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Applicant: Mervin A. Dayan et al.
Application No. 11/757,774
Filed: June 4, 2007
For: COMBINED MODULATOR AND
INVERTER

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: **Decision On Petition to Make**
: **Special under 37 C.F.R. § 1.102 (d)**
: **and M.P.E.P § 708.02(a)**
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This is a decision in response to the “Request for Reconsideration on the Decision on Petition to Make Special for New Application Under 37 C.F.R. § 1.102 & M.P.E.P. 708.02” filed on August 2, 2007. The paper constitutes a petition under 37 C.F.R. § 1.181 to review the decision mailed July 6, 2007, denying accelerated examination status for the instant application. The petition for accelerated examination status was denied on July 6, 2007 by an official having delegated authority to act on behalf of the Director of Technology Center 2800 in such matters. Therefore, the petition filed on August 2, 2007 is treated as a request for review of a decision of a Technology Center Director. Accordingly, this petition is being treated in the Office of Patent Legal Administration. M.P.E.P. § 1002.02(b)(15).

The petition under 37 C.F.R. § 1.181 to reconsider the denial of accelerated examination status for application No. 11/757,774 and to grant such status under 37 C.F.R. § 1.102 is **DENIED**.

Background

The above-identified application was filed under 35 U.S.C. § 111(a) on June 4, 2007, and was accompanied by a petition under 37 C.F.R. § 1.102(d) to make the application special under the accelerated examination program. See 71 Fed. Reg. 36323.

On July 6, 2007, the United States Patent and Trademark Office (USPTO) issued a decision denying the petition to make the application special. The decision outlined the requirements for accelerated examination pursuant to the “Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination” (71 Fed Reg. 36323), and held that the application, as filed, was not in condition for examination as required under the accelerated examination program. The decision of July 6, 2007, indicates that the application, as filed, was not in condition for examination because the domestic benefit claims under 35 U.S.C. § 119(e) and 35 U.S.C. § 120 were not in compliance with 37 C.F.R. § 1.78 because the application improperly claims benefit under 35 U.S.C. § 119(e) to provisional application No. 60/778,661 after this provisional application became abandoned (the claim for benefit was made more than one year from the filing date of the provisional application), and the claim for benefit under 35

U.S.C. § 120 to prior non-provisional application No. 11/681,988 does not comply with 37 C.F.R. § 1.78 because it fails to identify the relationship of the applications under 37 C.F.R. § 1.78(a)(2)(i) and M.P.E.P. § 201.11. III. A. Accordingly, the decision concluded that the application, as filed, was not eligible for the accelerated examination program and denied the granting of special status.

On August 2, 2007, the instant petition was filed under 37 C.F.R. § 1.181 to request reconsideration of the decision of July 6, 2007, denying of the petition to make special. The petition is accompanied by an amendment to the specification to correct the claim for benefit of prior patent applications under 35 U.S.C. § 119(e) and 35 U.S.C. § 120.

Applicable Regulations and Notice Sections

37 CFR § 1.78 Claiming benefit of earlier filing date and cross-references to other applications.

(a)

...

(2)

(i) Except for a continued prosecution application filed under § 1.53(d), any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending nonprovisional applications or international applications designating the United States of America must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date **and indicating the relationship of the applications**. Cross references to other related applications may be made when appropriate (see § 1.14)." (emphasis added)

...

(iii) If the later-filed application is a nonprovisional application, the reference required by this paragraph must be included in an application data sheet (§ 1.76), or the specification must contain or be amended to contain such reference in the first sentence(s) following the title.

...

(5)

(i) Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed provisional applications must contain or be amended to contain a reference to each such prior-filed provisional application, identifying it by the provisional application number (consisting of series code and serial number).

Manual of Patent Examining Procedure (MPEP) § 201.11.III.

A. Reference to Prior Nonprovisional Applications

Except for benefit claims to the prior application in a continued prosecution application

(CPA), benefit claims under 35 U.S.C. 120, 121, and 365(c) must identify the prior application by application number, or by international application number and international filing date, and indicate the relationship between the applications. See 37 CFR 1.78(a)(2)(i). The relationship between the applications is whether the instant application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application. An example of a proper benefit claim is “this application is a continuation of prior Application No. ---, filed ---.” **A benefit claim that merely states that “this application claims the benefit of Application No. ---, filed ---” does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i), since the relationship between the applications is not stated. In addition, a benefit claim that merely states that “this application is a continuing application of Application No. ---, filed ---” does not comply with 35 U.S.C. 120 and 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing (i.e., continuation, divisional, or continuation-in-part) application, is not stated.** (emphasis added).

“Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination”, 71 Fed. Reg. 36323 (June 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:

...

(4) The application, at the time of filing, must be complete under 37 CFR 1.51 and in condition for examination.

...

Part VIII: More Information:

Eligibility:

...

Conditions for Examination: The application must be in condition for examination at the time of filing. This means the application must include the following:

...

(I) Domestic claims under 35 USC 119(e), 120, 121, or 365(c) **in compliance with 37 CFR 1.78** (e.g., the specific reference to the prior application must be submitted in the first sentence(s) of the specification or in an application data sheet...

.....

The opportunity to perfect a petition (part II) does not apply to applications that are not in condition for examination. (emphasis added)

Decision

As indicated above, to be eligible for the accelerated examination program, the application must be in condition for examination on filing. One of the conditions being any claim for benefit under 35 U.S.C. §§ 119(e) or 120 must comply with the requirements of 37 C.F.R. § 1.78. 37 C.F.R. § 1.78(a)(2)(i) requires that a non-provisional application claiming benefit of one or more prior filed copending nonprovisional applications must contain a reference to each such prior application, identify it by application number, and indicate the relationship of the application. The M.P.E.P. defines “relationship between the applications” to be whether the application is a continuation, divisional, or continuation-in-part of the prior application. It also indicates explicitly that a benefit claim that merely states that “this application claims the benefit of Application No. ---, filed ---” does not comply with 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2)(i).

Petitioner indicates that the “petition was denied because the priority claims to U.S. Provisional Application 60/778,661 and U.S. Non-Provisional Application 11/681,988 were deemed improper,” and requests that the special status be granted since a preliminary amendment that properly claims priority to the prior applications and remedies any non-compliance with regard to 35 U.S.C. § 119(e), 35 U.S.C. § 120, 37 C.F.R. § 1.78(a)(2)(i) and M.P.E.P. § 201.11.III.A, and a supplemental Accelerated Examination Support Document that includes the showing of support under 35 U.S.C. § 112, first paragraph, for each limitation of the claims in the prior U.S. application No. 11/681,988 have been submitted.

A review of the application record reveals that the application was filed with an improper claim for benefit under 35 U.S.C. § 119(e) and 35 U.S.C. § 120. On filing the specification included the following statement relating to the benefit claim: “[T]his application claims benefit of U.S. Provisional Application No. 60/828,293 filed on October 5, 2006; U.S. Provisional Application No. 60/778,661 filed on March 3, 2006; and U.S. Non Provisional Application No. 11/681,988 filed on March 5, 2007.” The claim for benefit does not comply with 37 C.F.R. § 1.78(a)(2)(i) because it fails to indicate the relationship between the instant application and the prior non-provisional application. Accordingly, the failure to make the benefit claim in compliance with 37 C.F.R. § 1.78(a)(2)(i) on filing renders the instant application not eligible for the accelerated examination status. The “Change to Practice for Petitions in Patent Applications to Make Special and for Accelerated Examination” (71 Fed Reg. 36323, 36327) specifically lists such a defect as one that does not afford an opportunity for perfection of the petition.

While the deficiencies in the application as filed have been addressed by the preliminary amendment, the filing of the preliminary amendment and of the supplemental accelerated examination support document does not save the application from being ineligible for inclusion in the accelerated examination program.

Accordingly, the decision denying special status by the Technology Center has been reviewed and found proper.

CONCLUSION

For the above-stated reasons, the petition under 37 C.F.R. § 1.181 to reconsider and grant special status to application No. 11/757,774 is **DENIED**. Therefore, the USPTO will examine the above-identified application in accordance with standard examination procedures and will take up the application in its regular turn for action.

This decision may be viewed as final agency action. See M.P.E.P. § 1002.02.

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

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 Alexandria, VA 22313-1450

Telephone inquiries related to this decision should be directed to Pinchus M. Laufer, Legal Advisor at (571) 272-7726 or in his absence to Joseph Weiss Jr., Legal Advisor at (571) 272-7759.



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