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EXAMINER

CARTAGENA, MELVIN A

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ELECTRONIC

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In re Application of: LASSERRE	:	DECISION ON PETITION TO
Serial No.: 11/674,301	:	MAKE SPECIAL FOR NEW
Filed: February 13, 2007	:	APPLICATION UNDER 37
Title: LOCKABLE DISPENSING HEAD	:	C.F.R. § 1.102 & M.P.E.P. §
	:	708.02
	:	
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This is a decision in response to the submission denominated "Petition to Invoke the Supervisory Authority of the Director under 37 CFR 1.181" received on August 13, 2007. The delay in processing this petition is regretted. Petitioner seeks relief under 37 CFR 1.181 from the decision mailed June 13, 2007 denying accelerated examination status for the instant application. The signatory of the June 13, 2007 decision denying accelerated examination status possessed delegated authority to act on behalf of the Technology Center Director in such matters. Therefore, the petition received on August 13, 2007 is a request for review of a decision of a Technology Center Director. Accordingly, the Office of the Deputy Commissioner for Patent Examination Policy has decision-making authority over Applicant's petition. M.P.E.P. § 1002.02(b)(15).

The petition under 37 CFR 1.181 to reconsider the denial of accelerated examination status for application No. 11/674,301 and to grant such status under 37 CFR 1.102 is **DENIED**.

Background

The above-identified application was filed under 35 U.S.C. § 111(a) on August February 13, 2007 and accompanied by a petition under 37 CFR 1.102(d) to make the application special under the accelerated examination program. See 71 Fed. Reg. 36,323.

On April 19, 2007, the United States Patent and Trademark Office (USPTO) issued a decision dismissing said petition based upon failure to meet policy conditions 5.2, 6.2, 6.3 and 6.5. A full explanation of each of the deficiencies was provided in the decision. In particular with respect to section 6.3, the decision states in pertinent part:

Regarding the requirements of section II element 6.3 outlined above, the petition fails to provide a detailed explanation of how each of the claims are patentable over each of the references with particularity required by 37 CFR 1.111 (b) and (c). The instant petition merely refers generally to a few claim limitations and generally refers to claims 1, 19, and 20 when referring to each of the cited references. There is no detailed explanation of each claim with respect to each reference. The requirement is not limited to only independent claims but rather must provide a detailed explanation of the patentability of each claim. As outlined above, all claims must be addressed with at least

the same specificity to claim language as is provided for the requirement of section II element 6.2 above, and with respect to each cited reference. For reference, a grantable petition must meet the requirements of the practice and such includes a discussion with respect to the claimed subject matter. 37 CFR § 1.111 (b) states "[a] general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." 37 CFR § 1.111 (c) states in part "the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made."

On May 21, 2007, Applicant filed a Request for Reconsideration of the Decision on Petition.

On June 13, 2007 the United States Patent and Trademark Office (USPTO) issued a decision denying said petition based upon a failure to meet policy condition 6.3. A full explanation of the remaining deficiency was provided in the decision. The decision states in pertinent part:

The petitioner has argued that "dependent claims need not be separately patentable from the claims from which they depend". While that may or may not be the case, the facts in this instance are that the petitioner has made no clear assertion that claims 2-18 are not separately patentable from the claims from which they depend. The petitioner must specifically address each claim by either pointing out that the patentability of said Claim is predicated solely on its dependence from a specific claim which is patentable (for reasons specifically identified) or that said claim is separately patentable due to a specific feature of that claim which is separately identified. The Supplemental AESD notes, with respect to all dependent claims that "for at least the reasons discussed above with respect to claim 1, the cited references also fail to disclose or suggest the subject matter of claims 2-18" and further that "the additional features of claims 2-18, when taken together with the features of claim 1, form further novel and non-obvious combinations of features that are neither taught nor suggested by the cited references". Thus petitioner has not made clear whether the patentability of claims 2-18 derives solely from those reasons discussed with respect to claim 1 and/or for additional features or reasons. Thus the petition fails to meet the requirements of element 6.3.

On August 13, 2007, Applicant submitted the instant Petition under 37 CFR 1.181 requesting reconsideration of the October 24, 2006 denial of the petition to make special.

Applicable Regulations and Notice Sections

37 CFR 1.102. Advancement of examination.

(a) Applications will not be advanced out of turn for examination or for further action except as provided by this part, or upon order of the Director to expedite the business of the Office, or upon filing of a request under paragraph (b) of this section or upon filing a petition under paragraphs (c) or (d) of this section with a showing which, in the opinion of the Director, will justify so advancing it.

(d) A petition to make an application special on grounds other than those referred to in paragraph (c) of this section must be accompanied by the fee set forth in § 1.17(h).

Implementation of 37 CFR 1.102 (c) and (d) is prescribed in "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination" published in the Federal Register on June 26, 2006 (71 Fed. Reg. 36323) and in MPEP section 708.02(a).

MPEP 708.02(a)Condition (I) (3) :

The accelerated examination support document must include a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c).

37 CFR 1.111.

Sections (b) and (c) state in pertinent part, respectively:

(b) ... The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. ... A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent owner must also show how the amendments avoid such references or objections.

Decision

Petitioner requests reconsideration of the petition denial based upon petitioner's assertions that the statements provided by applicant with respect to both the independent claims and the dependent claims are sufficient and meet the requirements of particularity required by the policy and regulation. Petitioner submits that it is axiomatic patent law that because dependent claims are narrower in scope than the base claim from which they depend, it follows that patentability of the base claim over the prior art will result in patentability of a claim depending therefrom. Further, petitioner submits that the requirement to provide a separate rationale regarding the patentability of each dependent claim, or "affirmatively state that no such separate rationale exists"¹ is not a requirement of the Policy and further such a requirement would seem at odds with the provision of the Notice which provides that applicant's cannot separately argue the patentability of dependent claims on appeal.

At the onset, it is noted petitioner expresses uncertainty as to whether or not the petition has been denied based upon applicant's statements with respect to all of the claims or applicant's statements with respect to the dependent claim. A fair reading of the decision dated June 13, 2007 at page 3 third full paragraph indicates the Office position is that the discussion with respect to the dependent claims remains deficient in the Accelerated Examination Support Document (AESD).

Petitioner's points are not well taken. First, petitioner's point with respect to axiomatic patent law and the patentability of dependent claims is without merit in that here applicant is not submitting an argument for patentability to overcome a rejection. Applicant is fulfilling a

¹ The petition decision states : The petitioner must specifically address each claim by either pointing out that the patentability of said claim is predicated solely on its dependence from a specific claim which is patentable (for reasons specifically identified) or that said claim is separately patentable due to a specific feature of that claim which is separately identified.

requirement of a petition based in policy which will result in the advancement of examination and the application being taken out of order. The purpose of the policy requirements are to aid applicant in the submission of an application in the best possible condition for examination and to aid the Office in understanding Applicant's position. Applicant's position on the patentability of each claim must be set forth so that, upon examination, should the examiner find he disagrees with applicant's position of patentability on the independent claims, the examiner can look to the dependent claims for separately patentable subject matter and suggest amendments which may result in the allowance of all of the claims at an earlier point in prosecution.

As to petitioner's second point, the policy clearly requires the AESD include a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c). Particularity means specifically pointing out how the language of the claims patentably distinguishes them from the references (37 CFR 1.111 (b)) and the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references (37 CFR 1.111 (c)). Particularity can be accomplished by separately addressing the subject matter believed to patentably distinguish each dependent claim from the prior art. Alternatively, should applicant wish to predicate patentability of the dependent claims solely upon that which is opined with respect to the independent claim(s) from which they depend, applicant may so state and such is considered as meeting the requirement of particularity. While petitioner argues he met the requirements of the policy with the statement: "*[c]laims 2-18 depend from claim 1 ... for at least the reasons discussed above with respect to claim 1, the cited references also fail to disclose or suggest the subject matter of claims 2-18.*" (See Substitute AESD, page 58), petitioner is only quoting half of the statement. The substitute AESD continues "*Also, the additional features of claims 2-18, when taken together with the features of claim 1, form further novel and non-obvious combinations of features that are neither taught nor suggested by the cited references.*" The provision of an alternative indicates applicant may believe the dependent claims to be separately patentable. This contradicts the statement that the dependent claims are patentable for the reasons discussed with respect to the independent claim. Thus, it is not clear from the record what applicant's position on patentability of the dependent claims is: are these claims patentable for the reasons given for the claim from which they depend, or are they separately patentable based upon limitations added therein. Furthermore, a general statement that additional features of the dependent claims form novel and non-obvious combinations, without making specific reference to any individual feature is not specific enough to meet the standard of 37 CFR 1.111. Applicant's position with respect to the dependent claims is not clear and thus the statement fails to rise to the level of particularity required by the policy. The denial of the petition appears proper.

Finally, it is noted that while petitioner submits this requirement would seem at odds with the provision of the Notice which provides that applicant's cannot separately argue the patentability of dependent claims on appeal, such is not the case. The requirement that applicant agree not to separately argue patentability of dependent claims upon appeal relates to streamlining issues for consideration upon appeal. Streamlining results from placing the features relied upon for patentability into the independent claims. This requirement is predicated on the view that a clear issue should have been developed in the prosecution before resorting to appeal and serves the purpose of requiring applicant to focus the appeal on a limited number of issues, thus reducing

the time spent on preparing an answer and facilitating the Board opinion. This agreement is not impacted by the policy requirement applicant include a detailed explanation of how each of the claims are patentable over the references cited with the particularity required by 37 CFR 1.111(b) and (c) in order to obtain the advantages of Accelerated Examination.

CONCLUSION

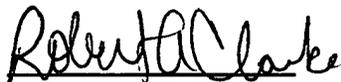
For the above-stated reasons, the petition under 37 CFR 1.181 to reconsider the denial of Accelerated Examination status in application No. 11/674,301 is **DENIED**. Therefore, the USPTO will examine the above-identified application in accordance with standard examination procedures.

This decision may be viewed as final agency action. See MPEP 1002.02.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop
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Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor at (571) 272-7726.



Robert A. Clarke, Director
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