of those individuals were and still are in the process of transitioning their practices from the now dissolved Synnesvedt & Lechner firm to Fox Rothschild LLP. Accordingly, none

of those people were in a position to prepare for and to take StonCor's deposition testimony in the instant trademark opposition proceeding.

16. Mr. Edward L. Brant is an associate intellectual property attorney in our Philadelphia office. Mr. Brant has less than one year of legal experience; he graduated from Temple University Law School last spring. Mr. Brant has never taken a deposition of any type, has never even sat in on a deposition, and certainly would not have been qualified to take the deposition testimony in support of StonCor's case-in-chief in this proceeding. Mr. Brant did assist, during the period I was ill, in opposition number 9117161, StonCor Group, Inc. v. Stonel, Inc. After I had outlined the arguments for him, he wrote StonCor's reply brief, which I reviewed and approved on a day that I came into the office during the course of the illness.

17. Mr. Tristram Fall is a trademark, computer law and licensing attorney in our Philadelphia office and has assisted me in a few minor StonCor trademark matters. Mr. Fall did sign the papers concluding trademark opposition 91168700, as set forth in the paragraph bridging pages 7 and 8 of Les Pierres' paper opposing StonCor's motion to reopen the testimony period. However, Mr. Fall has never taken testimony in a trademark opposition proceeding, has never taken a deposition of any type, has never handled a trademark opposition proceeding from beginning through testimony and briefing, and is not familiar with StonCor's business or its overall trademark enforcement program.

18. Mr. James Griffith is a general litigation attorney. Mr. Griffith does not practice before the United States Patent and Trademark Office. Mr. Griffith spends most of his time in our firm's Blue Bell office, not in our Philadelphia office. Mr. Griffith has never handled a trademark opposition proceeding in the United States Patent and Trademark Office. Mr. Griffith is completely unfamiliar with StonCor Group, Inc. He has never worked on any matter for

³ Mr. Henrie is not an attorney; he is a patent agent.

StonCor and has no knowledge whatsoever of StonCor or its business, let alone StonCor's trademark enforcement program. He is unfamiliar with trademark opposition practice.

19. Mr. Mark Hand is a biotechnology patent attorney in our Philadelphia office. He has never handled a trademark opposition proceeding. He has never taken a deposition in a trademark opposition proceeding. Mr. Hand has no familiarity with StonCor Group, Inc., has never worked on any matter for StonCor, has no knowledge of StonCor's trademark enforcement program, knows nothing about this or any of the other trademark oppositions brought by StonCor as a part of the trademark enforcement program, and is unfamiliar with trademark opposition practice.

20. Mr. Mark McCreary is an Internet, general corporate, and bankruptcy lawyer in our Philadelphia office. Mr. McCreary has filed trademark registration applications in the United States Patent and Trademark Office but has never taken a deposition in any type of legal proceeding. He has never handled a trademark opposition matter from beginning through testimony and briefing. Mr. McCreary has never worked on any significant StonCor matter and has no familiarity with the StonCor business or with the StonCor trademark enforcement program.

21. Mr. Abraham Reich is a general litigation attorney specializing in professional liability and ethics issues. Mr. Reich does not practice before the United States Patent and Trademark Office. Mr. Reich has never worked on any StonCor matters, has no knowledge of StonCor or its trademark enforcement program, has never filed a trademark application in the United States Patent and Trademark Office, and has never handled a trademark opposition proceeding or taken a deposition in a trademark opposition proceeding. He is unfamiliar with trademark opposition practice.

22. Ms. Martha Reilly is a part-time Internet and general corporate attorney in our Philadelphia office, working three days each week. The remaining time she is at home with her two children. Ms. Reilly has never worked on any StonCor Group matters, has never taken a deposition, has never handled a trademark opposition proceeding from beginning to end, and has no knowledge of StonCor or its trademark enforcement program. She is unfamiliar with trademark opposition practice.

23. Mr. Ronald Shaffer is a general litigation attorney in our Philadelphia office. Mr. Shaffer does not practice before the United States Patent and Trademark Office. Mr. Shaffer has never handled a trademark opposition proceeding, has never filed a trademark application, has never taken a deposition in a trademark opposition proceeding, and has no knowledge of StonCor, or the business of StonCor, or the trademark enforcement program of StonCor, let alone any knowledge of this opposition. He is unfamiliar with trademark opposition practice.

24. Mr. Eric Sumner is a second year associate biotechnology attorney who divides his time between our Philadelphia and Exton, Pennsylvania offices. Mr. Sumner has worked on one StonCor patent matter with me but has no knowledge of any of StonCor's trademark issues. He has no specific knowledge of StonCor's business and no knowledge of StonCor's trademark enforcement program or any of the trademark oppositions that have been filed on behalf of StonCor. He is unfamiliar with trademark opposition practice and has never taken a deposition.

25. Ms. Lindette Thornton is a second year associate and biotechnology patent attorney who divides her time between our Philadelphia; Blue Bell, Pennsylvania; and Princeton, New Jersey offices, spending two or three days a week in our Philadelphia office. Ms. Thornton has never taken a deposition in any kind of proceeding, has never handled a trademark opposition proceeding, has never worked on any matters for StonCor, has no knowledge of the

business of StonCor or the trademark enforcement program of StonCor. She is unfamiliar with trademark opposition practice.

26. Les Pierres implies that Mr. Brant could have taken StonCor's testimony in support of StonCor's case-in-chief because Mr. Brant's name is listed on the reply brief filed on 7 January 2009 in opposition number 91177161 and because "the marks asserted by opposer in opposition 91177161 are the same as those in the instant proceeding"⁴. The fact that StonCor is asserting the same mark(s) in this proceeding as in opposition 91177161 is to be expected. StonCor asserts the same marks in nearly all of the opposition proceedings StonCor files. StonCor is asserting its house mark "STONHARD" and its family of "S T O N" marks in this proceeding; these are the marks that are the basis for StonCor's trademark enforcement program and are the marks that StonCor seeks to protect. In all likelihood StonCor will assert those same marks in the future in nearly every trademark opposition StonCor files as a part of its trademark enforcement program. No negative inference should be drawn from the fact that the marks asserted by StonCor in this proceeding are the same as those asserted by StonCor Group in opposition 91177161. Les Pierres' suggestion to this effect is wrong.

27. As respecting the consented extension stipulation filed in connection with 91177161 and signed by Mr. Brant and Mr. Hecht on my behalf, Mr. Hecht and Mr. Brant required no knowledge whatsoever of the merits of opposition 91177161 with respect to the submission of that stipulated extension. To suggest that the signing of that stipulated extension somehow qualified Mr. Hecht and Mr. Brant to handle the matter of StonCor's testimony-in-chief in the instant opposition is ludicrous.

28. Respecting the action by Mr. Fall of signing and filing a motion to dismiss opposition number 91168700 while I was ill, I had briefed Mr. Fall on that situation and the fact

that the opposition was being dismissed because StonCor's parent had acquired the applicant. As a result, the opposition was moot. I had firmly established the parameters for that dismissal with counsel for StonCor's parent, as the new owner of the opposed application, well before I fell ill. Mr. Fall followed through with instructions that I gave him, before I was taken ill, in working through the mechanics of the dismissal of opposition 91168700. Les Pierres' implication that this qualified Mr. Fall to take the deposition testimony in support of StonCor's case-in-chief in this proceeding is wrong.

29. Summarizing respecting Les Pierres' contention that another attorney in our Philadelphia office Intellectual Property Group could have taken the testimony while I was ill, all of the other attorneys in the IP Group, as nominated by Les Pierres, were either still in the process of moving into our Philadelphia office⁵, or had no experience in taking depositions of any type⁶, or had never represented a client in a trademark opposition⁷. Les Pierres' contention that pinch hitters were available for me is wrong.

30. I hereby declare, under penalty of perjury pursuant to 28 USC 1746, that all statements made herein are true and that all statements made herein on information and belief are believed to be true and further that I realize that false statements and the like so made herein are punishable by fine, or imprisonment or both, under 18 USC 1001 et seq., and further may jeopardize StonCor's position in this proceeding.

⁴ Pg. 7, ln 9 of Les Pierres' paper.

⁵ Mss. Lisa Lane and Tara Rachinsky and Messrs. Alexis Barron, Frank T. Carroll, Gary Hecht, Jimmie Johnson, and Joseph Posillico.

⁶ Messrs. Brant, Fall, Sumner, McCreary and Hand, and Mss. Thornton and Reilly.

⁷ Messrs. Shaffer, Griffith, Reich, in addition to those attorneys listed in footnote 6 immediately above.

31. To the extent there is any fee required in connection with the receipt, acceptance and/or consideration of declaration and/or any accompanying papers herewith, please charge all such fees to Deposit Account 50-1943.

Respectfully submitted,

Date: 1 March 2009

/Charles N. Quinn/
CHARLES N. QUINN
Attorney for Opposer
Fox Rothschild LLP
2000 Market Street
Tenth Floor
Philadelphia, PA 19103
Tel: 215-299-2135
Fax: 215-299-2150
email: cquinn@foxrothschild.com

**Exhibit “1” to Quinn Declaration
In Support of StonCor’s Reply to
Les Pierres’ Opposition to StonCor’s
Motion to Reopen StonCor’s Testimony
Period-in-Chief**

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**Exhibit “2” to Quinn Declaration
In Support of StonCor’s Reply to
Les Pierres’ Opposition to StonCor’s
Motion to Reopen StonCor’s Testimony
Period-in-Chief**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Application Serial No. 78/879396

STONCOR GROUP, INC.	:	Opposition No. 91177161
	:	
Opposer,	:	
	:	
v.	:	
	:	
STONEL INC.	:	
	:	
Applicant.	:	

**DECLARATION OF DEANNA M. MCGREGOR IN SUPPORT OF
OPPOSER'S MOTION TO EXTEND TIME TO FILE ITS REPLY BRIEF**

1. I, Deanna McGregor, am employed as a paralegal at the law offices of Fox Rothschild LLP in its Philadelphia offices at 2000 Market Street, Tenth Floor, Philadelphia, PA 19103. I am a citizen of the United States and reside in Wilmington, Delaware.

2. I work under the direction of attorney Charles N. Quinn and have been in contact with Mr. Quinn and his wife over the past three weeks. Mr. Quinn is the lawyer representing Opposer StonCor Group, Inc. in the above identified Opposition proceeding.

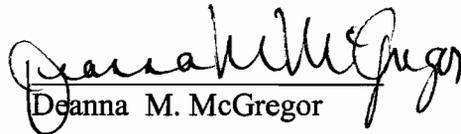
3. Mr. Quinn was absent from work beginning December 3 through to today, December 19, 2008, with exceptions of a half day on December 8, and on December 9, 10 and 11.

4. I spoke with Mr. Quinn and his wife at various times during the week of December 15, 2008, and was informed that he is extremely ill. I was also informed that he initially had the flu beginning on December 3, 2008, which has since developed into secondary infections, and that his illness has been complicated by his heart related problems. I spoke with Mr. Quinn's wife today, December 19, 2008, and was informed that Mr. Quinn is still very ill and that it is presently unknown as to when he will return to work.

6. Mr. Quinn had previously coordinated with the staff at Fox Rothschild LLP to work on the reply brief the end of the week of December 8, 2008, and during the week of December 15, 2008. Due to his illness he has not been able to do any work associated with the reply brief.

I declare under penalty of perjury under the laws of the United States that the foregoing statements, made of my own knowledge, are true and correct.

Dated: December 19, 2008


Deanna M. McGregor

3. From early in the month of December 2008 until well into the month of January 2009, Mr. Quinn was quite ill with a severe sinus and upper bronchial infection and missed a number of days of work. This commenced on 3 December 2008 and continued well into the second full week of January 2009.

4. While Mr. Quinn was ill, there was a period during which he was so ill, he was unable to get out of bed and certainly could not come into the office. During that period I spoke with him on, I believe, two occasions with regard to instructions for various cases. On other days during the most intense period of his illness, I would get messages to Mr. Quinn by calling his wife. My purpose in doing this was to keep Mr. Quinn informed while attempting to ease his mind and allowing him to rest. When I would call Mr. Quinn's house, more often than not, I would speak with Mr. Quinn's wife and she would tell me that Mr. Quinn was asleep.

5. After the most severe portion of Mr. Quinn's illness had run its course, Mr. Quinn would come into the office on some days, but only for very short periods on any given day.

6. When I came to work at Fox Rothschild, I already had extensive experience in patent matters, including the electronic filing of patent applications and other patent application-related papers using the United States Patent and Trademark Office Electronic Filing System (EFS). I had a moderate amount of trademark filing and prosecution experience. However, I had practically no experience with respect to the electronic filing system for trademarks. Mr. Quinn, while practicing both in the patent and trademark area, over the time that I have been here, has had much more paralegal work for me in the trademark area than he has had in the patent area.

7. While I work with other attorneys in the office, I work most closely with Mr. Quinn. In the course of our day-to-day practice, he will provide instructions to me with respect

to a particular task, I will then prepare a paper in accordance with those instructions and Mr. Quinn will review the paper. If the paper relates to a patent, trademark or trademark opposition matter in the United States Patent and Trademark Office or at the Trademark Trial and Appeal Board, after Mr. Quinn's review and his insertion of his electronic signature, namely /CHARLES N. QUINN/ onto the paper, pursuant to his authorization I file the paper electronically in the United States Patent and Trademark Office or with the Trademark Trial and Appeal Board. For example, in the case of a patent application Information Disclosure Statement, Mr. Quinn will provide me with directions for preparing the document and possibly where the references are to be found. I then prepare the document and email it to Mr. Quinn. Mr. Quinn will review the document, affix his electronic signature, and email the document back to me. I then electronically file the Information Disclosure Statement pursuant to his authorization.

8. As is the normal procedure in our office, whenever Mr. Quinn is absent from the office, his assistant, Ms. Beth Palmerchuck will put an "out of office" message on his work voicemail and an out of the office message on the "in box" of his e-mail on his computer. These messages inform the caller or the e-mail sender that Mr. Quinn is not in the office and, if their need is urgent, to please contact me or Ms. Palmerchuck. Our phone numbers are given. On 17 December 2008, which was one of the days when Mr. Quinn's illness was at its most severe and he was home in bed, I received a voice mail message from Gordon Hill, Esquire, opposing counsel in opposition proceeding 91182060. His message stated that he had called Mr. Quinn's phone and had been directed to contact me. He stated, in his message, that a deadline was approaching and he was interested in obtaining authorization to file a consented motion to extend. He requested a return phone call. I retrieved the case file and reviewed all of the correspondence. It was apparent from the file that active settlement discussions had been

ongoing. Therefore, I contacted our client and relayed the request that Mr. Hill had left on my voice mail. The client authorized the consent Mr. Hill was seeking. I then called Mr. Hill and left a message to contact me. He called me back later that afternoon, and I informed him that I had sought and received approval from our client to consent to the motion. Mr. Quinn was not in the office that day; Mr. Hill's discussion was with me. Attached as Exhibit "1" is a photocopy of a letter Mr. Hill sent Mr. Quinn confirming that Mr. Hill did not speak with Mr. Quinn on 17 December 2008.

9. Also on 17 December 2008, as previously authorized during one of the earlier regular docket reviews with Mr. Quinn, I was able to finally contact one of our clients regarding use of the trademark that is the subject of U.S. trademark application 78/568,858, which is an intent to use application. I contacted the client to ask the client whether the mark was being used in connection with the offering and rendering of the services recited in the application. I was advised by the client that the mark was not as yet being used in connection with the offering and rendering of the services recited in the application, however they wished to maintain the mark. 17 December 2008 was the limiting date for filing a statement of use or a first request for an extension of time to file a statement of use for that application. I electronically filed a first request for an extension of time to file a statement of use for that application over Mr. Quinn's electronic signature.

10. I have since spoken with Mr. Quinn about the action I took regarding U.S. application 78/568,858 and have been instructed that it was improper for me to have electronically filed the first request for an extension of time to file a statement of use for that application over his signature when he was out of the office and not in a position to insert his electronic signature on the request for an extension of time. I now further understand that in

every case when Mr. Quinn is out of the office, if I am to electronically file a paper in any trademark matter in the United States Patent and Trademark Office, I need to have an attorney insert the attorney's electronic version of the attorney's signature into the paper before the paper is filed.

11. My understanding respecting the permissibility of my filing the first request for an extension of time for application serial number 78/568,858 on 17 December 2008 stemmed from my experience with the Patent EFS and, specifically, the link on the website containing information provided by the United States Patent and Trademark Office entitled "Legal Framework for EFS-Web" dated September 2008. A copy of that document is attached hereto as Exhibit "2". My understanding regarding the permissibility of what I did on 17 December 2008 was premised on my reading of the "Legal Framework for EFS-Web" dated 2008. For example, one of the statements in that document is that "EFS-Web permits a legal assistant or paralegal to submit an application/request for re-examination previously reviewed by a registered practitioner without the registered practitioner being present." Yet another statement in the "Legal Framework for EFS-Web" is that one of the major innovations of the EFS-Web is that the "responsible attorney or agent need not be present for submission" of a patent application. Further on down in the document under the heading "Security" there is a statement that "only PKI registered users (or persons under their direction and control) can submit follow on papers." All of these statements in the "Legal Framework for EFS-Web" as published by the United States Patent and Trademark Office made me think that in Mr. Quinn's absence, when the client wanted to maintain the application in a pending status, it was permissible for me to file the first request for an extension of time electronically over Mr. Quinn's electronic signature. I now know that is incorrect.

EXHIBIT 1

TO

**DECLARATION OF DEANNA M. MCGREGOR IN SUPPORT OF STONCOR'S
REPLY TO LES PIERRES' OPPOSITION TO STONCOR'S MOTION TO REOPEN
STONCOR'S TESTIMONY PERIOD-IN-CHIEF**

OPPOSITION PROCEEDING 91181621

February 25, 2009

**Via Electronic Mail: cquinn@foxrothschild.com
Confirmation Copy Via U.S. First Class Mail**

Charles N. Quinn
FOX ROTHSCHILD, LLP
2000 Market Street, 10th Floor
Philadelphia, Pennsylvania 19103-3291

Re: *CytoSport, Inc. v. Agropur Cooperative*
Trademark Opposition No. 91182060

To Whom It May Concern:

I represent the Opposer, CytoSport, Inc., in the above-referenced trademark opposition proceeding that is pending before the Trademark Trial and Appeal Board. Mr. Charles Quinn represents Agropur Cooperative in the opposition proceeding. In response to Mr. Quinn's inquiry, I am providing my best recollection of the events and correspondence between myself and Mr. Quinn's office leading up to the filing of the Opposer's Motion for Extension of Time, which I filed with the Trademark Trial and Appeal Board on December 17, 2008.

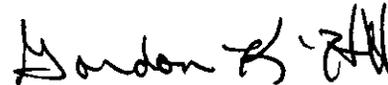
I attempted to call Mr. Quinn a day or two before the deadline for filing the motion for extension of time to request that he stipulate to the extension based on continuing settlement negotiations between the parties. I was unable to reach Mr. Quinn and had to leave a voice mail. I did not receive a response to my voicemail and the deadline approached for me to file the motion for extension of time. I contacted Mr. Quinn's assistant regarding my request for a stipulated extension and to find out if another attorney could help me. Mr. Quinn's assistant informed me that Mr. Quinn was not in the office due to illness, but that she would forward my request to alternate counsel that could help me. Later, Mr. Quinn's assistant informed me that Agropur Cooperative would stipulate to requested extension.

Based on this correspondence, I stated in Opposer's Motion for Extension of Time dated December 17, 2008 that "[c]ounsel for CytoSport and counsel for Agropur had a telephone conversation on December 17, 2008, wherein counsel for Agropur consented to this requested extension..." I apologize for any misunderstanding this statement may have caused, however, I did not speak with Mr. Quinn prior to filing this motion.

If you have any questions or comments, please do not hesitate to contact me.

Best Regards,

THORPE NORTH & WESTERN, LLP



Gordon K. Hill

GKH/tm

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Sandy, Utah 84091-1219

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EXHIBIT 2

TO

**DECLARATION OF DEANNA M. MCGREGOR IN SUPPORT OF STONCOR'S
REPLY TO LES PIERRES' OPPOSITION TO STONCOR'S MOTION TO REOPEN
STONCOR'S TESTIMONY PERIOD-IN-CHIEF**

OPPOSITION PROCEEDING 91181621



United States Patent and Trademark Office

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LEGAL FRAMEWORK FOR EFS-WEB

September 2008

[Note: a signed PDF copy of this document is available at
<http://www.uspto.gov/ebc/portal/efs/legalframework.pdf>]

I. Introduction - Scope of Document

This Legal Framework provides guidance on the background statutes, regulations and policies that support the Electronic Filing System – Web (EFS-Web) project. The document is provided as a reference for applicants, parties in reexamination proceedings, attorneys, and agents, as well as their staffs using the system.

II. Background

From October 2000 through October 2006, the USPTO provided eFiling software including two client-side components. Those components were EFS-ABX for patent application specification authoring and ePAVE for form generation, validation, and submission to the USPTO. EFS-ABX generated an .abx package that contained the Portable Document Format (PDF) version of the file and an XML version with all associated files needed for rendering in a browser. ePAVE generated XML forms based on user input, allowed for the .abx file to be attached, validated the package, and submitted it to the USPTO for processing. Due to low adoption rates of eFiling, the USPTO requested feedback from the IP community and found that users prefer filing applications using PDF, as well as being free from downloading and installing software on their workstations.

As a result of these user requests, the USPTO created EFS-Web, a PDF-based Internet patent application filing system. The use of a web browser on the client side answered requests for a "light" client, that is a system that does not require a user to download a substantial amount of software onto his/her computer. As a result of the highly favorable reception of the EFS-Web filing system and the low adoption rate of the ePAVE and ABX filing components, the ePAVE and ABX filing components were retired by the USPTO in the Fall of 2006.

III. EFS-Web

EFS-Web is a PDF-based filing system. Accordingly, all EFS-Web submissions are required to be in PDF format unless otherwise indicated below. In addition, PDF files created from scanned documents and submitted via EFS-Web must be created using a scanning resolution no lower than 300 dpi. Lower resolution scans have significantly delayed processing and publication of applications, e.g. resubmission has been required for documents failing to comply with the legibility requirements. See 37 CFR 1.52(a)(1)(v) and (a)(5) regarding document legibility requirements.

EFS-Web collects data elements from on-screen entries made through the EFS-Web graphical user interface (GUI) data collection screens. Needed patent information, however, also is collected on fillable PDF forms, or user created PDF files attached to the submission.

The user and the USPTO benefit greatly from such automated processing by increasing the accuracy and timeliness of data going from one system to another, while eliminating the need for the user to prepare paper submissions (which may be extensive) and eliminating the need for the USPTO to process large volumes of paper submissions. An applicant need not provide a duplicate copy of any document filed through EFS-Web unless the Office specifically requires the filing of a duplicate in a particular situation.

The USPTO provides users with PDF Web-based fillable forms. Currently there are several fillable forms including the Provisional Cover Sheet, the Information Disclosure Statement, the Application Data Sheet, Petition to Make

Special Under Accelerated Examination Program, Petition to Accept Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent, Request for Continued Examination (RCE), and Petition to Make Special Based on Age. The USPTO will continue to convert additional forms to the PDF form-fillable format over time.

EFS-Web permits a legal assistant or paralegal to submit an application/request for reexamination previously reviewed by a registered practitioner without the registered practitioner being present.

IV. Relevant Statutes and Rules

- 35 USC 111 – filing a patent application
- 35 USC 302, 311 – filing a request for reexamination
- 37 CFR 1.52 – form of an application/reexamination
- 37 CFR 1.4 – signatures
- 37 CFR 1.6 – receipt of correspondence

Electronic Filing System Available to Public 1240 OG 45 (14 November 2000) indicates that to the extent that any USPTO regulation is inconsistent with EFS procedures, the regulation will be interpreted in a manner to support EFS.

Improper Use of EFS-Web:

Use of EFS-Web in a manner significantly in violation of the instructions proscribed by the Legal Framework may result in non-entry of the submission or failure to accord a filing date in the event the USPTO does not fully, successfully, and officially receive all of the elements necessary to obtain a filing date for an intended submission once the applicant/patent owner clicks the SUBMIT button on the Confirm and Submit screen.

V. Legal Advantages to the Filer of the EFS-Web Approach

Major Innovations of EFS-Web:

- a. Web access from anywhere using web browser.
- b. Standard PDF accepted, from commercial and free PDF converters.
- c. Portable PDF forms, can be passed around for collaboration.
- d. **Responsible attorney or agent need not be present for submission.**
- e. Real time fee payments.
- f. An Acknowledgement Receipt received upon making an electronic filing is the legal equivalent of a post card receipt described in MPEP 503.

VI. Legal Issues & Policies

This initiative does not depend upon, or require, statutory changes. PDF files when submitted as part of a Patent Application Specification via EFS-Web are used to create the official record.

The following are policies of the Office concerning e-filed patent applications/requests for reexamination under EFS-Web, as well as follow-on papers in applications and reexamination proceedings.

VII. Subscriber Agreement/ Signature Policy

A practitioner or an employee acting under the direction and control of a practitioner may, as a general rule, file documents signed by either the practitioner exercising the direction and control or another practitioner via EFS. Filing of a document that is unauthorized to be filed via EFS (e.g. a withdrawal from issue by a third party) is inconsistent with the subscriber agreement. Thus, the certificate holder and employee acting under the direction and control of a registered attorney (or agent) must make sure that documents being submitted are authorized to be filed via EFS, regardless of whether the document is signed by the practitioner exercising the direction and

control or another practitioner.

VIII. Acknowledgement Receipt Policy

The Acknowledgement Receipt establishes the date of receipt by the USPTO of electronic documents itemized in the receipt. Under EFS-Web, the Acknowledgement Receipt will contain a full listing of the documents submitted to the USPTO as described by applicant or a reexamination party (patent owner or reexamination requester) during the submission process, including the count of pages and/or byte sizes for each document. Thus, the Acknowledgement Receipt is the electronic equivalent of the post card receipt described in MPEP 503.

The official application filing date will be noted on the Filing Receipt (37 CFR 1.54), PTO Form-103X, after the submitted application parts are reviewed for compliance with 35 U.S.C. § 111. The filing date is based on the dates indicated on the Acknowledgement Receipt assuming that, after review, the documents submitted are found to be entitled to an application filing date. Likewise the official reexamination filing date will be noted on the "Notice of ... Reexamination Request Filing Date," after Central Reexamination Unit (CRU) review for filing date compliance and is based on the dates indicated on the Acknowledgement Receipt.

If the official version of any document received by the EFS-Web is lost, damaged or rendered unreadable by the USPTO and if it cannot be recovered from the stored files received by electronic submission, then the applicant/reexamination party will be promptly notified. In that situation, the applicant/reexamination party may have to resubmit the document(s) or portion of the document that are lost and petition for the original filing date. Such events are expected to be rare, indeed since inception of the EFS project no documents submitted using USPTO EFS software and received in EFS have been lost. In most cases a phone call to the Electronic Business Center (EBC) will resolve the issue. But if that is not sufficient, the applicant/reexamination party would present (1) the Acknowledgement Receipt (2) a copy of the missing files as submitted and (3) a signed petition and statement verifying that the attached files are the same as mentioned in the Acknowledgement Receipt for that application number. The Acknowledgement Receipt and statement will serve as prima facie evidence that the resubmitted documents are the same as those submitted on the date of receipt. Note the Acknowledgement Receipt only indicates that the USPTO received what was actually sent, as opposed to what may have been intended to be transmitted. Applicants/ reexamination parties should exercise the same care in preparing and preserving a copy of a submission in electronic form as in paper.

IX. Entry in the US national stage under 35 USC 371

It is recommended that applicants continue to use the Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Submission Under 35 USC 371 (Form PTO-1390) when electronically filing documents for entry into the US national stage under 35 USC 371. The PTO-1390 Form includes useful information that is not otherwise collected by EFS-Web at this time.

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 USC 371 and other applicable requirements. Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 USC 371 will be issued in addition to the Filing Receipt.

X. Security

The USPTO requires Public Key Infrastructure (PKI) certificates to meet federal government computer system authentication guidelines as defined by the National Institute of Standards and Technology (NIST) and the Office of Management and Budget (OMB). The required evaluation of EFS and PAIR determined that level 3 authentication was needed which is met by the USPTO's PKI.

Only PKI registered users (or persons under their direction and control) can submit follow on papers. This preserves confidentiality and is consistent with power of attorney and correspondence regulations. In order to obtain a PKI certificate the user already must be a registered attorney (or equivalent) or inventor and complete the appropriate paperwork to get credentials. Once the user has a PKI certificate, the user can authenticate himself/herself to the USPTO through the EFS-Web sign-on. This will generate a secure, encrypted, connection with the USPTO. While an inventor and his/her attorney may obtain a PKI certificate, only a single PKI certificate associated with a single customer number is allowed access to a particular application in Private PAIR.

For filers who do not have or do not wish to use a PKI certificate to authenticate to the USPTO, they may still submit new filings only via a non-authenticated workflow. The user would go to the EFS-Web page and choose to submit without a PKI certificate as an unregistered user, which would generate a Transit Layer Security (TLS) connection for the session, thus allowing secure data transmission to the USPTO. Non-authenticated users have the same level of protection for filing as a registered user, but are limited to submission of initial filings. This practice minimizes the risk of improperly filed third party petitions and other papers.

Note: Users are advised that the USPTO may revoke a user's digital PKI certificate if the user makes an improper submission through EFS-Web. See Section XXXI (Documents Policy) at the end of this Framework. See also paragraph 4 of the "United States Patent and Trademark Office Public Key Infrastructure Subscriber Agreement" located at [<http://www.uspto.gov/ebc/documents/subscribersagreement.pdf>].

XI. Policy of Annex F of the PCT Administrative Instructions

EFS-Web employs a Web based approach to document submission which is different from the Annex F "wrapped, bundled and signed package" approach. Thus EFS-Web does not meet Annex F requirements. See Annex F of the PCT Administrative Instructions located at [<http://www.wipo.int/pct/en/texts/>]. While EFS-Web is not required to meet Annex F requirements at this time, work will commence to expand Annex F as a world standard.

XII. What is the official record of documents submitted by EFS-Web?

The Official Record for application files and reexamination proceeding documents (e.g., reexamination requests) submitted via EFS comprises (1) ASCII text documents as well as color and grayscale drawings in PDF format as stored in the Supplemental Complex Repository for Examiners (SCORE) and (2) TIFF images of all other original documents as stored in the Image File Wrapper system as well as the Electronic Acknowledgement Receipt and the Electronic Patent Application Fee Transmittal both of which contain information entered via the EFS-Web graphical user interface (GUI). The original documents submitted via EFS, e.g., applications and, reexamination proceeding documents are stored exactly as filed, for reference, in an independent location.

XIII. May biotechnology sequence listings, large tables, or computer program listing appendices be submitted as text files via EFS-Web?

Yes, all of these types of documents may be submitted as text files for national applications (other than international applications filed under the Patent Cooperation Treaty (PCT) and reexamination proceeding documents. The CD practice of 37 CFR 1.52(e) and 37 CFR 1.821 remains as a filing option. The filing of international applications under the PCT via EFS-Web is discussed in Part XVIII below.

A filer may submit the following document types, as specified in 37 CFR 1.52(e), as text files via EFS-Web instead of on compact disc provided such files are in compliance with the American Standard Code of Information Interchange (ASCII):

A computer program listing (see 37 CFR 1.96);

A "Sequence Listing" (submitted under 37 CFR 1.821(c)); or

Any individual table (see 37 CFR 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, wherein a table page is a page printed on paper in conformance with 37 CFR 1.52(b) and 37 CFR 1.58(c).

The requirements of 37 CFR 1.52(e)(3)(ii), (4), and (6) are not applicable to computer program listings, sequence listings, and tables submitted as text files via EFS-Web. However, each text file must be in compliance with the American Standard Code for Information Interchange (ASCII). Further, the specification must contain an incorporation-by-reference of the material in the text file in a separate paragraph identifying the name of the text file, the date of creation, and the size of the text file in bytes as per 37 CFR 1.52(e)(5).

Pursuant to 37 CFR 1.821, a patent application which discloses nucleotide and/or amino acid sequences must contain both "a paper copy" of the sequence listing (37 CFR 1.821(c)) and a computer readable form (CRF) of the

sequence listing (37 CFR 1.821(e)). If a sequence listing text file submitted via EFS-Web complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b) (i.e., is a compliant sequence listing ASCII text file), the text file will serve as both the paper copy required by 37 CFR 1.821(c) and the CRF required by 37 CFR 1.821(e). Thus a statement under 37 CFR 1.821(f) (indicating that the paper copy and CRF copy of the sequence listing are identical) is unnecessary. Furthermore, the filer need not submit any additional copies of the sequence listing pursuant to 37 CFR 1.821(e). If a filer submits a compliant sequence listing ASCII text file via EFS-Web, the filer should not request the use of a compliant computer readable "Sequence Listing" that is already on file for another application pursuant to 37 CFR 1.821(e). If such a request is filed, the Office will not carry out the request but will use the sequence listing submitted with the application as originally filed via EFS. Checker software that may be used to check a sequence listing for compliance with the requirements of 37 CFR 1.824 is available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/checker/>.

If a filer submits a sequence listing (under 37 CFR 1.821(c) and (e)) as a text file via EFS-Web in response to a requirement under 37 CFR 1.821(g) or (h), the sequence listing text file must be accompanied by a statement that the submission does not include any new matter which goes beyond the disclosure of the application as filed. However, if the sequence listing text file complies with the requirements of 37 CFR 1.824(a)(2)-(6) and (b), the filer need not submit (i) any additional copies of the sequence listing pursuant to 37 CFR 1.821(e) nor (ii) the statement described in 37 CFR 1.821(f) and any request under 37 CFR 1.821(e) for the use of a compliant computer readable "Sequence Listing" that is already on file for another application is unnecessary and will not be carried out.

XIV. How are text files counted for application size fee purposes?

Any sequence listing submitted as a text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.821(c) or (e), and any computer program listing submitted as a text file via EFS-Web that is otherwise in compliance with 37 CFR 1.52(e) and 1.96, will be excluded when determining the application size fee required by 37 CFR 1.16(s) or 1.492(j) as per 37 CFR 1.52(f)(1).

Regarding a table submitted as a text file via EFS-Web that is part of the specification or drawings, each three kilobytes of content submitted will be counted as a sheet of paper for purposes of determining the application size fee required by 37 CFR 1.16(s) or 1.492(j). Each table should be submitted as a separate text file. Further, the file name for each table should indicate which table is contained therein.

XV. What is the size limit for text files?

100 megabytes is the size limit for sequence listing text files submitted via EFS-Web. If a filer wishes to submit an electronic copy of a sequence listing text file that exceeds 100 megabytes, it is recommended that the electronic copy be submitted on compact disc via Express Mail in accordance with 37 CFR 1.10 on the date of the corresponding EFS-Web filing in accordance with 37 CFR 1.52(e) if the filer wishes the electronic copy to be considered part of the application as filed. Alternatively, a filer may submit the application in paper and include the electronic copy of the sequence listing text file on compact disc in accordance with 37 CFR 1.52(e). Sequence listing text files may not be partitioned into multiple files for filing via EFS-Web as the EFS-Web electronic filing system is not currently capable of handling such submissions. If the sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the filer breaks up a sequence listing so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., "1 of X", "2 of X", etc.).

For all other file types, 25 megabytes is the size limit. If a filer wishes to submit an electronic copy of a computer program listing or table that is larger than 25 megabytes, it is recommended that the electronic copy be submitted on compact disc via Express Mail in accordance with 37 CFR 1.10 on the date of the corresponding EFS-Web filing in accordance with 37 CFR 1.52(e) if the filer wishes the electronic copy to be considered to be part of the application as filed. Alternatively the applicant/patent owner may submit the application in paper and include the electronic copies on compact disc in accordance with 37 CFR 1.52(e). Another alternative would be for the filer to break up a computer program listing or table file that is larger than 25 megabytes into multiple files that are no larger than 25 megabytes each and submit those smaller files via EFS-Web. If the filer chooses to break up a large computer program listing or table file so that it may be submitted electronically, the file names must indicate their order (e.g., "1 of X", "2 of X", etc.).

XVI. What is the limit on the number of electronic files submitted via EFS-Web?

60 electronic files is the file number limit, as EFS-Web is not currently capable of accepting more than 60 electronic files in any one submission. Accordingly, if an application file is comprised of more than 60 electronic files, it is recommended that the filer submit 60 or fewer files in an initial filing via EFS-Web at which time the application will be assigned an application number. Note that regarding the 60 electronic file limit, an applicant may upload and validate in sets up to 20 files each, with a limit of three sets of 20 files. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. Then the filer may submit any additional electronic files as follow-on documents later on the same day as the initial filing. This will allow all of the electronic files making up the application to receive the same filing date.

XVII. May international applications filed under the Patent Cooperation Treaty (PCT) with the US Receiving Office (RO/US) be electronically submitted via EFS-Web?

Yes, EFS-Web enables a user to electronically file international applications under the Patent Cooperation Treaty (PCT) with the United States Receiving Office (RO/US).

XVIII. May EFS-Web be used to file international applications containing nucleotide/amino acid sequence listings and/or tables related thereto in the United States Receiving Office?

Yes, applicants may file international applications under the PCT that contain nucleotide/amino acid sequence listings and/or tables related thereto with the United States Receiving Office (RO/US) via the EFS-Web filing system of the USPTO. However, computer program listings may not be included in international applications filed under the PCT.

Applicants are advised that EFS-Web may be used to file either: (1) international applications in fully electronic form or (2) follow-on papers to previously filed international applications. Applications containing large sequence listings and/or tables related thereto (i.e. 400 or more combined sequence listing and/or tables pages) may qualify for a reduced filing fee under Section 707(a-bis) of the PCT Administrative Instructions (AI) as discussed below.

Applicants should note that AI Part 8 does not apply to applications filed via EFS-Web, because AI Part 8 is reserved for applications filed partly on paper and partly on electronic media.

A. Sequence Listing:

Under PCT Rule 5.2(a), the sequence listing part must always be presented as a separate part of the description. The sequence listing part of the description should be submitted as a single ASCII text file with a ".txt" extension (e.g. "seqlist.txt"). Submission of the sequence listing part in PDF format is not recommended because applicant would still be required to supply a copy of the sequence listing in text format in accordance with AI Annex C, ¶39. If the sequence listing part is submitted as a text file, applicant need not submit any additional copies. The text file will serve both as the written portion of the sequence listing under PCT Rule 5.2 and the electronic form under PCT Rule 13ter.1 (a). Furthermore, the required statement in paragraph 40 of Annex C that "the information recorded in the electronic form is identical to the sequence listing in the application" is not required.

B. Tables Related to a Sequence Listing:

Tables related to a sequence listing may be either interspersed with the rest of the description or consolidated into a separate part of the description. Description pages, which contain interspersed tables, must be submitted in PDF format. Table pages which are consolidated into a separate part of the description may be submitted in either PDF or text format when using EFS-Web, although text format is preferred. For consolidated tables, each table must be contained in a separate file with the appropriate extension (i.e. ".txt" for text files and ".pdf" for PDF files). Furthermore, each table file must have a filename which indicates the name of the table contained therein (e.g. "table-1.txt", "table-2.txt", "table-3.txt" etc. or "table-1.pdf", "table-2.pdf", "table-3.pdf", etc.). Regardless of the file format used, the spatial relationships (e.g., columns and rows) of the table elements must be maintained.

C. File Size and Quantity Limits

100 megabytes is the size limit for sequence listing text files. For all other file types (including tables related to a sequence listing) EFS-Web is currently not capable of accepting files that are larger than 25 megabytes. Additionally, a single EFS-Web submission may include no more than 60 electronic files. Note that regarding the 60 electronic file limit, an applicant may upload and validate in sets up to 20 files each, with a limit of three sets of 20. If applicant chooses to divide a file into multiple parts using the multi-doc feature, each part is counted as one file. Unusually large or numerous sequence listings and/or tables may prevent applicant from making a complete international application filing in a single EFS-Web submission. In such instances, applicant may use EFS-Web to file part of the international application and to obtain the international application number and the confirmation number. The remainder of the international application must then be submitted on the same day as one or more follow-on submissions using EFS-Web, Express Mail from the United States Postal Service (USPS) in accordance with 37 CFR 1.10, or hand delivery, as appropriate, in order to secure the same filing date for all parts of the international application. However, sequence listing text files may not be partitioned into multiple files for filing via EFS-Web as the EFS-Web electronic filing system is not currently capable of handling such submissions. In addition, USPS Express Mail and hand carried submissions may not contain PDF files and must fully comply with the guidelines for filing a sequence listing and/or tables related thereto on electronic media as set forth in MPEP 1823.02, except that only one copy of the sequence listing and/or tables is required, and applicant need not make any reference to AI Part 8 or AI § 801. If a sequence listing is filed on a compact disc, the sequence listing must be a single document, but the document may be split using software designed to divide a file, that is too large to fit on a single compact disc, into multiple concatenated files. If the filer breaks up a sequence listing into multiple concatenated files so that it may be submitted on multiple compact discs, the compact discs must be labeled to indicate their order (e.g., "1 of X", "2 of X", etc.).

As an alternative to using USPS Express Mail or a hand carried submission to submit a table file related to a sequence listing that exceeds the EFS-Web 25 megabyte limit, applicant may partition the oversize table file into multiple files, each of which is smaller than 25 megabytes. If applicant chooses to partition an oversize table file, the filenames of the resulting segments must indicate their proper order (e.g. "table-35-part1of3.txt", "table-35-part2of3.txt", etc.).

D. Fee Determination for International Applications Containing a Sequence Listing

The calculation of the international filing fee shall take into account only the first 400 pages of the combination of any sequence listing and any tables related thereto which are individually consolidated in separate parts of the description. Tables that are not related to a sequence listing will not qualify for any potential fee reduction.

Pursuant to AI § 707(a), the international filing fee, subject to the 400 page limit described above, is calculated on the basis of the number of sheets that the application would contain if presented as a print-out complying with the physical requirements prescribed in PCT Rule 11. For text files, each three kilobytes of content as measured by USPTO computer systems shall be counted as one printed page for fee calculation purposes.

XIX. Follow-on Submissions for International Applications.

As noted above, a sequence listing part and/or tables related thereto may be submitted using one or more follow-on EFS-Web submissions. Such follow-on submissions will form part of the international application if filed on the same date on which the international application was filed. Note that follow-on submissions may change the number of pages in the international application and therefore may affect the international filing fee.

EFS-Web may also be used to submit a sequence listing in text format after the international filing date in response to a requirement under 37 CFR 1.821(h) and PCT Rule 13ter. Such sequence listing will not form part of the international application as set forth in PCT Rule 13ter.1(e).

XX. May a reissue application or a request for reexamination, and follow on papers be submitted

via EFS-Web?

Yes, EFS-Web permits a user to electronically submit a reissue application under 35 USC 251 and follow-on papers, a request for ex parte reexamination under 35 USC 302 and follow-on papers, or a request for inter partes reexamination under 35 USC 311 and follow-on papers. In reexamination, both the reexamination requester and the patent owner may file via EFS-Web.

XXI. May pre-grant publication requests be submitted via EFS-Web?

Yes, EFS-Web enables users to electronically submit pre-grant publication requests for amended publication, redacted publication, voluntary publication, or republication under 37 CFR §§ 1.215, 1.217, 1.219, and 1.221(a) via EFS-Web. When filing pre-grant publication requests via EFS-Web, the form fillable application data sheet (PTO/SB/14) is required to be used for fulfilling the bibliographic data requirements. An electronic submission for voluntary publication, amended publication, republication (37 CFR § 1.221(a)) or redacted publication must be submitted as a "Pre-Grant Publication" by selecting the "Pre-Grant Publication" radio button on the EFS-Web data collection screen. It is not sufficient for a filer to merely submit a document via EFS-Web requesting voluntary publication, amended publication, republication or redacted publication without also selecting the "Pre-Grant Publication" radio button on the EFS-Web data collection screen.

XXII. May color drawings for design applications be submitted via EFS-Web?

Yes, all design application drawings may be submitted via EFS-Web. However, the Office will treat color drawings in design applications as informal drawings unless accompanied by a grantable petition filed under 37 CFR § 1.84(a)(2) explaining why the color drawings are necessary.

The requirement for three (3) sets of color drawings under 37 CFR 1.84(a)(2)(ii) is not applicable to color design drawings submitted via EFS-Web. Only one set of such color design drawings is sufficient when filing via EFS-Web.

Drawings submitted via EFS-Web in application types other than design applications must be in bitonal black and white only.

XXIII. What is the date of receipt of an application received under the EFS-Web?

35 USC 111(a)(4) states in part (emphasis added):

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.

Thus, the filing date of an application is the date of receipt of the application in the USPTO. Further, the USPTO is located in the Eastern Standard Time zone. Accordingly, the date of filing of an application officially submitted through EFS-Web will be the date in the Eastern Standard Time zone at the time of submission. As such, the submission's "date of receipt", as shown on the Acknowledgement Receipt, is the Eastern Standard Time date that the documents are fully, successfully, and officially received at the USPTO as indicated by pressing the Submit Button on the Confirm and Submit screen. This date is controlling for filing date purposes of your newly filed application. There is no "certificate of transmission" practice for new application e-filings (37 CFR 1.8). This applies by analogy to reexamination proceedings.

To be very specific, the EFS-Web system records as the date of receipt of documents the local date in Eastern Standard Time on which it receives an electronic indication that the SUBMIT button has been clicked on the Confirm and Submit screen for those documents.

So, for example, if an applicant in California officially files a patent application with the USPTO through EFS-Web by clicking on the SUBMIT button at 10:00 PM Pacific Time in California on May 1, that application would be officially received by the USPTO at 1:00 AM Eastern Standard Time on May 2. Accordingly, the application would receive a filing date of May 2. However, the applicant could alternatively file the application using the "Express Mail Post Office to Addressee" service of the United States Postal Service in accordance with 37 CFR 1.10 in which

case the applicant would have until midnight on May 1 in his/her local time zone to file the application and obtain a filing date of May 1.

XXIV. What if the applicant electronically files an application via EFS-Web, and on that same day, realizes that they have inadvertently omitted a document from the application?

One advantage of filing an application via EFS-Web is that the applicant may view the submission in PAIR and file a paper directly into the application on the same day as the filing date of the application. In certain situations, applicant may correct an error by filing a missing item(s) on the same day as the filing date of the application. Applicant, however, may wish to file another new application in other certain situations. For example:

(1) **Oath or Declaration** - Applicant may file an executed oath or declaration on the same day as the filing date as the application via EFS-Web. The oath or declaration will not be considered late and thus a surcharge for filing a late oath or declaration will not be required.

(2) **Filing Fees** - Applicant may file the filing fees (e.g., the basic filing fee, search and examination fees, application size fee, or excess claims fee) on the same day as the filing date of the application via EFS-Web. The fees will not be considered late and thus a surcharge for filing the filing fees will not be required.

(3) **Non-publication request** - Since 37 CFR 1.213(a)(1) requires any non-publication request to be filed with the application, applicant cannot simply file the non-publication request to correct the error. If applicant does not wish to have the application publish, applicant must file: (a) a new application with a nonpublication request; and (b) file a petition for express abandonment to avoid publication under 37 CFR 1.138(c) and fee under 37 CFR 1.17(h) in sufficient time to permit the appropriate officials in Pre-Grant Publication Division to recognize the abandonment and remove the application from the publication process.

(4) **Drawings** - Applicant may file the missing drawings as a preliminary amendment on the same day as the filing date of the application. The drawings will be considered as part of the original disclosure of the application. See 37 CFR 1.115(a)(2). If the application, however, were filed with the "wrong drawings," the "wrong drawings" would still be part of the original disclosure. A preliminary amendment could be filed on the same day as the filing date of the application adding the correct drawings and deleting the "wrong drawings." An amendment adding new drawings and deleting the "wrong drawings," filed on a day after the filing date of the application, may raise new matter issues. Certainly, if applicant wishes to have an application without the "wrong drawings" being a part of the original disclosure, applicant should file a totally new application (e.g., new specification including claims(s) and fees) comprising the correct drawings, and, if desired, expressly abandon the original application.

(5) **Claims** - Applicant may file the claims as a preliminary amendment on the same day that applicant filed the application papers. Please note that the application will not be entitled to a filing date until applicant files at least one claim in the application.

(6) **Part of the specification** - Applicant may file the missing portion of the written description as a preliminary amendment on the filing date of the application. Such amendment will be considered as part of the original disclosure.

If applicant files another new application to correct the error, applicant will have two applications. Applicant may continue to prosecute the first application that has the error or abandon the first application by filing a declaration of express abandonment. Please note that any fees paid in the first application will not be refunded or applied to the second application. Applicant may request refund of the search fee and any excess claims fees (but not the basic filing fee, examination fee, and application size fee) paid in the first application if the application was filed under 35 USC 111(a) on or after December 8, 2004 and the applicant files a declaration of express abandonment in accordance with 37 CFR § 1.138(d).

XXV. What is the date of receipt of follow-on correspondence received by the USPTO through EFS-Web?

Patent application/reexamination proceeding correspondence filed after the initial application filing (i.e. follow-on correspondence) will receive as an official filing date the date the follow-on correspondence is received at the USPTO. However, follow-on correspondence that is required to be filed within a set time period will be considered timely if the correspondence is officially submitted through EFS-Web prior to the expiration of the set time period, and the correspondence includes a certificate for each piece of correspondence stating the local date of submission. See 37 CFR 1.8(a)(1)(i)(C).

XXVI. Hours of Operation

Hours of operation of the EFS-Web will be clearly provided in the EFS-Web instructions. If a transmission is attempted during a down time, the Office cannot accept it and will, if possible, transmit back a notice that the Office is not accepting submissions. No Acknowledgement Receipt will be sent. Instead a notice will advise the applicant/reexamination party to use alternative filing methods, such as hand delivery of paper to the USPTO or Express Mail (under 37 CFR 1.10), to establish the filing date. Note that most applications filed under 37 CFR 1.53, and reexamination requests, cannot be submitted by fax (37 CFR 1.6(d)(3) and (5)), and that normal certificate of mailing procedures do not apply to new applications and reexamination requests (37 CFR 1.8(a)(2)(i)(A) and (D)). Users are strongly advised to transmit their electronic filings sufficiently early in the day to allow time for alternative paper filing when transmission cannot be initiated or correctly completed.

If the submission is successfully received on a Saturday, Sunday or Federal holiday within the District of Columbia, the Office will assign that receipt date at the USPTO to the submission.

XXVII. Are there any legal consequences of the Office's accepting electronic patent applications on Saturday and Sunday?

The USPTO will be open for receiving applications in electronic form during scheduled hours every day of the week. Hours will be announced on the Patents Electronic Business Center Web Page, at the USPTO Web site: <http://www.uspto.gov/ebc>.

Electronic filing will provide applicants with the opportunity to receive a filing date on any day of the week, including Saturday, Sunday, and Federal holidays. In addition, 35 USC 21(b) states:

When the day, or the last day, for taking any action or paying any fee in the United States Patent and Trademark Office falls on Saturday, Sunday, or a Federal holiday within the District of Columbia, the action may be taken, or fee paid, on the next succeeding secular or business day.

Further, 35 USC 119((e)(3)) states:

If the day that is 12 months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day.

Thus, under United States law, applicants will be permitted to take action on the next business day when the last day for taking action falls on a weekend or Federal holiday, regardless of the mode or form of filing.

However, Article 4 of the Paris Convention addresses the priority period and in Article 4(c)(3) it states:

If the last day of the period is an official holiday, or a day when the Office is not open for the filing of applications in the country where protection is claimed, the period shall be extended until the first following working day.

Further, as stated above, the USPTO is capable of accepting electronic patent application filings every day of the week, including weekends and holidays, through EFS-Web. Thus, applicants are cautioned to consider possible adverse consequences regarding the determination in other countries of priority periods under Article 4(C)(3) of the Paris Convention when filing international applications with the United States Receiving Office (RO/US). Specifically, the ability to file applications electronically on weekends and holidays in the USPTO *may* result in loss of priority rights in foreign jurisdictions designated in international applications filed with the RO/US, if applicants

elect, in accordance with 35 USC 21(b) or 119(e)(3), to file an international application on the next succeeding business day in the event that the twelve month Paris Convention priority period set out in Article 4(C)(1) falls on a Saturday, Sunday, or Federal Holiday. In such circumstances, other Patent Offices *may* deny the priority claim on the basis that the international application was not timely filed if their national law strictly incorporates the provision of Paris Convention Article 4(c)(3) and considers the USPTO to be open for the filing of applications on weekends and holidays. For this reason, applicants may prefer not to rely upon the "next business day" provisions of sections 21(b) and 119(e)(3) of title 35 when filing applications with the USPTO, and instead file the application before the Paris Convention twelve-month priority period has expired.

XXVIII. Under what authority does an authorized assistant of the digital certificate holder submit signed documents?

Subscriber Agreements and Certificate Action Forms have been written to permit Assistants under the direction and control of the digital certificate holder (applicant/reexamination party or attorney) to submit documents under EFS-Web. The Assistant will use the Certificate Holder's certificate to make the submission.

The Assistant will serve the ministerial function of pickup and delivery of documents that have been electronically or ink signed by the applicant/reexamination party or the attorney. (Ink signed documents can be electronically scanned and then e-filed.) The Assistant, not being a registered attorney or the applicant/reexamination party, does not have the authority to sign or be responsible for the content of the documents submitted. However, they may view and retrieve documents from Private PAIR, or submit documents under EFS-Web under the direction of a registered practitioner.

In the submission process, the Assistant is required to specify certain "locator information" so the documents can be associated with the proper electronic File Wrapper in the IFW system. That locator information may include the application's title, first named inventor, docket number, application number, confirmation number, correspondence address and filing date, all if available. The type of application (e.g. 111(a), 371, international application, etc) and information necessary for the payment of fees are not considered to be locator information. This information is entered on submission to assure that the documents are placed in the proper file, and do not constitute a signed submission of bibliographic data on behalf of the applicant/reexamination party. Errors made in the "locator information" may be corrected by the Office on its own initiative, or by the applicant/reexamination party, similar to the way they are corrected in paper processing.

It also should be noted that the assistant could pay the fees associated with the submission in the EFS-Web solution. This is comparable to the paper practice in which law firms designate individuals to pay fees.

XXIX. Under what conditions will EFS-Web allow refunds?

The USPTO will grant refunds to e-filers when, due to a malfunction with the EFS-Web system, the EFS-Web system has misled a filer into paying a fee in error. If it cannot be determined that a malfunction occurred, but rather seems only to be an e-filer error, no refund will be given. The filer should contact the EBC if there are any issues associated with their submission.

XXX. Signature Policy

Signatures, other than handwritten signatures meeting the standard of 37 CFR 1.4(d)(1), included in image attachments submitted via EFS-Web are governed by the S-signature requirements of 37 CFR 1.4(d)(2) (See also 69 FR 56186, Sept. 21, 2004).

If the signer is submitting an application through EFS-Web in image-based PDF format, he or she should apply either a handwritten signature in compliance with 37 CFR 1.4(d)(1) or an S-signature in compliance with 37 CFR 1.4(d)(2) before scanning the document or converting it to image-based PDF form. It is noted that when filing a new application by EFS-Web, a signed transmittal form or a signed application data sheet (ADS) is recommended for identification purposes. It should be noted, however, that a signature is not required to obtain a filing date for a new patent application.

A legible electronic image of a handwritten signature inserted, or copied and pasted by the person signing the correspondence into an application document may be considered to be an acceptable signature. The legible image

of the handwritten signature of the person signing the correspondence must be inserted by the person. Additionally, the signature must be surrounded by a first single forward slash mark before the electronic image and a second single forward slash mark after the electronic image. That is, the legible electronic image of a handwritten signature must be enclosed between two single forward slashes and the signer's name is indicated below or adjacent the signature as per 37 CFR 1.4(d)(2). The slashes may be inserted into the document prior to the insertion of the signature.

The presentation to the USPTO (whether by signing, filing, submitting, or later advocating) of any document constitutes a certification under 37 CFR 10.18(b)(2). See 37 CFR 1.4(d)(4).

XXXI. Documents Policy

EFS-Web will allow registered users to file both new submissions and follow-on documents. **The following is a list of submission types that are not allowed to be filed using EFS-Web:**

1. Correspondence concerning **Registration Practice** submitted under 37 CFR 1.4(e), which states:

Correspondence requiring a person's signature and relating to registration practice before the Patent and Trademark Office in patent cases, enrollment and disciplinary investigations, or disciplinary proceedings must be submitted with an original hand written signature personally signed in permanent dark ink or its equivalent by that person. See 37 CFR 1.6(d)(1)

2. **Certified Copies** submitted under 37 CFR 1.4(f), which states:

When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable. See 37 CFR 1.6(d)(2). An example of such a submission is a certified copy of a foreign patent application filed pursuant to 35 USC 119 or a certified copy of an international application filed pursuant to 35 USC 365.

3. Correspondence to be filed in a patent application subject to a **secrecy order** under §§ 5.1 through 5.5 of this chapter. See 37 CFR 1.6(d)(6).
 4. Submissions in contested cases before the **Board of Patent Appeals and Interferences**, except as the Board may expressly authorize. See 37 CFR 1.6(d)(9).
 5. Papers filed in contested cases before the **Board of Patent Appeals and Interferences**, which are governed by 37 CFR 41.106(f). See 37 CFR 1.6(d)(3).
 6. Correspondence filed in connection with a **disciplinary proceeding** under 37 CFR part 10. See 37 CFR 1.6(d)(3).
 7. Submissions that are **not associated with an application/reexamination proceeding**.
 8. **Third party papers** under 37 CFR 1.99.
 9. **Protests** under 37 CFR 1.291.
 10. **Public use hearing papers** under 37 CFR 1.292.
 11. **Maintenance fees** submitted under 37 CFR 1.366. See MPEP 2510 for information regarding the proper methods for submitting maintenance fees.
 12. Assignment documents under 35 USC 261, which may be electronically filed using the Electronic Patent Assignment System (EPAS) or the Electronic Trademark Assignment System (ETAS). Information regarding EPAS is available at: <http://epas.uspto.gov>. Information regarding ETAS is available at: <http://etas.uspto.gov>.
 13. Submissions under 35 USC 161 associated with **plant applications**
 14. Initial submissions for Patent Term Extension under 35 USC 156.
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For more information on these policies, please contact Diana Oleksa, Legal Advisor – IT Projects, PCT Legal Administration, at Diana.Oleksa@uspto.gov .

John J. Love
Deputy Commissioner for Patent Examination Policy

September 2008

KEY: =online business system =fees =forms =help =laws/regulations =definition (glossary)

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Last Modified: 09/24/2008 13:34:54