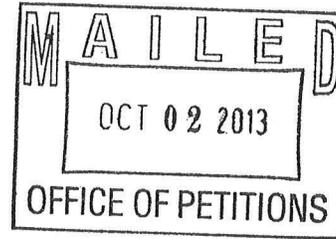




Tim R. Miles or Sharyn B. Miles
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Albuquerque NM 87122



In re Application of
Tim R. MILES, et al.
Application No. 13/506,849
Filed: May 21, 2012

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ON PETITION

This is a decision on the petition filed May 23, 2013, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated May 14, 2013, which refused to assign a different examiner to the instant application.

The petition to overturn the decision of the Technology Center Director dated May 14, 2013, is **DENIED**.

BACKGROUND

The instant application was filed May 21, 2012.

On August 13, 2012, a non-final Office action was mailed.

On October 1, 2012, an amendment was filed changing the scope of independent claims 1, 7, and 11.

On October 19, 2012, a final Office action, which included rejections based upon new art as necessitated by amendment to the claims, was mailed.

On November 14, 2012, an amendment under 37 CFR 1.116 was filed amending the claims and requesting reconsideration of the finality of the October 19, 2012 Office action.

On December 10, 2012, a non-final Office action was mailed withdrawing the finality of the previous Office action and rejecting claims based upon new art as necessitated by amendment to the claims.

On January 9, 2013, an amendment was filed changing the scope of independent claims 1, 7, and 11, and adding new independent claim 21.

On February 5, 2013, a final Office action, which included rejections based upon new art as necessitated by amendment to the claims, was mailed.

On March 1, 2013, an amendment under 37 CFR 1.116 was filed.

On March 15, 2013, an Advisory Action refusing entry of the March 1, 2013 amendment was mailed.

On March 27, 2013, a petition to invoke supervisory authority was filed.

On May 14, 2013, a decision denying the petition of March 27, 2013 was mailed.

On May 23, 2013, the instant petition was filed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. 132(a) states:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

MPEP 904 states:

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

MPEP 904.03 states:

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further

searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. Applicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept.

In doing a complete search, the examiner should find and cite references that, while not needed for treating the claims, would be useful for forestalling the presentation of claims to other subject matter regarded by applicant as his or her invention, by showing that this other subject matter is old or obvious.

MPEP 1201 states:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134) .

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. 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. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of May 14, 2013, on the ground that the Technology Center Director has acted improperly in refusing to replace the examiner of record.

As noted in In re Ovshinsky, 24 USPQ2d 1241, 1251-2 (Comm'r Pats.1992), the issue is not whether the perceptions of an applicant regarding alleged bias are reasonable; rather the issue is: whether an applicant has demonstrated improper conduct, including bias or the appearance of bias, on the part of the Technology Center Director. A full investigation of the facts set forth in the petition, as well as a full consideration of the entire record of this application fails to reveal bias or improper conduct on the part of either the Group Director or the examiner, and as such, there is no reversible error in the Technology Center Director's decision.

Specifically, petitioner contends: (1) the examiner has made four searches and cited four sets of references, through no fault of applicant, and has thus failed to comply with the "one search" requirement of MPEP 904.03; and (2) various statements in the Office action of October 19, 2012 are arbitrary and capricious, and as such the examiner should be replaced.

With respect to petitioner's arguments as to the search of the application, there is no requirement in either MPEP 904 or MPEP 904.03 that only one search of the claimed subject matter of an application be made. MPEP 904 states: "[T]he first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply". MPEP 904.03 states: "that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search" and further states; "[A]pplicants can facilitate a complete search by including, at the time of filing, claims varying from the broadest to which they believe they are entitled to the most detailed that they would be willing to accept".

A thorough review of the application file shows that petitioner, in response to each of the rejections of record, has filed substantive amendments to the claims which necessitated the examiner to extend the search. As such the examiner's actions with respect to the search of the instant application are reasonable and exhibit no improper conduct, including bias or the appearance of bias.

With respect to petitioners contentions that various statements in the October 19, 2012 Office action are arbitrary and capricious, the gravamen of applicant's complaint seems to be that the examiner continues to reject the claims on various statutory grounds, and applicant obviously disagrees with the rejections contained in the Office action of October 19, 2012. It should be noted that reasonable [people] can disagree as to whether a given claim is patentable and on what basis. See Lear, Inc. v. Adkins, 395 U.S. 653, 670, 162 USPQ 1, 8 (1969). A mere difference of opinion between the examiner and the applicant as to the patentability of one or more claims does not evidence bias, a lack of understanding, "an arbitrary or capricious act", or improper conduct on the part of the examiner, much less that their replacement is justified. Indeed, the examiner correctly observed that some of the rejections made in the Office action mailed October 19, 2012, should be withdrawn. This does not evidence bias or

“arbitrary and capricious” action on the part of the examiner; rather the examiner is merely attempting to clarify the record.

Moreover, applicant is reminded that any rejection of the claims cannot be reviewed on petition; rather, as explained in MPEP 1201, the mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Patent Trial and Appeal Board under 35 U.S.C. § 134 and 37 CFR 1.191. The issues of whether the rejections set forth in the last office action are “plagiarism” or “a falsification” relate to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a); see also Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). 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, 133 USPQ 39, 43 (CCPA 1962); Baylev's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

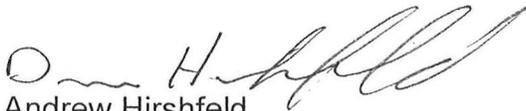
DECISION

For the reasons given above, petitioner has failed to adequately demonstrate bias or the appearance of bias towards applicant by the Technology Center Director, or the examiner. The petition is granted to the extent that the decision of the Technology Center Director dated May 14, 2013, has been reviewed, but is **denied** as to the request that the aforementioned decision be overturned. The examiner will not be replaced; no action will be taken against the examiner.

This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review of the petitionable questions only. See MPEP 1002.02.

This application is being referred to Technology Center 3600 for further processing.

Telephone inquiries related to this decision should be addressed to Petitions Examiner David Bucci at (571) 272-7099.



Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer