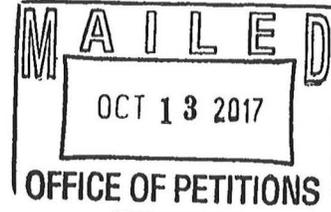




UNITED STATES PATENT AND TRADEMARK OFFICE

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

OLIFF PLC
P.O. BOX 320850
ALEXANDRIA VA 22320-4850



ON PETITION

In re Application of :
Hideaki SHIRAI, et al. :
Application No. 13/353,841 :
Filed: January 19, 2012 :
Attorney Docket No.: 152067 :
For: WELDING METHOD AND WELDING :
APPARATUS :

This is a decision on the petition under 37 CFR 1.181 filed on August 25, 2017, requesting that the Director exercise supervisory authority and overturn the decision of August 17, 2017, by the Director of Technology Center 3700 (Technology Center Director), which decision refused to withdraw the finality of the Office action of June, 9, 2017, or issue a new non-final Office action in the above-identified application.

The petition to withdraw the finality of the Office action of June, 9, 2017, or issue a new non-final Office action in the above-identified application is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on January 19, 2012.

A non-final Office action was mailed on March 23, 2015. The non-final Office action of March 23, 2015, included, *inter alia*: (1) a rejection of claims 1 through 5 under 35 U.S.C. § 112, ¶ 2,¹ as being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention; and (2) a rejection of claims 1 through 5 under 35 U.S.C. § 103 as being unpatentable over *Oros et al.* (U.S. Patent No. 5,938,948).

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). Since the above-identified application has a filing date prior to September 16, 2012, this decision refers to the pre-AIA version of 35 U.S.C. § 112.

A reply to the non-final Office action of March 23, 2015, was filed on June 22, 2015. The reply of June 22, 2015, included an amendment amending claims 1 through 5 and adding new claims 17 and 18.

A final Office action was mailed on October 8, 2015. The final Office action of October 8, 2015, included a rejection of claims 1 through 5, 17, and 18 under 35 U.S.C. § 103 as being unpatentable over *Oros et al* (U.S. Patent No. 5,938,948).

In response to the final Office action of October 8, 2015, a request for continued examination under 37 CFR 1.114 was filed on December 7, 2015. The request for continued examination of December 7, 2015, included an amendment canceling claim 2, amending claims 1, 3 through 5, and 18, and adding new claims 19 and 20.

A final Office action was mailed on July 7, 2016. The final Office action of July 7, 2016, included a rejection of claims 1, 3 through 5, and 17 through 20 under 35 U.S.C. § 103 as being unpatentable over *Oros et al* (U.S. Patent No. 5,938,948).

In response to the final Office action of July 7, 2016, another request for continued examination under 37 CFR 1.114 was filed on September 30, 2016. The request for continued examination of September 30, 2016, included an amendment amending claims 1 and 19 and adding new claims 21 through 23.

A final Office action was mailed on June 9, 2017. The final Office action of June 9, 2017, included a rejection of claims 1, 3 through 5, and 17 through 23 under 35 U.S.C. § 103 as being unpatentable over *Oros et al* (U.S. Patent No. 5,938,948).

A petition under 37 CFR 1.181 to the Technology Center Director was filed on July 28, 2017, requesting that the finality of the Office action of June 9, 2017 (the first action following the request for continued examination of September 30, 2016) be withdrawn or that a new non-final Office action be issued.

The petition of July 28, 2017 was denied by the Technology Center Director in a decision dated on August 17, 2017.

The instant petition was filed on August 25, 2017, again requesting that the finality of the Office action of June 9, 2017 (the first action following the request for continued examination of September 30, 2016) be withdrawn or that a new non-final Office action be issued.²

² The instant petition under 37 CFR 1.181 was accompanied by a petition under 37 CFR 1.182 requesting expedited processing of the instant petition. The petition to expedite the processing of the instant petition is **dismissed** as moot in view of this decision. The \$400 fee payment for the petition to expedite under 37 CFR 1.182 filed on September 1, 2017, has been refunded by credit to the deposit account to which this fee was previously charged.

STATUTE AND REGULATION

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).

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 1.114 provides that:

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

- (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
- (2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

- (1) A provisional application;
- (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
- (3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;
- (4) An application for a design patent;
- (5) An international design application; or
- (6) A patent under reexamination.

OPINION

Petitioners argue that the finality of the Office action of June 9, 2017, is improper because: (1) the claims in the above-identified application have been changed in scope relative to the claims prior to the filing of the request for continued examination of September 30, 2016; and (2) section 706.07(b) of the Manual of Patent Examining Procedure (MPEP) does not permit a final rejection in the action immediately subsequent to the filing of a request for continued examination if there is a change in scope of the claims in the request for continued examination. Petitioners specifically argue that the phrase “same invention” in MPEP § 706.07(b) means “same invention” as discussed in MPEP § 804, which states that “same invention claimed” means “the ‘scope’ of the inventions claimed is identical.” Petitioners further argue that “same invention” in MPEP § 706.07(b) does not simply mean that the claims are drawn to a patently indistinct invention, as the requirement would be meaningless since an applicant may not present claims to a patently distinct invention with a request for continued examination. Petitioners also

contends that the Technology Center Director's position is contrary to the position provided by the Office of Patent Legal Administration (OPLA), who indicated they would interpret "same invention claimed" consistent with how petitioners interpret the phrase, in that more than a *de minimis* amendment would not meet the "same invention claimed" condition required to make a first action final rejection after a request for continued examination.

Current first action final rejection practice is set forth in MPEP § 706.07(b), which provides that—

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114.

It would not be proper to make final a first Office action in a continuing or substitute application or an RCE where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

See MPEP § 706.07(b) (9th ed., Nov. 2015 Rev.). All references to the MPEP are to the Nov. 2015 Revision (9th ed.) of the MPEP unless otherwise indicated.

First action final rejection practice for continuing applications is traceable at least back to the 1920s and serves the function of reducing delay by forcing an applicant to draft claims in the continuing application in view of the prosecution history in the earlier application. *See In Bogese*, 22 USPQ2d 1821, 1824-26 (Comm'r Pat. 1992). The requirement of current MPEP

§ 706.07(b) that the claims of the new application “are drawn to the same invention claimed in the earlier application” was introduced in April of 1969. Specifically, first action final rejection practice was revised in April of 1969 to provide as follows—

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the art of record in the next Office action if they had been entered in the earlier application. A first action final rejection in a continuation-in-part application is not proper where any claim includes subject matter not present in the parent application.

See 861 Off. Gaz. Pat. Office 1011 (Apr. 22, 1969) (1969 First Action Final Rejection Notice).

The 1969 First Action Final Rejection Notice does not specifically define “same invention.” The context of and other provisions in the 1969 First Action Final Rejection Notice, however, indicate that its use of the phrase “same invention” is not synonymous with the use of the phrase “same invention” as discussed in MPEP § 804 with respect to statutory double patenting under 35 U.S.C. § 101.

The discussion of the phrase “same invention” in MPEP § 804 is in the context of statutory double patenting under 35 U.S.C. § 101, which means that identical subject matter is being claimed twice. *See* MPEP § 804 (discussing *In re Vogel*, 422 F.2d 438 (CCPA 1970)). The phrase “same invention” in the 35 U.S.C. § 101 double patenting context admits of different wording only if those different words still define the same invention (the example given being in *Vogel* is a claim reciting a length of “thirty-six inches” defining the same invention as a claim reciting a length of “three feet,” all other limitations being identical). *See Vogel*, 422 F.2d at 441.

The use of the phrase “same invention” in current MPEP § 804 is not persuasive that “same invention” in MPEP § 706.07(b) means “same invention” as discussed in MPEP § 804 with respect to “statutory” double patenting under 35 U.S.C. § 101. While the phrase “same invention” is used in current MPEP § 804 (albeit in quotes) in its discussion of double patenting under 35 U.S.C. § 101, the phrase “same invention” was also used in the MPEP in 1969 when describing a continuation application as being a subsequent application for the same invention claimed in a prior application. *See* MPEP § 201.07 (3rd ed., Rev. 17, July 1968) (the revision of MPEP chapter 200 in effect in April of 1969). Continuation applications (currently and in 1969), however, are not limited to the situation in which the later (continuation) application claims subject matter identical to that claimed in the earlier application. More significantly, the introduction of the phrase “same invention” into first action final rejection practice (MPEP § 706.07(b)) in April of 1969 predates the use of the phrase “same invention” by the Court of Customs and Patent Appeals (CCPA) in the 1970 *Vogel* decision to distinguish between statutory double patenting under 35 U.S.C. § 101 and obviousness-type (or non-statutory) double patenting, and thus further predates the incorporation of the distinction between “same

invention” (35 U.S.C. § 101) double patenting and obviousness-type double patenting from *Vogel* into the MPEP in 1972 (MPEP § 804 (3rd ed., Rev. 32, Apr. 1972)). Given the temporal relationship of the use of the phrase “same invention” in the 1969 First Action Final Rejection Notice (incorporated into MPEP § 706.07(b)) and the introduction of the concept of “same invention” double patenting under 35 U.S.C. § 101 (as distinguished from obviousness-type double patenting) by the CCPA in its 1970 *Vogel* decision (and subsequent incorporation into MPEP § 804 in 1972), it is not reasonable that the discussion of “same invention” in current MPEP § 804 concerning double patenting under 35 U.S.C. § 101 informs the meaning of “same invention” in MPEP § 706.07(b).

The other provisions in the 1969 First Action Final Rejection Notice also indicate that its use of the phrase “same invention” is not synonymous with the use of “same invention” in the context of statutory double patenting under 35 U.S.C. § 101. First, the 1969 First Action Final Rejection Notice indicates that it is applicable to continuing (and substitute) applications, not simply continuation applications. The term “continuing applications” (currently and in 1969), however, includes continuation applications, divisional applications, and continuation-in-part applications. See MPEP § 211.01(b) and MPEP § 201.11 (3rd ed., Rev. 17, July 1968). If the 1969 First Action Final Rejection Notice intended first action final rejection practice to be limited to the situation in which identical subject matter is being claimed in the continuing application and the earlier application, the 1969 First Action Final Rejection Notice would refer only to continuation applications, rather than using a more generic term (“continuing applications”) that also includes divisional applications and continuation-in-part applications. Additionally, the 1969 First Action Final Rejection Notice provides that it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. This provision is superfluous if the 1969 First Action Final Rejection Notice intended first action final rejection practice to be limited to the situation in which identical subject matter is being claimed in the continuing application and the prior application, as claims to identical subject matter would never involve the claiming of subject matter not even present in the earlier application.³ Thus, treating the phrase “same invention” in the 1969 First Action Final Rejection Notice as meaning “same invention” in the context of statutory double patenting under 35 U.S.C. § 101 under current MPEP § 804 would be incompatible with the other provisions in the 1969 First Action Final Rejection Notice.

Moreover, while many first action final rejection situations involve instances in which an applicant has failed to make any amendment to the claims (*e.g.*, *Bogese*), a review of past first action final rejection decisions reveals first action final rejections being approved

³ As discussed previously, the purpose of first action final rejection practice is to reduce delay by forcing an applicant to draft claims in the continuing application in view of the prosecution history (*e.g.*, the prior art cited) in the earlier application. See *Bogese*, 22 USPQ2d at 1825. Applying first action final rejection practice only in the situation in which the applicant is again claiming identical subject matter would permit an applicant to avoid a first action final by making only nominal or even *de minimis* changes in the claims in the continuing application, which would not serve the stated purpose of first action final rejection practice to reduce delay by forcing an applicant to draft claims in the continuing application in view of the prosecution history in the earlier application.

notwithstanding a change to the scope of the claims (e.g., the application at issue in *Molins PLC v. Quigg*, 837 F.2d 1064 (Fed. Cir. 1988), involved a change to the scope of the claims that is comparable to the changes in the above-identified application). This suggests that the phrase “same invention” in MPEP § 706.07(b) has not previously been considered by the United States Patent and Trademark Office (USPTO) as being limited to the “same invention” for purposes of statutory double patenting under 35 U.S.C. § 101.

With respect to petitioners' argument concerning the presentation of claims to a patently distinct invention with a request for continued examination: Request for continued examination practice was implemented in 2000 as part of the American Inventors Protection Act of 1999 (AIPA).⁴ See *Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 Fed. Reg. 50092, 50092 (Aug. 16, 2000) (final rule). The USPTO did not create first action final rejection practice, or even modify the existing action final rejection practice, when request for continued examination practice was implemented in 2000. Rather, the USPTO simply applied the first action final rejection practice then currently in place for continuing application in MPEP § 706.07(b) to applications in which a request for continued examination was filed. See *Request for Continued Examination Practice and Changes to Provisional Application Practice*, 65 Fed. Reg. at 50096 (“[t]he action immediately subsequent to the filing of [a request for continued examination] may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met”). Since first action final rejection practice in MPEP § 706.07(b) remains applicable to continuing applications (which include continuation applications, divisional applications, and continuation-in-part applications), and first action final rejection practice was not modified when request for continued examination practice was implemented in 2000, it is not superfluous for “same invention” in MPEP § 706.07(b) to mean only that the claims must not be drawn to a patently distinct invention.

With respect to petitioners' argument concerning the information allegedly provided by an employee or employees of OPLA: Petitioners are reminded that business with the USPTO is to be conducted in writing; that the action of the USPTO will be based exclusively on the written record; and that no attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt. See 37 CFR 1.2. Therefore, any discussions between petitioners' representative and OPLA concerning MPEP § 706.07(b) that are external to the record of the above-identified application are of no consequence.⁵

In the above-identified application, the claims filed in the amendment of September 30, 2016, were directed to the same invention claimed previously, even though claim 1 included the additional limitation “wherein the nozzle plate has a flat portion which is parallel to the surface

⁴ See Pub. L. 106-113, 113 Stat. 1501, 1501A-560 (1999).

⁵ Assuming *arguendo*, that OPLA provided petitioners with information that is not consistent with this decision, the undersigned regrets that petitioners were provided with such information. Nevertheless, any information provided by OPLA in this matter did not occur until after the final Office action of June 9, 2017, was mailed, and thus was not a cause or contributing factor in this application being in condition for a first action final rejection in June of 2017.

of the base material and the opening is arranged in the flat portion” and claim 19 included the limitation “and the pressure outside of the arc region is measured at the peripheral portion of the opening.” In addition, the claims were rejected in the final Office action dated June 9, 2017, under 35 U.S.C. § 103 as being unpatentable over U.S. Patent No. 5,938,948 to *Oros et al.*, the same grounds and art used in the final Office action of July 7, 2016. Therefore, making the Office action of July 7, 2016, the first Office action following the request for continued examination of September 30, 2016, a final Office action was consistent with MPEP § 706.07(b).

In conclusion, for the reasons stated herein, making the Office action of July 7, 2016, a final Office action was consistent with MPEP § 706.07(b). Accordingly, the Technology Center Director or examiner will **not** be directed to withdraw the finality of the Office action of June, 9, 2017, or issue a new non-final Office action in the above-identified application.

Finally, petitioners are reminded that it would not be proper to make final a first Office action in a request for continued examination where that application contains material which was presented in the earlier application after final rejection or closing of prosecution, but was denied entry because: (1) new issues were raised that required further consideration and/or search, or (2) the issue of new matter was raised. *See* MPEP § 706.07(b). Thus, petitioners could have taken advantage of after final practice in order to avoid receiving a first action final rejection by simply submitting an amendment-after-final rather than submitting the amendment for the first time as part of a request for continued examination. *See Molins PLC v. Quigg*, 4 U.S.P.Q.2d 1646, 1650 (D.D.C. 1987).

DECISION

The instant petition is granted to the extent that the action of the Technology Center Director has been reviewed, but is **denied** with respect to overruling the Technology Center Director’s decision or directing the Technology Center Director or examiner to withdraw the finality of the Office action of June, 9, 2017, or issue a new non-final Office action in the above-identified application.

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 petitioners in the instant application (*e.g.*, a final decision by the Patent Trial and Appeal Board). *See* MPEP § 1002.02.

Petitioners are reminded that a proper reply under 37 CFR 1.113 to the final Office action of June 9, 2017, remains outstanding. The mere filing of a petition will not stay any period for reply that may be running against the application. *See* 37 CFR 1.181(f).

Telephone inquiries concerning this decision should be directed to Vincent N. Trans at (571) 272-3613.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy