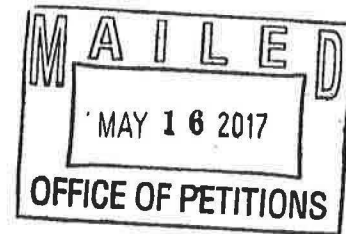




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In re Application of
Mark TELLEFSEN, et al.
Application No. 12/779,334
Filed: May 13, 2010
For: PIGMENT MIXTURES

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on March 29, 2017, requesting that the Director exercise her supervisory authority and overturn the decision of March 23, 2017 by the Director of Technology Center 1600 (Technology Center Director), which decision refused petitioners' request that the examiner be directed to withdraw the finality of the Office action of December 30, 2016, and to consider the references submitted in the reply of September 2, 2016.

The petition is **GRANTED** to the extent that the examiner will be directed to issue a supplemental final Office action (setting a new time period for reply) or other appropriate action that considers the references submitted in the reply of September 2, 2016.

RELEVANT BACKGROUND

The above-identified application was filed on May 13, 2010.

A non-final Office action was mailed on March 2, 2016. The Office action of March 2, 2016 included, *inter alia*, a rejection of claims 1 through 6, 8, 9, 11, 13 through 16, 18 and 22 through 24 under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al. (U.S. Patent Application Publication No. 2004/0120909), Tanaka (U.S. Patent Application Publication No. 2008/0081028), and Nasuno et al. (U.S. Patent No. 4,390, 524).

A reply under 37 CFR 1.111 to the Office action of March 2, 2016, was filed on September 2, 2016. The reply of September 2, 2016 amended claims 1 and 22, canceled claims 19 through 21, and added new claim 25. The reply of September 2, 2016 also included a reference to the following five documents (collectively referred to as "references"): (1) "Kirk Othmer Encyclopedia of Chemical Technology 4sup.th Edition, Vol 16, p. 556 (1991)";

(2) <http://www.naturalpigments.com/mica-fine-wet-ground.html>";
(3) http://www.parasmica.com/wet_ground_mica_powder.htm; (4) http://yamaguchi-mica.com/E/PRODUCT/GENERAL/general_mica.html; and
(5) <http://www.groundmicapowder.com/products.html>. The reply of September 2, 2016 relied upon these references in support of the argument that the "wet ground mica" recited in claim 22 has a recognized meaning in the art.

A final Office action was mailed on December 30, 2016. The Office action of December 30, 2016 included, *inter alia*, (1) a rejection of claim 1 under 35 U.S.C. § 112 ¶1¹, as failing to comply with its written description requirement, and (2) a rejection of claims 1 through 6, 8, 9, 11, 13 through 16, 18, 22, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over Cohen et al., Tanaka, and Nasuno et al. The Office action of December 30, 2016 also stated (at page 15) that—

Applicant argues that the Examiner did not give due weight to the limitation "wet ground mica." (Remarks, pp. 7 - 9) Applicant cites to a couple of references, however these references are not of record because Applicant has not cited them on an IDS. If Applicant had provided the references earlier, the Examiner would have considered them and might have made a different rejection. If Applicant had cited them on an IDS and provided them as an Appendix to the Remarks, the Examiner could have considered them and indicated the claims allowable or issued a Final Rejection necessitated by IDS. However, Applicant has done neither of these things. The burden remains with Applicant to provide the references cited.

A petition under 37 CFR 1.181 was filed on February 28, 2017. The petition of February 28, 2017 requested withdrawal of the finality of the Office action of December 30, 2016 on the basis that the references submitted by petitioners in the reply of September 2, 2016 were not considered by the examiner. The petition of February 28, 2017 was denied by the Technology Center Director in a decision mailed March 23, 2017.

The instant petition under 37 CFR 1.181 was filed on March 29, 2017, and requests that the Director exercise her supervisory authority to review the decision of the Technology Center Director mailed March 23, 2017, and again requests: (1) that the finality of the Office action of December 30, 2016 be withdrawn and (2) consideration of the references submitted in the reply of September 2, 2016.

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated 35 U.S.C. § 112, ¶¶ 1 through 6, as 35 U.S.C. §§ 112(a) through (f), effective as to applications filed on or after September 16, 2012. *See* Pub. L. No. 112-29, § 4, 125 Stat. 284, 293-97 (2011). Because the above-identified application was filed before September 16, 2012, this decision refers to the pre-AIA version of 35 U.S.C. § 112.

STATUTE AND REGULATION

35 U.S.C. § 132(a) provides that:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

OPINION

Petitioners assert that the examiner improperly failed to consider the references submitted in the reply of September 2, 2016 and therefore, the finality of the Office action of December 30, 2016, should be withdrawn. Petitioners argue that the examiner's failure to consider the references submitted in the reply of September 2, 2016 does not comply with section 609.05(c) of the Manual of Patent Examining Procedure (MPEP).

The review of the propriety of a rejection *per se* (and its underlying reasoning) is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 41.31. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468, 1472 (E.D. Va. 2004). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Patent Trial and

Appeal Board. *See In re Dickerson*, 299 F.2d 954, 958 (CCPA 1962) (The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented is a matter appealable to the Board). *See also* MPEP § 1201. There is, however, a distinction between the refusal to consider materials submitted by an applicant (*e.g.*, affidavits and declarations under 37 CFR 1.132 or other information) in support of patentability and the examiner's determination as to the patentability of the claims upon consideration of the materials submitted by an applicant. The refusal to consider materials submitted by an applicant in support of patentability is a procedural matter that is appropriate for review under 37 CFR 1.181. *See In re Deters*, 515 F.2d 1152, 1156 (CCPA 1975) (refusal to enter and consider a terminal disclaimer is reviewable by petition, not appeal); *Ex parte Hale*, 49 USPQ 209, 210-11 (Bd. App. 1941) (refusal to enter and consider an affidavit is not an appealable matter).

MPEP § 609.05(c) states:

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action. However, consideration by the examiner of the document submitted as evidence directed to an issue of patentability raised in the Office action is limited to the portion of the document relied upon as rebuttal evidence; the entirety of the document may not necessarily be considered by the examiner.

At the same time, the document supplied and relied on by applicant as evidence need not be processed as an item of information that was cited in an information disclosure statement. The record should reflect whether the evidence was considered, but listing on a form (*e.g.*, PTO-892, or PTO/SB/08A and 08B) and appropriate marking of the form by the examiner is not required.

For example, if applicant submits and relies on three patents as evidence in reply to a first Office action and also lists those patents on a PTO/SB/08A and 08B along with two journal articles, but does not file a statement under 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p), it would be appropriate for the examiner to indicate that the teachings relied upon by applicant in the three patents have been considered, but to line through the citation of all five documents on the PTO/SB/

9A and 08B and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

See MPEP § 609.05(c).

The references submitted in the reply of September 2, 2016 were relied upon by petitioners in support of the argument that the “wet ground mica” recited in claim 22 has a recognized meaning in the art. The final Office action of December 30, 2016, indicated that the references were not of record because the references were not cited on an Information Disclosure Statement (IDS) in accordance with 37 CFR 1.98(b). *See* Office action of December 30, 2016 at pages 3 and 15. The final Office action of December 30, 2016 further explained that had the references been cited on an IDS, the references would have been considered. *See Id.*

MPEP § 609.05(c) does not necessarily require consideration of an entire document submitted by an applicant as a part of a reply to an Office action, where the submission of the document does not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98. However, MPEP § 609.05(c) does require consideration of, at least, the portion of the document being relied upon as the rebuttal evidence.

While the submission of the references in the reply of September 2, 2016 did not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98, at least the portion of the references relating to the discussion of “wet ground mica” should have been considered by the examiner. *See* MPEP § 609.05(c). The final Office action of December 30, 2016, however, expressly indicated that the references were refused consideration *in toto*. Therefore, the failure to consider the references submitted in the reply of September 2, 2016 is not consistent with the procedures set forth in MPEP § 609.05(c).

DECISION

For the reasons set forth above, the petition is **GRANTED** to the extent that the examiner will issue a supplemental final Office action (setting a new time period for reply) or other appropriate action (a new non-final Office action or notice of allowance) that considers the references submitted in the reply of September 2, 2016.

Petitioners are reminded that any review of the propriety and underlying reasoning of the examiner’s consideration of the references submitted in the reply of September 2, 2016, if adverse to petitioners, is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 1.191, and not by way of petition under 37 CFR 1.181.

The application is being referred to Technology Center 1600 for further processing in accordance with this decision.

Telephone inquiries concerning this decision may be directed to Brian Brown whose telephone number is (571) 272-5338.

A handwritten signature in black ink, appearing to read 'R. Bahr', is positioned above the printed name.

Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy