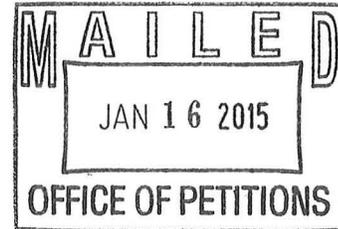




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In re Application of
Pei-Si WU, et al.
Application No. 13/040,267
Filed: March 4, 2011
Attorney Docket No.: 251812-4720

ON PETITION

This is a decision on the petition filed July 6, 2014, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decisions of the Director, Technology Center 2600 (Technology Center Director), dated April 25, 2014 and May 20, 2014, which refused to withdraw the finality of the December 5, 2013 Office action and compel the entry of the amendment after final filed February 19, 2014 in view of the filing of a Request for Continued Examination (RCE).

The petition to overturn the decision of the Technology Center Director dated June 1, 2012 is **DENIED**¹.

BACKGROUND

On July 24, 2013, a non-final Office action was mailed.

On October 22, 2013, a response was filed.

On December 5, 2013, a final Office action was mailed.

On February 19, 2014, an amendment under 37 CFR 1.116 was filed requesting withdrawal of the finality of the December 5, 2013 Office action.

On February 26, 2014, an Advisory Action was mailed.

On February 28, 2014, a Request for Continued Examination was filed.

¹ 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

On March 9, 2014, a petition requesting withdrawal of the final Office action was filed.

On April 25, 2014, a decision dismissing as moot the petition of March 9, 2014 was mailed.

On April 30, 2014, a petition requesting reconsideration of the April 25, 2014 petition decision was filed.

On May 20, 2014, a decision denying the petition of April 30, 2014 was mailed.

On July 6, 2014, the instant petition was filed.

STATUTE, REGULATION, AND EXAMING PROCEDURE

35 U.S.C. 42(d) provides:

The director may refund any fee paid by mistake or any amount paid in excess of that required.

35 U.S.C. 132(b) provides:

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) of this title.

37 CFR 1.26(a) provides, in part, that:

The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee. The Office will not refund amounts of twenty-five dollar or less unless a refund is specifically requested, and will not notify the payor of such amounts.

37 CFR 1.113(a) provides:

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.

37 CFR 1.114(d) provides:

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.

37 CFR 1.181 provides, in pertinent part, that:

(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.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, or in the ex parte or inter partes prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(f) 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.

MPEP 706.07(c) provides:

Any question as to prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of

complaint before the Board of Patent Appeals and Interferences. It is reviewable by petition under 37 CFR 1.181. See MPEP § 1002.02(c).

MPEP 706.07(h) provides, in pertinent part, that:

35 U.S.C. 132(b) provides for continued examination of an application at the request of the applicant (request for continued examination or RCE) upon payment of a fee, without requiring the applicant to file a continuing application under 37 CFR 1.53(b). To implement the RCE practice, 37 CFR 1.114 provides a procedure under which an applicant may obtain continued examination of an application in which prosecution is closed (e.g., the application is under final rejection or a notice of allowance) by filing a submission and paying a specified fee. Applicants cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined as a matter of right (i.e., applicant cannot switch inventions).

MPEP 714.13 provides, in pertinent part, that:

A reply under 37 CFR 1.113 is limited to:

- (A) an amendment complying with 37 CFR 1.116;
- (B) a Notice of Appeal (and appeal fee); or
- (C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

OPINION

Petitioner seeks reversal of the Technology Center Director decisions of April 25, 2014 and May 20, 2014, on the grounds that the filing of an RCE does not make the petition filed under 37 CFR 1.181, requesting withdrawal of the finality of the December 5, 2013 Office action, moot. Accordingly, petitioner requests a decision on the petition under 37 CFR 1.181 filed March 9, 2014, entry of the amendment after final filed February 19, 2014, withdrawal of the RCE, and a refund of the RCE fee.

Petitioner specifically argues that the filing of the RCE was necessary to avoid abandonment of the application as filing a petition does not stay any period set for reply. 37 CFR 1.181(f). Therefore, petitioner states the filing of an RCE was required to prevent the application from becoming abandoned and the timely filed petition under 37 CFR 1.181 to review the examiner's refusal to withdraw the finality should be treated as the rules require petitioner to take action without waiting for a decision on petition. Moreover, petitioner contends the application may have become abandoned prior to a decision on the petition under 37 CFR 1.181, filed March 9, 2014, had the RCE not been filed. Petitioner further argues there is no guarantee with respect to the resolution

timing of any petition that is filed and the only way petitioner could protect applicant's interest in the pendency of the application was to file an RCE. Petitioner further contends that a petition to accept color drawings in application serial number 12/468,224 took over five years to decide and a petition to add an omitted inventor in application serial number 13/024,803 has been pending over three years.

As set forth in MPEP 714.13, *supra*, an RCE is but one of the responses petitioner may have filed in order to prevent abandonment of the instant application. For instance, petitioner may have filed an extension of time and/or a Notice of Appeal instead of an RCE in order to prevent abandonment of the application. Further, petitioner may have contacted the Office regarding the status of his petition if a timely decision had not been rendered. In the instant case, petitioner chose to file an RCE prior to filing a petition requesting withdrawal of the finality of the December 5, 2013 Office action. As set forth in 37 CFR 1.114, *supra*, 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. As the filing of the RCE withdrew the finality of the Office action and entered the amendment submitted under 37 CFR 1.116, the petition under 37 CFR 1.181 was therefore properly considered as moot. (Emphasis added.)

Although petitioner further contends that the issue is not moot because petitioner incurred additional fees as a result of the filing of the RCE on February 28, 2014, the filing of the RCE was petitioner's decision. Petitioner knew that the filing of a reply to avoid abandonment of the application was not required until June 5, 2014, or with the filing of a Notice of Appeal until January 5, 2015. Moreover, the applicable statute, 35 U.S.C. 42(d), authorizes the Director to refund "any fee paid by mistake or any amount paid in excess of that required." Thus, the U.S. Patent and Trademark Office (USPTO) may refund: (1) a fee paid when no fee is required (*i.e.*, a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r pats. 1943)(the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment, and not the underlying action). In the situation, as herein, in which an applicant takes an action "by mistake" (*e.g.*, files an RCE "by mistake"), the submission of fees required to take that action (*e.g.*, an RCE fee submitted with an RCE) is not a "fee paid by mistake" within the meaning of 35 U.S.C. 42(d). See Changes to Implement the Patent Business Goals, Notice of Proposed Rulemaking, 64 FR 53771, 53780 (October 4, 1999), 1228 Off. Gaz. Pat. Office, 15, 23 (November 2, 1999).

Even if petitioner erred in presenting an RCE under 37 CFR 1.114 to the USPTO for this application, that does not warrant a finding that the payment was made "by mistake." Rather, the fee was owed at the time it was paid. As noted in 37 CFR 1.26(a), petitioner's change of purpose does not constitute a "mistake" in payment warranting refund of the fees previously paid. The payment of the fee automatically was due, by statute, when petitioner presented, rightly, or mistakenly, the RCE under 37 CFR 1.114. Thus, it is immaterial to the question of "mistake" in payment of the instant RCE fee, that petitioner may have erred in submitting the aforementioned submission. Here, it is noted, that petitioner requested an RCE under 37 CFR 1.114.

Furthermore, with respect to petitioner's statements with respect to petitions filed in other applications, the issue at hand is not what has occurred in another application, rather, it is whether petitioner has properly followed the statutes and regulations with exercise of reasonable care and diligence herein. In the instant case, a review of the record indicates that the petitioner knew or should have known that the filing of an RCE will withdraw the finality of any Office action and the submission will be entered and considered.

DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in his refusal to treat the petition on the merits, in view of the filing of an RCE, in the petition decisions of April 25, 2014 and May 20, 2014. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decisions of the Technology Center Director of April 25, 2014 and May 20, 2014 have been reviewed; however, the decisions of April 25, 2014 and May 20, 2014 will not be disturbed because, while the filing of the petition is timely, the refusal to further treat the petition of March 9, 2014, on the merits in view of the filing of the RCE is proper. No refund of the RCE fee will be given. The petition is denied.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.



Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer