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OFFICE OF PETITIONS

ZARKO SVATOVIC
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In re Application of	:	
Zarko Svatovic	:	
Application No. 11/397,977	:	ON PETITION
Filed: April 6, 2006	:	
Attorney Docket No.	:	

This is a decision on the Petition To The Director Of USPTO, filed November 23, 2011, which is being treated as a petition under 37 CFR 1.181 requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated October 24, 2011, which denied the petition filed October 7, 2011.

The petition is **DENIED**[1].

BACKGROUND

The relevant history of this application is set forth below:

A final rejection was mailed June 18, 2008.

An appeal was filed and a decision by the Board of Appeals and Patent Interferences (BPAI) was rendered on June 6, 2011 which reversed the examiner.

The examiner reopened prosecution with a non-final action mailed September 13, 2011. This action rejected claim 6, the only claim in the application, under 35 USC 101 which was a rejection that was not before the BPAI.

A petition to the Director of the USPTO was filed October 7, 2011 and was denied by the Director of Technology Center 3700 on October 24, 2011.

A corrected version of the non-final action, with the TC Director's signature, was mailed October 21, 2011.

The instant petition was filed November 23, 2011.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.198 states:

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:

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 that the Director overturn the Technology Center Director's decision of October 24, 2011 and withdraw the Office action of September 13, 2011 (and by inference all subsequent Office actions).

With respect to the request to withdraw the September 13, 2011 Office action, petitioner argues that the Office is failing to follow 37 CFR 1.198 and the procedures set forth in MPEP 1214.04. In essence, petitioner wants the prior BPAI decision to be conclusive and controlling. Nevertheless, the BPAI itself lacks authority to allow a claim; the examiner is not required to allow an application after reversal of a rejection(s) by the Board of Patent Appeals and Interferences. See Ex Parte Alpha Industries, Inc., 22 USPQ2d 1851,1857 (BPAI 1992). Notwithstanding a decision by the BPAI, 37 CFR 1.198 permits the reopening of prosecution by and through the delegated authority to the Technology Center Director, whose approval was obtained here. As such, the rejections made upon the reopening of prosecution stand and will only be reviewed by the BPAI.

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).

Petitioner argues that the Office action in question was not proper since it was not signed by the USPTO director, indicating that the signature of the Technology Center Director was not in compliance with 37 CFR 1.198. 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 his 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.

Petitioner's remaining arguments are, in essence, that the contents of the Office action, or the form of the rejection and its supportive reasoning, or both, are facially insufficient to demonstrate sufficient cause for reopening of prosecution. Nevertheless, as such arguments go more to the merits of the rejection set forth in that Office action, as opposed to the procedural question of reopening by way of that Office action, they will not be further addressed on petition. See Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC EDVA 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). Any review of the rejection of which petitioner complains (and its underlying reasoning) is limited to a merits appeal as provided by 35 U.S.C. § 134, and not by way of petition. Id. It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r pat. 1971).

Petitioner presents general comments regarding the prosecution of his application and such comments are noted. However, this decision is based solely on a review of the Technology Center Director's petition decision.

Petitioner's query regarding proper venue is noted. Matters regarding examining procedure are properly addressed via petition and petitioner has properly petitioned the matter of reopening prosecution after a decision by the BPAI.

DECISION

The instant petition is granted to the extent that the action of the Technology Center Director has been reviewed, but is denied as to making any change therein. As the reopening of prosecution was not inconsistent with 37 CFR 1.198 and MPEP 1214.04, the Technology Center Director's decision will not be disturbed. The Office action which reopened prosecution remains in full force and effect.

This application is being referred to Technology Center 3700 for further processing.

Telephone inquires concerning this decision may be directed to Petitions Examiner Carl Friedman at (571) 272-6842.

Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy

Tk/cf

[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 USPTO will not further consider or reconsider this matter.