

A paper granting a Power of Attorney to the practitioners listed at Customer No. 29747 (Greenberg Traurig) was filed on October 20, 2010.

A first request for continued examination was filed on February 14, 2011, and a second request for continued examination was filed on October 18, 2011.

A paper revoking the Power of Attorney to the practitioners listed at Customer No. 29747 was filed on August 30, 2012.

A third through eighth request for continued examination were filed on: January 4, 2013; August 6, 2014; October 27, 2014; March 12, 2015; April 16, 2015; and July 5, 2015.

A notice of allowance under 35 U.S.C. § 151 was mailed on July 21, 2015, and the above-identified application was issued as U.S. Patent No. 9,132,059 on September 15, 2015.

A petition was filed on September 28, 2015, requesting that the United States Patent and Trademark Office (USPTO) vacate the eight requests for continued examination filed in the above-identified application and their prosecution history on the basis that these requests for continued examination would not have been necessary but for the improper actions of the USPTO. A decision was issued on October 9, 2015 advising petitioner that any request for additional patent term adjustment must be filed as a petition for reconsideration of the patent term adjustment under 37 CFR 1.705(b).

A petition filed on October 13, 2015, and supplemented on October 15, 2015, invoking the general supervisory authority of the Director of USPTO and again requesting that the USPTO vacate the eight requests for continued examination filed in the above-identified application and their prosecution history on the basis that these requests for continued examination would not have been necessary but for the improper actions of the USPTO. The Technology Center Director mailed a decision on November 23, 2015, denying the petition of October 13, 2015 as untimely and indicating that the petition for patent term adjustment must be filed directly with the Office of Petitions under 37 CFR 1.705(b). The Office of Petitions mailed a letter on December 11, 2015, suggesting that the petitioner file a "renewed petition under 37 CFR 1.181" within two (2) months from the mailing date of the Technology Center Director's decision and be specifically directed to the Office of the Deputy Commissioner for Patent Examination Policy.

The instant petition was filed on October 13, 2015 and seeks review of the Technology Center Director's November 23, 2015 decision denying the petition filed on October 13, 2015. The instant petition again requests: (1) that the eight requests for continued examination filed in the above-identified application and their prosecution history be vacated; and (2) a redetermination of the patent term adjustment for the above-identified patent.

STATUTE AND REGULATION

35 U.S.C. § 132(b) provides that:

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).

37 CFR 1.114 provides that:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or
- (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) 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.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;

- (4) An application for a design patent;
- (5) An international design application; or
- (6) A patent under reexamination.

37 CFR 1.181(f) provides that:

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.

OPINION

Petitioner argues² that the patent issuing from the above-identified application has a term that is minimal due to improper delays caused by the USPTO, in that the USPTO's rules and practices have permitted examiners to act in a manner that resulted in a string of requests for continued examination being filed in the above-identified application. Petitioner specifically asserts that a string of requests for continued examination were filed in the above-identified application as a consequence of: (1) the USPTO not following the requirements for treatment of *pro se* applicants outlined in section 707.07(j) of the Manual of Patent Examining Procedure (MPEP), which includes the drafting of appropriate claims for a *pro se* applicant, during the examination of the above-identified application; (2) the USPTO not informing petitioner of after final practice

² Petitioner also raises the issue of the changes to the rules of practice pertaining to continuing applications and requests for continued examination practices (Claims and Continuations Final Rule) published in August of 2007. The USPTO published the Claims and Continuations Final Rule in the Federal Register in August of 2007, which revised the rules of practice for patent cases pertaining to continuing applications and requests for continued examination practices, and for the examination of claims in patent applications. *See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications*, 72 Fed. Reg. 46716 (Aug. 21, 2007). The U.S. District Court for the Eastern District of Virginia (District Court) issued an injunction, enjoining the USPTO from implementing the changes in the Claims and Continuations Final Rule. *See Tafas v. Dudas*, 541 F. Supp. 2d 805 (E.D. Va. 2008) (permanent injunction), and *Tafas v. Dudas*, 511 F. Supp. 2d 652 (E.D. Va. 2007) (preliminary injunction). The USPTO appealed this decision to the U.S. Court of Appeals for the Federal Circuit (Federal Circuit). In October of 2009, while the decision was still pending before the Federal Circuit, USPTO decided that it was no longer interested in pursuing the changes in the Claims and Continuations Final Rule and issued a final rule revising the rules of practice to remove the changes in the Claims and Continuations Final Rule from the Code of Federal Regulations. *See Changes to Practice for Continued Examination Filings, Patent Applications Containing Patentably Indistinct Claims, and Examination of Claims in Patent Applications*, 74 Fed. Reg. 52686 (Oct. 14, 2009), codified at 37 CFR part 1 (2010). Since the changes in the Claims and Continuations Final Rule were never in effect, and the Code of Federal Regulations was revised to remove the enjoined Claims and Continuations Final Rule in the 2010 edition, prior to the filing of the first request for continued examination in the above-identified application on February 14, 2011, the events surrounding the Claims and Continuations Final Rule are of no consequence to the prosecution and examination of the above-identified application.

as provided for in 37 CFR 1.116; and (3) the USPTO permitting its examiners to add new prior art references and arguments during the examination of patent applications. Petitioner also asserts that the USPTO's *pro se* program is inadequate as is shown by the high abandonment rate for *pro se* applicants, and requests that the USPTO improve its *pro se* program.

Initially, the Technology Center Director found that the petition under 37 CFR 1.181 filed on October 13, 2015 was untimely and denied the petition on that ground. 37 CFR 1.181(f) provides that any petition under 37 CFR 1.181 not filed within two months of the mailing date of the action from which relief is requested may be dismissed as untimely. The USPTO action or notice from which relief is complained of action must have occurred no more recently than July 5, 2015, the date the most recent of the eight requests for continued examination was filed. The first petition in the above-identified application contending that the filing of any request for continued examination was the result of improper action by the USPTO was not filed until September 28, 2015, more than two months after July 5, 2015. Therefore, there is no showing of any error in the Technology Center Director's decision to deny the petition filed on October 13, 2015 as untimely.

In any event, even if the petition to vacate the eight requests for continued examination filed in the above-identified application and their prosecution history were timely filed, there is no basis for granting the requested relief.

Initially, it is noted that petitioner was a represented applicant between October 20, 2010 and August 30, 2012. The first request for continued examination in the above-identified application was filed on February 14, 2011, while petitioner was a represented applicant. Therefore, petitioner's status as a *pro se* applicant prior to October 20, 2010 and subsequent to August 30, 2012, and whether the USPTO's treatment of the above-identified application prior to October 20, 2010 and subsequent to August 30, 2012 was consistent with its practices for the treatment of applications prosecuted by a *pro se* applicant, is immaterial to petitioner's need for or decision to file a first request for continued examination in the above-identified application on February 14, 2011. Regardless of what resulted in the need for petitioner to file any request for continued examination subsequent to the first request for continued examination filed on February 14, 2011, the period between February 14, 2011 (the filing of the first request for continued examination in the above-identified application) and July 21, 2015 (the date of a mailing of a notice of allowance in the above-identified application) was "time consumed by continued examination of the application requested by the applicant under [35 U.S.C. §] 132(b)" within the meaning of 35 U.S.C. § 154(b)(1)(B)(i). See *Novartis AG v. Lee*, 740 F.3d 593, 602 (Fed. Cir. 2014).

Nevertheless, the examination of the above-identified application was consistent with the practices outlined in MPEP § 707.07(j). MPEP § 707.07(j) provides that:

I. INVENTOR FILED APPLICATIONS

When, during the examination of a *pro se* application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent. Although this practice may be desirable and is permissible in any case deemed appropriate by the examiner, it is especially useful in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

II. ALLOWABLE EXCEPT AS TO FORM

When an application discloses patentable subject matter and it is apparent from the claims and applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and, when possible, should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, the examiner may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a canceled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

III. EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, the allowance of such claims should not be delayed.

The examiner drafted a claim for petitioner's consideration on several occasions. For example, examiner attached a draft claim (numbered 60) for petitioner to consider in the Examiner-Initiated Interview Summary dated February 26, 2013. The examiner also attached a draft claim numbered 144 for petitioner to consider in the Applicant-Initiated Interview Summary dated

February 2, 2015. The patent laws provide for the USPTO to work with and support intellectual property law associations to establish pro bono programs for *pro se* applicants designed to assist financially under-resourced independent inventors and small businesses³ and the USPTO does have a number of services available for inventors and *pro se* applicants.⁴ The patent laws, regulations, and procedures, however, do not require or provide for the examiner to act as an applicant's representative during the patent examination process. Therefore, that petitioner considered the claims drafted by the examiner to be inadequate does not mean that the examination of the above-identified application was inconsistent with the practices outlined in MPEP § 707.07(j).

Petitioner's argument that the USPTO did not inform petitioner of after final practice as provided for in 37 CFR 1.116 is unavailing. The record of the above-identified application indicates that petitioner did file several amendments after final under 37 CFR 1.116, and these amendments after final were denied entry. Since petitioner did file several amendments after final under 37 CFR 1.116 and these amendments after final under 37 CFR 1.116 did not avoid the need for petitioner to file any request for continued examination, there is no basis for concluding that specifically informing petitioner of the after final practice as provided for in 37 CFR 1.116 would have obviated the need for any request for continued examination.

The argument concerning the USPTO permitting its examiners to add new prior art references and arguments during the examination of patent applications is likewise unavailing. The USPTO has the responsibility under 35 USC §§ 131 and 151 to issue a patent containing only patentable claims. See *BlackLight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273 (Fed. Cir. 2002). It is well-established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director as to why an application should not issue, it is the USPTO's duty to refuse to issue the patent even if a notice of allowance has previously been issued for the application. See *In re Drawbaugh*, 9 App. D.C. 219, 240 (D.C. Cir 1896). An examiner may change his or her viewpoint as to the patentability of claims as the prosecution of an application progresses, and an applicant has no legal ground for complaint because of such change in view so long as there is compliance with the patent laws and regulations. See *In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967). While petitioner generally complains that the examiner added new prior art references and arguments during the examination of the above-identified application, the petition does not show instances in which there was a failure to comply with the patent laws and regulations in the manner in which the examiner added new prior art references and arguments during the examination of the above-identified application.

Finally, petitioner's arguments concerning the USPTO's *pro se* program are noted, but do not warrant granting the requested relief. While the USPTO takes considerable efforts to educate

³ *Leahy-Smith America Invents Act*, Pub. L. 112-29, § 32, 125 Stat. 284, 340 (2011).

⁴ *Inventor & Entrepreneur Resources* micro site available on the USPTO's Internet Web site at: <http://www.uspto.gov/learning-and-resources/inventors-entrepreneurs-resources>.

and assist independent inventors and unrepresented applicants, this is done as a matter of good government and not because such efforts are required of the USPTO by the patent laws or regulations. Therefore, that the USPTO's programs are not to petitioner's liking or that they could always be improved is not a basis for granting the requested relief in the above-identified application. That *pro se* applicants have a higher than average abandonment rate is similarly not a basis for granting relief in above-identified application. *Cf., e.g., In re McDaniels*, 293 F.3d 1379 (Fed. Cir. 2002) (actions taken by other examiners in other unrelated applications are immaterial to the actions taken in the application is question); *In re Wertheim*, 541 F.2d 257 (CCPA 1976) (same), and *In re Giolito*, 530 F.2d 397 (CCPA 1976) (same).

CONCLUSION

For the above-stated reasons, the petition to vacate the eight requests for continued examination filed in the above-identified application and their prosecution history is **DENIED**. A decision with respect to the request for redetermination of the patent term adjustment for the above-identified patent will follow.

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.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (571) 272-3613.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer