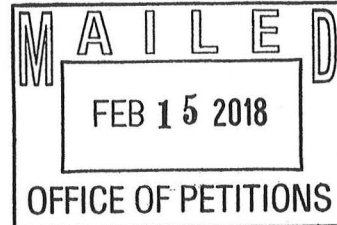




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In re Application of:	:	
Daniele Pianezze	:	DECISION
Application No.: 13/510,688	:	
PCT No.: PCT/US2010/061216	:	ON
International Filing Date: December 20, 2010	:	
Priority Date: December 21, 2009	:	PETITION
For: CONTROL CATENARY FOR	:	
LIGHTING GAS BURNERS WITH	:	
OPTICAL LIGHTING INDICATION	:	

This is a decision on the petitions under 37 CFR 1.181 filed on December 6, 2017, requesting that the Director exercise supervisory authority and overturn the decisions of October 6, 2017, by the Director of Technology Center 3700 (Technology Center Director), which Technology Center decisions refused to: (1) designate the examiner's answer of February 24, 2017 as containing a new ground of rejection and reopen prosecution of the application or issue a new examiner's answer; and (2) expunge the human translation of German document DE 19823120A (hereinafter "Boettcher reference") provided to petitioner on March 10, 2016.

The petitions to designate the examiner's answer of February 24, 2017 as containing a new ground of rejection and reopen prosecution of the application or issue a new examiner's answer in the above-identified application, and to expunge the human translation of the Boettcher reference in the above-identified application, are **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on May 18, 2012.

On June 22, 2012, the United States Designated/Elected Office (DO/EO/US) issued a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) reflecting a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date of June 1, 2012.

Prosecution of the above-identified application resulted in a non-final Office action being issued on October 7, 2015. The Office action of October 7, 2015 included, *inter alia*: (1) a rejection of claims 1 through 5, 8, 9, 11 through 15, 18, 19, 21, and 22 under 35 U.S.C. § 103¹ as being unpatentable over Boettcher (DE 19823120)² in view of Clapood (U.S. Patent No. 7,926,964); (2) a rejection of claims 6, 10, 16, and 20 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Rada (U.S. Patent No. 5,180,050); and (3) a rejection of claims 7 and 17 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Painter (U.S. Patent No. 665,459). A machine translation of the Boettcher reference was provided to applicant on October 7, 2015.

A reply to the Office action of October 7, 2015, was filed on January 7, 2016. The reply of January 7, 2016, included an amendment canceling claims 14 through 16 and adding new claims 23 through 27. In the reply of January 7, 2016, applicant challenged the quality of the machine translation of the Boettcher reference.

A final Office action was issued on March 10, 2016. The final Office action of March 10, 2016 included, *inter alia*: (1) a rejection of claims 1 through 5, 8, 9, 11 through 13, 18, 19, and 21 through 27 under 35 U.S.C. § 103 as being unpatentable over Boettcher (DE 19823120) in view of Clapood; (2) a rejection of claims 6, 10, and 20 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Rada; and (3) a rejection of claims 7 and 17 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Painter. A human translation of the Boettcher reference was provided to applicant on March 10, 2016.

A reply to the final Office action of March 10, 2016 was filed on May 10, 2016.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on May 10, 2016. The petition of May 10, 2016 requested the finality of the Office action of March 10, 2016 be withdrawn because the Office action contained new grounds of rejection not necessitated by any amendment to the claims or the filing of an Information Disclosure Statement.

The petition filed on May 10, 2016 was dismissed by the Technology Center Director in a decision issued on June 20, 2016. The decision of June 20, 2016 stated any request for

¹ Section 3 of the Leahy-Smith America Invents Act (AIA) revised 35 U.S.C. §§ 102 and 103, effective as to applications having any claim with an effective filing date on or after March 16, 2013. *See* Pub. L. No. 112-29, § 3, 125 Stat. at 285-293. Since the above-identified application only has claims with an effective filing date prior to March 16, 2013, this decision refers to the pre-AIA version of 35 U.S.C. §§ 102 and 103.

² DE 19823120 (inventors: Pommer Reinhardt; Gall Herbert; and Boettcher Jochen. "Boettcher" as referred by the examiner) was cited in the IDS submitted on May 18, 2012 and a copy of Boettcher reference was also provided on May 18, 2012. The Boettcher reference was also cited as a document of particular relevance and relied upon to reject PCT claims 1-8 as lacking an inventive step in the Written Opinion of the International Searching Authority. An English language of this Written Opinion was provided by applicant on May 18, 2012.

reconsideration of this decision must be submitted within two (2) months from the mailing date of the decision of June 20, 2016, under 37 CFR 1.181 and extensions of time under 37 CFR 1.136(a) were not available.

A renewed petition under 37 CFR 1.181 to the Technology Center Director was filed on August 22, 2016. The petitions of August 22, 2016 and May 10, 2016 are identical.

A notice of appeal and a request for pre-appeal brief review were filed on September 12, 2016.

The petition filed August 22, 2016 was dismissed as moot by the Technology Center Director in a decision issued on September 13, 2016. The decision of September 13, 2016 stated Ms. Brockett, a Quality Assurance Specialist, spoke with petitioner on September 1, 2016 and confirmed the renewed petition of August 22, 2016 was mistakenly filed and it was not petitioner's intent to file the renewed petition.

An advisory action was issued on October 19, 2016. The advisory action of October 19, 2016 notified applicant that: (1) a brief in compliance with 37 CFR 41.37 must be filed within two of the notice of appeal of September 12, 2016 (37 CFR 41.37(a), or any extension thereof (37 CFR 41.37(e)) to avoid dismissal of the appeal; and (2) the proposed amendments of May 10, 2016 would be entered for purposes of appeal and further explained how the claims (including the amended claims) would be rejected and reasons why.

A decision by the pre-appeal brief conference panel was issued on October 25, 2016, and indicated that the panel decision from the pre-appeal brief review was to proceed to the Patent Trial and Appeal Board (PTAB).

An appeal brief was filed on December 27, 2016.

An examiner's answer was issued on February 24, 2017. The examiner's answer maintained (1) a rejection of claims 1 through 5, 8, 9, 11 through 13, 18, 19, and 21 through 27 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood; (2) a rejection of claims 6, 10, and 20 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Rada; and (3) a rejection of claims 7 and 17 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Clapood, and further in view of Painter.

A petition under 37 CFR 1.181 was filed on April 24, 2017, requesting: (1) reopening of prosecution; and/or (2) withdrawal of the examiner's answer of February 24, 2017; and/or (3) issuance of a new examiner's answer that does not contain a Response to Arguments Section; and (4) a refund of the fees incurred as a result of filing the notice of appeal on September 12, 2016.

The petition filed April 24, 2017 was dismissed by the Technology Center Director in a decision issued on June 30, 2017. The decision of June 30, 2017, concluded that there were no new grounds of rejection found in the examiner's answer of February 24, 2017 or in the Office action of March 10, 2016. The decision stated the appeal was maintained and gave appellants two

months from the June 30, 2017 date of the decision to file a single reply brief under 37 CFR 41.41.

A reply brief, a request for an oral hearing, and payment of the oral hearing fee and appeal forwarding fee were submitted on August 30, 2017.

A renewed petition under 37 CFR 1.181 was filed on August 30, 2017, again requesting: (1) reopening of prosecution; and/or (2) withdrawal of the examiner's answer of February 24, 2017; and/or (3) issuance of a new examiner's answer that does not contain a Response to Arguments Section; and (4) a refund of the fees incurred as a result of filing the notice of appeal on September 12, 2016.

A petition to expunge under 37 CFR 1.181 was also filed on August 30, 2017. The petition to expunge filed on August 30, 2017 requested the human translation of the Boettcher reference be expunged from the record and that the examiner's answer be re-written to refer only to the machine translation of the Boettcher reference.

An Order Remanding Appeal to Examiner was entered on September 12, 2017 by the PTAB that administratively remanded the application for appropriate action on the two petitions under 37 CFR 1.181 filed on August 30, 2017.

The renewed petition under 1.181 filed on August 30, 2017, to reopen prosecution and/or withdraw the examiner's answer issued on February 24, 2017, was denied by the Technology Center Director in a decision issued on October 6, 2017. The decision of October 6, 2017, determined there was no new ground of rejection in the examiner's answer of February 24, 2017.

The petition to expunge under 37 CFR 1.181 filed on August 30, 2017 was denied by the Technology Center Director in a decision issued on October 6, 2017.

The Technology Center forwarded this application to the PTAB on October 16, 2017. The PTAB issued an Appeal Docketing Notice on October 27, 2017.

A petition under 37 CFR 1.181 was also filed on December 6, 2017, requesting: (1) the examiner's answer of February 24, 2017 be designated as containing a new ground of rejection; (2) reopening of prosecution ; (3) withdrawal of the examiner's answer of February 24, 2017; and/or (4) issuance of a new examiner's answer that does not contain a "Response to Arguments" section; and (5) refund of fees incurred as a result of filing the notice of appeal.

A petition to expunge under 37 CFR 1.181 was filed on December 6, 2017, once again requesting the human translation of the Boettcher reference be expunged and that the examiner's answer be rewritten to refer only to the machine translation of the Boettcher reference.

An Order Remanding Application was entered on February 14, 2018 by the PTAB. The Order of February 14, 2018, remanded this application to the Office of Commissioner for Patents for a decision on the "REREPETITION UNDER RULE 1.181 TO REOPEN PROSECUTION AND/OR WITHDRAW THE EXAMINER'S ANSWER AND

REFUND FEES INCURRED FOR NOTICE OF APPEAL” filed on December 6, 2017 (“2nd renewed petition”). The Order of February 14, 2018, stated, in the event the 2nd renewed petition of December 6, 2017 is not granted, jurisdiction over the application reverts immediately back to the PTAB with the mailing of decision on the petition.

STATUTE AND REGULATION

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 1.59 provides that:

(a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) or § 42.7(a) of this title.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment present on the filing date of the application) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f), and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

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).

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

I. Petition under 37 CFR 1.181 filed on December 6, 2017 to reopen prosecution and/or withdraw the examiner's answer of February 24, 2017 or, in the alternative, to issue new examiner's answer without the "Response to Arguments" section.

Petitioner asserts that the examiner's answer of February 24, 2017 contains new grounds of rejection and thus, requests that prosecution be reopened. Alternatively, petitioner requests that a new examiner's answer that does not contain a "Response to Arguments" section be issued.³ Petitioner specifically argues that the examiner's answer includes new rationales and teachings that were not present in the final office action of March 10, 2016. Petitioner further alleges that the examiner's answer relies on the human translation of the Boettcher reference that is different from the machine translation of the Boettcher reference previously relied upon by the examiner.

Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the applicant. *See In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting *Leithem*, 661 F.3d at 1319). The prior rejection, however, need not be repeated *in haec verba* to avoid being considered a new ground of rejection. *See id.* In addition, further explanation and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. *See In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2011).

Section 1207.03(III) of the Manual of Patent Examining Procedure (MPEP) specifically provides that:

A position or rationale that changes the "basic thrust of the rejection" will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for

³ Petitioner also requests a refund of the appeal fees paid in the above-identified application. The appeal fees paid in this application were necessary to continue proceedings in the above-identified application. Therefore, the appeal fees were not paid by mistake or in excess within the meaning of 35 U.S.C. § 42(d), regardless of whether prosecution is reopened in the above-identified application. *See Miessner v. United States*, 228 F.2d 643 (D.C. Cir. 1955); *Opinion of the Comptroller General of the United States*, 113 USPQ 28 (Comp. Gen. 1957); *Ex parte Grady*, 59 USPQ 276 (Comm'r Pat. 1943).

example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the "basic thrust of the rejection" is the same. *In re Kronig*, 539 F.2d at 1303; see also *In re Jung*, 637 F.3d 1356, 1364–65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time "did not change the rejection" and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when "explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner"); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) ("It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection." (citations omitted)); *In re Cowles*, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of "different language" does not necessarily trigger a new ground of rejection).

See MPEP § 1207.03(III).

Petitioner provides numerous examples where there is an alleged new grounds of rejection in the examiner answer. For example, Petitioner alleges that the examiner's answer introduced a new ground of rejection for claim 1 by asserting that wire 12 of Boettcher is the mechanical connection, whereas the final Office action indicated wires 13, 14, and 15 of Boettcher form the mechanical connection recited in claim 1.

The final Office action of March 10, 2016 included a rejection of claims 1 through 5, 8, 9, 11 through 13, 18, 19, and 21 through 27 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Claprod. The rejection of claim 1 included a citation to Boettcher, figure 5, reference numbers 12, 13, and 14 as teaching the three wires electronically connecting the elements, and reference numbers 13, 14, and 15 as teaching the three wires mechanically connecting the elements recited in claim 1.⁴ The rejection of claim 23 explained that by applying the teachings of Claprod to Boettcher, "wire 12 will no longer need to divert from the various elements, and would instead extend through the various elements becoming a mechanical connection for the elements..."⁵

In the appeal brief of December 27, 2016, petitioner argued, *inter alia*, that the examiner failed to establish a *prima facie* case of obviousness because "Boettcher does not disclose 'said elements being mechanically and electrically connected to one another by means of three wires passing through the body of the various elements.'"⁶ The "Response to Argument" section of the examiner's answer of February 24, 2017 responds to petitioner's arguments by providing a more detailed explanation of how the combination of Boettcher and Claprod teach the claimed elements and the wires that mechanically and electronically connect the elements.⁷ In view of the examiner's explanation, petitioner argues that the examiner's answer introduced a new ground of

⁴ See Office action dated March 10, 2016 at page 7.

⁵ *Id.* at page 17

⁶ See appeal brief filed December 27, 2016 at pages 22-31.

⁷ See examiner's answer dated February 24, 2017 at pages 27-28.

rejection for claim 1 by now asserting that wire 12 of Boettcher is the mechanical connection, in contrast to the final Office action that indicated wires 13, 14, and 15 of Boettcher form the mechanical connection recited in claim 1. However, the explanation in the examiner's answer indicating that wire 12 is the mechanical connection relates to the rejection of claim 23, not claim 1. The examiner's interpretation of wire 12 as the mechanical connection recited in claim 23 in the examiner's answer of February 24, 2017 has remained the same from the interpretation taken in the rejection of claim 23 in the final Office action of March 10, 2016.

Petitioner further alleges the examiner's answer introduced a new ground of rejection for claim 1 because the examiner did not previously: 1) rely on any cover that is larger than a knob of Claprood; 2) proffer modifications to Boettcher's element to make it larger or smaller, and; 3) assert modifying Boettcher to make the knob transparent.⁸

The rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Claprood in the final Office action of March 10, 2016 explained that Boettcher did not disclose that the cover is at least partially pervious to light as recited in claim 1.⁹ The rejection of claim 1 included a citation to Claprood, figure 3, element 50, to teach the cover being at least partially pervious to light.¹⁰

In the appeal brief of December 27, 2016, petitioner argued, *inter alia*, that one of ordinary skill "would not put a light where it is eclipsed by a knob" and "modify element 11 to be at least partially pervious to light" because the light source is underneath the cover (element 11), and the cover is hidden by the knob 21.¹¹ The "Response to Argument" section of the examiner's answer of February 24, 2017 responds to petitioner's arguments by explaining that "...one of ordinary skill would look to Claprood to determine an appropriate position for the light.... Therefore, one of ordinary skill in the art would make the catenary element of Boettcher larger or the knob of Boettcher smaller in order to be able to see the lights."¹² The examiner's answer further explains that "if it would be undesirable to change the relative size of the element and knob, one of ordinary skill in the art could also make the knob of Boettcher substantially transparent."¹³

The basic thrust of the examiner's position in rejecting claim 1 has remained the same from the final Office action of March 10, 2016 to the examiner's answer of February 24, 2017. Claim 1 remains rejected under 35 U.S.C. § 103 as being unpatentable over Boettcher in view of Claprood. The "Response to Argument" section of the examiner's answer of February 24, 2017 does include additional explanation in response to arguments presented by the petitioner in the appeal brief of December 27, 2016. Such additional explanation, however, does not change the basic thrust of the rejection of claim 1 under 35 U.S.C. § 103 as set forth in the final Office action of March 10, 2016. The additional discussion in the examiner's answer of February 24,

⁸ See petition filed December 6, 2017 at pages 14-15.

⁹ See Office action dated March 10, 2016 at pages 7-8.

¹⁰ *Id.*

¹¹ See appeal brief filed December 27, 2016 at page 58.

¹² See examiner's answer dated February 24, 2017 at page 16.

¹³ *Id.*

2017 relative to the final Office action of March 10, 2016 amounts only to an elaboration of the rationale set forth in the final Office action of March 10, 2016 and further responds to appellant's arguments in the appeal brief. *See Jung*, 637 F.3d at 1364-65. An examiner is not required to anticipate an applicant's arguments concerning the scope of the claims in advance and preemptively respond to those arguments. *See id.*, at 1363. Although the examiner did not use identical language in both the "Response to Argument" section of the examiner's answer of February 24, 2017, and the final Office action of March 10, 2016, the use of different language in responding to an applicant's arguments is not considered a new grounds of rejection, provided that the "basic thrust of the rejection" is the same. *See Leithem*, 661 F.3d at 1319 (a prior rejection need not be repeated *in haec verba* to avoid being considered a new ground of rejection).

Petitioner provides other instances where there is an alleged new grounds of rejection in the examiner's answer; however, a review of these instances reveals that, while the examiner has included additional explanation in the examiner's answer when responding to petitioner's arguments, the examiner has not changed the basic thrust of the rejections given in the final Office action of March 10, 2016.

With respect to petitioner's argument that the examiner's answer of February 24, 2017 relied on a human translation of the Boettcher reference that is different from the machine translation of the Boettcher reference that was previously relied upon by the examiner, it is noted that the human translation of the Boettcher reference was also relied upon in the final Office action of March 10, 2016. Therefore, with respect to the reliance on the human translation of the Boettcher reference, there was no change from the final Office action of March 10, 2016 to the examiner's answer of February 24, 2017.¹⁴

The cases cited by petitioner are readily distinguishable from the circumstances of the above-identified application. The circumstances of the above-identified application do not involve the examiner changing the interpretation of how a claim element was met by a disclosure in the prior art reference for the first time in the examiner's answer as was the case in *Leithem* and *Imes*. The circumstances of the above-identified application are similarly not comparable to the circumstances present in other cases in which a new ground of rejection was found. *See e.g., Biedermann, supra* (changing factual basis for combining references). *Rambus Inc. v. Rea*, 731 F.3d 1248 (Fed. Cir. 2013) (changing factual basis for combining references); *In re Stepan Co.*, 660 F.3d 1248 (Fed. Cir. 2011) (changing the treatment of an applicant-submitted affidavit or

¹⁴ To the extent that petitioner is requesting withdrawal of the finality of the Office action of March 10, 2016 because of the alleged differences between the human translation of the Boettcher reference cited in the final Office action of March 10, 2016 and the machine translation of the Boettcher reference cited in the non-final Office action of October 7, 2015, this request was denied by the decision of the Technology Center Director on June 20, 2016. Any request in the instant petition to withdraw the finality of the Office action of March 10, 2016 is denied as untimely. *See* 37 CFR 1.181(f). In any event, it is brought to petitioner's attention that providing English-language-translation of a non-English-language patent or publication does not preclude an Office action from being made final, provided that the condition set forth in MPEP § 706.07 for making an Office action final are met. *See* MPEP § 706.02(II).

declaration); *In re Kumar*, 418 F.3d 1361 (Fed. Cir. 2005) (providing new calculations to demonstrate that the prior art references fall within or overlaps with the claimed range); *In re De Blauwe*, 736 F.2d 699 (Fed. Cir. 1984) (changing the treatment of applicant's contentions of unexpected results); *In re Waymouth*, 486 F.2d 1058 (CCPA 1973) (changing aspect of a claim element relied upon for position that application did not provide written description support under 35 U.S.C. § 112, ¶ 1); *In re Eynde*, 480 F.2d 1364 (CCPA 1973) (changing factual basis for the position that application did not provide enablement under 35 U.S.C. § 112, ¶ 1); *In re Echerd*, 471 F.2d 632 (CCPA 1973) (changing portion of a reference relied upon to meet claim limitations); *In re Wiechert*, 370 F.2d 927 (CCPA 1967) (changing portion of a reference relied upon to meet claim limitations); and *In re Hughes*, 345 F.2d 184 (CCPA 1965) (changing the statutory basis of the rejection). The circumstances of the above-identified application are most analogous to the circumstances present in *Jung* (explanation of why the claims are not limited as asserted by the applicant is not a change to the basic thrust of the rejection), and are not analogous to the circumstances which a new grounds of rejection was found.

In conclusion, the examiner's answer of February 24, 2017 did not change the basic thrust of the rejections and petitioner has been given a fair opportunity to respond to the rejection of the claims. Accordingly, the examiner's answer of February 24, 2017 does not contain a new ground of rejection warranting the reopening of prosecution in the above-identified application.

II. Petition filed on December 6, 2017 to expunge the human translation of the Boettcher reference.

Petitioner requests that the human translation of the Boettcher reference be expunged from the record. Petitioner argues that the human translation of the Boettcher reference should be expunged from the record “[b]ecause TC 3700 alleges that the first translation is an adequate representation of the German language document, and because applicant had no chance to attack the accuracy of the second translation because it was added only after prosecution was closed, and because applicant has put forth a material dispute as to what the first translation did not disclose that is only alleged to be present in the second translation.”¹⁵

Section 724.05 of the MPEP sets forth the categories of information for which a petition to expunge may be filed under 37 CFR 1.59(b). Specifically, MPEP § 724.05 provides that a petition under 37 CFR 1.59(b) may be filed to expunge information submitted under MPEP § 724.02, information unintentionally submitted in an application, and information submitted in incorrect application. *See* MPEP § 724.05(I)-(III). The human translation of the Boettcher reference was provided by the examiner in the final Office action of March 10, 2016. Accordingly, the human translation of the Boettcher reference does not fall under any of the

¹⁵ It is noted that many of the arguments in the petition to expunge the second translation (human translation) of the Boettcher reference are similar to the arguments presented in the petition filed on December 6, 2017 to withdraw the examiner's answer of February 24, 2017 (see section I above).

categories of information set forth in MPEP § 724.05 for which a petition to expunge may be filed under 37 CFR 1.59(b).

With respect to petitioner's comment that the patent laws and rules require that prosecution be conducted in English: 37 CFR 1.52 requires that an application (specification, including the claims, drawings, inventor's oath or declaration) and any amendments to the application be in the English language. *See* 37 CFR 1.52(b)(1)(ii). The patent laws and rules of practice, however, place no English-language requirement on patents and publications. 35 U.S.C. § 102. The rules of practice permit the submission of information disclosure statements containing non-English-language documents without an English-language-translation if one is not readily available to the applicant (37 CFR 1.98(a)(3)), and do not require examiners to provide English-language-translations of non-English-language prior art patents or publications (37 CFR 1.104(d)(1)). Examiners are permitted to rely upon a machine translation of a non-English-language patent or publication unless the applicant provides evidence that the machine translation of the non-English-language patent or publication does not accurately represent the content of the non-English-language patent or publication. *See* MPEP § 706.02. The examiner's actions in the above-identified application were consistent with the established procedures in the MPEP for the situation in which an applicant questions whether a machine translation of the non-English-language patent or publication accurately represent the content of the non-English-language patent or publication. With respect to petitioner's contention that petitioner has not been given an opportunity to challenge the human translation of the Boettcher reference, petitioner is reminded that an applicant is free to obtain the applicant's own English-language-translation of any non-English-language patent or publication during the process of judging the propriety of continuing prosecution of, or seeking review of a rejection in, an application.

With respect to petitioner's challenges to the application of the Boettcher reference with respect to the subject matter defined by the claims of the above-identified application, petitioner is reminded that 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). 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). As stated by the Court of Customs and Patent Appeals (a predecessor of the U.S. Court of Appeals for the Federal Circuit), the adverse decisions of examiners which are reviewable by the Board are those which relate, at least indirectly, to matters involving the rejection of claims. *See In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971). 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.

DECISION

For the reasons stated above, the petition to withdraw the examiner's answer is granted to the extent that the Technology Center Director's decision of October 6, 2017 has been reviewed, but the petition is **DENIED** with respect to designating the examiner's answer of February 24, 2017 as containing a new ground of rejection or generating a new examiner's answer. As such, neither the Technology Center Director decision of October 6, 2017 nor the examiner's answer of February 24, 2017 will be disturbed. Furthermore, the petition to expunge the human translation of the Boettcher reference 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 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.

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



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy