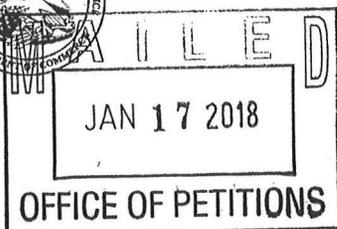




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GE GLOBAL PATENT OPERATION
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NORWALK CT 06851

In re Application of :
Charles Woychik *et al.* :
Application No. 12/061,141 : DECISION ON PETITION
Filed: April 2, 2008 :
For: DEMOUNTABLE INTERCONNECT :
STRUCTURE :

This is a decision on the petition filed on November 21, 2017 under 37 CFR 1.181, requesting that the Director exercise supervisory authority and overturn the decision of October 10, 2017, by a Director of Technology Center 1700 (Technology Center Director), which decision refused to withdraw the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112 ¶ 2.¹

The petition to withdraw the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36 and 40 under 35 U.S.C. § 112 ¶ 2, is **DENIED**.

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated pre-AIA 35 U.S.C. § 112, ¶¶ 1 through 6, as 35 U.S.C. §§ 112(a) through (f), effective as to applications filed on or after September 16, 2012. See Pub. L. No. 112-29, § 4, 125 Stat. 284, 293-97 (2011). Section 3 of the AIA revised 35 U.S.C. §§ 102 and 103, effective as to applications ever having a claim with an effective filing date on or after March 16, 2013, or ever having a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any patent or application that ever contained such a claim with an effective filing date on or after March 16, 2013. See Pub. L. No. 112-29, § 3, 125 Stat. at 285-293. The above-identified application was filed prior to September 16, 2012, asserts priority to an effective filing date prior to March 16, 2013 for every claim ever contained in the above-identified application, and never contained a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any other patent or application having a claim with an effective filing date on or after March 16, 2013. Therefore, this decision refers to the pre-AIA version of 35 U.S.C. §§ 102, 103, and 112.

RELEVANT BACKGROUND

The above-identified application was filed on April 2, 2008.

Prosecution of the above-identified application resulted in a final Office action being issued on September 8, 2014. Claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, 37, and 40 through 43 are pending in the above-identified application (claims 2, 3, 7, 24, 33, 35, 38 and 39 having been canceled), of which claims 1, 37, and 43 are independent claims and claims 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 through 42 are dependent claims). The final Office action of September 8, 2014 included: (1) a rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, 37, and 40 through 43 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description requirement; (2) a rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, for failure to comply with its definiteness requirement; (3) a rejection of claims 37, 42, and 43 under 35 U.S.C. § 102(b) as being anticipated by Stewart as evidenced by Hoban, the Oxford English Dictionary, Ullmann's Encyclopedia of Industrial Chemistry, and Graf; and (4) a rejection of claims 1, 4 through 6, 8 through 11, 14-18, 21 through 23, 25 through 30, 32, 34, and 43 under 35 U.S.C. § 102(b) as being anticipated by Cole as evidenced by Eichelberger (incorporated by reference).

A notice of appeal under 35 USC 134 and 37 CFR 41.31 was filed on December 8, 2014 and an appeal brief was filed on February 9, 2015.

An examiner's answer was issued on May 21, 2015, and a reply brief was filed on July 21, 2015.

The Patent Trial and Appeal Board (PTAB) issued its decision on June 30, 2017, in which the PTAB: (1) reversed the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, 37, and 40 through 43 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description requirement; (2) summarily affirmed the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, for failure to comply with its definiteness requirement; (3) reversed the rejection of claims 37 and 42 under 35 U.S.C. § 102(b) as being anticipated by Stewart as evidenced by Hoban, the Oxford English Dictionary, Ullmann's Encyclopedia of Industrial Chemistry, and Graf; and (4) reversed the rejection of claims 1, 4 through 6, 8 through 11, 14 through 18, 21 through 23, 25 through 30, 32, 34, and 43 under 35 U.S.C. § 102(b) as being anticipated by Cole as evidenced by Eichelberger (incorporated by reference).

A petition under 37 CFR 1.181 was filed on August 29, 2017, requesting withdrawal of the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2. The petition of August 29, 2017 was denied by the Technology Center director in a decision mailed October 10, 2017.

The instant petition under 37 CFR 1.181 was filed on November 21, 2017, and again requests withdrawal of the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2.

STATUTE AND REGULATION

35 U.S.C. § 134 provides that:

(a) PATENT APPLICANT — An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER — A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

37 CFR 1.181(a) provides that:

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 Patent Trial and Appeal Board 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 Patent Trial and Appeal Board, see § 41.3 of this title.

37 CFR 1.197 provides that:

(a) Proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action except:

(1) Where claims stand allowed in an application; or

(2) Where the nature of the decision requires further action by the examiner.

(b) The date of termination of proceedings on an application is the date on which the appeal is dismissed or the date on which the time for appeal to the U.S. Court of Appeals for the Federal Circuit or review by civil action (§ 90.3 of this chapter) expires in the absence of further appeal or review. If an appeal to the

U.S. Court of Appeals for the Federal Circuit or a civil action has been filed, proceedings on an application are considered terminated when the appeal or civil action is terminated. A civil action is terminated when the time to appeal the judgment expires. An appeal to the U.S. Court of Appeals for the Federal Circuit, whether from a decision of the Board or a judgment in a civil action, is terminated when the mandate is issued by the Court.

37 CFR 1.198 provides that:

When a decision by the Patent Trial and Appeal Board on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

37 CFR 41.50 provides that:

(a)(1) *Affirmance and reversal.* The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

(2) If a substitute examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the substitute examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) Reopen prosecution. Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131, or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the issues set forth in the remand or raised in the substitute examiner's answer. A request that complies with this paragraph (a) will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) Maintain appeal. Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any

amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

(b) *New ground of rejection.* Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

(c) *Review of undesignated new ground of rejection.* Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in § 41.52. Failure of appellant to timely file such a request for rehearing will constitute a waiver of any arguments that a decision contains an undesignated new ground of rejection.

(d) *Request for briefing and information.* The Board may order appellant to additionally brief any matter that the Board considers to be of assistance in reaching a reasoned decision on the pending appeal. Appellant will be given a time period within which to respond to such an order. Failure to timely comply with the order may result in the sua sponte dismissal of the appeal.

(e) *Remand not final action.* Whenever a decision of the Board includes a remand, that decision shall not be considered final for judicial review. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board may enter an order otherwise making its decision final for judicial review.

(f) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time periods set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications

and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

37 CFR 41.52 provides that:

(a)(1) Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.

(2) Appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

(3) New arguments responding to a new ground of rejection designated pursuant to § 41.50(b) are permitted.

(4) New arguments that the Board's decision contains an undesignated new ground of rejection are permitted.

(b) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

OPINION

Petitioners assert that the reversal of the other rejections in the above-identified application renders the rejection under 35 U.S.C. § 112, ¶ 2, unsupportable and without basis. Petitioners specifically argue that in view of the reversal of the rejections of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. §§ 102(b) and 112, ¶ 1, there is no basis for the examiner to maintain the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2. Petitioners further contend that this matter is petitionable, rather than appealable, as they are not arguing the decision by the PTAB, but are taking issue with the examiner's decision to maintain the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2. Petitioners request, *inter alia*, withdrawal

of the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112 ¶ 2.

The PTAB decision of June 30, 2017 unquestionably affirms the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2. *See* PTAB decision of June 30, 2017 at pages 5 (“We summarily affirm Rejection 2, [the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2,] which rejection has not been contested by Appellants in the Appeal Brief”) and 12 (“The Examiner’s decision to reject claims 1, 4—6, 8—23, 25—32, 34, 36, and 40 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is summarily affirmed”). Therefore, the PTAB decision of June 30, 2017 is an affirmance-in-part, as it affirmed a rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 (under 35 U.S.C. § 112, ¶ 2), but reversed all rejections of claims 37 and 41 through 43. *See* PTAB decision of June 30, 2017 at page 12. As the time for seeking judicial review of the PTAB decision of June 30, 2017 has now expired, the appropriate course of action in the above-identified application is for the examiner to cancel those claims for which a rejection has been affirmed (*i.e.*, claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40). *See* MPEP §§ 1214.01 and 1216.01.

While petitioners contend that the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, is unsustainable and without basis, the salient point remains that the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, was affirmed by the PTAB. Put simply, an “affirmance” is the “decision” by the PTAB in the decision of June 30, 2017 with respect to the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, notwithstanding what decisions were rendered with respect to other rejections and whatever else was discussed in the decision of June 30, 2017. *See* PTAB decision of June 30, 2017 at page 12. Petitioners’ contention that the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, is unsustainable and without basis in light of the reversal of the rejections under 35 U.S.C. §§ 102(b) and 112, ¶ 1, in the decision of June 30, 2017 is a matter that petitioners should have raised (if appropriate) with the PTAB in a request for rehearing under 37 CFR 41.52. Nonetheless, as the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, was affirmed by the PTAB in the decision of June 30, 2017, there is no basis for directing the examiner to withdraw the affirmed rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112, ¶ 2, or for directing the examiner to take any action with respect to these claims other than that provided for in MPEP § 1214.01.

Petitioners are reminded that review of the propriety of a rejection *per se* (and its underlying reasoning) is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 41.31, and not by way of petition under 37 CFR 1.181, even if a petitioner frames the issues as concerning procedure versus the merits. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468,

1472 (E.D. Va. 2004). As stated by the Court of Customs and Patent Appeals (a predecessor of the U.S. Court of Appeals for the Federal Circuit), the adverse decisions of examiners which are reviewable by the Board are those which relate, at least indirectly, to matters involving the rejection of claims. *See In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Patent Trial and Appeal Board. *See In re Dickerson*, 299 F.2d 954, 958 (CCPA 1962) (The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board). *See also* MPEP § 1201.

DECISION

For the previously stated reasons, the petition to withdraw the rejection of claims 1, 4 through 6, 8 through 23, 25 through 32, 34, 36, and 40 under 35 U.S.C. § 112 ¶ 2, is **DENIED**.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained.

Telephone inquiries concerning the decision should be directed to Chris Bottorff at (571) 272-6692.

The application is being forwarded to Technology Center 1700 for further processing in accordance with MPEP § 1214.01.



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy