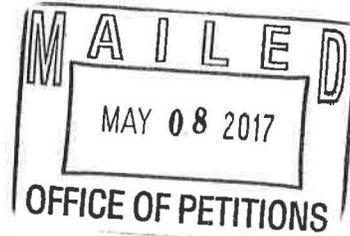




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PROCOPIO, CORY, HARGREAVES &
SAVITCH LLP
525 B Street
Suite 2200
San Diego, CA 92101



In re Application of
Mitchell Clark VOGES, et al.
Application No. 13/450,364
Filed: April 18, 2012
For: **SYSTEMS AND METHODS FOR
FITTING GOLF EQUIPMENT**

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ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) filed March 16, 2017, to withdraw the Notice of Withdrawal from Issue of January 13, 2017 and the Office action of February 3, 2017.

The petition to withdraw the Notice of Withdrawal from Issue of January 13, 2017 and the Office action of February 3, 2017 is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on April 18, 2012.

Prosecution of the above-identified application lead to an appeal under 35 U.S.C. § 134 to the Patent Trial and Appeal Board (Board). The Board issued a decision on June 1, 2016, in which the Board panel: (1) reversed the rejection of claims 1, 3, 7 and 8 under 35 U.S.C. § 103 as unpatentable over Gobush (U.S. Patent No. 6,758,759), Engfer (U.S. Patent No. 5,749,792), Naruo (U.S. Patent Application Publication No. 2004/0033845), and Muldoon (U.S. Patent No. 5,421,098); and (2) declined to reach the double patenting (obviousness-type) rejection of claims 1, 3 and 7.

A notice of allowance under 35 U.S.C. § 151 was mailed on September 23, 2016. The issue fee was paid on December 19, 2016.

A Notice of Withdrawal from Issue was mailed on January 13, 2017.

A non-final Office action was mailed on February 3, 2017. The Office action of February 3, 2017 included: (1) a rejection of claim 3 under 35 U.S.C. § 112 for failure to comply with its definiteness requirement; (2) a rejection of claims 1 and 3 under 35 U.S.C. § 103 as unpatentable over Lynch (U.S. Patent No. 4,375,887) and Fenton (U.S. Patent No. 4,974,846); and a rejection of claims 7 and 8 under 35 U.S.C. § 103 as unpatentable over Lynch, Fenton and Fluid Flow (How to use the golf ball Trajectory Simulation Applet) or Golf Achiever Focaltron (User Manual).

The instant petition was filed under 37 CFR 1.181(a) filed on March 16, 2017, and requests withdrawal of the Notice of Withdrawal from Issue of January 13, 2017 and the Office action of February 3, 2017.

STATUTE AND REGULATION

35 U.S.C. § 131 provides that:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 151 provides that:

(a) IN GENERAL.—If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) EFFECT OF PAYMENT.—Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.

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 1.313 provides that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For an interference or derivation proceeding.

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

OPINION

Petitioners assert that the withdrawal of the above-identified application from issue does not comply with 35 U.S.C. §151, 37 CFR 1.313(b), and section 1308 of the Manual of Patent Examining Procedure (MPEP). Petitioners argue that the United States Patent and Trademark Office (USPTO) is not authorized to withdraw an application from issue after payment of the issue fee for any reason except for the conditions set forth in 37 CFR 1.313(b), namely: (1) a mistake on the part of the Office; (2) a violation of 37 CFR 1.56 or illegality in the application;

(3) unpatentability of one or more claims; or (4) for interference or derivation. Petitioners request, *inter alia*, that the USPTO clarify the record to indicate that it was contrary to USPTO procedure to withdraw the application from issuance as none of the conditions provided in 37 CFR 1.313(b) existed in the above-identified application.¹

The USPTO has an obligation to refrain from knowingly issuing an invalid patent. *See, e.g., Blacklight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273-74 (Fed. Cir. 2002) (permitting extraordinary action in withdrawing an application from issue after payment of the issue fee and reopening prosecution to avoid knowingly issuing an invalid patent). Stated simply, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director of the USPTO as to why the application should not issue, the Director has the authority and the duty to refuse to issue the application. *See In re Drawbaugh*, 9 App. D.C. 219, 240 (D.C. Cir. 1896); *see also In re Alappat*, 33 F.3d 1526, 1535 (Fed. Cir. 1994) (the Director “has an obligation to refuse to grant a patent if he [or she] believes that doing so would be contrary to law”).

In addition, it is well-established that a court or Board decision reversing a rejection does not preclude further examination of the application by the USPTO or operate as a mandate to issue the application as a patent. *See Jeffrey Mfg. Co. v. Kingsland*, 179 F.2d 35, 36 (D.C. Cir. 1949); *see also In re Gould*, 673 F.2d 1385, 1386 (CCPA 1982) (USPTO can always reopen prosecution in an application once it regains jurisdiction over the application); *In re Arkley*, 455 F.2d 586, 589 (CCPA 1972) (the USPTO is free to make such other rejections as it consider appropriate subsequent to a court decision reversing a rejection); *In re Fisher*, 448 F.2d 1406, 1407, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); *In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967) (holding that, subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); *In re Citron*, 326 F.2d 418, 419 (CCPA 1964) (holding that, following decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references).

Petitioners are correct that the Notice of Withdrawal from Issue of January 13, 2017 does not specifically state why the above-identified application was being withdrawn from issue (other than to reopen prosecution). Nevertheless, the record of the above-identified application is clear as to why the above-identified application was withdrawn from issue: the Office action of February 3, 2017 clearly states that one or more claims of the above-identified application are considered by examiner to be unpatentable (37 CFR 1.313(b)(3)). *See* Office action of on

¹ With respect to petitioners’ request that the USPTO withdraw the non-final Office action of February 3, 2017 due to the examiner failing to update the interference search, MPEP § 1302.08 provides that an interference search is required when the application is in condition for allowance, which was not the situation when the non-final Office action of February 3, 2017 was issued.

February 3, 2017 at pages 4 through 8. While the reason for the withdrawal of the above-identified application could have been better communicated to petitioners in the Notice of Withdrawal from Issue of January 13, 2017, the decision to withdraw the above-identified application from issue did comply with 37 CFR 1.313(b), and the record of the above-identified application is clear as to why the above-identified application was withdrawn from issue. In addition, that the examiner had not completed the process of preparing an Office action (including the completion of a search) until after the above-identified application had been withdrawn from issue is immaterial. *See Blacklight Power*, 295 F.3d at 1273-74 (USPTO is not required to make final determination of unpatentability before withdrawing an application from issue pursuant to 37 CFR 1.313(b)(3), which permits the Office to withdraw an application after payment of the issue fee on ground of “unpatentability of one or more claims.”).

Petitioners argue that the Office action of February 3, 2017 is based on a reference (Lynch) that was cited and identified on an information disclosure statement filed on August 17, 2012 and considered by the examiner as early as August 28, 2012, and that any search for prior art to supplement Lynch should have been made well prior to the application being withdrawn from issuance on January 13, 2017. While it is regrettable that the rejections in the Office action of February 3, 2017 were not provided prior to the allowance of the above-identified application (and more preferably prior to the appeal in the above-identified application), that a rejection could have been made earlier in the examination process does not preclude an application from being withdrawn from issue under 37 CFR 1.313(b)(3). 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 Ruschig*, 379 F.2d at 993 (quoting *In re Becker*, 101 F.2d 557 (CCPA 1939)). In addition, while petitioners may complain that the USPTO should have uncovered any applicable prior art well prior to January of 2017, this does not warrant withdrawing the Notice of Withdrawal from Issue of January 13, 2017 and the Office action of February 3, 2017. *See Citron*, 326 F.2d at 419 (“while appellant may have just cause for complaint that the Patent Office should have operated more effectively in finding the closest prior art, which appears to have been available to it all during the prosecution, and in citing it early in the prosecution, this is of no moment whatever in deciding appellant’s legal right to the appealed claims in the fact of the new prior art now that it has been cited).

DECISION

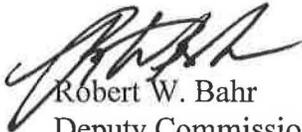
For the previously stated reasons, the petition filed to withdraw the Notice of Withdrawal from Issue of January 13, 2017 and the Office action of February 3, 2017 is **DENIED**. Accordingly, neither the Notice of Withdrawal from Issue of January 13, 2017 nor the non-final Office action of February 3, 2017 in above-identified application will be disturbed.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). *See* MPEP 1002.02.

Petitioners are reminded that a reply to the non-final Office action of February 3, 2017 remains outstanding. *See* 37 CFR 1.181(f) (mere filing of a petition will not stay any period for reply that may be running against the application).

The application is being forwarded to the Technology Center 3700 to await petitioners' reply to the Office action of February 3, 2017.

Telephone inquiries concerning this decision should be directed to Vincent N. Trans at (571) 272-3613.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy