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In re Application of :
Corliss O. Burandt :
Application No. 07/516,757 : ON PETITION
Filed: April 30, 1990 :
Attorney Docket No.: 1004/00002 :

This is a decision on the petition filed September 22, 2012 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated August 29, 2012. The Technology Center Director refused to rescind the obvious-type double patenting rejection made in the non-final Office action of May 18, 2012 and indicated that the matter is appealable rather than petitionable.

The petition to overturn the decision of the Technology Center Director dated August 29, 2012, is **DENIED**.

BACKGROUND

A decision to revive the instant application was granted on July 30, 2010. This revival required a terminal disclaimer that disclaimed the period of abandonment of approximately fifteen (15) years.

After revival, the above identified application was referred to the Technology Center for additional examination.

During examination, a non-final Office action was mailed on May 18, 2012 that presented, among other matters, a nonstatutory obvious-type double patenting rejection based in part on the patent resulting from the parent application to the above identified application.

The nonstatutory obvious-type double patenting rejection was challenged in a petition filed July 18, 2012.

The decision of the Technology Center Director denying this petition was mailed on August 29, 2012.

The present petition was filed on September 22, 2012.

On September 24, 2012, the Office granted a petition to make the instant application special based on applicant's age, which accorded this application "special" status.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 USC 134(a) states:

> An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

37 CFR 41.31(a)(1) and (c) state:

> (a)(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.
>
> (c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

37 CFR 1.181(a)(1) states:

> Petition may be taken to the Director: 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.

37 CFR 1.2 states:

> All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and

> Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

MPEP § 1201 states, in pertinent part:

> 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.

MPEP § 1203 states, in pertinent part:

> Subject alone to diligent prosecution by the applicant, an application for patent that once has been made special and advanced out of turn by the United States Patent and Trademark Office (Office) for examination will continue to be special throughout its entire course of prosecution in the Office, including appeal, if any, to the Board.

OPINION

The petition asserts that an obvious-type double patenting (ODP) rejection is not possible when the term is already determined. The petition further suggests that the decision on revival mailed July 30, 2010 rendered a final decision regarding the patent term of this application such that a subsequent ODP rejection was precluded. This is not correct. The decision of July 30, 2010 was final with regard to the earlier matter of abandonment of the instant application and its effect on patent term, but was not a final decision on patent term for the application or a determination of patent term in light of the expired parent. The July 30, 2010 decision allowed further prosecution of the instant application, and revival is recognized as a separate matter from an ODP rejection. The Office is not precluded from requiring or accepting additional terminal disclaimers in this application when the terminal disclaimer relates to matters other than the previous period of abandonment. Multiple terminal disclaimers are permitted in an application, including the instant application.

Also, the official record for this application does not include an indication of a telephone interview in which the Office expressly stated that an ODP rejection would not be made in this case. In accordance with 37 CFR 1.2, the Office will not give attention to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

As the Technology Center Director correctly indicated, the ODP rejection is a matter for appeal under 35 USC 134 and 37 CFR 41.31. The ODP rejection relates to the merits of the claimed invention and patentability issues in dispute. Therefore, in accordance with MPEP 1201, the OPD rejection may be appealed. As review of this rejection is proper for appeal, this is not a petitionable matter under 37 CFR 1.181.

Any 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 not by way of petition. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468, 1472 (E.D. Va. 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 (formerly the Board of Patent Appeals and Interferences). *See In re Dickerson*, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); *Bayley's Restaurant v. Bailey's of Boston, Inc.*, 170 USPQ 43, 44 (Comm'r Pat. 1971).

Furthermore, the petition presents various items of case law supporting the contention that reversal of the double patenting rejection would be equitable. Since ODP is a judicially created doctrine, rather than a standard established by statute or regulation, consideration of the applicable case law presented here is appropriately addressed by the Patent Trial and Appeal Board during the appeal process.

The petition also asserts that some questions subject to judicial review may be decided by petition in appropriate circumstances. This was illustrated by citing the petition decision in *In re Oku* (Commissioner Decision in 07/453,762, October 27, 1992) in which prosecution was permitted to continue after the Commissioner decided that a decision of the Board of Patent Appeals and Interferences presented new terms of rejection such that Applicant should have an opportunity to respond. The present matter concerning an ODP rejection is notably distinct from the circumstances presented in *In re Oku* and is not an appropriate circumstance for deciding the present ODP matter by petition rather than appeal.

An ODP rejection may be overcome by a timely filed terminal disclaimer, an appropriate amendment of the claims at issue or the successful appeal of the rejection. Considering the limited term already available to this application if it is issued as a patent, the problems associated with the filing of a terminal disclaimer to overcome the ODP rejection are understood. However, the options of amending the claims or appealing the rejection remain viable for this application from the Office's perspective. Also, since this application has been accorded "special" status, consideration of the application may be expedited during the appeal process in accordance with MPEP 1203.

In addition, the Technology Center Director did not address the concerns raised regarding withdraw of terminal disclaimers other than the disclaimer provided for revival and the transition of examination for restricted claims. These concerns will not be addressed now in a review of the Technology Center Director's previous decision related to the ODP rejection.

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 the petition decision of August 29, 2012. 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 decision of the Technology Center Director of August 29, 2012 has been reviewed, but is denied with respect to making any change therein. As such, the decision of August 29, 2012 will not be disturbed. The petition is **denied**.

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.

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

Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy

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