



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

CESARI AND MCKENNA, LLP
ONE LIBERTY SQUARE
SUITE 310
BOSTON MA 02109



In re Application of:	:	
Tonia Walstad Miller	:	
Application No. 13/218,874	:	DECISION ON PETITION
Filed: August 26, 2011	:	
For: FURNITURE HAVING LOAD-	:	
BEARING OR NON-LOAD BEARING	:	
STRUCTURES FOR STORAGE OF WATER	:	
OR OTHER MATERIAL	:	

This is a decision on the petition under 37 CFR 1.181 filed February 15, 2018,¹ requesting supervisory review of the decision of the Technology Center Director to reopen prosecution in the above-identified application, and requesting that the Office action of December 27, 2017 be withdrawn and that either a notice of allowance be issued in the above-identified application or the above-identified application be assigned to a new examiner.

The petition to withdraw the Office action of December 27, 2017 and to either issue a notice of allowance in the above-identified application or direct the Technology Center Director to assign the above-identified application to a new examiner is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on August 26, 2011.

A requirement for restriction under 35 U.S.C. § 121 was issued on September 30, 2013. The restriction requirement of September 30, 2013 required that the above-identified application be restricted to one of the following inventions: (1) a table as defined by claims 1 through 3 and 10 through 22; and (2) a chair as defined in claims 4 through 9. An election of species requirement for restriction under 35 U.S.C. § 121 was issued on January 30, 2014. The restriction requirement of September 30, 2013 and the election of species requirement of January 30, 2014

¹ The instant petition was only recently forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for decision. Any delay in rendering this decision is regretted.

resulted in claims 3 through 22 being withdrawn from consideration as being directed to a non-elected invention or species.

A non-final Office action was issued on April 18, 2014. The Office action of April 18, 2014 included (1) a rejection of claims 1, 2, and 24 through 26 under 35 U.S.C. § 102(b) as being anticipated by Shaw (U.S. Patent No. 5,060,580); and (2) a rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Shaw and Bylo (U.S. Patent No. 6,729,490). A reply to the Office action of April 18, 2014 was filed on October 20, 2014.

A final Office action was issued on January 30, 2015. The final Office action of January 30, 2015 included (1) a rejection of claims 1 and 24 through 26 under 35 U.S.C. § 102(b) as being anticipated by Shaw (claim 2 having been canceled); and (2) a rejection of claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Shaw and Bylo. A request for continued examination under 35 U.S.C. § 132(b) and 37 CFR 1.114 was filed on April 30, 2015.

A final Office action was issued on May 21, 2015. The final Office action of May 21, 2015 included a rejection of claims 1 and 24 through 26 under 35 U.S.C. § 103(a) as being unpatentable over Shaw and Bylo (claim 23 having been canceled).

A notice of appeal under 35 U.S.C. § 134 and 37 CFR 41.31, and a request for a pre-brief appeal conference, were filed on October 21, 2015. Petitioner was notified that the above-identified application remains under appeal in a notice issued on November 19, 2015. An appeal brief under 37 CFR 41.35 was filed on January 21, 2016, and an examiner's answer was issued on August 22, 2016.

A decision by the Patent Trial and Appeal Board (Board) was issued on July 26, 2017. The Board decision of July 26, 2017 agreed with petitioners that “the examiner erred in finding the cited portions of Shaw and Bylo collectively teach ‘said emergency water store including a plurality of *reusable storage containers* substantially identical in size and shape, each of which includes a spout,’ as recited in independent claim 1” (decision of July 26, 2017 at 2). The Board therefore reversed the examiner's decision to reject claims 1 and 24 through 26 under 35 U.S.C. § 103(a) as being unpatentable over Shaw and Bylo, specifically stating—

Appellant correctly argues Bylo teaches disposable—not reusable—storage containers. *See* App. Br. 12—13; *see, e.g.*, Bylo Abst. (repeatedly discussing disposable storage containers); 2:16—31 (same). In fact, the word “reusable” does not appear in Bylo. The Examiner chose the inherency theory to show Bylo teaches “reusable” storage containers, but has not established Bylo's disposable storage container are necessarily reusable. *See* App. Br. 12—13. Therefore, Appellant has persuaded us the Examiner erred.

Because the Examiner fails to provide sufficient evidence or explanation to support the rejection, we are constrained by the record to reverse the Examiner's rejection of claim 1.

We also reverse the Examiner's rejection of dependent claims 24—26, which depend from claim 1.

Decision of July 26, 2017 at 4.

A non-final Office action was issued on December 27, 2017. The Office action of December 27, 2017 included a rejection of claims 1 and 24 through 26 under 35 U.S.C. § 103(a) as being unpatentable over Shaw and Herckner (U.S. Patent Application Publication No. 2003/0173328). The Office action of December 27, 2017 indicates that the reopening of prosecution after the Board decision of July 26, 2017 was approved by the Director of Technology Center 3600.

The instant petition was filed on February 15, 2018, and requests supervisory review of the decision of the Technology Center Director to reopen prosecution in the above-identified application, and that the Office action of December 27, 2017 be withdrawn and that either a notice of allowance be issued in the above-identified application or the above-identified application be assigned to a new examiner.

STATUTE AND REGULATION

35 U.S.C. § 131 states:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 132 provides that:

(a) 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 the 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.

(b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1).

35 U.S.C. § 134 provides that:

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary

examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

35 U.S.C. § 151 states:

(a) IN GENERAL.—If it appears that an applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee and any required publication fee, which shall be paid within 3 months thereafter.

(b) EFFECT OF PAYMENT.—Upon payment of this sum the patent may issue, but if payment is not timely made, the application shall be regarded as abandoned.

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.

OPINION

Petitioner contends that the reopening of prosecution in the above-identified application was improper because it constituted an abuse of discretion, was against U.S. Patent and Trademark Office (USPTO) policy, and effectively undermined and defied the complete reversal by the Board. Petitioner specifically asserts that: (1) the rejection and prior art relied upon in the Office action of December 27, 2017 (35 U.S.C. § 103(a) over Shaw and Herckner) is very similar to the rejection and prior art relied upon in the Office action of May 21, 2015 (35 U.S.C. § 103(a) over Shaw and Bylo), which rejection was reversed by the Board; (2) the Board did not remand the above-identified application for further examination nor enter a new ground of rejection; (3) the new prior art reference applied in the Office action of December 27, 2017 (Herckner) was published almost eight years before the above-identified application was filed, and thus was available to the examiner at the time of the first Office action in the above-identified application; and (4) the examiner has taken the Board decision as a challenge to make a new search for prior art that, in the examiner's opinion, does not require reliance on the doctrine of inherency.

It is well-established that a court or Board decision reversing a rejection does not preclude further examination of the application by the USPTO or operate as a mandate to issue the application as a patent. *See Jeffrey Mfg. Co. v. Kingsland*, 179 F.2d 35, 36 (D.C. Cir. 1949); *see*

also *In re Gould*, 673 F.2d 1385, 1386 (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*, 455 F.2d 586, 589 (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*, 448 F.2d 1406, 1407, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); *In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967) (holding that, 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*, 326 F.2d 418, 419 (CCPA 1964) (holding that, following decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references); *Hull v. Commissioner*, 9 D.C. (2 MacArth.) 90 (D.C. 1875) (denying mandamus to issue a patent, notwithstanding that the Commissioner withdrew an application from issue after favorable decision by the Board and after payment of the issue fee).

The USPTO has an obligation to refrain from knowingly issuing an invalid patent. *See, e.g., Blacklight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273-74, 63 USPQ2d 1534, 1537-38 (Fed. Cir. 2002) (permitting extraordinary action in withdrawing an application from issue after payment of the issue fee and reopening prosecution to avoid knowingly issuing an invalid patent). Therefore, reopening prosecution after a Board decision to avoid issuing a patent containing claims that the Technology Center Director believes to be unpatentable for reasons not previously adjudicated by the Board or the courts is sufficient cause within the meaning of 37 CFR 1.198. Stated simply, if there is any substantial, reasonable ground within the knowledge or cognizance of the Director of the USPTO why the application should not issue, the Director has the authority and the duty to refuse to issue the application. *See In re Drawbaugh*, 9 App. D.C. 219, 240 (D.C. Cir. 1896); *see also In re Alappat*, 33 F.3d 1526, 1535 (Fed. Cir. 1994) (the Director “has an obligation to refuse to grant a patent if he [or she] believes that doing so would be contrary to law”).

37 CFR 1.198 permits the reopening of prosecution in an application subsequent to a decision by the Board with the written authority of the Director “only for the consideration of matters not already adjudicated, sufficient cause being shown.” *See* 37 CFR 1.198. The authority to permit the reopening of prosecution subsequent to a decision by the Board under 37 CFR 1.198 has been delegated to the Technology Center Director. *See* MPEP 1002.02(c). The reopening of prosecution in the above-identified application was approved by the Technology Center Director as provided for in MPEP 1002.02(c).

While petitioner considers the rejection and prior art relied upon in the Office action of December 27, 2017 to be very similar to the rejection and prior art relied upon in the Office action of May 21, 2015 and was reversed by the Board, the Office action of December 27, 2017 raises a patentability matter not already adjudicated under 37 CFR 1.198. While Office action of July 27, 2017 relies upon a prior art reference (Shaw) that was also relied upon in the rejection that was reversed by the Board in the decision of July 26, 2017, the Office action of July 27, 2017 also relies upon Herckner to support the position that the use of a reusable storage container with a spout is conventional (Office action of December 27, 2017 at 3). The Board decision of July 26, 2017 does not address whether Herckner supports the position that the use of a reusable storage container with a spout is conventional or whether Shaw and Herckner render claims 1

and 24 through 26 unpatentable under 35 U.S.C. § 103. Therefore, patentability of claims 1 and 24 through 26 under 35 U.S.C. § 103 over Shaw and Herckner is not a matter already adjudicated within the meaning of 37 CFR 1.198, and is not a rejection in defiance of the Board decision of July 26, 2017.

While petitioner notes that the Board did not remand the above-identified application for further examination nor enter a new ground of rejection, the reversal of a rejection is not tantamount to a decision that the claim is directed to patentable subject matter. The Board does not determine the patentability of claims in considering an appeal under 35 U.S.C. § 134(a), but reviews adverse decisions of examiners including the findings and conclusions made by the examiner. *See Ex parte Frye*, 94 USPQ2d 1072, 1077 (BPAI 2010); *see also Ex parte Alpha Industries, Inc.*, 22 USPQ2d 1851, 1857 (BPAI 1992) (the Board does not allow claims; it merely decides if, based on the evidence before it, the rejection was proper or not"). In addition, while the Board has the authority to issue a new rejection in its decision, the fact that the Board does not enter a new ground of rejection in its decision is not an indication that the Board considers a claim to be patentable. *See Frye*, 94 USPQ2d at 1077 n.2, *Alpha Industries*, 22 USPQ2d 1851 at 1857. While a decision by the Board to reverse the examiner's rejection generally results in the allowance of the application, such a decision does not require the examiner to allow the application. *See Alpha Industries*, 22 USPQ2d 1851 at 1857.

With respect to petitioner's argument that the new prior art reference applied in the Office action of December 27, 2017 (Herckner) was published almost eight years before the above-identified application was filed, it is regrettable that Herckner was not previously cited and applied in the above-identified application. However, that a rejection could have been made earlier in the examination process does not preclude prosecution from being reopened in an application under 37 CFR 1.198. That is, while petitioner may complain that the USPTO should have uncovered and applied Herckner well prior to December of 2017, this does not warrant directing the examiner to withdraw the Office action of December 27, 2017 or to issue a notice of allowance in the above-identified application.² *See Citron*, 326 F.2d at 419 ("while appellant may have just cause for complaint that the Patent Office should have operated more effectively in finding the closest prior art, which appears to have been available to it all during the prosecution, and in citing it early in the prosecution, this is of no moment whatever in deciding appellant's legal right to the appealed claims in the fact of the new prior art now that it has been cited"). An examiner may change his or her viewpoint as to the patentability of claims as the prosecution of an application progresses, and an applicant has no legal ground for complaint because of such change in view, so long as there is compliance with the patent laws and regulations. *See Ruschig*, 379 F.2d at 993 (quoting *In re Becker*, 101F.2d557 (CCPA 1939)).

With respect to petitioner's requests that the application be assigned to a new examiner, an applicant is not entitled to choose his or her examiner, Supervisory Patent Examiner, or other

² With respect to petitioner's contentions concerning compact prosecution principles and the admonition in MPEP 1214.04 concerning treatment of an application subject to a reversal by the Board, neither of these USPTO policies decrees the allowance of a claim that the Technology Center considers to be unpatentable.

deciding official. *See In re Arnott*, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991). A Technology Center Director and Supervisory Patent Examiner have considerable latitude as part of their day-to-day management of a Technology Center or Group Art Unit (respectively) in deciding the assignment of applications to examiners and the transfer of applications between examiners. A petitioner seeking to invoke the Director's supervisory authority to overrule the Technology Center Director and direct the Technology Center to assign an application to a new examiner must demonstrate improper conduct amounting to bias or the appearance of bias on the part of the examiner. *See In re Ovshinsky*, 24 USPQ2d 1241, 1251-1252 (Comm'r Pats. 1992). The record of the instant application does not indicate improper conduct amounting to bias or the appearance of bias on the part of the examiner so as to warrant directing the Technology Center Director to transfer the above-identified application to a new examiner. The examination of the application has been carefully reviewed and there is no evidence of bias or improper conduct therein on the part of the examiner that would warrant replacing the examiner. The alleged improprieties cited by petitioner do not evidence bias or prejudice on the part of the examiner.

DECISION

The petition to withdraw the Office action of December 27, 2017 and to either issue a notice of allowance in the above-identified application or direct the Technology Center Director to assign the above-identified application to a new examiner is **DENIED**.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). *See* MPEP § 1002.02.

In view of the delay in responding to the petition of February 15, 2018, the time period for reply to the non-final Office action of December 27, 2017 is reset in this decision. Petitioner is given a shortened statutory time period of **two (2) months** from the mailing date of this decision within which to reply to the Office action of December 27, 2017. Failure to file a timely reply under 37 CFR 1.111 to the Office action of December 27, 2017 will result in abandonment of the above-identified application (35 U.S.C. § 133).



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy