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MAILED
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OFFICE OF PETITIONS

In re Application of :
Roy SIMRELL : ON PETITION
Application No. 11/153,377 :
Filed: June 16, 2005 :
Attorney Docket No. PIP171SIMRU-US :

This is a decision on the renewed petition under 37 CFR § 1.181, filed April 22, 2010, requesting supervisory review of the decision dated April 20, 2010 by the Group Director of Technology Center 3600 (Group Director), and inter alia, expungement of the Notice of Noncompliant Amendment mailed November 3, 2008.

The petition to set aside the Group Director’s decision dated April 22, 2010, or to instruct the Technology Center personal take other specific action with respect to this application, is **DENIED**.

BACKGROUND

On June 16, 2005, applicant filed an application having 33 claims. Claims 1-6 properly had no status identifier; claims 7-33 were listed as “Original”.

In response to an Office action, on July 17, 2008, applicant listed claims 1, 3, 4, 6, 7-11, 24, 26, 30, 31, and 33 as “Currently Amended”. Claims 2, 5, 12-19, 21-23, 25, 27-29, 31 and 32 were listed as “Previously Presented”. Claims 20 and 32 were listed as “Cancelled”.

On November 3, 2008, a Notice of Non-Compliant Amendment was mailed.

On November 25, 2008, applicant filed a response.

On December 19, 2008, applicant filed a petition under 37 CFR § 1.181.

On April 29, 2009, a decision by the Technology Center Director denying the petition of December 19, 2008 was mailed.

On June 4, 2009, a petition under 37 CFR § 1.181, requesting review of the Technology Center Director's decision of April 29, 2009 was filed.

On April 7, 2010, a decision dismissing the petition filed June 4, 2009, as moot was mailed.

On April 16, 2010, a petition under 37 CFR § 1.181, requesting reconsideration of the decision on April 7, 2010 was filed.

On April 20, 2010, a corrected decision dismissing the petitions filed April 7, 2010 and April 16, 2010 was mailed.

On April 22, 2010, a petition under 37 CFR § 1.181, requesting review of the petition decision of April 20, 2010 was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. § 2(B)(2) provides in part that:

The Office... may establish regulations, not inconsistent with law, which —
(A) shall govern the conduct of proceedings in the Office.

37 CFR § 1.59(b) provides that:

§ 1.59 Expungement of information or copy of papers in application file.

- (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
- (2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
- (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR § 1.121(c) provides that:

Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

In addition, the status of each claim included in the claim listing must be described by one of the following seven defined identifiers in parentheses after the claim number:

(Original): Claim filed with the application.

(Currently amended): Claim being amended in the current amendment document.

(Canceled): Claim deleted from the application.

(Withdrawn): Claim still in the application, but in a non-elected status.

(Previously presented): Claim added or amended in an earlier amendment document.

(New): Claim being added in the current amendment document.

(Not entered): Claim presented in a previous amendment document but which has either not been entered or the status of entry is unknown to applicant when a subsequent amendment to the claims is filed. (Underlining added).

See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. 38,611, 38,616 (June 30, 2003).

The status identifier “previously presented” must be used in those circumstances where: (1) A claim has been previously presented as “new” in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as “currently amended” in a prior amendment document.

OPINION

A review of the record indicates that on July 17, 2008, the applicant filed an amendment that listed the claim status identifier “(Previously Presented)” to refer to the status of claims that were present at the time of filing the instant application. Applicant’s originally filed claims presented 33 claims. Claims 7-33 contained the status identifier “Original”.

On November 3, 2008, the United States Patent and Trademark Office (USPTO) mailed a Notice of Non-Compliant Amendment requiring that claims presented in an amendment

that contained unamended claims, which were present at the time of filing, have the status identifier “(Original)”. In response, petitioner filed an amendment on November 25, 2008, correcting the status identifiers “(Previously Presented)” to “(Original)”. On December 19, 2008, applicant submitted a petition to accept, enter, and act on the amendment as meeting the requirements of 37 CFR § 1.121 and 37 CFR § 1.4. Additionally petitioner requested expungement of the requirement to submit a revised amendment and a recording to the file that the application would not lose patent term based upon 37 CFR § 1.704(c)(7). On March 9, 2009, the examiner, being satisfied that the claims were now in proper form, issued an office action on the amended claims. A petition filed December 19, 2008, was denied by the Technology Center Director. Applicant on June 4, 2009, requested review under 37 CFR § 1.181. On April 7, 2010, a decision dismissing the petition as moot was mailed. Applicant responded with a request for reconsideration on April 16, 2010. The request for reconsideration was granted on April 20, 2010, to the extent that a review was made of the petitions of April 7, 2010 and April 20, 2010. The petitions were dismissed. On April 22, 2010, a third petition under 37 CFR § 1.181 requesting supervisory review was filed.

A review of the Notice of Non-Compliant Letter dated November 25, 2008 correctly indicates that the amendment filed July 17, 2008 contained original claims that were identified as “Previously Presented”. In an amendment, original claims must be identified by the status identifiers “Original Claim” or “Originally filed Claim”. See Changes to Implement Electronic Maintenance of Official Patent Application Records, 68 Fed. Reg. at 38,616. With respect to the status identifier “previously presented”:

The status identifier “previously presented” must be used where; (1) A claim has been previously presented as “new” in a prior amendment document and entry of the claim is certain; and (2) a claim has been previously presented as “currently amended” in a prior amendment document.

See id. at 38,617

Furthermore, the status identifier “Previously presented” is to indicate “claims added” or “amended”. See id. at 38,616. By definition, a claim that is originally filed is neither a “claim added” or “amended” and thus the status identifier “Previously presented” is inappropriate for use with original claims.

Here applicant chose to file original claims 8-33 with the status identifier “Original”. However claims 1-6 were also original claims. Since claims 12-19, 21-23, 25, 27-29, 31 and 33 have not been amended, they should retain their initial status as “Original”. Claims not present at the time of filing or that are present as a preliminary amendment after filing of the application, and/or subsequently presented, merit the status “Previously presented” or as acceptable alternatives “Previously amended”, “Previously added”, “Previously submitted” or “Previously presented claim”. To permit the applicant to have claims that have not been amended to go from “Original” to “Previously presented” would not be accurate, and clear as to identification of the originally filed claims. The use of appropriate

identifiers in the image file environment are designed to inform any user (examiner, technical support staff, applicant, practitioners, etc.) of the current status of each and every claim in the application. Labeling a claim as “original” serves the desired purpose by providing a focus on what unamended claim was filed with the application. Labeling a claim as “previously presented” serves the desired purpose by providing a focus on what claim was presented in a previous amendment and has not now been amended in the current amendment.

35 U.S.C. § 2(b)(2) authorizes the USPTO to prescribe regulations for the conduct of proceedings in the USPTO, and does not provide that applicants may determine what procedures are best suited to their needs and then insist that the USPTO follow those procedures during the examination of their applications. There are a large number of applications pending before the USPTO: more than 500,000 applications were filed in fiscal year 2010, and more than 1,150,000 applications are pending before the USPTO. See United States Patent and Trademark Office Performance and Accountability Report Fiscal Year 2010 at 126-27 (2010). The USPTO needs applicants to submit their applications and amendments to their applications in accordance with the prescribed regulations to be able to process applications in an orderly manner. An applicant’s failure to submit his or her application and amendments to the applications in accordance with the prescribed regulations will hinder the USPTO’s ability to process and examine the application. Here the status identifiers of originally filed claims presented in the amendment filed July 17, 2008 were not accurate and clear. Therefore the Notice of Non-Compliant Amendment was proper.

Applicant has requested the Office to expunge the requirement to submit a revised amendment so that it is clear on the record that the requirement was improper, and so that the requirement cannot detrimentally affect patent term adjustment. As the Notice of Non-Compliant Amendment mailed November 3, 2008 was not mailed in error, there is no basis for its expungement. As discussed previously, an applicant’s failure to submit his or her application and amendments to the applications in accordance with the prescribed regulations will hinder the USPTO’s ability to process and examine the application. Thus, there is no basis for relieving petitioners from any patent term adjustment flowing from their failure to submit an amendment in compliance with the regulations. Cf. 35 U.S.C. § 154(b)(2)(c)(i) (patent term adjustment “shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution of the application”).

DECISION

The record shows no error on the part of the Technology Center Director. The Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in regard to refusing to accept the status identifiers and expunge information from the application file. For the reasons set forth above, the Technology Center Director's decision to refuse to expunge information from the application file is not shown to be in error. The petition is granted to the extent that the decision of the Technology Center Director, dated April 29, 2009, has been reviewed, but is **denied** as to the request that the aforementioned decision be overturned.

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

This application is being referred to Technology Center Art Unit 3629 for appropriate action in the normal course of business.

Telephone inquiries concerning this decision should be directed to Thurman K. Page at 571-272-0602.



Robert W. Bahr
Acting Associate Commissioner
For Patent Examination Policy