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OFFICE OF PETITIONS

In re Application of :
Deborah Semple, et al. :
Application No.: 09/604,602 : DECISION ON PETITION
Filed: June 27, 2000 :
Attorney Docket No. 387798 :

This is a decision on the petition, filed September 20, 2010, entitled "PETITION TO REVIEW A DECISION OF A TECHNOLOGY CENTER DIRECTOR" that is being treated under 37 CFR 1.181(a)(3) requesting the Director to exercise his supervisory authority and overturn the decision of July 21, 2010, of the Director of Technology Center 3600 (TC Director), which refused to withdraw the finality of the Office action mailed March 12, 2010. This is also a decision on the "Petition to Strike Information from the Record" that seeks to have removed from the file record examiner's comment(s) pertaining to a reference cited in the final Office action of March 12, 2010.

The petition to overturn the TC Director's decision of July 21, 2010 is **DENIED**.

The petition to "Strike Information from the Record" is **DENIED**.

BACKGROUND

1. The instant application was filed on June 27, 2000, as a continuation of U.S. patent application 08/931,626. The prosecution history of the application includes a number of Office actions and responses thereto from the applicant.
2. A non-final Office action was mailed on August 21, 2009.
3. On December 21, 2009, a response was filed that included: an amendment, remarks and a request for reconsideration, as well as a declaration pursuant to 37 CFR 1.132 by Patrick Green ("Green Declaration").

4. On March 12, 2010, a final Office Action was mailed, indicating: (a) that arguments included in the remarks were unpersuasive, and (b) that the Green Declaration was not effective to overcome the rejection(s) cited in the non-final Office action.
5. A petition and reply to the Final Office action¹ were filed on May 11, 2010, with the petition requesting a withdrawal of "Premature Final Rejection" and to "Strike Information from the Record".
6. In response to the After-Final reply, an Advisory action was mailed on June 10, 2010.
7. The TC Director issued a decision on July 21, 2010, dismissing the request for a withdrawal of the "premature" final Office action concluding that the examiner properly made final the Office action of March 12, 2010.
8. The instant petition was filed September 20, 2010, requesting the TC Director's decision to be reviewed and reversed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. §132 Notice of rejection; reexamination.

- (a) *Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.*

37 CFR § 1.4 Nature of correspondence and signature requirements.

- (c) *Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.*

¹ A submission supplementing the petition filed May 11, 2010, was filed on July 12, 2010, along with a Notice of Appeal and a "Pre-Appeal Brief Request".

37 CFR §1.59 Expungement of information or copy of papers in 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 §1.113 Final rejection or action

- (a) *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.*
- (b) *In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.*
- (c) *Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.*

37 CFR §1.181 Petition to the Director

- (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.*

MPEP 706.07(a) [R-6] Final Rejection, When Proper on Second Action

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 2144.03 [R-6] Reliance on Common Knowledge in the Art or "Well Known" Prior ArtD. Determine Whether the Next Office Action Should Be Made Final

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final. See MPEP § 706.07(a).

OPINION

Petitioners specifically request that the Director overturn the TC Director's decision of July 21, 2010 and, "either: (1) withdraw the final rejection dated 3/12/2010 because it is premature; or (2) strike the Examiner's Journal comments from the record (i.e., the final Office Action) because their presence is legally improper."

PETITION FOR WITHDRAWAL OF PREMATURE FINAL REJECTION

In the final Office action dated March 12, 2010, examiner made a reference to "The Journal of Economic Perspectives, vol. 8, no. 3, 1994, pp. 75-96" ("Journal") in the section entitled "Response to Arguments". In arguing that the final Office action "newly relied on the Journal to augment the rejections," petitioners cite the following passage from final Office action at page 6, lines 3-6 that states that: "In view of the foregoing, when all of the evidence [which includes the Journal] is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence [which includes the Journal] of obviousness" Further summarizing the arguments, petitioners note that: "(1) at least one rejection relies on a new reference, which constitutes a new ground of rejection; (2) the new ground of rejection was not necessitated by amendment of the

claims; and (3) the new ground of rejection was not necessitated by an information disclosure statement (IDS). Thus, since the rejection is at least in part based on the newly cited Journal, the final rejection dated 3/12/2010 constitutes a premature final rejection.”

The reference to the Journal was only made in the section of the final Office action entitled “Response to Arguments,” and even then was limited to providing additional support for examiner’s response to the Green Declaration. As noted in the final Office action, “although the Declaration asserts that TCP/IP is not limited to Internet usage, the Journal illustrates that TCP/IP was developed for “Internet usage”(emphasis added).” The examiner maintained the same statutory basis of rejection and relied upon the same references in both the final Office action of March 12, 2010 and the preceding non-final Office action of August 21, 2009. As the thrust of the rejection set forth in the Office action remained the same, there was no new ground of rejection. See In re Kronig, 539 F.2d 1300, 190 USPQ 425, 427 (CCPA):

Having compared the rationale of the rejection advanced by the examiner and the board on the record, we are convinced that the basic thrust of the rejection at examiner and board level was the same.

Petitioners have not demonstrated that the basic thrust of the rejection has been changed by the examiner in the final Office action. See also In re Echerd, 176 USPQ 321 (CCPA 1973).

Contrary to the petitioners' contention that there is a new ground of rejection in the final Office action here, there are situations where even a new position or rationale does not constitute a new ground of rejection. Particularly, changing a § 103 rejection based on reference A in view of reference B to a § 103 rejection based on reference B in view of reference A (which involves changing the rationale for combining the references) does not constitute a new ground of rejection. See e.g., In re Cowles, 156 F.2d 551 (CCPA 1946) and In re Cook, 372 F.2d 563 (CCPA 1966), In re Bush, 296 F.2d 491 (CCPA 1961). Changing a § 103 rejection to a § 102 rejection based on the same reference is not a new ground of rejection. See In re May, 574 F.2d 1082 (CCPA 1978). Also, the usage of a new dictionary definition to “fill in the gaps” in the evidentiary showing made by the examiner to support a rejection is not a new ground of rejection. See In re Boon, 439 F.2d 724, 727-728 (CCPA 1971), citing In re Ahlert, 424 F.2d 1088, 1092 (CCPA 1970)(It is found necessary to take notice of facts which may be used to supplement or clarify the teaching of a reference disclosure, perhaps to justify or explain a particular inference to be drawn from the reference teaching.). Furthermore, the new calculations presented by the Office to rebut the appellants' argument of non-obviousness do not necessarily constitute a new ground of rejection when the statutory basis for the rejection remained the same. See In re Plockinger, 481 F.2d 1327, 1331-32 (CCPA 1973). In the instant case, while a reference to the Journal was included as part of the rebuttal to the Green Declaration in the final Office action, there was no change in the basis for the rejection of claims in the final Office action. Here, the examiner cited the Journal to merely clarify a term used in one of the references. Specifically, petitioners submitted the Green Declaration contending that “use of TCP/IP protocol is not limited to Internet usage,” and thus can hardly claim surprise (“no fair opportunity

to rebut”) when confronted by evidence illustrating that “TCP/IP was developed for internet usage.”

In determining whether a second or subsequent Office action may be made final, if the statutory basis for the rejection remains the same, and the reference(s) relied upon in support of the rejection remains the same, the rejection is not considered to include a new ground of rejection in the final Office action unless the examiner's reasoning in support of the rejection in the latter Office action changes the basic thrust of the rejection relative to the rejection as set forth in the previous Office action. In the instant application, the examiner maintained the same statutory basis of rejection and relied upon the same references in both the final Office action of March 12, 2010 and the preceding non-final Office action of August 21, 2009. Moreover, the nonfinal and final Office actions are virtually word for word identical in the rejections set forth by the examiner, save for some typographical corrections. The reference to the Journal in the final Office action was in response to the Green Declaration, and it did not change the basic thrust of the rejections. Accordingly, the final Office action did not introduce any new grounds of rejection within the meaning of MPEP § 706.07(a). The finality of the final Office action is proper and therefore not withdrawn.

Petitioners' argument concerning the reliance on MPEP § 2144.03 in the TC Director's decision has been noted. While the reference to MPEP § 2144.03 in the TC Director's decision was misplaced, such reference was merely gratuitous since it was not the basis for the TC Director's decision. Accordingly, the TC Director did not err in refusing to withdraw the finality of the Office action of March 12, 2010.

PETITION TO STRIKE INFORMATION FROM THE RECORD

Petitioners remark that “[t]he [TC] Director failed to act on Applicants' "Petition to Strike Information from the Record" (filed 5/11/2010).” The request to “Strike Information from the Record” pertains to relief that is distinct from that requested in seeking withdrawal of finality. However, this request was not submitted as a separate paper. 37 CFR 1.4(c) requires that each distinct subject must be contained in a separate paper since different matters may be considered by different branches of the United States Patent and Trademark Office. In this instance, the request to “Strike Information from the Record” was a petition to expunge that is treated under the provisions of 37 CFR 1.59 and was for consideration by the Office of Petitions. Accordingly, the TC Director's decision did not consider the petitioners' request to “Strike Information from the Record.”

A petition under 37 CFR 1.59 requires fee of \$200, as specified in 37 CFR 1.17(g) and has been charged to Deposit Account 09-0428, as authorized.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, as set forth in 37 CFR 1.59(b), petitioner “must ...establish to the satisfaction of the Director that the expungement of the information is appropriate...” While petitioner may disagree with some of

the contents of the contested Office communication, the USPTO has also long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication from the file record. See for e.g., Ex Parte Fox, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910). The mere disagreement of an applicant with examiner's comments on a reference cited in the Office action is not an adequate reason for deleting such comments from the administrative record, which the USPTO has long striven to maintain as complete and accurate as possible. Under the circumstances of this case, petitioners have not met their burden of proof under the terms of the rule in establishing to the satisfaction of the Director that expungement of information is appropriate.

Accordingly, the petition to "Strike Information from the Record" is **DENIED**.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of July 21, 2010. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion. The Technology Center Director's decision to refuse petitioners' request to withdraw the finality of Office action of March 12, 2010 is not shown to be in clear error.

The petition is granted to the extent that the decision of the Technology Center Director of July 21, 2010, has been reviewed, but is denied with respect to withdrawing the finality of Office action of March 12, 2010. The instant petition to withdraw the finality of Office action of March 12, 2010 is **DENIED**. The Director will undertake no further reconsideration or review of this matter.

This application is being referred to Technology Center 3600 for consideration of the Appeal Brief filed October 12, 2010.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272- 4914.



Robert Bahr
Associate Commissioner for
Patent Examination Policy, Acting
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