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| 16/632,567 | 01/21/2020 | Dominique POIRIER | 2017-038-03 | 1075 |
| 25277 | 7590 | 12/13/2022 | EXAMINER | |
| National Research Council of Canada 1200 Montreal RD., Bldg. M-55, Room 29 OTTAWA, ONTARIO K1A 0R6 CANADA | | | HILL, STEPHANI A | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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In re Application of :
National Research Council of Canada :
Application No. 16/632,567 :
Filed: 21 Jan 2020 : DECISION ON PETITION
For: METHOD FOR PREPARING :
POWDERS FOR A COLD SPRAY :
PROCESS, AND POWDERS THEREFOR :

This is a decision on the petition under 37 CFR 1.181 filed September 9, 2022, requesting that the Director exercise supervisory authority and review the decision of August 16, 2022, by the Director of Technology Center 1700 (Technology Center Director) which decision refused to withdraw finality of the Office action issued on January 4, 2022, and reopen prosecution of the instant application.

The petition to withdraw finality of the Office action issued January 4, 2022, and reopen prosecution in the instant application is **DENIED**.

RELEVANT BACKGROUND

The instant application entered the national stage on January 21, 2020.

Prosecution in the instant application resulted in a non-final Office action being issued on October 12, 2021. The Office action of October 12, 2021, included, *inter alia*: (1) a restriction requirement between Groups I and II on the basis of lack of unity; (2) an oral election of Group II (claims 24, 25, and 27 through 29) from an agent of record, without traverse; (3) drawing objections; (4) a rejection of claim 27 under 35 U.S.C. § 112(a) as failing to comply with the enablement requirement; (5) a rejection of claims 25 and 27 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention; (6) a rejection of claims 24, 25, 27, and 29 under 35 U.S.C. § 103 as being unpatentable over Ray (U.S. Patent No. 4,318,733; hereinafter “Ray”), as evidenced by AZoM (“Particle Size – US Sieve Series and Taylor Mesh Size Equivalents,” hereinafter “AZoM”); and (7) a rejection of claim 28 under 35 U.S.C. § 103 as being unpatentable under Ray as evidenced by AZoM, and further in view of ASTM B933-16 (ASTM B9933-16, “Standard Test Method for Microindentation Hardness of Powder Metallurgy Materials,” hereinafter “ASTM”).

A reply to the Office action of October 12, 2021, was filed on December 1, 2021. The reply of December 1, 2021, included *inter alia*: (1) a written traverse of the restriction requirement; (2) affirmation of the election of Group II; (3) an amendment to the drawings; (4) claim amendments; and (5) arguments directed to the rejections under 35 U.S.C. §§ 112 and 103. An information disclosure statement accompanied by the fee set forth in 37 CFR 1.17(p) was received on December 10, 2021.

A final Office action was issued on January 4, 2022. The Office action of January 4, 2022, included, *inter alia*: (1) a response to petitioner's arguments presented in the reply filed on December 1, 2021; (2) an objection to claim 25; (3) a rejection of claim 27 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement; (4) a rejection of claim 25 under 35 U.S.C. 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention; (5) a rejection of claims 24, 25, and 27 under 35 U.S.C. § 103 as being unpatentable over Ray, as evidenced by AZoM; and (6) a rejection of claim 28 under 35 U.S.C. § 103 as being unpatentable under Ray as evidenced by AZoM, and further in view of ASTM.

An after-final reply to the Office action of January 4, 2022, was filed on March 3, 2022. The reply of March 3, 2022, included a proposed claim amendment, a request for reconsideration of the rejections under 35 U.S.C. § 112 and 103, and a request for withdrawal of finality of the Office action of January 4, 2022.

An advisory action was issued on March 22, 2022. The advisory action of March 22, 2022, entered the claim amendment, but found that the request for reconsideration did not place the application in condition for allowance. The advisory action further maintained the finality of the Office action of January 4, 2022.

A notice of appeal and a petition under 37 CFR 1.181 were filed on May 20, 2022. The petition of May 20, 2022, was dismissed by the Technology Center Director in a decision issued on August 16, 2022.

An appeal brief was filed on July 20, 2022.

The instant petition under 37 CFR 1.181 was filed on September 9, 2022.

An examiner's answer was issued on September 13, 2022.

A request for continued examination (RCE) and a claim amendment were filed on November 10, 2022.

STATUTES AND REGULATIONS

35 U.S.C. § 132(a) provides that:

(a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify, the application 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).

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, *see* § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.114 provides that:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;
(2) Abandonment of the application; or
(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(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.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;
- (4) An application for a design patent;
- (5) An international design application; or
- (6) A patent under reexamination.

37 CFR 1.181(a) provides that:

Petition may be taken to the Director:

(1) 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 Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

37 CFR 1.97 provides in part:

(b) An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

- (1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);
- (2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application;
- (3) Before the mailing of a first Office action on the merits;
- (4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114; or
- (5) Within three months of the date of publication of the international registration under Hague Agreement Article 10(3) in an international design application.

(c) An information disclosure statement shall be considered by the Office if filed after the period specified in paragraph (b) of this section, provided that the information disclosure statement is filed before the mailing date of any of a final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in § 1.17(p).

OPINION

Petitioner requests withdrawal of the finality of the Office action of January 4, 2022, on the basis that the Office action of January 4, 2022, is the first "action on the merits" and not a "second or subsequent action on the merits."

I. The request to withdraw finality of the Office action of January 4, 2022, is rendered moot by the filing of a request for continued examination.

The filing of a request for continued examination on November 10, 2022, rendered moot any request to withdraw the finality of the Office action of January 4, 2022. 37 CFR 1.114(a) provides that an applicant may request continued examination of an application if, *inter alia*, prosecution in an application is closed. 37 CFR 1.114(b) defines prosecution of the application being closed for the purposes of a request for continued examination as meaning that "the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application. See 37 CFR 1.114(b). When a request for continued examination in compliance with 37 CFR 1.114 is filed 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. See 37 CFR 1.114(d).

In the instant application, a request for continued examination, including a submission (a claim amendment and accompanying arguments) and the fee set forth in 37 CFR 1.17(e), was timely

filed on November 10, 2022. As provided in 37 CFR 1.114(d), the appeal has been withdrawn, the finality of the Office action of January 4, 2022, has been withdrawn, and prosecution has been reopened as a consequence of the filing of the request for continued examination on November 10, 2022. A determination that the finality of an Office action in an application was improper does not *nunc pro tunc* render null any previously filed request for continued examination of an application. Accordingly, the petition is denied as moot.

Nevertheless, petitioner's argument that the finality of the Office action of January 4, 2022, is improper as the Office action of January 4, 2022, is not a "second or subsequent action on the merits" is unpersuasive.

II. The Office action of January 4, 2022, is a second or subsequent action on the merits which may be made final.

Petitioner argues that the finality of the Office action of January 4, 2022, was improper because it was, in fact, the first Office action on the merits. Although an earlier Office action was issued on October 12, 2021, petitioner asserts that the Office action of October 12, 2021, was not an "action on the merits" due to certain features of the Office Action Summary (Form PTO-326) accompanying the Office action. Primarily, petitioner states that the form set a two-month shortened statutory period for response, suggesting that the action was a restriction requirement, rather than an action on the merits. Petitioner's arguments have been carefully considered but are not persuasive.

(a) The Office action of October 12, 2021, included a written record of the restriction requirement and a first action on the merits of the elected invention.

Petitioner argues that the Office action of October 12, 2021, should be considered a restriction requirement rather than a first action on the merits because the Office action expressly made a written restriction requirement and required affirmation of the election. This argument is not persuasive as the incorporation of the written restriction requirement, oral election, and requirement to affirm the oral election in writing into the Office action is consistent with the guidelines for telephone restriction practice outlined in *The Manual of Patent Examining Procedure* (MPEP) § 812.01.

MPEP § 812.01 states in part (emphasis added):

If an examiner determines that a requirement for restriction should be made in an application, **the examiner should formulate a draft of such restriction requirement** including an indication of those claims considered to be linking and/or generic. Thereupon, **the examiner should telephone the attorney or agent of record and request an oral election, with or without traverse.** The examiner should arrange for a second telephone call within a reasonable time, generally within 3 working days, to provide time for the attorney or agent to consider the requirement. If the attorney or agent

objects to making an oral election, or fails to respond, a restriction requirement will be mailed, and should contain reference to the unsuccessful telephone call. **When an oral election is made, the examiner will then proceed to incorporate into the next Office action a formal restriction requirement including the date of the election, the attorney's or agent's name, and a complete record of the telephone interview, followed by a complete action on the elected invention as claimed, including linking and/or generic claims if present.**

MPEP § 810 further states (emphasis added):

In general, in an application when only a nonfinal written requirement to restrict is made, no action on the merits is given. A 2-month shortened statutory period will be set for reply when a written restriction requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). The Office action making the restriction requirement final also ordinarily includes an action on the merits of the claims of the elected invention. *See* 37 CFR 1.143. **In those applications wherein a requirement for restriction is made via telephone and applicant makes an oral election of a single invention, the written record of the restriction requirement will be accompanied by a complete action on the merits of the elected claims.** *See* MPEP § 812.01. The restriction requirement, should be made final as soon as reasonably possible. If the election is made with traverse, it is proper to make the restriction requirement final after consideration of the reasons for traversal. *See* MPEP § 821.01.

While the Office Action Summary (PTO-326) accompanying the Office action of October 21, 2021, may have inadvertently omitted checked boxes on items (3) and (9),¹ the Office Action Summary (PTO-326) does not stand alone. The body of the Office action clearly includes a restriction requirement based on lack of unity, an oral election of Group II (claims 24, 25, and 27 through 29) from an agent of record, Nassima Naas, and a requirement to affirm the oral election in writing.² The Office action then proceeds with an action on the merits of the elected invention as claimed, including a drawing objection and rejections of claims 24, 25, and 27 through 29 under 35 U.S.C. § 112 and/or 35 U.S.C. § 103.³ Therefore, the Office action of October 12, 2021, clearly includes a written record of the restriction requirement and is accompanied by a complete action on the merits of the elected claims, consistent with MPEP §§ 810 and 812.01.

Petitioner further argues that the presence of a claim rejection in an action does not necessarily make an Office action an “action on the merits” and that the Office action of October 12, 2021, did not include any evidence that it was an “action on the merits.” This argument is not persuasive.

¹ Check box (3) on Form PTO-326 reads “An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.” Check box (9) reads “Claim(s) ____ are subject to a restriction and/or election requirement.”

² Office action, issued October 12, 2021, pp. 2-7.

³ *Id.*, pp. 7-13.

In patent prosecution, an “action on the merits” is understood to be an Office action that addresses the substance or patentability of the claims. This is supported by numerous sections of MPEP.⁴ Because the Office action of October 12, 2021, explicitly addresses the substance and patentability of the elected claims, it is an action on the merits.

- (b) **MPEP describes procedures for resolving errors in Office actions and these procedures were available to petitioner following the issuance of the Office action of October 12, 2021.**

MPEP § 710.06 states (emphasis added):

Where the citation of a reference is incorrect or **an Office action contains some other error that affects applicant’s ability to reply to the Office action and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant.** If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. *See* MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to reissue any action (MPEP § 707.13), applicant’s period for reply will be restarted to correspond to the reissuing date of the action.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be

⁴ *See, e.g.*, MPEP §§ 810 (“when only a nonfinal written requirement to restrict is made, no action on the merits is given”), 706.01 (“a rejection, involving the merits of the claim”), 707.01 (“If action on the merits is to be given and claims rejected, the primary examiner may indicate how the references are to be applied in any prior art rejection and explain the basis for any non-prior art grounds of rejection.”), 707.07(d) (“Where a claim is refused for any reason relating to the merits thereof it should be “rejected” and the ground of rejection fully and clearly stated, and the word “reject” must be used.”).

restarted and any appropriate extension fee will be required to render a reply timely. The Office letter correcting the error will note that the time period for reply remains as set forth in the previous Office action.

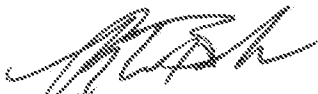
Petitioner argues that it is unreasonable to expect an applicant to second guess the content of an Office action and request clarification when a question arises. This argument is not persuasive as MPEP § 710.06 explicitly sets forth the procedures for requesting clarification from the Office when a potential error in an Office action may impact an applicant's ability to reply to an Office action. Petitioner did not call attention to the purported defect in the Office action of October 12, 2021, until after the expiration of the period for reply; therefore, the time period could not have been restarted.⁵

DECISION

For the previously stated reasons, the petition requesting withdrawal of finality of the Office action of January 4, 2022, is **DENIED** as moot.

This constitutes a final decision on the petition. No further requests for reconsideration will be entertained. *See* MPEP § 1002.02. Judicial review of this petition may be available upon entry of a final agency action in the instant application (*e.g.*, a final decision by the Patent Trial and Appeal Board).

This application is being forwarded to the Technology Center for action on the request for continued examination filed on November 10, 2022.



Robert W. Bahr
Deputy Commissioner
for Patents

⁵ *See* MPEP § 710.06 ("If the error in citation or other defective Office action is called to the attention of the Office after the expiration of the period for reply, the period will not be restarted and any appropriate extension fee will be required to render a reply timely. The Office letter correcting the error will note that the time period for reply remains as set forth in the previous Office action.")