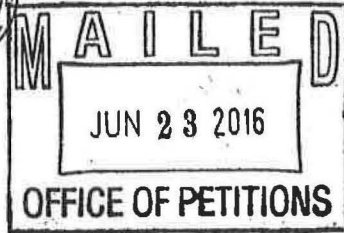




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In re Application of
Man-Seok Kang et al.
Application No. 13/447,441
Filed: April 16, 2012
Attorney Docket No.: 011001.0206C3
For: INFORMATION STORAGE MEDIUM
STORING TEXT-BASED SUBTITLE, AND
APPARATUS AND METHOD FOR
PROCESSING TEXT-BASED SUBTITLE

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed November 30, 2015, requesting supervisory review of the decision of the Director of Technology Center 2400 dated September 28, 2015, and specifically requesting the authorization of the issuance of a certificate of correction to include U.S. Patent No. 6,088,507 among the references cited in the patent (U.S. Patent No. 9,031,380) that resulted from the above-identified application.

The petition to authorize the issuance of a certificate of correction to include U.S. Patent No. 6,088,507 among the references cited in the patent that resulted from the above-identified application is **DENIED**.

BACKGROUND

The above-identified application was filed on April 16, 2012, and is identified as a continuation of 10/956,342, which in turn has a filing date of October 4, 2004.

A Notice of Allowance in the above-identified application was mailed October 1, 2014.

An Information Disclosure Statement (IDS) was filed in the above-identified application on November 5, 2014.

A Notice of Non-Compliant IDS was mailed November 13, 2014 stating that the IDS filed November 5, 2014 failed to comply with 37 CFR 1.97.

The IDS was resubmitted on December 30, 2014.

A Notice of Non-Compliant IDS was mailed January 13, 2015 stating that the IDS filed December 30, 2014 failed to comply with 37 CFR 1.97.

A petition under 37 CFR 1.181 to the Technology Center Director of 2400 was filed January 14, 2015.

The Technology Center Director of 2400 denied the petition filed on January 14, 2015 in a decision mailed on March 19, 2015.

A renewed petition to the Technology Center Director of 2400 was filed on May 11, 2015.

The above-identified application issued as U.S. Patent No. 9,031,380 on May 12, 2015.

The Technology Center Director of 2400 denied the petition filed on May 11, 2015 in a decision mailed on September 28, 2015.

The present petition was filed on November 30, 2015, and requests supervisory review of the decision of the Director of Technology Center 2400 dated September 28, 2015, and authorization of the issuance of a certificate of correction to include U.S. Patent No. 6,088,507 among the references cited in the patent that resulted from the above-identified application.

OPINION

Petitioner argues that the timing requirements of 37 CFR 1.97 are inapplicable to the IDS submitted on November 5, 2014¹. Petitioner specifically argues that MPEP 609.02 (A)2 permits an applicant in a continuing application to provide a listing of references cited on an IDS that was filed in and considered by the Examiner in the parent application, and that such listing of references need only meet the requirements of 37 CFR 1.98(a)(1) to have the items of information listed thereon printed among the References Cited section of any patent resulting from the continuing application.

Petitioner's argument is not persuasive. 37 CFR 1.97 and 1.98 set out the requirements for filing an IDS. The IDS (or the listing of information) submitted on November 5, 2015 does not comply with the requirements of 37 CFR 1.97. Therefore, there is no error in the decision to treat the IDS (or the listing of information) submitted on November 5,

¹ Petitioner characterizes the document submitted on November 5, 2014 as a listing of information considered in the parent application. The document submitted on November 5, 2014 is referred to in this decision as an IDS inasmuch the rules of practice provide for such a listing only in the context of an IDS.

2015 as a non-compliant IDS. See 37 CFR 1.97(e)("[i]f an information disclosure statement does not comply with either this section or [37 CFR] 1.98, it will be placed in the file but will not be considered by the Office").

MPEP 609.02 and 609.02(A)2 discuss filing an IDS in a continuing application. MPEP 609.02 provides that all references listed on a properly submitted IDS in a parent case will be considered by the Examiner of the continuing application, but also indicates that such references are not printed on a patent resulting from a continuing application. See MPEP 609.02 ("[a] listing of the information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent").

Petitioner, however, argues that the statement in MPEP 609.02(A)2 that "[i]f resubmitting a listing of the information, applicant should submit a new listing that complies with the format requirements in 37 CFR 1.98(a)(1)" indicates that an applicant is not required to comply with the timing requirements of 37 CFR 1.97.

Petitioner specifically argues that since MPEP 609.02(A)2 refers only to a list of information and not to an IDS, and refers only to the format requirements of 37 CFR 1.98(a)(1) and not the timing and fee requirements of 37 CFR 1.97, petitioner was not required to file an IDS in compliance with the timing requirements of 37 CFR 1.97 to have U.S. Patent No. 6,088,507 included among the references cited in the patent (U.S. Patent No. 9,031,380) that resulted from the above-identified application.

This argument is not persuasive. MPEP nowhere states that such a listing is not an IDS or that such a listing need not comply with the IDS timing requirement of 37 CFR 1.97. Petitioner apparently contends that the absence of an express statement that compliance with the timing requirement 37 CFR 1.97 is required implies that there is no need to comply with the timing requirement 37 CFR 1.97. This interpretation of MPEP 609.02(A)2 is not correct. The entire provision (MPEP 609.02) is temporally linked to the filing of a continuing application, at which point an IDS may be filed under 37 CFR 1.97(b) without a fee or certification under 37 CFR 1.97(e). In any event, the mere absence of a mention of a regulation (37 CFR 1.97) does not imply that it is not applicable (e.g., documents such as an IDS or a listing of information must comply with the format requirements of 37 CFR 1.52, but this regulation is also not mentioned in MPEP 609.02(A)2).

37 CFR 1.98(a) states that: "Any information disclosure statement filed under §1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section." 37 CFR 1.97 (a) states that: "[i]n order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section." The rules specifically refer to each other and must be read together. When read together, it is clear that a listing of information, as referenced in MPEP 609.02(A)2, must meet the

requirements of both 37 CFR 1.97 and 1.98 to receive the treatment accorded a compliant IDS.

Petitioner appears to be arguing that there are different types of information disclosure statements: one being an IDS meeting the requirements of 37 CFR 1.97 and 1.98, and the other being a mere listing of information that need not comply with the requirements of 37 CFR 1.97 and 1.98, except for the format requirements of 37 CFR 1.98(a)(1). There is no provision in the rules of practice or MPEP for an IDS that meets only the format requirements of 37 CFR 1.98(a)(1). The two types of information disclosure statements provided for in 37 CFR 1.97 and 1.98 and the MPEP are those meeting the requirements of 37 CFR 1.97 and 1.98 (a compliant IDS), and those that do not comply with the requirements of 37 CFR 1.97 and 1.98 (a non-compliant IDS). The IDS submitted on November 5, 2014 did not comply with the timing requirement of 37 CFR 1.97, and, as such, was properly treated as a non-compliant IDS.

DECISION

The instant petition is granted to the extent that the decision of the Technology Center Director dated September 28, 2015 has been reviewed, but is **denied** with respect to overruling the Technology Center Director's decision or authorizing the issuance of a certificate of correction to include U.S. Patent No. 6,088,507 among the references cited in the patent (U.S. Patent No. 9,031,380) that resulted from the above-identified application.

This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries concerning this decision may be directed to Vanitha Elgart at 571.272.7395.



Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy