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11/675,978	02/16/2007	Vikramaditya Jain	17625-010004	7268
26161	7590	09/03/2008	EXAMINER	
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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.



FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of: Vikramaditya Jain, et al. :
Serial No.: 11/675,978 :
Filing date: February 16, 2007 :
Title: DYNAMICALLY FABRICATED STORE FOR :
DISTRIBUTION OF MEDIA CONTENT :
DECISION ON PETITION TO
MAKE SPECIAL FOR NEW
APPLICATION UNDER 37
C.F.R. § 1.102 & M.P.E.P. §
708.02

This is a decision in response to the submission denominated "Rule 181 Petition" received on June 29, 2007. The paper is being treated as a petition under 37 CFR 1.181 to review the decision mailed May 15, 2007, denying accelerated examination status for the instant application. The signatory of the May 15, 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 June 29, 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. 11/675,978 and to grant such status under 37 CFR 1.102 is **DENIED**.

Background

On February 16, 2007, the above-identified application was filed under 35 U.S.C. § 111(a) 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 March 12, 2007, the United States Patent and Trademark Office (USPTO) issued a decision dismissing the petition to make special of February 16, 2007 including an indication that the showing where each limitation of each of the claims finds support under 35 USC 112 in the written description of the application was insufficient.

On April 11, 2007, Applicant replied to the dismissal with a request for reconsideration addressing the defects noted in the dismissal issued March 12, 2007 including a new showing of support under 35 USC 112, first paragraph.

On May 15, 2007, a decision was mailed by the USPTO denying Applicant's petition to make special because the petition failed to show where each limitation of the claims finds support under 35 USC 112, first paragraph.

On June 29, 2007, Applicant submitted the instant paper, which is being treated as a Petition under 37 CFR 1.181, requesting reconsideration of the May 15, 2007 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.

“Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination”, 71 Fed. Reg. 36,323 (Jun. 26, 2006)

The relevant portions of the Accelerated Examination Notice are as follows:

Part I. Requirements for Petitions to Make Special under Accelerated Examination: A new application may be granted accelerated examination status under the following conditions:

...

(9) At the time of filing, applicant must provide in support of the petition an accelerated examination support document.

...

(E) The accelerated examination support document must include a showing of where each limitation of the claims finds support under the first paragraph of 35 U.S.C. 112 in the written description of the specification... If the application claims the benefit of one or more applications under title 35, United States Code, the showing must also include where each limitation of the claims finds support under the first paragraph of 35 U.S.C. 112 in each such application in which such support exists.

...

Part II. Decision on Petition To Make Special: Applicant will be notified of the decision by the deciding official. If the application and/or petition does not meet all the prerequisites set forth in this notice for the application to be granted special status (including a determination that the search is deemed to be insufficient), the applicant will be notified of the defects and the application will remain in the status of a new application awaiting action in its regular turn. In those instances in which the petition or accelerated examination support document is defective in one or more requirements, applicant will be given a single opportunity to perfect the petition or accelerated examination support document within a time period of one month (no extensions under 37 CFR 1.136(a)).

Decision

Petitioner requests reconsideration of the denial of the petition based upon the assertion that petitioner's response "cannot reasonably be viewed as failing to show where each limitation of the claim find support". Petitioner asserts that the showing under 35 USC 112, first paragraph was a) more detailed than the example provided by the Office; and b) that the requirement to show "each limitation" is met by showing "the subject matter which the Applicant regards as his invention" as per 35 USC 112 given that the term "limitation" is not defined.

With respect to the level of detail provided by Petitioner in the showing responsive to the dismissal, Petitioner emphasizes the mere number of lines in the Office's example compared to the number of lines in the response. The mere number of lines however is not an indicator of whether "*each limitation* of the claims finds support under the first paragraph of 35 U.S.C. 112" (emphasis added) has been shown as required by Part I (9) (E) of the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination", 71 Fed. Reg. 36,323 (Jun. 26, 2006). The response provided to the dismissal was only directed to the claim as a whole. Page 2 of the Request for Reconsideration filed April 11, 2007 states for example "the limitations of claims 1 and 2 are supported by at least... (*citations of figures, page and line numbers omitted*) ... of the present application serial no. 11/675,978. The limitations of claim 3 are supported by at least... (*citations of figures, page and line numbers omitted*)... of the present application serial no. 11/675,978". Although this showing is indeed greater in sheer length than the showing in the Office's example, the Office's example does provide a specific showing for each of "steps (a) through (k)". Again, no showing for "each limitation" as required was provided in the response to the dismissal.

With respect to Petitioners arguments concerning the term "limitation" and the content of 35 USC 112, Petitioner argues that 35 USC 112 itself makes no reference itself to "limitations" and that the number of limitations in a claim is a merely a matter of draftsmanship. Although 35 USC 112 does not make reference to limitations, the requirement of Part I (9) (E) is not a duplicate of 35 USC 112. It is a separate requirement to show support for "each limitation". Further, on page 2 in the Request for Reconsideration filed April 11, 2007, petitioner clearly indicates that the claims have plural "limitations" when referring to the support in the written description. For example, "the *limitations* of claims 1 and 2 are supported by at least...The *limitations* of claim 3 are supported by at least..." (emphasis added). Thus it is clear that "each limitation" of the claims has not been addressed in the response as required by Part I (9) (E).

Finally, Petitioner has attached to this petition Exhibit B wherein a new showing of support in the written description according to claim limitations is provided. Petitioner is reminded that only a single opportunity to perfect the support document within a one month time period is provided as stated in Part II of the "Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination", 71 Fed. Reg. 36,323 (Jun. 26, 2006). Since Exhibit B is after both the one month time period and the single opportunity to perfect the support document, it cannot be effective in removing the denial.

It is further noted that petitions to make special based upon applicant's health or age, as outlined in MPEP 708.02 III and IV respectively, are available to petitioner should the requirements of those programs be met.

CONCLUSION

For the above-stated reasons, the petition under 37 CFR 1.181 to reconsider a dismissal to make special application No. 11/675,978 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
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

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



Robert A. Clarke, Director
Office of Patent Legal Administration
Office of the Deputy Commissioner for Patent Examination Policy