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OFFICE OF PETITIONS

In re Application of :
Tyler Jacks et al. :
Application No. 11/453,787 : ON PETITION
Filed: June 15, 2006 :
Attorney Docket No.: 01997/559002 :

This is a decision on the Request for Reconsideration of Decision on Petition Under 37 CFR 1.181 to Withdraw Finality, filed October 25, 2010. This petition is being treated as a request under 37 CFR 1.181 that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 1600 (Technology Center Director), dated August 23, 2010, which refused to withdraw the finality of the April 23, 2010 Office action.

The petition to overturn the decision of the Technology Center Director dated August 23, 2010, is **DENIED**.

BACKGROUND

A non-final Office action was mailed July 14, 2009. This action included a rejection of claim 11 under 35 USC 102(b) as being anticipated by Hodson et al taken in light of Kim et al.

Petitioners filed an amendment on January 14, 2010 including an extensive amendment to claim 11.

In response to this amendment, a final Office action was mailed April 23, 2010. This action included inter alia a new rejection of claims 11-14 and 35 under 35 USC 102(b) as being anticipated by Kotton et al. This reference was newly cited by the examiner.

A petition to the Technology Center Director was filed June 23, 2010 requesting the finality of the April 23, 2010 Office action be withdrawn. This petition was denied in a decision mailed August 23, 2010 and the instant petition requesting reconsideration of that decision was filed October 25, 2010.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.181(a) states in part:

- (a) 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 Board of Patent Appeals and Interferences 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 Board of Patent Appeals and Interferences, see § 41.3 of this title.

MPEP 706.07(a) states in part:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

OPINION

Petitioners argue in their petition to the Technology Center Director and in the instant petition that the Kotton reference, applied for the first time in the final Office action, was cited for teaching limitations of claim 11 that were present in claim 11 prior to the January 14, 2010 amendment. Petitioners further argue that the Kotton reference could have been applied to claim 11 prior to the January 14, 2010 amendment. From this, petitioners conclude that the amendment to the claim did not necessitate a new ground of rejection.

Petitioners' argument is not persuasive. Claim 11 was extensively amended in the January 14, 2010 amendment, introducing many additional limitations. The argument that a reference cited to meet an amended version of a claim could also meet the unamended version of the claim is not germane to whether the change in rejection was necessitated by the amendment. The issue is whether the amendment to the claim necessitated the new rejection. As noted in the Technology Center Director's decision, "These limitations were not previously set forth in the original claims and thus a new search was required to address these limitations." In other words, claim 11 was amended to the point that the Hodson reference could no longer meet claim 11. Petitioner's opinion that Kotton also met claim 11 before the amendment is not the issue. The salient point remains that claim 11 was amended to the point that a new rejection based on Kotton was required and thus the new ground of rejection was necessitated by applicant's amendment to the claim. Therefore, the finality of the Office action was in compliance with MPEP 706.07(a).

It follows that the Technology Center Director did not clearly err in upholding the finality of the Office action. Petitioners' contention that the finality was premature is without merit. The requirement in MPEP § 706.07 for making an Office action final is the development of a clear issue so that petitioner may ascertain the advisability of an appeal. As such, the new rejection of claim 11 based on Kotton was necessitated by petitioners' amendment to the claim and making that action final was appropriate.

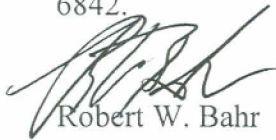
DECISION

In regard to the premature finality of the April 23, 2010 Office action based on the new rejection under 35 USC 102, 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 decisions of August 23, 2010. 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 April 23, 2010 has been reviewed, but is denied with respect to making any changes therein. The petition is denied.

This decision becomes a final agency action within the meaning of 5 U.S.C. § 704 for the purposes of obtaining judicial review upon entry of a final decision by the Board of Appeals and Interferences. See MPEP 1002.02.

Telephone inquires concerning this decision should be directed to Carl Friedman at (571) 272-6842.



Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy

ak/cf