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In re Application of :
Schlessmann, et al. :
Application No. 11/336,526 :
Filed: January 20, 2006 :
Patent No. 7,331,276 :
Issued: February 19, 2008 :
Attorney Docket No.: A 92 528/LR :

ON PETITION

This is a decision on the petition filed February 25, 2009, which is being treated as a petition 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 January 6, 2009. The decision refused entry of an amendment submitted under 37 CFR 1.312 with the issuance of a Certificate of Correction.

The petition to overturn the decision of the Technology Center Director dated January 6, 2009, is **DENIED**.

BACKGROUND

The instant application was filed with original claims 1-20. Claim 13 depended from claim 1, and claims 15 and 16 each depended from claim 13.

Original claims 1-20 were addressed in an office action mailed May 24, 2007 in which claims 1-3, 7-10 and 13-20 were rejected and claims 4-6, 11 and 12 were objected to.

In an amendment filed August 23, 2007, among other changes, claim 1 was amended to include the limitations of originally dependent claim 4 and claims 15 and 16 were canceled. Original claim 13 depended from amended claim 1.

The amended and new claims (1-3, 5-7, 9, 11-14 and 17-22) were then allowed, as noted in the Notice of Allowability mailed September 18, 2007.

After the patent was issued, an amendment under 37 CFR 1.312 was presented having a certificate of mailing of October 18, 2007. In that amendment, original claims 15 and 16 were represented as depending from claim 13, which depended from amended claim 1. The USPTO has no record of receiving an amendment under 37 CFR 1.312 mailed October 18, 2007 for the above noted application prior to issue.

On August 1, 2008, the amendment under 37 CFR 1.312 was addressed as a request for a Certificate of Correction and its entry was denied.

On August 7, 2008, a petition was filed requesting entry of the amendment under 37 CFR 1.312.

On October 9, 2008 a decision dismissing this petition was mailed.

On December 8, 2008, a request for reconsideration of the decision to dismiss the petition was filed.

On January 6, 2009 a decision denying this petition was mailed.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 USC 131 states:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 USC 132(a) states:

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.

35 USC 151 states:

If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Director as though no abandonment or lapse had ever occurred.

37 CFR 1.121 states(c):

Claims. Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a status of "currently amended," and be submitted with markings to indicate the

changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of "currently amended," or "withdrawn" if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as "withdrawn-currently amended."

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, i.e., without any markings in the presentation of text. The presentation of a clean version of any claim having the status of "original," "withdrawn" or "previously presented" will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of "withdrawn" or "previously presented." Any claim added by amendment must be indicated with the status of "new" and presented in clean version, i.e., without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of "canceled" or "not entered."

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

37 CFR 1.312 states:

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue.

MPEP 714.16 states in pertinent part:

Consideration of an amendment under 37 CFR 1.312 cannot be demanded as a matter of right. Prosecution of an application should be conducted before, and

thus be complete including editorial revision of the specification and claims at the time of the Notice of Allowance.

As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show:

- (A) why the amendment is needed;
- (B) why the proposed amended or new claims require no additional search or examination;
- (C) why the claims are patentable; and
- (D) why they were not presented earlier.

37 CFR 1.312 was never intended to provide a way for the continued prosecution of an application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient:

- (A) an additional search is required;
 - (B) more than a cursory review of the record is necessary; or
 - (C) the amendment would involve materially added work on the part of the Office, e.g., checking excessive editorial changes in the specification or claims.
- Where claims added by amendment under 37 CFR 1.312 are all of the form of dependent claims, some of the usual reasons for nonentry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of January 6, 2009, on the ground that the decision erred in determining that the reinstatement of cancelled claims 15 and 16 would have required further examination. Petitioner asserts that since the limitations of amended claim 1 have already been considered with regard to dependent claim 13, a further limiting of claim 13 would not require further examination, citing In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) in support of the proposition that if an independent claim is not obvious, then any claim depending therefrom is not obvious.

However, the Federal Circuit's decision in Fine only addressed the non-obvious requirements of 35 USC 103. The Technology Center Director did not suggest that

further examination was needed to ensure compliance with 35 USC 103 and. Therefore, the decision in Fine is not dispositive here.

As the Technology Center Director correctly recognized, the alleged invention must be entitled to a patent **under the law** pursuant to 35 USC 131. This requires the examiner to review the claims for compliance with **all** relevant portions of the patent statute, including sections 101 and 112, and notify the applicant in accordance with 35 USC 132 if necessary.

35 USC 132(a) provides that, after the first examination of an application, the applicant may amend and obtain reexamination of the application. See 35 U.S.C. 132(a) ("if after receiving [the first Office action], the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined"). 35 USC 151 does not provide any corresponding right to amend an application after a notice of allowance has been issued in an application. See 35 USC 151. Therefore, an amendment under 37 CFR 1.312 is not entered as a matter of right but at the discretion of the USPTO. See 37 CFR 1.312; see also MPEP 714.16. In addition, such an amendment is not intended for the purpose of continuing prosecution but to correct minor matters that do not involve more than a cursory review of the record. See MPEP 714.16. Here, more than a cursory review would be necessary due to the required examination beyond 35 USC 103. Moreover, the amendment was not accompanied by the required showing as to why the amendment was needed; why the proposed amended or new claims require no additional search or examination; why the claims are patentable; and why they were not presented earlier.

Also, the reintroduction of original claims 15 and 16 in the amendment under 37 CFR 1.312 after the cancellation of original claims 15 and 16 did not comply with 37 CFR 1.121. Since claim 1 was amended, a further limiting of dependent claim 13 by additional claims involved the introduction of new claims. That is, the claims identified as original claims 15 and 16 in the amendment under 37 CFR 1.312 were actually misnumbered and misidentified new claims. Each of these new claims presented a claim scope that was not examined for compliance with all relevant portions of the patent statute. For example, the new claims were not examined for compliance with 35 USC 112. These new claims should have been numbered as claims 23 and 24 and presented in time for examination of those claims. See 37 CFR 1.121(c)(5). Moreover, the USPTO has no record of receiving the amendment prior to issue such that examination could have occurred, contrary to petitioners assertion. If the amendment had been timely received, it would not have been entered since it did not comply with 37 CFR 1.121.

Since the application has now matured into a patent, the new claims cannot be examined absent a request for reissue or a reexamination of the patent. This is true despite the alleged submission of the amendment on October, 18, 2007, prior to the

date the patent was issued. The patent owner(s) have not made a request for reissue or reexamination. The proposed addition of the new claims after issuance of the patent is recognized as a request for a Certificate of Correction. However, a Certificate of Correction would not be appropriate in this instance. USPTO records do not clearly disclose that there was a mistake by the USPTO such that the claims could now be added pursuant to 35 USC 254. Moreover, any mistake in not adding the new claims prior to issue was not a mistake of a clerical or typographical nature, or of minor character, such that the claims could now be added pursuant to 35 USC 255.

For the reasons set forth above, the Technology Center Director's decision refusing entry of an amendment submitted under 37 CFR 1.312 is not shown to be in clear error.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of January 6, 2009. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of January 6, 2009 has been reviewed, but is denied with respect to making any change therein. As such, the decision of January 6, 2007 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.



Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

cp/db