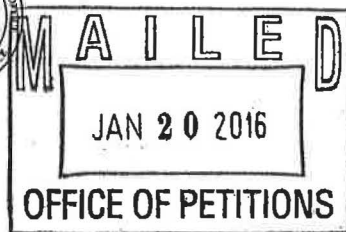




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In re Application of
Haisam YAKOUB, et al.
Application No. 13/462,811
Filed: May 2, 2012
Attorney Docket No.:

ON PETITION

This is a decision on the petition filed June 28, 2015, under 37 CFR 1.181(a)(3) requesting that the Director exercise her supervisory authority and overturn the decisions of the Director, Technology Center 2800 (Technology Center Director), dated June 2, 2015, which refused to: (1) withdraw the finality of the January 28, 2015 Office action; and (2) withdraw the Advisory Acton dated April 21, 2015 and continue prosecution according to the After Final Consideration Pilot Program 2.0 (AFCP 2.0). This is also a decision on the petition filed June 29, 2015, under 37 CFR 1.181(a)(3) requesting that the Director exercise her supervisory authority and overturn the decisions of the Technology Center Director, dated May 29, 2015, which refused to appoint a new examiner, Supervisory Patent Examiner, and art unit.

The petitions to overturn the decisions of the Technology Center Director dated June 2, 2015 and May 29, 2015 are **DENIED**.

RELEVANT BACKGROUND

The instant application was filed May 2, 2012.

On January 28, 2015, a final Office action was mailed rejecting claims 15-18, 21 and 23 under 35 U.S.C. 102, rejecting claims 22 and 23 under 35 U.S.C. 103, withdrawing claim 24 as being directed to a nonelected invention, and objecting to claims 19 and 20 as being allowable if rewritten to include the limitations of the base claim and any intervening claims.

On March 23, 2015 and March 25, 2015, petitions to the TC Director were filed.

On March 25, 2015, a response after final Office action was filed

On April 20, 2015 and April 21, 2015, petitions to the TC Director were filed.

On April 21, 2015, an Advisory Action in response to the March 25, 2015 amendment after final Office action was mailed along with an unnecessary AFCP 2.0 Decision.

On April 22, 2015, a petition to the TC Director was filed.

On April 24, 2015, an improperly signed Certification and Request for Consideration Under the After Final Consideration Pilot Program 2.0 was filed.

On April 27, 2015, an improperly signed Notice of Appeal was filed, along with a petition to the TC Director and a response after final Office action.

On May 4, 2015 and May 28, 2015, petitions to the TC Director were filed along with a response after final Office action.

On May 28, 2015, an AFCP 2.0 decision in response to the April 24, 2015 AFCP 2.0 request was mailed along with an Advisory Action which responded to the April 27, 2015 response after final Office action.

On May 29, 2015 and June 2, 2015, the TC Director mailed petition decisions which dismissed the previously filed petitions.

On June 11, 2015, an Advisory Action which responded to the May 28, 2015 response after final Office action was mailed.

On June 17, 2015 and June 26, 2015, Appeal Briefs were filed.

On June 19, 2015, a Notice of Non-Compliant Amendment was mailed along with an Advisory Action correcting an error in the Advisory Action mailed June 11, 2015.

On June 28 and June 29, 2015, petitions were filed requesting supervisory review of the petition decisions of the TC Director.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. 2(b) states, in part:

The Office..... may establish regulations, not inconsistent with law, which—
shall govern the conduct of proceedings in the Office.

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 states:

(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) of this title.

37 CFR 1.33(b)(pre-AIA) states:

Amendments and other papers.

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

- (1) A patent practitioner of record appointed in compliance with § 1.32(b);
- (2) A patent practitioner not of record who acts in a representative capacity under the provisions of § 1.34;
- (3) An assignee as provided for under § 3.71(b) of this chapter; or
- (4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

37 CFR 1.113 states:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicants, 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 (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner

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 1.116 states:

(a) An amendment after final action must comply with § 1.114 or this section.

(b) After a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913, but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title):

(1) An amendment may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action;

(2) An amendment presenting rejected claims in better form for consideration on appeal may be admitted; or

(3) An amendment touching the merits of the application or patent under reexamination may be admitted upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented.

(c) The admission of, or refusal to admit, any amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or reexamination proceeding from its condition as subject to appeal or to save the application from abandonment under § 1.135, or the reexamination prosecution from termination under § 1.550(d) or § 1.957(b) or limitation of further prosecution under § 1.957(c).

(d)(1) Notwithstanding the provisions of paragraph (b) of this section, no amendment other than canceling claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the

reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

MPEP 706.07 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits. Neither the statutes nor the Rules of

Practice confer any right on an applicant to an extended prosecution; Ex parte Hoogendam, 1939 C.D. 3, 499 O.G.3, 40 USPQ 389 (Comm'r Pat. 1939).

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's reply. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with Form Paragraph 7.39.

MPEP 706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b).

MPEP 714.01 states:

An unsigned amendment or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment is signed by only one of two joint inventors and the one signing has not been given a power of attorney by the other inventor.

MPEP 714.12 states:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b). Amendments filed after the date of filing an appeal may be entered if the amendment complies with 37 CFR 41.33. See MPEP § 1206. Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See MPEP § 706.07(f), § 714.13 and § 1206.

MPEP 714.13 states:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

MPEP 1201 states:

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. 134) .

The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (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. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the

Board for a decision. In re Watkinson, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

OPINION

With respect to the petition filed June 28, 2015

Petitioner seeks reversal of the Technology Center Director's decisions of June 2, 2015, on the grounds that the final Office action of January 28, 2015 improperly rejected the claims over the prior art. Accordingly, petitioner further contends that the finality of the January 28, 2015 Office action should be withdrawn and the amendments filed March 25, 2015 and April 27, 2015 should be entered.

Petitioner complains that the examiner has erred in not recognizing as to how the claims distinguish over the prior art. A rejection, or the continuation of a rejection, of a claim(s) cannot be reviewed on petition; rather, as explained in MPEP 1201, the mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Patent Trial and Appeal Board under 35 U.S.C. § 134 and 37 CFR 41.31. The issues of whether, *e.g.*, the examiner properly analyzed the claims in light of the specification disclosure before making the rejection(s), or whether the rejections over prior art were properly maintained relate to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a); see also Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). 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, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

Petitioner next argues that the copying and underlining of applicant's remarks in the final rejection was confusing and that the examiner's responses to the arguments presented by petitioner were irrelevant. The issue of copying and underlining applicant's remarks is not considered to be confusing. Moreover, that petitioner disagrees with the examiner's remarks or considers the examiner's remarks irrelevant are not an issue to be reviewed on petition. Additionally, as noted by the TC Director the interviews conducted with the examiner and Supervisory Patent Examiner are not factors which determine the propriety of the final Office action.

Petitioner further argues that the Advisory Action dated April 21, 2015 should be withdrawn and prosecution should continue in accordance with the After Final Consideration Pilot Program 2.0 (AFCP 2.0). While petitioner contends that there has been no response to the AFCP 2.0 request filed April 24, 2015 it should be noted that the examiner indicated in the AFCP 2.0 Decision, mailed May 28, 2015, the after final

amendment would be treated under pre-pilot procedure as the after final amendment cannot be reviewed and a search conducted within the guidelines of the AFCP 2.0. It is noted that the AFCP 2.0 request should have been treated as an improper paper as it was signed by only one inventor. See 37 CFR 1.33(b)(pre-AIA), *supra*. See also MPEP 714.01, *supra*. This was explained by the examiner in the Advisory Action mailed May 28, 2015. As such, prosecution should not be conducted in accordance with the AFCP 2.0. Moreover, as set forth in the After Final Consideration Pilot 2.0 Extension, "[A]s was the case with the AFCP, examiners will continue to use their professional judgment to decide whether the response can be fully considered under AFCP 2.0. This will include determining whether any additional search is required and can be completed within the allotted time, in order to determine whether the application can be allowed. As such the examiner has acted within his discretion."

With respect to the petition filed June 29, 2015

Petitioner seeks reversal of the Technology Center Director's decision of May 29, 2015, on the ground that the Technology Center Director has acting improperly in refusing to replace the examiner, Supervisory Patent Examiner, and art unit of record.

As noted in *In re Ovshinsky*, 24 USPQ2d 1241, 1251-2 (Comm'r Pats.1992), the issue is not whether the perceptions of an applicant regarding alleged bias are reasonable; rather the issue is: whether an applicant has demonstrated improper conduct, including bias or the appearance of bias, on the part of the Technology Center Director. A full investigation of the facts set forth in the petition, as well as a full consideration of the entire record of this application fails to reveal bias or improper conduct on the part of the Group Director, the Supervisory Patent Examiner, or the examiner, and as such, there is no reversible error in the Technology Center Director's decision.

Petitioner contends that the Office action mailed April 21, 2015, evidences "illegal actions" on the part of the examiner. However, that Office action has been carefully reviewed and there is no evidence of any improper action or conduct therein on the part of the examiner or Supervisory Patent examiner that would warrant replacing them with another to prosecute the instant application. While, an unnecessary AFCP 2.0 decision was mailed on April 21, 2015 such does not rise to the level of improper conduct that would warrant their replacement. Petitioner further questions why the examiner fails to acknowledge the Notice of Appeal of April 27, 2015. It is noted that the Notice of Appeal of April 27, 2015 is signed by only one inventor and is therefore an improper paper as it was signed by only one inventor. See 37 CFR 1.33(b)(pre-AIA), *supra*. See also MPEP 714.01, *supra*. Next petitioner fails to understand why the Advisory Action mailed May 28, 2015 fails to recognize that the amendment to claim 15 of April 27, 2015 was withdrawn in an amendment filed May 28, 2015. The reason is that the Advisory Action mailed May 28, 2015 was responsive to the amendment of April 27, 2015 and not the amendment of May 28, 2015. Petitioner continues to mention the

underlining in an Office action and the failure to treat the application under the AFCP 2.0. As set forth above, despite petitioner's contention, there is nothing improper in underlining portions of an Office and as noted by the examiner the AFCP 2.0 request is not properly signed.

The gravamen of applicant's complaint seems to be that despite five Office actions on the merits and numerous interviews, the examiner continues to reject claims on various statutory grounds, and applicant obviously disagrees with the rejections contained in the Office actions. It should be noted that reasonable men can disagree as to whether a given claim is patentable and on what basis. See Lear, Inc. v. Adkins, 395 U.S. 653, 670, 162 USPQ 1, 8 (1969). A mere difference of opinion between the examiner and the applicant as to the patentability of one or more claims does not evidence bias, a lack of understanding, "an illegal action", or improper conduct on the part of the examiner, much less that their replacement is justified. Indeed, the Technology Center Director correctly observed that the examiner has indicated allowable subject matter. This does not evidence bias or "fraudulent" action on the part of the examiner; rather the examiner is merely attempting to clarify the record. Petitioner's contentions of illegal actions (e.g., presenting rejections with which petitioner disagrees) are not improper conduct on the part of the examiner.

Moreover, as set forth above, petitioner appears to be unaware that any rejection of the claims cannot be reviewed on petition; rather, as explained in MPEP 1201, the mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Patent Trial and Appeal Board under 35 U.S.C. § 134 and 37 CFR 1.191. The issues of whether the rejections set forth in the last office action are "plagiarism" or "a falsification" relate to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a); see also Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). 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, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to withdrawal the finality of the Office action of December 31, 2008 and compel the entry of the affidavit and amendment after final filed March 30, 2009 is not shown to be in clear error.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decisions of June

2, 2015 and May 29, 2015. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decisions of the Technology Center Director of June 2, 2015 and May 29, 2015 have been reviewed, but is denied with respect to making any change therein. As such, the decisions of June 2, 2015 and May 29, 2015 will not be disturbed. The refusal to withdraw the finality of the January 28, 2015 Office action will not be disturbed. The examiner, Supervisory Patent Examiner, and art unit will not be replaced. No further review of this matter will be undertaken by the Office. The petition 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 if the USPTO issues a final agency action adverse to the petitioner in the underlying proceeding or examination to which it relates, or, if this decision does not relate to any ongoing proceeding or examination, if it otherwise constitutes final agency action under 5 U.S.C. 704.

This application is being forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.



Robert W. Bahr
Acting Deputy Commissioner for
Patent Examination Policy/
Petitions Officer