



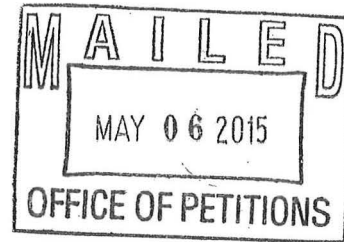
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In re Application of  
Peter Madrid et al.  
Application No. 13/726,135  
Filed: December 23, 2012  
Attorney Docket No. SRI-6428-US

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ON PETITION

This is a decision on the petition, filed June 27, 2014 entitled "PETITION TO BE DECIDED BY OFFICE OF PETITIONS" that is being treated under the provisions of 37 CFR 1.181(a)(3) requesting the Director to exercise her supervisory authority and overturn the decision of June 26, 2014, of the Director of Technology Center 1600 (TC Director), which refused to withdraw the finality of the Office action mailed March 21, 2014.

The petition is **granted** to the extent that the TC Director's decision has been reviewed herein by the undersigned, but is **DENIED** with respect to all other matters, as indicated below.

**BACKGROUND**

1. On March 21, 2014 the Office mailed a final Office action which set a three (3) month shortened statutory period to reply. A reply was filed on March 27, 2014. Office mailed an Advisory action on April 3, 2014.
2. On April 3, 2014, applicants submitted a petition stating that the final Office action of March 21, 2014 was non-compliant with 35 USC 132.
3. On May 13, 2014, a petition decision by the TC Director was mailed to applicants dismissing the petition.
4. On May 22, 2014, applicants submitted a renewed petition stating that the final Office action of March 21, 2014 was non-compliant with 35 USC 132.
5. On June 26, 2014, a petition decision by the TC Director was mailed to applicants dismissing the renewed petition.
6. The instant petition was filed June 27, 2014 requesting that the Office of Petitions review the TC Director's decision dated June 26, 2014.

7. On January 15, 2015 petitioner filed a letter renewing the request that the Office of Petitions decide the petition filed June 27, 2014.

### **STATUTE, REGULATION, AND EXAMINING PROCEDURE**

#### **35 U.S.C. 132 Notice of rejection; reexamination**

*(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 1.104 Nature of examination (Excerpt)**

*(d) Citation of references. (1) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees will be stated. If domestic patent application publications are cited by the examiner, their publication number, publication date, and the names of the applicants will be stated. If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees will be stated, and such other data will be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon will be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, will be given.*

*(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons*

**37 CFR 1.135 Abandonment for failure to reply within time period**

- (a) *If an applicant of a patent application fails to reply within the time period provided under §1.134 and §1.136, the application will become abandoned unless an Office action indicates otherwise.*
- (b) *Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.*
- (c) *When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under §1.134 to supply the omission.*

**37 CFR 1.181 Petition to the Director (states in part):**

- (a) *Petition may be taken to the Director:*
- (1) *From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;*
  - (2) *In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and*
  - (3) *To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.*
- (f) *The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.*
- (g) *The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.*

**Manual of Patent Examining Procedure (MPEP) §707.05(a) (Excerpt)**

*Copies of cited foreign patent documents and non-patent literature references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the examiner during the prosecution. Copies of U.S. patents and U.S. patent application publications are not provided in paper to applicants and are not placed in the application file.*

*Copies of references cited by applicant in accordance with MPEP § 609, § 707.05(b) and § 708.02 are not furnished to applicant with the Office action. Additionally, copies of references cited in continuation applications if they had been previously cited in the parent application are not furnished. The examiner should check the left hand column of form PTO-892 if a copy of the reference is not to be furnished to the applicant.*

*Copies of foreign patent documents and nonpatent literature (NPL) which are cited by the examiner at the time of allowance will be furnished to applicant with the Office action and be retained in the image file wrapper. This will apply to all allowance actions, including first action allowances and Ex Parte Quayle actions.*

*In the rare instance where no art is cited in a continuing application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent.*

**Manual of Patent Examining Procedure (MPEP) §1001.01 Modes of Exercising Authority (Excerpt)**

*The delegations set forth in this Chapter do not confer a right to have a matter decided by a specific Office official, rather, such delegations aid in the efficient treatment of petitions by the Office.*

**OPINION**

As an initial matter, it is noted that the Director of USPTO, pursuant to 37 CFR 1.181(g), may delegate the determination of petitions. As stated in MPEP § 1001.01,

*The delegations set forth in this Chapter do not confer a right to have a matter decided by a specific Office official, rather, such delegations aid in the efficient treatment of petitions by the Office.*

Therefore, it is the prerogative of the Office that an independent review be made of this case. Such a review has been made and a decision appears below.

In regard to the TC Director's decision whose review the petitioner is seeking, petitioner states that "[t]he purported Decision of the Group Director dated Jun 26, 2014 is non-responsive, as the Group Director does not have authority to decide petitions made to the Office of Petitions. The Office of Petitions is required to decide our Petition made May 21, 2014." Petitioner should note that the petition filed May 21, 2014 was not explicitly directed to the Office of Petitions. As the petition alleged the final Office action to be "noncompliant with 35USC 132 for failure to provide applicant "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application,"" the petition was properly considered as a petition to withdraw the finality of the Office action referenced in the petition. In accordance with the delegation of authority to decide petitions, as set forth in MPEP § 1002, the petition was properly decided by the Technology Center Director.

Petitioner states that "the Final Action dated Mar 21, 2014 is noncompliant with 35USC132 for failure to provide applicant "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application". The Action cites "Ex parte Weston 121 USPQ 428" and "In re Doebl 174 USPQ 156" for a contention that compounds that differ only as H vs. Me on nitrogen are obvious. These are unofficial cites, and not publically available, and Applicant has been unable to determine whether or not the contention is true or not."

Petitioner is seeking "copies of the cited opinions, publicly available means for accessing them, or withdrawal of the citations."

In the final Office action mailed March 21, 2014, examiner rejected claim 21 under pre-AIA 35 U.S.C. 103(a) as being unpatentable over Seng et al. US 3,991,189. In explaining this rejection further, examiner stated "[w]hile said compound does not anticipate the scope of instant claims, they are very closely related having NHCH<sub>3</sub> in the reference versus N(CH<sub>3</sub>)CH<sub>3</sub> in the instant claims. However, compounds that differ only in having H vs Me on nitrogen are not deemed patentably distinct absent evidence of superior or unexpected properties. See for compounds that differ only as H vs Me on nitrogen, Ex parte Weston 121 USPQ 428; In re Doebl 174 USPQ 156."

The issue of "cited opinions" that is the subject of the petition herein include "Ex parte Weston 121 USPQ 428; In re Doebl 174 USPQ 156." These "cited opinions" have been cited by the examiner in the final Office action, only in connection with the rejection of claim 21, as noted above. Clearly, this rejection of claim 21 is not relying on the "cited opinions" as **references** in establishing the rejection. The only reference relied upon in the rejection identified above is Seng et al. (US 3,991,189).

In alleging the final Office action to be "noncompliant with 35USC132," petitioner appears to be relying on a provision in 35 USC 132 that states "*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.*" The requirement that an Office action

contain "such information and references as may be useful in judging of the propriety of continuing the prosecution of his application" was added to the patent laws in the Patent Act of 1870. The circumstances surrounding this provision reveal that it requires that an Office action **identify** the prior inventions or patents that are relied upon in making a rejection, **not that it requires that an Office action be accompanied by copies of the cited references**. The USPTO did not even begin providing copies of cited references with Office actions until 1965, when 35 U.S.C. Sec. 41 was amended to authorize (but not require) the USPTO to provide copies of patents cited in Office actions without charge. See Official Gazette Notice (1282 O.G. 109, (May 18, 2004)). Accordingly, as the "cited opinions" are not even references, per se, they need not be provided under the provisions of 35 USC 132.

Additionally, in regard to the issue of "cited opinions," the citation for Ex parte Weston is correct; however, the citation of "In re Doebl 174 USPQ 156" had a typographical error in that "156" should have been "158." As noted in the Official Gazette Notice (1282 O.G. 109, (May 18, 2004)), briefs and court opinions that include case citations do not include paper copies of the cited cases. Rather, the cited cases are available via books or electronic databases. In particular, a search of an online database such as that of USPQ and Lexis would have provided petitioner access to the "In re Doebl" case by simply searching for the case title. Petitioner's "most plausible inference" "that neither the Examiner nor Group Director have accessed or read these "cases", and their citation is a bluff," is without foundation.

For the reasons set forth above, the TC Director's decision is not shown to be in clear error in refusing petitioner's requests: (1) to provide copies of the cited opinions, (2) to provide publicly available means for accessing them, or, (3) for withdrawal of the citations.

Further correspondence with respect to this matter should be addressed as follows:

By mail:                      Mail Stop Petition  
                                    Commissioner for Patents  
                                    P.O. Box 1450  
                                    Alexandria, VA 22313-1450

By FAX:                      (571) 273-8300  
                                    Attn: Office of Petitions

By hand:                     Customer Service Window  
                                    Randolph Building  
                                    401 Dulany Street  
                                    Alexandria, VA 22314

Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.<sup>1</sup>

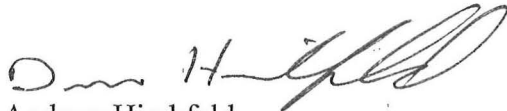
In the examiner's answer mailed February 2, 2015, petitioner was notified of the requirement to pay appeal forwarding fee required under 37 CFR 41.45 within the time permitted by 37 CFR 41.45(a). Office records do not indicate receipt of this fee. Accordingly, the instant application has gone abandoned at midnight on April 2, 2015.

### CONCLUSION

A review of the record indicates that the TC Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of June 26, 2014. The record establishes that the TC Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the previous decision of June 26, 2014, has been reviewed, but is denied with respect to making any change therein. The instant petition is DENIED.<sup>2</sup> The Director will undertake no further reconsideration or review of this matter.

Telephone inquiries related to this decision may be directed to Ramesh Krishnamurthy at (571) 272-4914.



Andrew Hirshfeld,  
Deputy Commissioner for  
Patent Examination Policy/  
Petitions Officer

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<sup>1</sup> <http://www.uspto.gov/portal-home.jsp>

<sup>2</sup> 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.