



STMICROELECTRONICS, INC.
MAIL STATION 2346
1310 ELECTRONICS DRIVE
CARROLLTON TX 75006

COPY MAILED

MAR 03 2008

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Jefferson Eugene OWEN et al. :
Application No. 09/207,554 :
Filed: December 8, 1998 :
Attorney Docket No. 119932-1023 :

This is a decision on the petitions filed July 1, 2005, (and resubmitted July 31, 2006, November 20, 2006, February 9, 2007, and February 11, 2008) under 37 CFR 1.181(a)(3) requesting the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2600 (Technology Center Director), dated April 25, 2005, which refused to: (1) withdraw the holding of abandonment; (2) enter a substitute brief of appeal; (3) enter an Examiner's Answer; and (4) forward the application to the Board of Patent Appeals and Interferences, and under 37 CFR 1.26 requesting a refund of the extension of time fee charged in the decision of the Technology Center Director dated April 25, 2005.

The petition to overturn the decision of the Technology Center Director dated August 31, 2005, is **DENIED**¹.

The petition for refund is **DISMISSED AS MOOT**.

BACKGROUND

The instant application was filed December 8, 1998.

The application was amended once prior to a first Office action being mailed on April 17, 2001.

An amendment was filed August 20, 2001.

On November 9, 2001 a final Office action was mailed.

On January 28, 2002 an amendment was filed.

On February 1, 2002 an Advisory Action was mailed.

On February 19, 2002 an amendment was filed.

On March 14, 2002 an Advisory Action was mailed.

On April 4, 2002 a Continued Prosecution Application was filed.

On May 3, 2002 a non-final Office action was mailed.

On July 22, 2002 a request for reconsideration was filed.

On October 7, 2002 a final Office action was mailed.

On February 7, 2003 a response and a Notice of Appeal were filed.

On March 6, 2003 an Advisory action was mailed.

On May 29, 2003 an Appeal Brief was filed.

On August 5, 2003 a Notice of Non-Compliance with 37 CFR 1.192(c) was mailed.

On September 5, 2003 a response to the Notice of Non-Compliance and a Substitute Brief on Appeal were filed.

On December 3, 2003 a Notice of Dismissal of Appeal and a Notice of Abandonment were mailed.

On July 20, 2004 a petition to invoke supervisory authority was filed.

On April 25, 2005 a decision denying the petition filed July 20, 2004 was mailed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.26(b) states:

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based

upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

37 CFR 1.192(c)(7) states:

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(7) *Grouping of claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

37 CFR 1.192(d) states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

MPEP 1206 states:

(7) *Grouping of Claims.* For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone, unless a statement is included that the claims of the group do not stand or fall together and, in the argument section of the brief (37 CFR 1.192(c)(8)), appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable. If an appealed ground of rejection applies to more than one claim and appellant considers the rejected claims to be separately patentable, 37 CFR

1.192(c)(7) requires appellant to state that the claims do not stand or fall together, and to present in the appropriate part or parts of the argument under 37 CFR 1.192(c)(8) the reasons why they are considered separately patentable.

37 CFR 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c) (8) (iii)). In the absence of a separate statement that the claims do not stand or fall together, the Board panel assigned to the case will normally select the broadest claim in a group and will consider only that claim, even though the group may contain two broad claims, such as "ABCDE" and "ABCDF." The same would be true in a case where there are both broad method and apparatus claims on appeal in the same group. The rationale behind the rule, as amended, is to make the appeal process as efficient as possible. Thus, while the Board will consider each separately argued claim, the work of the Board can be done in a more efficient manner by selecting a single claim from a group of claims when the appellant does not meet the requirements of 37 CFR 1.192(c)(7).

It should be noted that 37 CFR 1.192(c)(7) requires the appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered. The appellant must (A) state that the claims do not stand or fall together and (B) present arguments why the claims subject to the same rejection are separately patentable. Where the appellant does neither, the claims will be treated as standing or falling together. Where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "Argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). *Ex parte Schier*, 21 USPQ2d 1016 (Bd. Pat. App. & Int. 1991); *Ex parte Ohsumi*, 21 USPQ2d 1020 (Bd. Pat. App. & Int. 1991).

The usual period of time in which appellant must file his or her brief is 2 months from the date of appeal. The Office date of receipt of the notice of appeal (and not the date indicated on any Certificate of Mailing under 37 CFR 1.8) is the date from which this 2 month time period is measured. See MPEP § 512.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for action on the allowed claims. See MPEP § 1215.04. If there are no allowed claims, the application is abandoned as of the date the brief was due.

OPINION

Petitioners specifically request that the Director overturn the Technology Center Director's decision of August 25, 2005 and (1) withdraw the holding of abandonment; (2) enter the substitute brief on appeal; (3) enter an Examiner's Answer; and (4) forward the application to the Board of Patent Appeals and Interferences.

Petitioners were notified in the Notification of Non-Compliance with 37 CFR 1.192(c) mailed August 5, 2003 that the Appeal Brief filed May 29, 2003 was defective because: (1) a single ground of rejection has been applied to two or more claims in this application, and the brief includes the statement required by 37 CFR 1.192(c)(7) that one or more claims do not stand or fall together, yet does not present arguments in support thereof in the argument section of the brief; and (2) under the "Grouping of Claims" section of the Brief there is a showing of overlapping claims in the different groupings and it is unclear how claim 1 of Group A is separately patentable from claim 1 of Group B, for example. Additionally, Petitioners were notified in the Notice of Abandonment mailed December 3, 2003 that the overlapping claims as presented in the different groupings is improper because 37 CFR 1.192(c)(7) requires appellant to explain why the claims of the group are believed to be separately patentable and merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

Petitioners argue that the grouping of claims in the substitute Brief on Appeal was not improper and thus, the Examiner exceeded his authority in holding the application abandoned for Petitioner's failure to adhere to the Examiner's interpretation as to the meaning of "Grouping of Claims". It is further contended by Petitioners that: (1) the Appeal Brief logically organized the "claim in groups" according to the common claim limitations on which patentability arguments were based, rather than strictly according to the particular grouping the Examiner chose in applying different combinations of references in making anticipation/obviousness rejections; (2) through this organization, the same argument(s) for patentability applied to all claims in a given group, rather than repeating arguments for different groups of claims rejected on different grounds; (3) this organization facilitates consideration to the arguments – and the corresponding claims – on appeal in a more efficient manner; (4) MPEP 1206 and 37 CFR 1.192(c)(7) do not support the conclusion that an appellant must group the claims in accordance with the

grounds of rejection, instead, they simply identify the minimum required by an appellant to have claims subject to a common grounds of rejection considered separately; and (5) 37 CFR 1.192(c)(7) explicitly requires grouping of claims in a manner allowing an explanation of why all claims within a particular group are separately patentable, independent of any decision made with respect to any other group of claims and thus, the rule did not preclude overlapping groups of claims merely because a single claim happens to fall within multiple groups. Additionally, Petitioners state the decision of April 25, 2005 is directed to an issue that has been rendered moot by recent changes in the rules governing appeals.

At the outset it is noted that whether or not Petitioners' arrangement of the claims according to claim limitations was more efficient or whether the rules have subsequently been changed is immaterial to the issue at hand. Here, the issue is whether or not Petitioners complied with 37 CFR 1.192(c)(7), the reason for non-compliance of the Appeal Brief with the Rule in effect at the time of the action complained of. 37 CFR 1.192(c)(7) states that "the brief shall contain... (7) Grouping of claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable." MPEP 1206 further clarifies this as it states that 37 CFR 1.192(c)(7) requires appellant to perform two affirmative acts in his or her brief in order to have the separate patentability of a plurality of claims subject to the same rejection considered the appellant must: (1) (A) state that the claims do not stand or fall together and (B) present arguments as to why the claims subject to the same rejection are separately patentable; and (2) where, however, the appellant (A) omits the statement required by 37 CFR 1.192(c)(7) yet presents arguments in the argument section of the brief, or (B) includes the statement required by 37 CFR 1.192(c)(7) to the effect that one or more claims do not stand or fall together (i.e., that they are separately patentable) yet does not offer argument in support thereof in the "argument" section of the brief, the appellant should be notified of the noncompliance as per 37 CFR 1.192(d). [Emphasis added]. A grounds of rejection is a rejection of claim(s) based on a common set of prior art reference(s) or reasons, and the final Office action from which the appeal is taken included a total of five (5) grounds of rejection, one (1) based upon 35 U.S.C. 102 and four (4) based upon 35 U.S.C. 103. First with respect to Petitioners argument that 37 CFR 1.192(c)(7) contains permissive language, the rule does not contain permissive language as it utilizes the word "shall" and, thus directs or requires the act of appellant grouping the claims in accordance with the grounds of rejection. Next, with respect to Petitioners' argument that the rule did not preclude overlapping groups of claims merely because a single claim happens to fall within multiple groups, MPEP 1206 clearly

states: "37 CFR 1.192(c)(7) requires the inclusion of reasons in order to avoid unsupported assertions of separate patentability. The reasons may be included in the appropriate portion of the "Argument" section of the brief. For example, if claims 1 to 4 are rejected under 35 U.S.C. 102 and appellant considers claim 4 to be separately patentable from claims 1 to 3, he or she should so state in the "Grouping of claims" section of the brief, and then give the reasons for separate patentability in the 35 U.S.C. 102 portion of the "Argument" section (i.e., under 37 CFR 1.192(c) (8) (iii))." Therefore, the supplemental brief fails to comply with the rule.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' requests to: (1) withdraw the holding of abandonment; (2) enter the substitute brief of appeal; (3) enter an Examiner's Answer; and (4) forward the application to the Board of Patent Appeals and Interferences is not shown to be in clear error.

With respect to Petitioner's request for a refund of the \$320 extension of time fee for a second month, the Notice of Appeal was received on February 20, 2003 and the Appeal Brief was filed with a certificate of mailing of May 20, 2003. Therefore, the second month extension of time was unnecessary and was refunded on August 19, 2005.

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 25, 2005. 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 25, 2005 has been reviewed, but is denied with respect to making any change therein. As such, the decision of August 25, 2005 will not be disturbed. The petition is **denied**.

This application file is being forwarded to Files Depository.

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



John Love
Deputy Commissioner for
Patent Examination Policy

cp/db

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