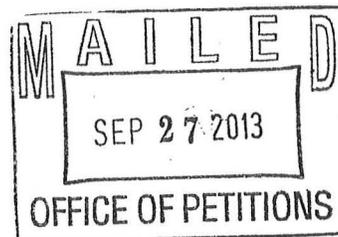




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In re Application of :
YU et al. :
Application No. 11/655,766 :
Filed: January 19, 2007 :
Attorney Docket No. 4010.3011 US1 :

DECISION ON PETITION TO
REVERSE THE EXAMINER
UNDER 37 C.F.R. § 1.181

This is decision on the petition to the Office of the Deputy Commissioner for Patent Examination Policy filed October 4, 2011, requesting review of the petition decision from the Director of Technology Center 1700 (Technology Center Director) dated August 4, 2011 that refused entry of the Amendment After Final Rejection dated December 14, 2010.

The petition is **DENIED**.

BACKGROUND

A preliminary amendment was filed October 31, 2007. Original claims 17, 19 and 20 were cancelled. Claims 1-16 and 18 were pending.

A non-final Office action was mailed January 25, 2010. Claims 1-16 and 18 were rejected under both 35 USC 112, second paragraph and under 35 USC 103.

A response to the non-final Office action was filed on July 23, 2010 in which claims 1, 2, 7, 11, 14, 16 and 18 were amended. Applicant also presented arguments traversing the rejections and requested reconsideration.

A Final Office action was mailed August 17, 2010 again rejecting claims 1-16 and 18 under both 35 USC 112, second paragraph and under 35 USC 103. After addressing applicant's arguments, the Final Office action stated that applicant's amendment necessitated the new grounds of rejection and that the action was made final.

A Notice of Appeal and an amendment under 37 C.F.R. § 1.116 (rule 116 amendment) was filed on December 14, 2010.

An Advisory action was mailed December 21, 2010, indicating that the rule 116 amendment would not be entered because the amendments raised new issues that would require further consideration and/or new search.

On January 27, 2011 petitioner sought relief by filing a petition under 37 C.F.R. § 1.181 requesting a Technology Center Director to exercise supervisory authority to reverse the examiner's refusal to enter applicant's rule 116 amendment that was submitted on December 14, 2010 and to direct entry of the amendment.

An Appeal Brief was filed on April 28, 2011.

On June 8, 2011 the petition was denied by Technology Center Director W. Gary Jones.

An Examiner's Answer to the April 28, 2011 Appeal Brief was mailed June 24, 2011.

On July 6, 2011 petitioner again sought relief by filing a petition under 37 C.F.R. § 1.181 requesting a Technology Center Director to exercise supervisory authority to reverse the examiner's refusal to enter applicant's rule 116 amendment that was submitted on December 14, 2010 and to direct entry of the amendment.

A Supplement to the June 24, 2011 Examiner's Answer was mailed

On August 4, 2011 the petition was denied by Technology Center Director Karen M. Young.

STATUTE, REGULATION AND
EXAMINING PROCEDURE

37 C.F.R. § 1.116(a) and (b) state that:

- (a) An amendment after final action must comply with § 1.114 or this section.
- (b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):
 - (1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;
 - (2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or
 - (3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

M.P.E.P. § 714.13 II and III states in part that:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. However, if the proposed amendment raises the issue of new matter, the examiner should identify the subject matter that would constitute new matter. If the proposed amendment presents new issues requiring further consideration and/or search, the examiner should provide an explanation as to the reasons why the proposed amendment raises new issues that would require further consideration and/or search. The reasons for nonentry should be concisely expressed. For example:

(A) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(B) The claims, if amended as proposed, would raise the issue of new matter.

(C) The claims as amended present new issues requiring further consideration or search.

(D) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal. *Ex parte Wirt*, 1905 C.D. 247, 117 O.G. 599 (Comm'r Pat. 1905).

OPINION

Petitioner asserts that the amendment submitted under 37 C.F.R. § 1.116 on December 14, 2010 should be entered. Petitioner argues that the petition decision does not provide a concise explanation for why the proposed amendment raises new issues that would require further consideration and/or search.

A review of the file record indicates that the Technology Center Director clearly set forth in concise detail the claim limitations that would require further consideration and search. Two limitations were added to claim 1 and the previously rejected term "tomato" was removed from claim 2. Contrary to petitioner's assertion, this change in claim scope gives sufficient explanation as to why further consideration and/or search are needed in accordance with agency procedure set forth in M.P.E.P. § 714.13.

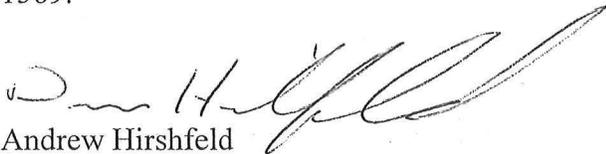
DECISION

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 August 4, 2011. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of August 4, 2011 has been reviewed, but is denied with respect to making any change therein. As such, the decision of August 4, 2011 is upheld. The petition is **denied**.

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

Telephone inquiries concerning this decision should be directed to José' G. Dees at (571) 272-1569.



Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer

cb/jc