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In re Application of :
Roger Davenport :
Application No.: 13/269,603 : DECISION ON PETITION
Filed: October 9, 2011 :
For: **GOLF SWING MEASUREMENT** :
AND ANALYSIS SYSTEM :

This is a decision on the petition filed December 21, 2016, which is being treated as a petition under 37 CFR 1.181 requesting that the Director exercise her supervisory authority and overturn the decision of a Technology Center 3700 Director (Technology Center Director), and direct the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner.¹

The petition to direct the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner is **DENIED**.

BACKGROUND

The above-identified application was filed in the United States Patent and Trademark Office (USPTO) on October 9, 2011.

¹ Petitioner is advised that the Office of Petitions is not another forum to which he may press his request that the above-identified application be transferred from the current Supervisory Patent Examiner and examiner to another Supervisory Patent Examiner and examiner. An applicant dissatisfied with the decision of a Technology Center Director on a matter that is subject to petition under 37 CFR 1.181 may seek higher level review of that matter by the Deputy Commissioner for Patent Examination Policy. Therefore, the instant petition is being treated as a petition under 37 CFR 1.181 seeking higher level review of the Technology Center Director decision refusing petitioner's request to transfer the above-identified applications to a new Supervisory Patent Examiner and examiner.

A non-final Office action (requirement for restriction) was mailed on December 3, 2012. A reply to the Office action (requirement for restriction) of December 3, 2012 was filed on December 28, 2012.

A non-final Office action was mailed March 27, 2013. The Office action of March 27, 2013 included, *inter alia*, (1) a rejection of claims 3, 5, and 12 under 35 U.S.C. § 112, ¶ 2, for failure to comply with its definiteness requirement; (2) a rejection of claims 3, 9, and 11 under 35 U.S.C. § 102(e) as being anticipated by Lueders (U.S. Patent No. 7,691,004) (Lueders); (3) a rejection of claims 4 and 7 under 35 U.S.C. § 103 as being unpatentable over Lueders and Achour et al. (U.S. Patent Application Publication No. 2008/0048917) (Achour); (4) a rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Lueders and Niegowski (U.S. Patent Application Publication No. 2009/0209358) (Niegowski); (5) a rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Lueders and Marsh et al. (U.S. Patent No. 6,196,932) (Marsh); and (6) an indication that claims 5, 6, and 8 were allowed (the reply of December 28, 2012 elected the invention of Group II (claims 3 through 12) for examination). A reply to the Office action of March 27, 2013 was filed on September 27, 2013.

A non-final Office action was mailed January 31, 2014. The Office action of January 31, 2014 included, *inter alia*, (1)) a rejection of claim 3 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description requirement; (2) a rejection of claim 3 under 35 U.S.C. § 103 as being unpatentable over Lueders and Holmberg (U.S. Patent Application Publication No. 2006/0254116) (Holmberg); (3) a rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Lueders, Holmberg, and Achour; (4) a rejection of claims 9 and 11 under 35 U.S.C. § 103 as being unpatentable over Lueders and Papadourakis (U.S. Patent Application Publication No. 2010/0049468) (Papadourakis); (5) a rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Lueders, Papadourakis and Niegowski; (6) a rejection of claim 12 under 35 U.S.C. § 103 as being unpatentable over Lueders, Papadourakis and Marsh; and (7) an indication that claims 5 through 8 were allowed. A reply to the Office action of January 31, 2014 was filed on June 19, 2014.

A non-final Office action was mailed October 17, 2014. The Office action of October 17, 2014 included, *inter alia*, (1) a rejection of claims 5 and 6² under 35 U.S.C. § 112, ¶ 2, for failure to comply with its definiteness requirement; (2) a rejection of claims 5, 7, and 8 under 35 U.S.C. § 103 as being unpatentable over Aisenbrey (U.S. Patent Application Publication No. 2006/0287126) (Aisenbrey) and Boyd (U.S. Patent Application Publication No. 2012/0277018) (Boyd); (3) a rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Aisenbrey, Boyd and Golden et al. (U.S. Patent Application Publication No. 2009/0120197) (Golden); and objections to various informalities in claims 5 through 8 (the reply of June 19, 2014 canceled claims 1 through 4 and 9 through 12). A reply to the Office action of October 17, 2014 was filed on March 17, 2015.

² While not included in the statement of the rejection under 35 U.S.C. § 112, ¶ 2, the body of the rejection under 35 U.S.C. § 112, ¶ 2, also discusses claims 7 and 8.

A final Office action was mailed July 16, 2015. The Office action of July 16, 2015 included, *inter alia*, (1) a rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Aisenbrey, Boyd, and Gaucher et al. (U.S. Patent Application Publication No. 2005/012265) (Gaucher); (2) a rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Aisenbrey, Boyd, Gaucher and Golden; and (3) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Aisenbrey, Boyd, Gaucher and Soler Castany et al. (U.S. Patent Application Publication No. 2009/0085810) (Soler Castany).

A non-final Office action was mailed September 25, 2015. The Office action of September 25, 2015 withdrew the finality of the Office action of July 16, 2015 included, *inter alia*, (1) a rejection of claims 5 through 8 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description and enablement requirements; (2) a rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Carrender (U.S. Patent Application Publication No. 2005/0093700) (Carrender), Aisenbrey and Gaucher; (3) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher, and McKinnon et al. (U.S. Patent No. 6,002,370) (McKinnon); and (4) a rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher, Marshall et al. (U.S. Patent No. 5,355,142) (Marshall), and Telford (U.S. Patent Application Publication No. 2006/0052173) (Telford). A reply to the Office action of September 25, 2015 was filed on February 25, 2016.

A final Office action was mailed June 2, 2016. The Office action of June 2, 2016 included, *inter alia*, (1) a rejection of claims 5 through 8 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description and enablement requirements; (2) a rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher; (3) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher, and McKinnon; and (4) an objection to claim 6 as being dependent upon a rejected base claim, with an indication that claim 6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

A petition under 37 CFR 1.181 was filed on August 16, 2016, requesting that the Technology Center Director transfer the above-identified application to a new Supervisory Patent Examiner and examiner.

A notice of appeal to the Patent Trial and Appeal Board (Board) under 35 U.S.C. § 134 was filed on September 2, 2016.

The petition under 37 CFR 1.181 filed on August 16, 2016 was denied by the Technology Center Director in a decision mailed on September 16, 2016.

The instant petition was filed on December 21, 2016, and again requests transfer of the above-identified application to a new Supervisory Patent Examiner and 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.

37 CFR 1.181(f) provides that:

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.

OPINION

Petitioner asserts that the above-identified application has been subjected to “non-standard” examination. Petitioner specifically asserts that he has two distinct application families pending before the USPTO, and that while the first set of applications has been given “fair” treatment, the second set of applications has been given non-standard treatment. Petitioner details a number of examples of the non-standard treatment given to the above-identified application and other applications, and includes a number of emails to the USPTO’s Ombudsman Program concerning the treatment given to the above-identified application and other applications. Petitioner requests that the Office of Petitions investigate the circumstances of the above-identified application and the other applications and transfer the above-identified application to a new Supervisory Patent Examiner and examiner, preferably the examiner handling the first set of applications.

Initially, the instant petition was filed on December 21, 2016, more than two (2) months after the Technology Center Director’s decision of September 12, 2016. Accordingly, to the extent that the instant petition seeks administrative review of the Technology Center Director’s decision of September 12, 2016, the petition is **denied** as untimely. *See* 37 CFR 1.181(f).

An applicant is not entitled to choose his or her examiner, Supervisory Patent Examiner, or other 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 as between examiners. An applicant seeking to invoke the Director’s supervisory authority to overrule the Technology Center Director and direct the Technology Center Director to assign an application to a new examiner (or Supervisory Patent Examiner) must demonstrate improper conduct amounting to bias or the appearance of bias on the part of the examiner (or Supervisory Patent Examiner). *See In re Ovshinsky*, 24 USPQ2d 1241, 1251-52 (Comm’r Pats. 1992).³ While the course of examination of the above-identified application has been somewhat atypical and more piecemeal than ideal, the record of the above-identified application simply does not indicate improper conduct amounting to bias or the appearance of bias on the part of the examiner or Supervisory Patent Examiner so as to warrant directing the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner.

In the Office actions on the merits issued during the examination of the above-identified application (the Office actions of June 2, 2016, September 25, 2015, July 16, 2015, October 17,

³ The Technology Center Director decision of September 16, 2016 refuses petitioner’s request to transfer the above-identified application to a new Supervisory Patent Examiner and examiner on the basis that the examiner’s actions in the above-identified application are not arbitrary or capricious. A determination that an examiner’s objection, requirement, or other action is arbitrary or capricious would warrant reversing the examiner’s objection, requirement, or other action; however, such a determination would not by itself also warrant transferring an application to a new Supervisory Patent Examiner and examiner.

2014, January 31, 2014 and March 27, 2013), the examiner thoroughly explained the basis for the decision to reject claims under 35 U.S.C. §§ 102, 103, and 112, first or second paragraphs, as applicable. A close review of the Office actions of June 2, 2016, September 25, 2015, July 16, 2015, October 17, 2014, January 31, 2014 and March 27, 2013 reveals nothing more than the explanations that are typically provided to an applicant when the examiner has reached the decision that the applicant's claims are not patentable. The Office actions of June 2, 2016, September 25, 2015, July 16, 2015, October 17, 2014, January 31, 2014 and March 27, 2013 do not reveal any evidence of bias, appearance of bias, or any other improper conduct. A difference of opinion between the examiner and the applicant as to the patentability of one or more claims does not evidence bias, abuse, or any other improper conduct on the part of the examiner, much less that the examiner's replacement is justified. The decision to find a claim patentable or unpatentable is ultimately a judgment call over which reasonable people can disagree. *See Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (U.S.1969).

The argument concerning the examiner's changes of position during examination is likewise unavailing. The USPTO has the responsibility under 35 USC §§ 131 and 151 to issue a patent containing only patentable claims. *See BlackLight Power, Inc. v. Rogan*, 295 F.3d 1269, 1273 (Fed. Cir. 2002). 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 In re Ruschig*, 379 F.2d 990, 993 (CCPA 1967). The USPTO has procedures under which an examiner may withdraw a final Office action to either allow an application or set out new grounds of rejection (MPEP § 706.07(e)) and under which an examiner may reject a previously allowed claim (MPEP § 706.04). It follows that neither withdrawing a final Office action to enter new grounds of rejection nor entering a rejection of a previously allowed claim is an indication of improper conduct on the part of the examiner or Supervisory Patent Examiner.⁴

As discussed previously, a final Office action was mailed June 2, 2016, including, *inter alia*, (1) a rejection of claims 5 through 8 under 35 U.S.C. § 112, ¶ 1, for failure to comply with its written description and enablement requirements; (2) a rejection of claims 5 and 7 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher; and (3) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Carrender, Aisenbrey and Gaucher, and McKinnon. A notice of appeal under 35 U.S.C. § 134 to the Board was filed on September 2, 2016. The review of the propriety of the rejections contained in the final Office

⁴ MPEP § 706.04 does indicate that full faith and credit should be given to the search and action of a previous examiner and that an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something. The rejection of previous allowed claims in the above-identified application, however, is not a consequence of the above-identified application being taken up for action by a new examiner. In any event, this provision is not a proscription against an examiner engaging in an additional search when the examiner has reason to believe that there is relevant prior art that has not been uncovered in a previous search.

action of June 2, 2016 is by way of an appeal as provided by 35 U.S.C. § 134, and not by way of petition or by way of the Ombudsman Program. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468, 1472 (E.D. Va. 2004); *see also Patents Ombudsman Pilot Program*, 75 *Fed. Reg.* 17380, 17381 (Apr. 6, 2010) (Patents Ombudsman Program cannot be used as an alternative forum for resolution of disagreements between the applicant and a USPTO official that are currently resolved via appeal, petition, or other procedures). It is well settled that the Director will not, on petition or otherwise, 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); *see also* MPEP § 1201 (“The line of demarcation between appealable matters for the Board and petitionable matters for the Director of the U.S. Patent and Trademark Office (Director) should be carefully observed. 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.”).

Petitioner also asserts that: (1) the examiner made an examiner’s amendment without the applicant’s authorization (in applications No. 12/287,303 and 13/352,313); and (2) placed “untrue” statements in an interview summary (in application No. 13/273,216). While none of these assertions pertain to the above-identified application, they also do not warrant directing the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner. With respect to the examiner’s amendments: this is not a situation in which the examiner entered an examiner’s amendment despite the applicant not authorizing any examiner’s amendment, but rather a situation in which the language added to the claims by examiner’s amendment may not have matched the agreed upon claim language. Each of the applications in question has now issued as a patent and the situation appears to have been resolved with respect to each application (via a Certificate of Correction in the patent resulting from application No. 12/287,303 and via an amendment under 37 CFR 1.312 in application No. 13/352,313). The post-allowance changes to the claim language in applications No. 12/287,303 and 13/352,313 are of a typographical or minor character and seem more attributable to misunderstanding than the type of improper conduct that would warrant directing the Technology Center Director to transfer an application to a new examiner. With respect to the interview summary: a review of application No. 13/273,216 reveals that this situation is one of disagreement between the applicant and the examiner with respect to the prior art and the applicant’s invention: i.e., a statement being wrong (in petitioner’s view) is being equated to the statement being “untrue.” Application No. 13/273,216 is currently under appeal (an appeal brief having been filed on August 5, 2016). That an applicant and examiner do not agree on whose position is correct and whose position is not correct (i.e., untrue) is typical in an application under appeal, and is not illustrative of the type of improper conduct that would warrant directing the Technology Center Director to transfer an application to a new examiner.

Finally, it is brought to petitioner’s attention that each of the Office actions of June 2, 2016, September 25, 2015, July 16, 2015, October 17, 2014, January 31, 2014 and March 27, 2013 are also signed by a primary examiner or Supervisory Patent Examiner other than examiner Weatherford. The final Office action of June 2, 2016 was signed by primary examiner McClellan, who petitioner characterizes as appearing to be “highly competent and willing to

afford applicant a fair prosecution.” Therefore, the granting of the requested relief would not change the disposition of the pending claims as stated in the final Office action of June 2, 2016.

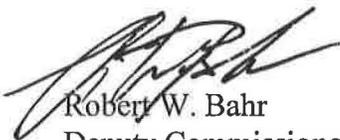
DECISION

For the above-stated reasons, the petition to direct the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner is **DENIED**.

While the circumstances of the above-identified application do not warrant directing the Technology Center Director to transfer the above-identified application to a new Supervisory Patent Examiner and examiner, they do warrant a greater degree of effort on the part of the USPTO to conclude prosecution of the above-identified application. **Accordingly, absent the filing of a request for continued examination under 37 CFR 1.114, any new ground rejection entered in the above-identified application must be approved by a Technology Center Director.**

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.

The application is being forwarded to the Technology Center 3700 to await an appeal brief under 37 CFR 41.37 (or other action) by petitioner.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy