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OFFICE OF PETITIONS

In re Application of :
Leslie William BOLTON, et al. :
Application No. 10/480,346 :
Filed: June 4, 2004 :
Attorney Docket No.: 8540G-203/USB :

ON PETITION

This is a decision on the petition filed October 19, 2009, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decisions of the Director, Technology Center 1700 (Technology Center Director), dated March 6, 2009 and September 21, 2009, which refused to withdraw the finality of the August 11, 2008 Office action and compel the entry of the amendment after final filed October 13, 2008, withdraw the Request for Continued Examination (RCE), and refund \$940 in fees required under 37 CFR 1.17(e) and 37 CFR 1.136(a).

The petition to overturn the decisions of the Technology Center Director dated March 6, 2009 and September 21, 2009 is **DENIED**¹.

BACKGROUND

On March 26, 2008, a non-final Office action was mailed.

On May 23, 2008, a response was filed.

On August 11, 2008, a final Office action was mailed.

On October 13, 2008, an amendment under 37 CFR 1.116 was filed requesting withdrawal of the finality of the August 11, 2008 Office action.

On October 20, 2008, an Advisory Action was mailed.

¹ This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02

On November 19, 2008, a Request for Continued Examination and a petition under 37 CFR 1.181 requesting withdrawal of the finality of the August 11, 2008 Office action were filed.

On December 3, 2008, a Notice of Allowability and a Notice of Allowance and Issue Fee(s) Due were mailed.

On January 6, 2009, the application was withdrawn from issue.

On February 18, 2009, a non-final Office action was mailed.

On March 6, 2009, a decision dismissing the petition filed November 19, 2008 as moot was mailed.

On April 27, 2009, a petition requesting reconsideration of the petition decision of March 6, 2009 was filed.

On September 21, 2009, a decision dismissing the petition filed April, 27, 2009 was mailed.

On October 19, 2009, the instant petition was filed.

STATUTE, REGULATION, AND EXAMING PROCEDURE

35 U.S.C. 42(d) provides:

The director may refund any fee paid by mistake or any amount paid in excess of that required.

35 U.S.C. 132(b) provides:

The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

37 CFR 1.26(a) provides, in part, that:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such

fee. The Office will not refund amounts of twenty-five dollar or less unless a refund is specifically requested, and will not notify the payor of such amounts.

37 CFR 1.113(a) provides:

On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

37 CFR 1.114(d) provides:

If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.

37 CFR 1.181 provides, in pertinent part, that:

(a)Petition may be taken to the Director:

(1)From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2)In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3)To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

(c)When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written

statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP 706.07(c) provides:

Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

MPEP 706.07(h) provides, in pertinent part, that:

35 U.S.C. 132(b) provides for continued examination of an application at the request of the applicant (request for continued examination or RCE) upon payment of a fee, without requiring the applicant to file a continuing application under 37 CFR 1.53(b). To implement the RCE practice, 37 CFR 1.114 provides a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (e.g., the application is under final rejection or a notice of allowance) by filing a submission and paying a specified fee. Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions).

MPEP 714.13 provides, in pertinent part, that:

A reply under 37 CFR 1.113 is limited to:

- (A) an amendment complying with 37 CFR 1.116;
- (B) a Notice of Appeal (and appeal fee); or
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

OPINION

Petitioner seeks reversal of the Technology Center Director decisions of March 6, 2009 and September 21, 2009, on the grounds that the filing of an RCE does not make the petition filed under 37 CFR 1.181, requesting withdrawal of the finality of the August 11, 2008 Office action, moot. Accordingly, petitioner requests a decision on the petition under 37 CFR 1.181 filed November 19, 2008, the amendment after final filed October 13, 2008 be entered, the RCE be withdrawn, and the RCE and extension of time fees be refunded.

Petitioner specifically argues² that after a final rejection, only two actions may be taken by an applicant to prevent an application from becoming abandoned: filing an RCE or filing an appeal as filing a petition does not stay any period set for reply. 37 CFR 1.181(f). Therefore, petitioner states the filing of an RCE was required to prevent the application from becoming abandoned and the timely filed petition under 37 CFR 1.181 to review the examiner's refusal to withdraw the finality should be treated as the rules require petitioner to take action without waiting for a decision on petition. Moreover, petitioner contends the application would have become abandoned prior to a decision on the petition under 37 CFR 1.181, filed November 19, 2008, had the RCE not been filed as the petition decision was not rendered prior to February 11, 2009.

As set forth in MPEP 714.13, *supra*, an RCE is but one of the responses petitioner may have filed in order to prevent abandonment of the instant application. For instance, petitioner may have filed a Notice of Appeal instead of an RCE in order to prevent abandonment of the application. This would have resulted in petitioner having a period of up to seven (7) months or until July 19, 2009 (assuming petitioner filed a Notice of Appeal on November 19, 2008 instead of the RCE) for petitioner to file an Appeal Brief. In any event, petitioner chose to file an RCE. As set forth in 37 CFR 1.114, *supra*, if an applicant timely files a submission and fee set forth in § 1.17(e), the Office **will withdraw the finality** of any Office action and the submission **will** be entered and considered. As the filing of the RCE withdrew the finality of the Office action and entered the amendment submitted under 37 CFR 1.116 the petition under 37 CFR 1.181 was properly considered as moot. (Emphasis added.)

Although petitioner further contends that the issue is not moot because petitioner incurred additional fees as a result of the filing of the RCE on November 19, 2008, the filing of the RCE was petitioner's decision. Petitioner knew that the filing of a reply to avoid abandonment of the application was not required until February 11, 2009. The fact that the Technology Center did not render a decision on the petition filed November 19, 2008 until after February 11, 2009 is immaterial as the filing of the RCE removed any urgency in replying to the petition. Moreover, the applicable statute, 35 U.S.C.

² See petition filed April 27, 2009

42(d), authorizes the Director to refund "any fee paid by mistake or any amount paid in excess of that required." Thus, the U.S. Patent and Trademark Office (USPTO) may refund: (1) a fee paid when no fee is required (*i.e.*, a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r pats. 1943)(the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment, and not the underlying action).

In the situation, as herein, in which an applicant takes an action "by mistake" (*e.g.*, files an RCE "by mistake"), the submission of fees required to take that action (*e.g.*, an RCE fee submitted with an RCE) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). See Changes to Implement the Patent Business Goals, Notice of Proposed Rulemaking, 64 FR 53771, 53780 (October 4, 1999), 1228 Off. Gaz. Pat. Office, 15, 23 (November 2, 1999).

Furthermore, even if petitioner erred in presenting an RCE under 37 CFR 1.114 to the USPTO for this application, that does not warrant a finding that the payment was made "by mistake." Rather, the fee was owed at the time it was paid. As noted in 37 CFR 1.26(a), petitioner's change of purpose does not constitute a "mistake" in payment warranting refund of the fees previously paid. The payment of the fee automatically was due, by statute, when petitioner presented, rightly, or mistakenly, the RCE under 37 CFR 1.114. Thus, it is immaterial to the question of "mistake" in payment of the instant RCE fee, that petitioner may have erred in submitting the aforementioned submission. Here, it is noted, that petitioner requested an RCE under 37 CFR 1.114.

Additionally, petitioner submits that the petitions of November 19, 2008 and March 22, 2010 were timely filed. As the initial petition was filed within two months of the mailing of the Advisory Action on October 20, 2008 wherein the examiner refused petitioners request, filed October 13, 2008 (October 11, 2008 being a Saturday), to withdraw the finality of the Office action mailed August 11, 2008, and as the second petition was filed within two months of the first petition decision, the petitions were timely filed.

DECISION

A review of the record indicates that the Technology Center Directors did not abuse their discretion or act in an arbitrary and capricious manner in their refusal to treat the petitions on their merits, in view of the filing of an RCE, in the petition decisions of March 6, 2009 and September 21, 2009. The record establishes that the Technology Center Directors had a reasonable basis to support their findings and conclusion.

The petition is granted to the extent that the decisions of the Technology Center Director of March 6, 2009 and September 21, 2009 have been reviewed; however, the decisions of March 6, 2009 and September 21, 2009 will not be disturbed because, while the filing of the petitions is timely, the refusal to further treat the petitions of

November 19, 2008 and April 27, 2009, on their merits in view of the filing of the RCE is proper. The petition is denied.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy