UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THE INVENTION SCIENCE FUND
CLARENCE T. TEGREENE
11235 SE 6TH STREET
SUITE 200
BELLEVUE WA 98004

MAILED

JUN 27 2012

OFFICE OF PETITIONS

In re Application of :
Muriel Y. Ishikawa et al. :
Application No. 11/213,325 : ON PETITION
Filed:August 26, 2005 :
Attorney Docket No. 1003-002-002K-000000 :

This is a decision on the PETITION PURSUANT TO 37 CFR § 1.182 REQUESTING REVIEW OF TC 1600 DIRECTOR'S DECISION ON PETITION UNDER 37 CFR § 1.181, filed March 30, 2012, requesting that the Director exercise his supervisory authority to review and overturn the decision of the Director, Technology Center 1600 (TC Director), dated February 3, 2012, which denied the petition filed November 15, 2011.

The petition under 37 CFR 1.181, to overturn the decision of the TC Director dated February 3, 2012 is **DENIED**[1].

BACKGROUND

A Board of Patent Appeals and Interferences (BPAI) decision was mailed July 26, 2011, wherein the examiner was reversed.

A non-final Office action was mailed September 16, 2011.

A petition to the TC Director under 37 CFR 1.181 was filed on November 15, 2011 and was denied in a decision mailed February 3, 2012.

A final Office action was mailed March 16, 2012.

[1] 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.

The instant petition was filed March 30, 2012.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR § 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.

> When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states in relevant part:

> **1214.04 Examiner Reversed [R-3]**
>
> If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution

MPEP 1214.07 states in relevant part:

> **1214.07 Reopening of Prosecution [R-3]**
>
> When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

OPINION

Petitioner requests review of the TC Director's decision of February 3, 2012, indicating the decision was in error as it was not based on evidence or supported by statute.

The examiner was reversed on appeal in a decision by the BPAI on July 26, 2011. The examiner then issued a non-final Office action. This Office action was signed by the primary examiner,

John Brusca, and Technology Center 1600 Director Jacqueline Stone. Applicants filed a petition arguing that this Office action was in error and inconsistent with patent rules. The TC Director's decision indicated the reopening of prosecution after the decision by the BPAI was proper and denied the petition.

The USPTO's reviewing courts have specifically held that even a court decision reversing a rejection does not preclude further examination of the application by the USPTO subsequent to examination provided for in 35 U.S.C. §§ 131 and 132 and the BPAI and court review provided for in 35 U.S.C. §§ 134 and 141. See Jeffrey Mfg. Co. v Kingsland, 83 USPQ 494, 494 (D.C. Cir. 1949), see also In re Gould, 213 USPQ 628, 629 (CCPA 1982) (USPTO can always reopen prosecution in an application under an ex parte court appeal once it regains jurisdiction over the application); In re Arkley, 172 USPQ 524, 527 (CCPA 1972) (the USPTO is free to make such other rejections as it consider appropriate subsequent to a court decision reversing a rejection); In re Fisher, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); In re Ruschig, 154 USPQ 118, 121 (CCPA 1967) (subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); In re Citron, 140 USPQ 220, 221 (CCPA 1964) (following a decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references). Accordingly, it is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the authority, much less the duty, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir. 1896).

Two issues are raised in the instant petition. The first issue is that there is no evidence in the record that the decision to reopen prosecution complied with 37 CFR 1.198. Under this rule, for the examiner to reopen prosecution after a decision by the BPAI, there are three requirements that must be met:

1. Written authority of the Director.

   This was provided by TC Director Jacqueline Stone's signature at the end of the Office action.

2. For consideration only for matters not already adjudicated (by the BPAI).

   The reference applied in the art rejections of the Office action, Chirino et al, was not applied in any rejections under appeal and thus the BPAI had not considered this reference. Therefore, there was no previous adjudication of this matter.

3. Sufficient cause must be shown.

   The examiner indicated in the non-final Office action why the Chirino et al reference was being applied.

The authority to permit, under 37 CFR 1.198, the reopening of prosecution subsequent to a decision by the BPAI has been delegated to the Technology Center Director. See MPEP 1002.02(c). Since the Office action that reopened prosecution was signed by the Technology Center Director, thus indicating her approval, the statement of the rejections in that Office action is all the justification required under 37 CFR 1.198 for reopening prosecution. See Drawbaugh, supra. While petitioner is understandably unhappy with the reopening, as noted in Citron, 140 USPQ at 221:

> While appellant may have just cause of complaint that the Patent Office should have operated more effectively in finding the closest prior art...this is of no moment whatever in deciding appellant's legal right to the appealed claims in the face of the new prior art now that it has been cited.

The TC Director, in her decision, indicated TC Director Stone signed the Office action as required and the examiner indicated in the non-final Office action why the new reference to Chirino et al was now being applied. Requirement (2) above was self-evident as the reference had not been applied in any rejection before the BPAI. The Office action was in compliance with all three requirements of the rule.

The second issue raised in the instant petition is that the explanation in the decision to authorize reopening prosecution is inconsistent with the patent rules, the MPEP and USPTO Policy. Specifically, again, petitioner states that there is no evidence on the record that the decision to reopen prosecution complied with 37 CFR 1.198. In the petition to the TC Director, petitioner argued that the "sufficient cause "requirement of the rule was not met. Petitioner avers that the examiner's comments in the Office action in regard to the BPAI decision in related application 10/925,904 (in which the Chirino et al reference was applied) was not sufficient cause to reopen prosecution in the instant application and raises several reasons in regard to similarity of claims in both applications, issues of obvious double patenting and similar inventive entity. Petitioner states that the Chirino reference was adjudicated in the BPAI decision in application 10/925,904. However, a board decision on a reference applied in an application is not evidence of adjudication of the same reference in a different application. Chirino et al was not applied in the instant application prior to the BPAI decision in the instant application. Neither 37 CFR 1.198 nor MPEP 1414.07 specifies the nature of indicating sufficient cause for reopening prosecution. Petitioner is apparently looking for some formalized statement, but no such formal statement is required. As already noted, the rejection itself is a clear indication of sufficient cause, or in this instance the examiner's comments regarding an appeal in a related application are sufficient. There is no requirement that applicant agree with the statement.

Petitioner argues that the petition decision focused on guidance set forth in the MPEP and not on the requirements of 37 CFR 1.198. The rule and the relevant sections of the MPEP are not in conflict with each other and the TC Director's recitation of various sections of the MPEP does not indicate disregard of the requirements of 37 CFR 1.198.

Given the above facts, the examiner had only one option open to him given that he considered the claims were not patentable based on a reference (Chirino et al) that he had knowledge of (MPEP 1214.04). The TC Director's petition decision based on the application of the reference against the claims being proper to reopen prosecution on those claims was correct. In this regard, the TC Director's decision has been reviewed and no error is found in the decision.

DECISION

The Petition is granted to the extent that the decision of the TC Director has been reviewed; however, the petition is denied with respect to making any changes to or otherwise disturbing the TC Director's decision.

The above-identified application is being referred to Technology Center 1600 for further processing consistent with this decision.

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

Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer

ak/cf