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OFFICE OF PETITIONS

BASCH & NICKERSON LLP  
1777 PENFIELD ROAD  
PENFIELD NY 14526

In re Application of :  
Peter D. MCCANDLISH :  
Application No. 11/126,970 : DECISION ON PETITION  
Filed: May 11, 2005 :  
Attorney Docket No. 20040435-US-NP :

This is a decision on the petition, filed November 3, 2009, under 37 CFR 1.181 requesting the Director to exercise his supervisory authority and reconsider the decision of October 19, 2009, of the Acting Director, Technology Center 2600 (TC Director), which dismissed as moot the petition to withdraw the finality of the Office action mailed June 1, 2009.

The petition to overturn the TC Director's decision of October 19, 2009, is **DENIED**.

**BACKGROUND**

The instant application was filed on May 11, 2005. A final Office action was mailed on June 1, 2009. Applicant filed an after-final response on July 1, 2009, that was followed by the filing of a petition on July 24, 2009, requesting withdrawal of the finality of the Office action mailed on June 1, 2009. A Request for Continued Examination (RCE) was filed September 1, 2009. In a decision mailed October 19, 2009, the TC Director dismissed the petition as moot in view of the filing of the RCE. The instant petition was filed November 3, 2009, requesting the Director to exercise his supervisory authority and reconsider the TC Director's decision of October 19, 2009.

**STATUTE, REGULATION, AND EXAMINING PROCEDURE**

35 U.S.C. 132 Notice of rejection; reexamination

- (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.*

- (b) *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§ 1.114 Request for continued examination

- (d) *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.*

OPINION

Petitioner is requesting reconsideration on the grounds that the finality of the Office action dated June 1, 2009, is not a moot issue. Petitioner further contends that the fees paid in filing the RCE were never due in the first instance due to the alleged improper finality, and therefore is refundable.

The requested relief from an Office action allegedly made prematurely final has already been realized by way of petitioner's filing of a proper RCE request on September 1, 2009, that itself withdrew the contested finality and reopened prosecution. As such, there is no remaining condition of finality of that Office action to review, or overturn. See 37 CFR 1.114(d).

Petitioner's contention that "Contrary to the position of the Acting Group Director, the issue as whether or not the Examiner completely considered the substance of Applicant's arguments is central to the filing of the Request for Continued Examination" is untenable in view of the availability of other options to the applicant. An alternative to the filing of the RCE, while the finality issue was being reviewed on petition, was for the applicant to have filed a Notice of Appeal and to have the appeal duly perfected by filing the Appeal Brief. This alternative would have permitted the requested review on the petition of the procedural issue of finality while it remained in place, as well as a review of the merits of the contested rejections by the Board of Patent Appeals and Interferences. However, by voluntarily filing the RCE, petitioner has terminated the very condition of which he complained, i.e., the alleged premature finality of the Office action of June 1, 2009. Hence the issue of the premature final rejection is moot. As it is the voluntary action of petitioners, not that of the USPTO, that resulted in the lack of review of the very issues that the petitioner sought to have addressed, it is reasonable to expect petitioner to accept the consequences of such action(s).

The fee for filing an RCE is authorized by 35 USC § 132(b) and required by 37 CFR 1.114 and 1.17(e). Petitioners obtained the results for which they paid the fees: finality was withdrawn, and the examination was continued. See, for example, the non final Office action of November 24, 2009. Again, petitioners have obtained exactly what they requested and paid for. The patent statute and the rules of practice before the USPTO do not permit an applicant to file a conditional request and fee for continued examination, and depending on the subsequent events, obtain a refund of the fee(s).

For the reasons set forth above, the Technology Center Director's decision to refuse petitioner's requests to withdraw the finality of Office action of June 1, 2009 as moot is not shown to be in clear error.

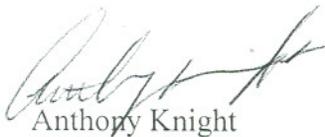
### DECISION

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 October 19, 2009. 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 October 19, 2009, has been reviewed, but is denied with respect to making any change therein. As such, the decision of October 19, 2009, will not be disturbed. The instant petition is **DENIED**<sup>1</sup>. The Director will undertake no further reconsideration or review of this matter.

This application is being referred to Technology Center 2600 for consideration of the response filed April 23, 2010.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272- 4914.



Anthony Knight  
Director,  
Office of Petitions

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<sup>1</sup> 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.