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OFFICE OF PETITIONS

In re Application of
Asif Khalfan et al.
Application No. 10/147,218
Filed: May 14, 2002
Attorney Docket No. 01-1048

ON PETITION

This is a decision on the PETITION FOR RULEMAKING AND IMPLEMENT INSTRUCTIONS FROM THE PRESIDENT, AND PETITION TO VACATE MEMORANDA OF JOHN LOVE OF APRIL 2007 AND OF ROBERT BAHR OF JANUARY 2010, AND TO VACATE EXAMINER'S PAPERS OF APRIL 14, 2008, AUGUST 13, 2008, AND APRIL 27, 2009 BASED THEREON, AND TO VACATE ABANDONMENT, OR IN THE ALTERNATIVE, TO REVIVE UNAVOIDABLY OR UNINTENTIONALLY ABANDONED APPLICATION, filed December 20, 2010. This petition is being treated as one filed under 37 CFR 1.181 requesting that the Director exercise his supervisory authority to review the decision of the Director, Technology Center 3600 (Technology Center Director), dated October 18, 2010. The petition is also treated in the alternative as a petition to revive an abandoned application under 37 CFR 1.137(a) as abandoned unavoidably and further in the alternative to revive an application abandoned unintentionally under 37 CFR 1.137(b).¹

The petition under 37 CFR 1.181 is **DENIED**².

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

BACKGROUND

¹ The petition for Rulemaking must be filed in a separate paper since it is treated by a different part of the Office. No opinion is expressed in this decision with regards to the Petition for Rulemaking.

² This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02

A requirement for restriction was mailed April 14, 2008. The restriction identified two distinct inventions and identified the claims drawn to each invention.

A response to the restriction requirement was filed on May 14, 2008.

A Notice of Non-Responsive Election/Restrictions (Notice) was mailed August 13, 2008. This Notice indicated that applicant had failed to properly elect an invention. Applicant elected an invention identified by claims drawn to both inventions.

A Notice of Abandonment was mailed April 27, 2009.

A petition to the TC Director was filed November 20, 2009.

A petition decision by the TC Director was mailed October 18, 2010 which denied the petition filed November 20, 2009.

The instant petition to the Director was filed December 20, 2010.

In regard to the petition under 37 CFR 1.181:

STATUTE AND REGULATIONS

35 U.S.C. § 121 states that:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

37 CFR 1.142 states in part that:

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

37 CFR 1.143 states that:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 CFR 1.181 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.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

5 U.S.C. § 555 states in part that:

(b) A person compelled to appear in person before an agency or representative thereof is entitled to be accompanied, represented, and advised by counsel or, if permitted by the agency, by other qualified representative. A party is entitled to appear in person or by or with counsel or other duly qualified representative in an agency proceeding. So far as the orderly conduct of public business permits, an interested person may appear before an agency or its responsible employees for

the presentation, adjustment, or determination of an issue, request, or controversy in a proceeding, whether interlocutory, summary, or otherwise, or in connection with an agency function. With due regard for the convenience and necessity of the parties or their representatives and within a reasonable time, each agency shall proceed to conclude a matter presented to it. This subsection does not grant or deny a person who is not a lawyer the right to appear for or represent others before an agency or in an agency proceeding.

* * * * *

(e) Prompt notice shall be given of the denial in whole or in part of a written application, petition, or other request of an interested person made in connection with any agency proceeding.

OPINION

On April 14, 2008, the examiner issued a restriction requirement under 37 CFR 1.142, indicating two groups of inventions. Applicant filed a reply to the restriction requirement on May 14, 2008. This reply to the restriction requirement did not provide a proper election. The examiner mailed a Notice on August 13, 2008 indicating to applicant that the election was not proper and gave applicant one month to properly respond to the restriction requirement. Applicant failed to respond to the Notice in a timely manner and the application went abandoned on September 14, 2008 for failure to respond to the Notice. A Notice of Abandonment was mailed April 27, 2009.

37 CFR 1.143 provides that “[i]f applicant disagrees with a requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefore” and applicant must provisionally elect one of the inventions for prosecution in the request for reconsideration.

Applicant’s response to the restriction requirement filed May 14, 2008 argued that the examiner’s grouping of claims for group I was faulty. Applicant proposed his own listing of claims for group I which included claims from group I and group II as originally set forth by the examiner. Applicant then states “Applicant elects that group.” “That group” was neither group I or group II as set forth by the examiner. By amending what he considered the proper claims drawn to the group I invention, applicant did not follow proper procedure set forth under 37 CFR 1.143. Applicant should have clearly indicated that he elected the invention of group I and then provided a request for modifying the claim listing for group I. Instead, applicant elected a self determined, modified listing of group I claims which was not the claim listing the examiner had established. Applicant did not follow the rules governing restriction election and the examiner properly put applicant on notice to this point. Applicant did not respond to the Notice and the application was properly abandoned.

The Technology Center Director’s petition decision of October 18, 2010 in regard to the abandonment of this application has been reviewed and no error discovered in this decision.

Petitioner is requesting a review of the TC Director's decision mailed October 18, 2010, for compliance with 5 U.S.C. § 553(e), 555(b) and (e), the Paperwork Reduction Act, 35 USC § 2(b)(2), 3(a), 3(b)(2), 3(b)(3)(B), and 37 CFR 1.181(b). Petitioner further asks the Director to exercise his duties to provide management supervision and to superintend duties of PTO employees to comply with the law in a fair, impartial, and equitable manner, and to define the authority of PTO employees.

Petitioner sets forth three fundamental errors in the Technology Center Director's decision of "November" 2010. It is noted the Technology Center Director's decision was mailed in October of 2010.

Petitioner indicates the decision referenced "withdrawal" of abandonment whereas petitioner requested the abandonment be "vacated". As review of the Technology Center Director's decision shows that abandonment was proper, this argument is moot and neither the restriction requirement nor notice of abandonment will be withdrawn or vacated.

Petitioners disagree with the Technology Center Director's decision because the decision did not vacate the April 25, 2007 memorandum. 37 CFR 1.181 provides for review of actions or requirements of an examiner in the *ex parte* prosecution of an application, and is not a forum for general complaints about USPTO practices or procedures. The April 25, 2007 memorandum is not an action or requirement made in the instant application. The withdrawal of the restriction requirement (rather than vacatur) is likewise not an action or requirement made in the instant application.³ In any event, petitioners' request that the examiner's restriction requirement be vacated is not granted because 37 CFR 1.143 only provides that applicant may request for reconsideration and withdrawal or modification of a restriction requirement. Accordingly, the Technology Center Director's decision addressed all the relevant issues related to actions taken or requirements made in the instant application that were presented in the petition under 37 CFR 1.181 filed on November 20, 2009, and is thus in compliance with 5 U.S.C. § 555(b) and (e).

Petitioner also raises issues under the Paperwork Reduction Act of 1995, 44 U.S.C. § 3501 *et seq.* (Paperwork Reduction Act). The collection of information pertaining to the filing of applications has been reviewed and approved by OMB under control number 0651-0032 and the collection of information pertaining to replies to Office action up to allowance of an application has been reviewed and approved by OMB under control number 0651-0031. The collection of information at issue (the election by an applicant in reply to a requirement for restriction by the examiner) has been reviewed and approved by OMB under control number 0651-0031. The public protection provision of the Paperwork Reduction Act provides in part that: "no person shall be subject to any penalty for failing to comply with a collection of information that is subject to this subchapter if- (1) the collection of information does not display a valid control

³ Any patent term adjustment under 35 U.S.C. § 154(b) will be indicated on the notice of allowance if the Office subsequently allows the instant application after an examination on the merits. See 37 CFR 1.705. Any complaint about the patent term adjustment indicated on any notice of allowance that issues in the instant application must be presented in compliance with 37 CFR 1.705(b) after the Office issues a notice of allowance in this application.

number assigned by the Director in accordance with this subchapter; or (2) the agency fails to inform the person who is to respond to the collection of information that such person is not required to respond to the collection of information unless it displays a valid control number.” See 44 U.S.C. § 3512(a). Thus, the Paperwork Reduction Act does not create private right of action, but is only defense to enforcement actions. See Ass’n of Am. Physicians & Surgs. v. United States HHS, 224 F. Supp. 2d 1115, 1128 (S.D.Tex. 2002). The information required by the public protection provision of the Paperwork Reduction Act is provided on the transmittal form the USPTO provides for any reply to an Office action, namely the transmittal form PTO/SB/21.

Petitioner argues that the petition to the Technology Center Director was timely filed and the Technology Center Director’s decision to the contrary was in error. The Technology Center Director’s decision noted that the petition filed November 20, 2009 was filed almost seven months after the mailing of the Notice of Abandonment and was thus untimely, see 37 CFR 1.181(f). Although no specific justification for timeliness was made in this petition, petitioner does make reference to arguments presented on pages 8-10 of the petition to the Technology Center Director. 37 CFR 1.181(f) specifically states that any petition not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. In regard to actions taken by the examiner in the *ex parte* prosecution of this application, the petition was filed more than two months from the mailing date of the notice of abandonment. Any arguments on timeliness of the petition based on issues outside the realm of *ex parte* prosecution are not appropriate.

Finally, petitioner argues that the Technology Center Director’s decision did not rule on petitioner’s request that the PTO comply with the OMB’s Good Guidance Practices directive. Section 11 of Executive order 12866 expressly indicates that: “[t]his Executive order is intended only to improve the internal management of the Federal Government and does not create any right or benefit, substantive or procedural, enforceable at law or equity, against the United States, its agencies or instrumentalities, its officers or employees, or any other person.” See Executive Order 12866 of September 30, 1993; Regulatory Planning and Review, 58 Fed. Reg. 51735 (Oct. 4, 1993). The Bulletin on Good Guidance Practice is a bulletin issued by OMB in a Federal Register notice entitled Final Bulletin for Agency Good Guidance Practices, published at 72 Fed. Reg. 3432 (Jan. 25, 2007). Similar to Executive order 12866, the Final Bulletin for Agency Good Guidance Practices expressly indicates that: “[t]his Bulletin is intended to improve the internal management of the Executive Branch and is not intended to, and does not, create any right or benefit, substantive or procedural, enforceable at law or equity, against the United States, its agencies, or other entities, its officers or employees, or any other person.” See Final Bulletin for Agency Good Guidance Practices, 72 Fed. Reg. at 3440. Any person may bring issues of alleged non-compliance on the part of the USPTO with Executive order 12866 or the Final Bulletin for Agency Good Guidance Practices to the attention of the Department of Commerce or the Office of Management and Budget; however, petitioners’ issues concerning compliance or non-compliance with Executive order 12866 or the Final Bulletin for Agency Good Guidance Practices do not provide a basis for setting aside or otherwise disturbing the Technology Center Director’s decision in the above-identified application. See, e.g., Teledyne, Inc. v. United States, 50 Fed. Cl. 155, 190 (Fed. Cl. 2001) (plaintiff cannot rely upon an Executive order that, by its

plain terms, precludes judicial review of an agency's compliance with its directive as a basis for challenging agency action).

In regard to the petition under 37 CFR 1.137(a):

Petitioner requests in the alternative that the application be considered as abandoned unavoidably under 37 CFR 1.137(a).

The petition under 37 CFR 1.137(a) is **dismissed**.

The petition fee set forth under 37 CFR 1.17 has been charged to petitioner's deposit account.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the Notice mailed August 13, 2008, which set a period for reply of one (1) month. Accordingly, the application became abandoned on September 14, 2008. A Notice of Abandonment was mailed April 27, 2011.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks items (1) and (3).

In regard to item (1), the instant petition includes what appears to be an election of inventions. However, applicant indicates the examiner's listing of claims for the two groups of inventions (as set forth in the examiner's restriction requirement of April 14, 2008) is in error and lists what claims he feels are proper for group I. This grouping includes claims from the examiner's group I and group II. Applicant indicates he elects "that group" which is a reference to group I claims as determined by applicant and is neither the group I or group II as defined by the examiner. Therefore the election is improper under 37 CFR 1.143 for the very same reason as indicated in the examiner's Notice of August 13, 2008.

In regard to item (3), the showing of record is not sufficient to establish to the satisfaction of the Director that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

Petitioner indicates that abandonment was unavoidable "as no reasonable applicant could have foreseen the PTO's refusal to follow statutes and directives from the President." This stated reason for unavoidable delay is not convincing. The examiner mailed the Notice clearly indicating the defect in applicant's election of invention and what steps applicant must take to correct the election defect. The response period was clearly indicated as one month. Petitioner has presented no reason why applicant was unavoidably prohibited from properly and timely responding to the Notice.

In regard to the petition under 37 CFR 1.137(b):

Petitioner requests that if the petition under 37 CFR 1.137(a) is not granted, in the alternative a petition under 37 CFR 1.137(b) be considered.

The petition under 37 CFR 1.137(b) is **dismissed**.

The petition fee as set forth in 37 CFR 1.17 has been charged to petitioner's deposit account.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. See MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (1).

As noted above, the election filed with the instant petition is not a proper response to the Notice of August 13, 2008 and therefore the required reply has not been filed.

Petitioner will need to file a proper election of invention in order to revive the instant application.

Any further petition to revive must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a) and (b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

CONCLUSION

The petition is granted to the extent that the decision of the Technology Center Director of December 18, 2010 has been reviewed; however, the petition is **denied** with respect to making any change to or otherwise disturbing the Technology Center Director's decision of December 18, 2010.



Andrew Hirshfeld
Associate Commissioner for
Patent Examination Policy