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MAILED

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OFFICE OF PETITIONS

In re Application of:	:	
Shunpei YAMAZAKI	:	
Application No. 08/386,187	:	ON PETITION
Filed: February 09, 1995	:	
Attorney Docket No. 740756-1193	:	

This is a decision on the renewed petition under 37 CFR 1.183, filed August 22, 2006, requesting waiver of 37 CFR 1.129(a). The petition was only recently brought to the attention of this office.

The renewed petition is DENIED¹.

BACKGROUND

Pre-Petition:

This continuation application was initially filed December 08, 1992 as Application Serial Number 07/987,160. The parent application, as well as this continuation, was docketed to Examiner Fleck, hereinafter referred to as the prior or previous or first Examiner, for examination up to at least the date of the final Office action mailed March 21, 1996 (Paper Nos. 1-29). Such final Office action rejected all the claims and included prior art rejections under 35 USC 103 based on the prior art combinations of Nakagawa et al '477 in view of Matsumura et al NCR, Tsai et al NCR in view of Matsumura et al NCR, Tsai et al NCR and Matsumura et al NCR further in view of Matsumura JJAP and Nakagawa et al '477 and Matsumura et al NCR further in view of Matsumura JJAP, 35 USC 112 objections and rejections and double patenting rejections. At the time of such mailing the application included 33 claims, reference to at least 15 applications and three IDS's and 3 PTO-892's citing at least 120 prior art references all signed by such previous Examiner.

An interview regarding such final Office action was held on May 09, 1996 between Petitioner's representative Mr. Ferguson and Examiner Kunemund, hereinafter referred to as the second Examiner. The May 09, 1996 Interview Summary (Paper No. 30) indicates no agreement was reached but the issues and certain prior art references were discussed. An after FINAL

amendment was filed on August 27, 1996 (Paper No. 31) and a Notice of Appeal (Paper No. 32) was filed September 24, 1996. An Advisory Action signed by the second Examiner (Paper No. 33) was mailed December 5, 1996 indicating such August 27, 1996 amendment would be entered and the “rejections over the prior art of record have been withdrawn by the examiner” (emphasis added) but objections and rejections under 35 USC 112 and double patenting rejections of the remaining 21 claims were being maintained.

An Appeal Brief (Paper No. 34) was filed on December 26, 1996. The Examiner’s Answer signed by the second Examiner (Paper No. 35) was mailed April 2, 1997. Petitioner filed a Reply Brief and request for Oral Hearing (Paper Nos. 36-37) on June 3, 1997, the former of which was noted by the second Examiner in a communication (Paper No. 38) mailed August 11, 1997. Two further communications filed October 3, 1997 and October 31, 1997 (Paper Nos. 39 and 41) regarding related litigation and patent applications were acknowledged by the second Examiner in Office communications (Papers Nos. 40 and 42) mailed October 17, 1997 and November 25, 1997, respectively.

On June 29, 1998 the instant application was officially docketed to the second Examiner. The Board of Patent Appeals and Interferences remanded this application back to the second Examiner on September 02, 1998 (Paper No. 44) for the resolution of various issues including the consideration of an IDS (Paper No. 43) filed June 09, 1998. The IDS did not include a certification under 37 CFR 1.97(d)(1) but did include authorization to charge a fee under 1.17(p).

A non-final rejection signed by the second Examiner (Paper No. 45), including a signed copy of the June 9, 1998 IDS citing 298 references, was mailed October 8, 1998. The non-final rejection not only maintained the prior 35 USC 112 objections and rejections and double patenting rejections, but added prior art rejections under 35 USC 103 based on the prior art combinations of Nakagawa et al ‘477 or Sony JP ‘2073 or Canon JP ‘968 in view of Tsai et al, JP ‘423 and JP ‘488, and Matsumura et al. The last paragraph of such Office Action states “This application has been withdrawn from the Board of Appeals due to Applicants information disclosure statement of June 9, 1998. The newly submitted information has led to reopening of prosecution in front of the examiner by the creation of a new grounds of rejection”.

On February 8, 1999 an amendment (Paper No. 53) was filed. The amendment cancelled all but 12 of the remaining claims and added 31 claims. On September 9, 1999 an interview was held between Petitioner’s representative, Mr. Robinson, and the second Examiner. The September 9, 1999 Interview Summary (Paper No. 52) indicates no agreement was reached but a declaration under 37 CFR 1.132 intended to be submitted was discussed.

A supplemental amendment including 27 additional claims and a declaration under 37 CFR 1.132 (paper No. 54) was filed on September 10, 1999. The second Examiner issued a final Office action on December 6, 1999 rejecting all 77 claims on the same grounds, i.e. the prior 35 USC 112 objections and rejections, double patenting rejections, and prior art rejections under 35 USC 103 based on the prior art combinations of Nakagawa et al ‘477 or Sony JP ‘2073 or Canon JP ‘968 in view of Tsai et al, JP ‘423 and JP ‘488, and Matsumura et al. were applied against all such claims, and finding the declaration of under 37 CFR 1.132 not persuasive.

It is further noted that prior to the issuance of the December 6, 1999 final Office action, at least two IDSs, one including a fee authorization (Paper No. 46) and one including a certification (Paper No. 51), were filed August 13, 1998 and July 12, 1999, respectively, and entered in this application. The former was acknowledged by the second Examiner in an Office communication (Paper No. 47) mailed December 14, 1998. Two other submissions, one entitled IDENTIFICATION OF CO-PENDING APPLICATIONS filed February 12, 1999 and one entitled SUBMISSION UNDER 2001.06(c) filed July 7, 1999 were received but not entered into the record. The record also does not indicate whether such were considered by the second Examiner. After issuance of the December 6, 1999 final Office action, two further IDSs, one including both a certification and fee authorization and one with only a fee authorization, were filed on May 2, 2000 and May 23, 2000, respectively. Again the record does not indicate whether such were considered by the second Examiner, i.e. they are not signed and initialed.

On June 8, 2000 Petitioner filed a second Notice of Appeal (Paper No. 58).

On December 19, 2000 a Notice of Abandonment was mailed. However, Petitioner had filed a response on December 6, 2000 prior to such abandonment which was not received by the PTO until December 11, 2000, nor entered into the record until subsequent to such Notice of Abandonment, Paper No. 59. Such response included an amendment (Paper No. 65) adding 15 claims, an IDS citing 30 references and drawing changes (Paper No. 64) and a request under 37 CFR 1.129 to withdraw finality of final Office action and four month extension of time (Paper No. 67).

Two copies of such response (Paper Nos. 60-63) were refiled along with a petition to revive under 37 CFR 1.137(a) on January 8, 2001.

Two further IDSs were filed May 31, 2001 and July 19, 2001, only the former was entered in the application (Paper No. 66). Again the record does not indicate whether such were considered by the second Examiner, i.e. they are not signed and initialed.

Petitions:

The petition to revive filed January 10, 2001 under 37 CFR 1.137(a) was forwarded to Office of Petitions where it was treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181. A decision on such petition (Paper No. 68) was mailed on September 7, 2001. The decision held that the second Examiner's Notice of Abandonment was premature and vacated such Notice. However, the decision also held that a request under 37 CFR 1.129 was not available to Petitioner since an Appeal Brief had been filed December 26, 1996 and that such was not considered a *bona fide* attempt to advance prosecution such that Petitioner was entitled to a new time period for response. Since the timely filed response to the final Office action did not include any of the acceptable courses of action, the instant application became abandoned by operation of law on January 8, 2001. Accordingly, the petition was DISMISSED and the application was abandoned.

A first PETITION (Paper No. 69) UNDER 37 CFR 1.183 TO SUSPEND THE PROVISIONS OF 37 CFR 1.129(a) was filed November 7, 2001 in response to the September 7, 2001 decision. The petition requested suspension or waiver of the provisions of 37 CFR 1.129 (a) in order to permit entry of the December 11, 2000 response based on the allegation that the second Examiner, if complying with 37 CFR 1.104(a)(1), (a)(2) and (b), could have and should have made the new grounds of rejection set forth initially in the October 8, 1998 Office Action prior to the filing of the Notice of Appeal on September 24, 1996, i.e. in lieu of issuing an Advisory action on December 5, 1996, and if such had so occurred, alleged that a request for continuation would have been filed rather than a Notice of Appeal, Appeal Brief and Reply Brief. The petition concludes with the reminder that compliance with an available course of action as referred to in the paragraph bridging pages 1-2 of the September 7, 2001 decision would detrimentally affect the term of any patent issuing from this application available to Petitioner and thereby, the requested suspension or waiver should be granted in the interests of fairness and equity. It is noted that the prior art combination set forth in the first full paragraph of page 2 of such petition does not correspond to that set forth in the final Office action of March 21, 1996.

On September 16, 2002, a decision dismissing such first petition was rendered. The decision concluded that that the first petition failed to show the existence of an extraordinary situation where justice requires waiver of the rule. Specifically, the decision set forth that the record failed to support the petition's contention that, barring the availability of 37 CFR 1.129(a) the petitioner was prejudiced to the extent that justice warrants the requested relief. The decision also found the prosecution ensuing the reopening of prosecution to be similar in nature to that intended under 37 CFR 1.129(a) and the lack of showing of error on the second Examiner's part in failing to raise the new grounds of rejection earlier necessitating the requested relief especially in light of the facts regarding the December 20, 1995 IDS.

A second renewed petition under 37 CFR 1.183, REQUEST FOR RECONSIDERATION of the September 16, 2002 DECISION ON PETITION, (Paper No. 73) was filed January 7, 2003. The petition requested reconsideration based on the grounds that 1) the spirit and intent of 37 CFR 1.129 was ignored by the petition, 2) Petitioner would suffer extreme prejudice and hardship from the denial of Petitioner's request, 3) precedent exists to grant fair and equitable relief requested by Petitioner and 4) the decision in order to justify the denial of the request obscures the relevant facts and ignores the underlying action leading to Petitioner's request for relief, namely the failure of the Patent Office to timely assert cited prior art.

On August 19, 2004 a decision dismissing such renewed petition was issued. The decision concluded that such renewed petition appeared to overlook facts which distinguished the decision on a petition in 07/895,229, which decision was relied upon as precedent for the requested relief, from the facts of the instant application as well as reiterated the grounds for dismissal set forth in the first decision.

A third renewed petition under 37 CFR 1.183, RENEWED REQUEST FOR RECONSIDERATION of the August 19, 2004 DECISION ON PETITION, (Paper No. 75) was filed March 30, 2005. The petition requests reconsideration based on the grounds set forth in the second renewed petition as well as requests that should such petition again be found not

persuasive that the petition be denied rather than dismissed, i.e. requests final agency action to permit opportunity to seek judicial review.

THE STANDARD

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.129(a) provides that:

(a) An applicant in an application, other than for reissue or a design patent, that has been pending for at least two years as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. 120, 121 and 365(c), is entitled to have a first submission entered and considered on the merits after final rejection under the following circumstances: The Office will consider such a submission, if the first submission and the fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the final rejection is automatically withdrawn upon the timely filing of the submission and payment of the fee set forth in § 1.17(r). If a subsequent final rejection is made in the application, applicant is entitled to have a second submission entered and considered on the merits after the subsequent final rejection under the following circumstances: The Office will consider such a submission, if the second submission and a second fee set forth in § 1.17(r) are filed prior to the filing of an appeal brief and prior to abandonment of the application. The finality of the subsequent final rejection is automatically withdrawn upon the timely filing of the submission and payment of the second fee set forth in § 1.17(r). Any submission filed after a final rejection made in an application subsequent to the fee set forth in § 1.17(r) having been twice paid will be treated as set forth in § 1.116. A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.

37 CFR 1.104(a)(1), (a)(2) and (b) provides that:

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

MPEP 704.01 provides that:

PREVIOUS EXAMINER'S SEARCH

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the application or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See MPEP § 719.05.

MPEP 706.04 provides that:

PREVIOUS ACTION BY DIFFERENT EXAMINER

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 126 F. Supp. 2d 69, 139, 57 USPQ2d 1449, 1499-50 (D. Mass. 2001).

MPEP 1214.04 provides that:

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 41.50(b), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or ex parte reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

(Emphasis added.)

MPEP 609.04(a) provides that:

CONCISE EXPLANATION OF RELEVANCE FOR NON-ENGLISH LANGUAGE INFORMATION

Each information disclosure statement must further include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information listed that is not in the English language. The concise explanation may be either separate from the specification or part of the specification. If the concise explanation is part of the specification, the IDS listing should include the page(s) or line(s) numbers where the concise explanation is located in the specification.

The requirement for a concise explanation of relevance is limited to information that is not in the English language. The explanation required is limited to the relevance as understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office. If a complete translation of the information into English is submitted with the non-English language information, no concise explanation is required. An English-language equivalent application may be submitted to fulfill this requirement if it is, in fact, a translation of a foreign language application

being listed in an information disclosure statement. There is no requirement for the translation to be verified. Submission of an English language abstract of a reference may fulfill the requirement for a concise explanation. Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report. The requirement for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a United States application which is not relied on under 35 U.S.C. 120.

If information cited or submitted in a prior application relied on under 35 U.S.C. 120 was not in English, a concise explanation of the relevance of the information to the new application is not required unless the relevance of the information differs from its relevance as explained in the prior application.

The concise explanation may indicate that a particular figure or paragraph of the patent or publication is relevant to the claimed invention. It might be a simple statement pointing to similarities between the item of information and the claimed invention. It is permissible but not necessary to discuss differences between the cited information and the claims. However, see *Semiconductor Energy Laboratory Co. v. Samsung Electronics Co.*, 204 F.3d 1368, 1376, 54 USPQ2d 1001, 1007 (Fed. Cir. 2000) ("[A]lthough MPEP Section 609A(3) allows the applicant some discretion in the manner in which it phrases its concise explanation, it nowhere authorizes the applicant to intentionally omit altogether key teachings of the reference.").

In *Semiconductor Energy Laboratory*, patentee during prosecution submitted an untranslated 29-page Japanese reference as well as a concise explanation of its relevance and an existing one-page partial English translation, both of which were directed to less material portions of the reference. The untranslated portions of the Japanese reference "contained a more complete combination of the elements claimed [in the patent] than anything else before the PTO." 204 F.3d at 1376, 54 USPQ2d at 1005. The patentee, whose native language was Japanese, was held to have understood the materiality of the reference. "The duty of candor does not require that the applicant translate every foreign reference, but only that the applicant refrain from submitting partial translations and concise explanations that it knows will misdirect the examiner's attention from the reference's relevant teaching." 204 F.3d at 1378, 54 USPQ2d at 1008.

Although a concise explanation of the relevance of the information is not required for English language information, applicants are encouraged to provide a concise

explanation of why the English-language information is being submitted and how it is understood to be relevant. Concise explanations (especially those which point out the relevant pages and lines) are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents are submitted and applicant is aware that one or more are highly relevant to patentability.

OPINION

The request for relief throughout the prosecution history is based on Petitioner's allegation of the failure of the Patent Office to properly examine the subject application in compliance with 37 CFR 1.104. Specifically it is alleged the Patent Office erred by failing to raise the new grounds of rejection prior to Applicant's filing of an Appeal Brief and thereby, precluded availability of the transitional practice under 37 CFR 1.129(a) thereto. See last sentence of the paragraph bridging pages 2-3 of the March 30, 2005 request and page 8, lines 10-13 of the December 31, 2002 request. However, such basis is not consistent either with the prosecution history of the instant application nor the Rules of Practice in light thereof.

Specifically, 37 CFR 1.104 assigned the first or prior Examiner with certain duties or responsibilities. MPEP 704.01, 706.04 and MPEP 1214.04 further mandate that any second or subsequent Examiner when assigned to act on an application which has received one or more actions by some other examiner, give full faith and credit to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. Petitioner is relying on reopening of prosecution in October 1998 by the second Examiner in light of review of the December 20, 1995 IDS only by the first Examiner as justification for the relief requested. However, not only did such IDS not cite at least one of the prior art references relied upon by the second Examiner in the prior art rejections of October 1998, i.e. JP '2073, but such was not yet assigned to the second Examiner. Furthermore, even when such application was so assigned to the second Examiner, the second Examiner was mandated to give full faith and credit to the search and action of the first or previous examiner unless there was clear error. There is no showing that such clear error existed and that the second Examiner was cognizant of such clear error with regard to the application until consideration of the IDS filed the June 9, 1998 citing not only JP '2073 for the first time but also presenting JP '968, JP '423 and JP '488 directly to the second Examiner for the first time as well as the second Examiner's knowledge of the Nakagawa et al and Matsumura et al references from the first or previous Examiner's prior art rejections pending at the time of assignment to the second Examiner. Petitioner's assertions as to what choices and decisions would have ensued reopening prosecution rather than issuance of the Advisory action are, at best, speculative in hindsight. Accordingly there is no showing of the failure on the part of the Patent Office to timely assert the cited prior art or, in other words, the action alleged by Petitioner to justify the grant of the requested relief.

Likewise the allegation that the spirit and intent of 37 CFR 1.129 was ignored by the previous decisions is not consistent with the prosecution history. Such intent was addressed in the first

dismissal of the first petition under 37 CFR 1.183. See decision of SEPTEMBER 16, 2002, the paragraph bridging pages 1-2 and the first full paragraph of page 2 and page 5, last full paragraph. In short, the intent, i.e. to facilitate completion of prosecution by permitting applicants to present submissions after a final rejection has been issued, was met by the mailing/filing of at least 30 documents including at least three IDSs citing at least 300 additional references, amendments adding at least 44 claims, communications including evidence of litigation, and a declaration under 37 CFR 1.132 over a period of at least 3 and a half years by Petitioner. Additionally, the impact of any patent term loss as argued by Petitioner is at least speculative absent corroborative evidence and at best premature since no claims were indicated as allowable and were under appeal at the time of abandonment.

As to the allegation that when faced with the improper and unjust rejection, Petitioner had “no choice” but to appeal rather than continue prosecution under 37 CFR 1.129(a). Petitioner states on page 2 of the March 30, 2005 petition that “[P]roceeding under 37 CFR 1.129 requires a further ‘submission,’ such as an Information Disclosure Statement, an amendment to the written description, claims or drawings or new substantive argument or new evidence in support of patentability” and that “[S]uch ‘submission’ was unnecessary and improper in that the then pending rejections were erroneous and ripe for appeal”. However, 37 CFR 1.129(a) as set forth supra, states “A submission as used in this paragraph includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims or drawings and a new substantive argument or new evidence in support of patentability.” (Emphasis added). Therefore, according to the facts of record, arguments and/or evidence as to the improper and unjust nature of the pending rejection could just as well have been made in a “submission” had Petitioner elected to proceed under 37 CFR 1.129(a) as in an appeal brief. Accordingly, Petitioner did have a choice and filed a brief on appeal based on the decision that a “submission”, i.e. proceeding under 37 CFR 1.129(a), “was unnecessary and improper in that the then pending rejections were erroneous and ripe for appeal”.

Finally the allegation that precedent exists to grant the relief requested is not consistent either with the instant prosecution history nor that of the ‘229 application alleged to present or support such precedent. Specifically as set forth in the August 14, 2004 dismissal the prosecution history’s of the respective applications differ in that in the ‘229 application the Appeal Brief was filed prior to existence of 37 CFR 1.129 whereas in the instant application the Appeal Brief was filed after the creation of such rule. The allegation that the ‘229 application petition decision on such facts indicates not only the grant of the requested relief is other than extraordinary but even possibly routine is not well taken. It is exactly such facts that not only distinguish the two applications but predicate the conclusion that an extraordinary situation presented itself in ‘229 and not in the instant application.

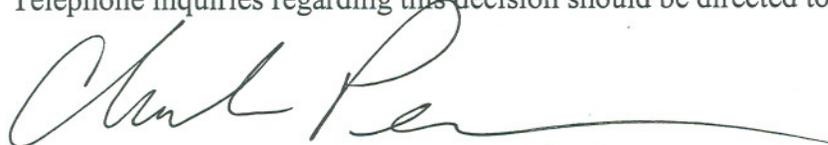
Accordingly the petition(s) fail to establish the existence of an extraordinary situation, i.e. one of extreme prejudice and hardship, where justice requires the relief requested, i.e. waiver of 37 CFR 1.129.

CONCLUSION

For the above stated reasons, this renewed petition pursuant to 37 CFR 1.183 is denied.

After mailing of this decision, this application is being returned to Technology Center 1765 for such action as is appropriate.

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

A handwritten signature in black ink, appearing to read "Charles A. Pearson". The signature is fluid and cursive, with a long horizontal flourish extending to the right.

Charles A. Pearson
Director, Office of Petitions
United States Patent and Trademark Office

¹ This decision may be regarded as a final agency action within the meaning of 5 U.S.C. 704 for the purposes of seeking judicial review. See MPEP 1002.02.