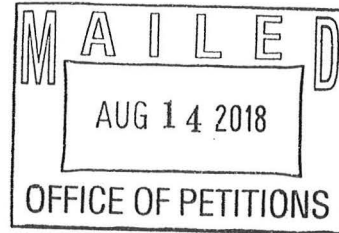




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In re Application of:	:	DECISION
Michael Gregory Zelin	:	
Application No.: 13/291,362	:	ON
Filing Date: December 09, 2011	:	
For: EDUCATIONAL GAMING SYSTEM	:	PETITION

This is a decision on the petition filed on June 21, 2018, which is being considered a petition filed under 37 CFR 1.181 requesting that the Director exercise his supervisory authority and overturn the decision of March 27, 2018, by the Director of Technology Center 3700 (Technology Center Director), which decision refused to: (1) transfer the above-identified application to a new examiner; (2) overturn the new matter rejection raised by the examiner in the final Office action of February 15, 2018; and (3) withdraw the final Office action of February 15, 2018.

The petition of June 21, 2018 is **DENIED** with respect to: (1) transferring the above-identified application to a new examiner; or (2) overturning or disturbing any aspect of the final Office action of February 15, 2018 or the Technology Center Director decision of March 27, 2018.

RELEVANT BACKGROUND

The above-identified application was filed on December 09, 2011.

Prosecution of the above-identified application resulted in a decision of the Patent Trial and Appeal Board (PTAB) being issued on April 24, 2017. The PTAB's decision of April 24, 2017, affirmed the examiner's rejection of all pending claims 1 through 14, 22 and 23 under 35 U.S.C. § 112,¹ second paragraph, as indefinite and also under 35 U.S.C. § 101 as directed to ineligible subject matter.

A request for rehearing of the PTAB's decision of April 24, 2017, was filed on June 20, 2017.

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated pre-AIA 35 U.S.C. § 112, paragraphs 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). The above-identified application was filed prior to September 16, 2012. Therefore, this decision refers to the pre-AIA version of 35 U.S.C. § 112.

A petition under 37 CFR 1.181 to the Technology Center Director was filed on June 26, 2017. The petition of June 26, 2017 requested the Technology Center Director instruct the examiner to re-open the prosecution and give a fair consideration of the application.

A decision on request for rehearing of June 20, 2017 was issued on September 29, 2017. The PTAB's decision of September 29, 2017, granted-in-part the request for rehearing. The decision maintained the affirmance of the examiner's rejections of all pending claims 1 through 14, 22 and 23 under 35 U.S.C. § 112, second paragraph as indefinite, and under 35 U.S.C. § 101 as being directed to ineligible subject matter. However, because the reasoning of the rejection of claims 1 through 14, 22 and 23 under 35 U.S.C. § 101 was further developed in the decision on request for rehearing, the PTAB designated the rejection as a new ground of rejection.

The petition of June 26, 2017 was dismissed by the Technology Center Director as moot in view of the decision on request for a rehearing in a decision issued on November 08, 2017.

An amendment was filed on November 20, 2017. The amendment of November 20, 2017 canceled all pending claims 1 through 14, 22 and 23 and added new claims 24 through 45.

A subsequent amendment was filed on November 28, 2017. The amendment of November 28, 2017 again canceled all pending claims 1 through 14, 22 and 23 and added a different version of new claims 24 through 45.

An advisory action was issued on January 11, 2018. The advisory action of January 11, 2018 stated that the newly filed claims 24 through 45 of November 28, 2017 do not overcome the rejection made by the PTAB under 35 U.S.C. § 101 because they remain directed to the same abstract idea without claiming significantly more than the recited judicial exception.

A petition was filed to the Technology Center Director on February 12, 2018. The petition of February 12, 2018 requested that the Technology Center Director: (1) remove the current examiner from the application and assign a new examiner and (2) take into consideration time lost due to improper rejections and re-start the time period for reply.

A final Office action was issued on February 15, 2018. The final Office action of February 15, 2018 included, *inter alia*: (1) a rejection of claims 24 through 45 under 35 U.S.C. § 112, first paragraph, as failing to comply with its written description requirement; (2) a rejection of claims 26, 33 and 36 under 35 U.S.C. § 112, first paragraph for failing to comply with its enablement requirement; (3) a rejection of claims 27, 37 and 45 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention; and (4) a rejection of claims 24 through 45 under 35 U.S.C. § 101 as being directed to ineligible subject matter.

The petition of February 12, 2018 was denied by the Technology Center Director in a decision issued on February 22, 2018.

Two renewed petitions were filed on February 28, 2018 and March 18, 2018. The renewed petitions of February 28, 2018 and March 18, 2018 requested the Technology Center Director to (1) withdraw the finality of the February 15, 2018 Office action; (2) take into consideration time lost due to all improper rejections and re-start the time count for the application; and (3) review the new matter rejections under 35 U.S.C. § 112, first paragraph .

An amendment in response to the final Office action of February 15, 2018, was filed on March 19, 2018. The amendment of March 19, 2018 presented proposed amendments to independent claims 24, 32 and 45.

The renewed petitions of February 28, 2018 and March 18, 2018, were denied by the Technology Center Director in a decision issued on March 27, 2018.

An advisory action was issued on June 5, 2018. The advisory action of June 5, 2018 stated the proposed amendment filed on March 19, 2018 would not be entered.

A petition to review the Technology Center Director's decision of March 27, 2018, was filed on June 21, 2018.

Additionally, two pre-appeal briefs were filed on June 21, 2018 and June 22, 2018.

A notice of non-compliant pre-appeal brief was issued on June 22, 2018. The notice of June 22, 2018 indicated that the pre-appeal brief of June 22, 2018 was non-compliant because it was not filed concurrently with a notice of appeal.

STATUTE AND REGULATION

35 U.S.C. § 131 provides that:

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 Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

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

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.

37 CFR 1.181 provides that:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) 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.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 41.31 provides that:

(a) *Who may appeal and how to file an appeal.* An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirements of §§ 1.33 and 1.18(a) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

37 CFR 41.39 provides that:

(a) *Content of examiner's answer.* The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief.

(1) An examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision), unless the examiner's answer expressly indicates that a ground of rejection has been withdrawn.

(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon any Evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. The examiner must obtain the approval of the Director to furnish an answer that includes a new ground of rejection.

(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under *ex parte* reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131 or 1.132 of this title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

37 CFR 41.40 provides that:

(a) *Timing.* Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § 1.181 to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant must file a reply under § 1.111 of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § 1.111, the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

(e) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for *ex parte* reexamination proceedings.

OPINION

Petitioner requests: (1) an admission that rejections issued in the above-identified application were wrongful; (2) an admission of the differences between the prior art and the claimed invention; (3) administrative actions be taken to address fraud and misrepresentations; and (4) the application be assigned to another examiner.

As an initial matter, the instant petition was filed on June 21, 2018, more than two (2) months after the Technology Center Director's decision of March 27, 2018. The decision of March 27, 2018, clearly stated that any request for reconsideration of the decision must be filed within two months of the mail date thereof. See Decision of March 27, 2018, pp. 4-5. 37 CFR 1.181(f)

states: "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." Therefore, a request for administrative review of the decision dated March 27, 2018, should be submitted in a petition dated no later than May 27, 2018 (*i.e.*, two months from the March 27, 2018 decision date). Accordingly, to the extent that the present petition dated June 21, 2018, seeks administrative review of the Technology Center Director's decision of March 27, 2018, the petition is **DENIED AS UNTIMELY**. See 37 CFR 1.181(f).

With respect to the petitioner's request for an admission that rejections given in this application were wrongful and an admission of the differences between the prior art and the claimed invention, these matters are clearly directed to the propriety of the examiner's rejections. 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, and not by way of petition under 37 CFR 1.181, even if a petitioner frames the issues as concerning procedure versus the merits. See *Boundy v. US Patent & Trademark Office*, 73 USPQ2d 1468, 1472 (E.D. Va. 2004). The adverse decisions of examiners, which are reviewable by the Board, are those that relate, at least indirectly, to matters involving the rejection of claims. See *In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971). An applicant dissatisfied with an examiner's decision in the second or subsequent rejection may appeal to the Patent Trial and Appeal Board. See 37 CFR 41.31(a)(1). 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.

With respect to petitioner's assertion the examiner has committed fraud and misrepresented facts during examination warranting the assignment of the above-identified application to another examiner, petitioner cites to several examples of alleged fraud or misrepresentations of facts. In particular, petitioner argues the examiner made a false statement when the examiner indicated that changes to rejections were the result of amendments to the claims. Petitioner maintains there were occasions when the examiner and the Patent Trial and Appeal Board decided to withdraw or change rejections because of petitioner's arguments and not as the result of amendments to the claims. Furthermore, petitioner alleges the examiner is aware of the differences between the rating scale of the invention and those of the prior art, and yet, the examiner still maintained the rejections in the advisory action of June 5, 2018.

It is noted that 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 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, including the statements made by the examiner in the final Office action of February 15, 2018, do not indicate improper conduct amounting to bias or the appearance of bias on the part of the examiner or supervisor so as to warrant directing the Technology Center Director to transfer the above-identified application to a new examiner. A close review of the Office actions issued in the above-identified application reveal nothing more than explanations typically provided to an applicant when the examiner has reached the decision that the applicant's claims are not patentable. The Office actions 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 petitioner's argument concerning the examiner's change of positions during examination is likewise unavailing. The USPTO has the responsibility under 35 U.S.C. §§ 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).

In view of the above, petitioner has not demonstrated improper actions amounting to bias or the appearance of bias on the part of the examiner that would warrant replacing the examiner.

DECISION

For the previously stated reasons, the petition is granted to the extent that the Technology Center Director decision of March 27, 2018 have been reviewed, but the petition is **DENIED** with respect to: (1) transferring the above-identified application to a new examiner; or (2) overturning or disturbing any aspect of the final Office action of February 15, 2018 or the Technology Center Director decision of March 27, 2018.

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.

Petitioner is advised that the Pre-Appeal Brief Request filed on June 22, 2018 was held non-compliant because the Request was not filed concurrently with a proper Notice of Appeal. The requirement for the submission of a proper reply to the final Office action of February 15, 2018

is still outstanding and the time period set forth in the final Office action of February 15, 2018 continues to run.

A handwritten signature in black ink, appearing to read 'R. W. Bahr', with a stylized flourish at the end.

Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy