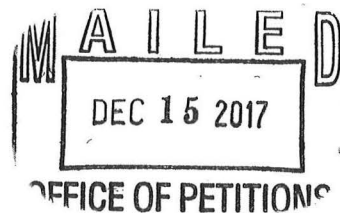




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Asha Nutrition Sciences, Inc.
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In re Application of
Urvashi Bhagat
Application No.: 13/877,847
PCT No.: PCT/US2011/056463
International Filing Date: October 14, 2011
Priority Date: October 14, 2010
For: **Optimized Nutritional Formulations,
Methods for Selection of Tailored Diets
Therefrom, And Methods of Use
Thereof**

DECISION

ON

PETITION

This is a decision on the petitions under 37 CFR 1.181 filed October 19, 20 and 21, 2017, requesting that the Director exercise supervisory authority and overturn the decision of September 29, 2017, by the Director of Technology Center 1600 (Technology Center Director), which decision refused to issue a new Office action.

The petitions to overturn the decision of the Technology Center Director and to direct the examiner to issue a new Office action in the above-identified application are **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on October 14, 2011.

On June 27, 2013, 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 April 4, 2013.

An Office action was issued on March 20, 2015. The Office action of March 20, 2015 included a restriction requirement requiring petitioner to elect one of four groups: (1) Group I, claims 53 through 55 and 68 through 75, drawn to a method for selecting a nutritional formulation or plan for an individual; (2) Group II, claims 56 through 62, 65 and 79, drawn to a nutritional formulation for an individual comprising at least one module comprising at least one nutrient; (3) Group III, claims 66, 67, 80 and 81, drawn to a method of prophylaxis or treatment of a

medical condition in a subject comprising administering a nutritional formulation for an individual comprising at least one module comprising at least one nutrient; and (4) Group IV, claim 76, drawn to a computer system. The Office action of March 20, 2015 also included an election of species requirement.

A reply to the Office action of March 20, 2015 was filed on September 18, 2015. The reply of September 18, 2015 included, *inter alia*, a preliminary amendment cancelling claims 1 through 81 and adding new claims 82 through 112, an election **with** traverse of Group I, claims 99 through 111 (indicated to correspond to previous claims 53 through 55 and 68 through 75), and an election in response to the election of species requirement.

A Notice of Non-Compliant Response concerning the reply of September 18, 2015 was issued on October 29, 2015.

A reply to the Notice of Non-Compliant Response of October 29, 2015 was filed on October 30, 2015. The reply of October 30, 2015 included an amended claim set, consisting of claims 82 through 112.

A non-final Office action was issued on February 9, 2016. The Office action of February 9, 2016 included, *inter alia*: (1) a rejection of claims 99 through 111 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (2) a provisional rejection of claims 99 through 111 under the judicially created double patenting doctrine over certain claims of copending application No. 13/332,251; and (3) a rejection of claims 99 through 111 under 35 U.S.C. § 112, ¶ 2,¹ as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The Office action of February 9, 2016 indicated that claims 1 through 81 have been canceled, claims 82 through 112 are pending, and claims 82 through 98 and 112 are withdrawn from consideration. The restriction requirement was made **final** in the Office action of February 9, 2016; however, the requirement for an election of species was withdrawn.

A petition under 37 CFR 1.144 and 1.181 was filed on June 18, 2016, requesting review, reconsideration and withdrawal of the final restriction requirement set forth in the Office action of February 9, 2016.

The petition of June 18, 2016 was granted in part and denied in part by the Technology Center Director in the decision of July 5, 2016. Specifically, the Technology Center Director determined that the inventions of Groups II and III have unity of invention, but that the elected invention of

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated pre-AIA 35 U.S.C. § 112, ¶¶ 1 through 6, as 35 U.S.C. §§ 112(a) through (f), effective as to applications filed on or after September 16, 2012. *See* Pub. L. No. 112-29, § 4, 125 Stat. 284, 293-97 (2011). Section 3 of the AIA revised 35 U.S.C. §§ 102 and 103, effective as to applications ever having a claim with an effective filing date on or after March 16, 2013, or ever having a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any patent or application that ever contained such a claim with an effective filing date on or after March 16, 2013. *See* Pub. L. No. 112-29, § 3, 125 Stat. at 285-293. The above-identified application was filed as a PCT application on October 14, 2011. Therefore, this decision refers to the pre-AIA versions of 35 U.S.C. §§ 102 and 112.

Group I (claims 99 through 111) lacked unity of invention with Groups II, III, and IV. The Technology Center Director thus concluded that it was unnecessary to examine additional Groups II, III, and IV.

A reply to the Office action of February 9, 2016 was filed on July 24, 2016, including an amendment to the claims. The amendment of July 24, 2016: (1) amended claims 82 through 97, 99 through 112; and (2) added new claims 113 and 114.

A renewed petition under 37 CFR 1.181 was filed on August 1, 2016, requesting review and reconsideration by the Technology Center Director of the restriction requirement. The petition of August 1, 2016 was denied by the Technology Center Director in the decision of August 17, 2016.

A petition under 37 CFR 1.181(a)(3) was filed on August 25, 2016, requesting review of the August 17, 2016 and July 5, 2016 decisions of a Director of Technology Center 1600 and withdrawal of the final restriction requirement set forth in the Office action of February 9, 2016.

The petition of August 25, 2016 was granted in part and denied in part by the Deputy Commissioner for Patent Examination Policy in the decision of October 20, 2016. Specifically, the Deputy Commissioner determined that the inventions of Groups I, II, and III have unity of invention and therefore the requirement for restriction as between the inventions of Groups I, II, and III (claims 82 through 111, 113, and 114) was withdrawn. The Deputy Commissioner further determined that Group IV lacked unity of invention with Groups I, II, and II, and therefore, the requirement for restriction as to the invention of Group IV (claim 112) was not withdrawn.

A supplemental reply and amendment to the Office action of February 9, 2016 was filed on October 31, 2016, including an amendment to the claims. The amendment of October 31, 2016 (1) amended claims 82, 83, 95-100, 105, 109, and 112 and (2) argued that claim 112 as amended recites the common technical feature shared by Groups I, II, and III and requested examination of all claims.

A final Office action was issued on February 21, 2017. The Office action of February 21, 2017 included, *inter alia*: (1) a rejection of claims 99 through 111 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (2) a provisional rejection of claims 99 through 111 under the judicially created double patenting doctrine over certain claims of copending application No. 13/332,251; (3) a rejection of claims 99 through 112 under 35 U.S.C. § 112, ¶ 1, as failing to comply with its written description requirement; and (4) a rejection of claims 99 through 111 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention. The final Office action of February 21, 2017 indicated that claims 1 through 81 have been canceled, claims 82 through 112, 113, and 114 are pending, and claims 82 through 98 and 112 through 114 are withdrawn from consideration. The restriction requirement was re-instituted based on the determination that the shared technical feature is disclosed in newly-cited prior art and therefore unity is lacking. Claims previously examined on the merits were considered constructively elected by original presentation and examined on the merits.

A petition was filed to the Technology Center Director on February 26, 2017, requesting withdrawal of the finality of the February 21, 2017 Office action, the issuance of a new non-final action addressing the unity of invention over cited art and addressing arguments and evidence of record, and a change of examiner.

The petition of February 26, 2017 was granted in part and denied in part by the Technology Center Director in the decision dated March 16, 2017. Specifically, the Technology Center Director granted the petition to the extent that it vacated the Office action of February 21, 2017 and required the examiner to abide by the final decision of the Deputy Commissioner for Patent Examination Policy on October 20, 2016 that there is unity of invention between Groups I, II, and III (claims 82 through 111, 113, and 114). The petition was denied to the extent that it requested reassignment to a new examiner.

A letter responding to the petition decision was filed March 22, 2017 indicating that the decision did not address remarks in the petition dated February 26, 2017 regarding unity of invention of Group IV (claim 112 as amended on October 21, 2016).

A reply pertaining to the vacated February 21, 2017 Office action was filed on March 26, 2017, including an amendment to the claims and additional remarks.

A non-final Office action was issued on July 11, 2017. The Office action of July 11, 2017 included, *inter alia*: (1) a rejection of claims 82 through 96, 99 through 111, 113 and 114 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (2) a provisional rejection of claims 82 through 98, 113 and 114 under the judicially created double patenting doctrine over certain claims of copending application No. 12/426,034; (3) a provisional rejection of claims 82 through 98, 99 through 111, and 113 and 114 under the judicially created double patenting doctrine over certain claims of copending application No. 13/332,251; (4) a rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 1, as failing to comply with its written description requirement; (5) a rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention; (6) a rejection of claims 97 and 98 under 35 U.S.C. § 102(b) as being anticipated by Woods (Super Foods: walnuts [online]; 2006), in view of Anonymous (Whfoods [online]; 2009) and Chen *et al.* (*Asia Pac J Clin Nutr.* 2008; 17(S1): 329-332); and (7) a rejection of claims 82 through 96, 113, and 114 under 35 U.S.C. § 102(b) as being anticipated by Anonymous (Self Nutrition Data [online]; 2009), in view of Phillips *et al.* (*J Agric Food Chem.* 2005; 53: 9436-9445), Kornhteinber *et al.* (*Food Chemistry.* 2006; 98: 381-387), and Chen *et al.* (*Asia Pac J Clin Nutr.* 2008; 17(S1): 329-332). The Office action of July 11, 2017 also indicated that 112 was withdrawn from consideration and that “species elections remain in effect.”

A petition was filed to the Technology Center Director on August 30, 2017, requesting the withdrawal of the unity of invention with respect to Group IV (claim 112) and issuance of a new, complete Office action including examination of Group IV.

A petition was filed to the Technology Center Director on September 4, 2017, requesting a new, complete non-final Office action addressing the arguments and evidence set forth by petitioner during prosecution.

Three petitions were filed to the Technology Center Director on September 10, 2017, each requesting a complete Office action addressing the arguments set forth by petitioner during prosecution.

A petition was filed to the Technology Center Director on September 11, 2017, requesting the above-identified application be assigned to a different examiner.

The petitions filed August 30, 2017, September 4, 2017, September 10, 2017, and September 11, 2017, were denied by the Technology Center Director in a decision issued on September 29, 2017.

Four petitions under 37 CFR 1.181 were filed on October 19, 2017, October 20, 2017, and October 21, 2017, requesting review of the September 29, 2017 decision by the Technology Center Director and that the examiner be directed to issue a new non-final Office action in the above-identified application.

STATUTE AND REGULATION

35 U.S.C. § 132(a) provides that:

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 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.

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 Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER — A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

37 CFR 1.104 provides that:

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

(4)(i) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, not later

than the effective filing date of the claimed invention, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which would otherwise qualify as prior art under 35 U.S.C. 102(a)(2) and a claimed invention will be treated as commonly owned for purposes of 35 U.S.C. 102(b)(2)(C) on the basis of a joint research agreement under 35 U.S.C. 102(c) if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter was developed and the claimed invention was made by or on behalf of one or more parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), that was in effect on or before the effective filing date of the claimed invention, and the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(5)(i) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application filed on or after November 29, 1999, or any patent issuing thereon, in an application filed before November 29, 1999, but pending on December 10, 2004, or any patent issuing thereon, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, if the applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention, at the time the claimed invention was made, were owned by the same person or subject to an obligation of assignment to the same person.

(ii) Subject matter which qualifies as prior art under 35 U.S.C. 102(e), (f), or (g) in effect prior to March 16, 2013, and a claimed invention in an application pending on or after December 10, 2004, or in any patent granted on or after December 10, 2004, will be treated as commonly owned for purposes of 35 U.S.C. 103(c) in effect prior to March 16, 2013, on the basis of a joint research agreement under 35 U.S.C. 103(c)(2) in effect prior to March 16, 2013, if:

(A) The applicant or patent owner provides a statement to the effect that the subject matter and the claimed invention were made by or on behalf of the parties to a joint research agreement, within the meaning of 35 U.S.C. 100(h) and § 1.9(e), which was in effect on or before the date the claimed invention was made, and that the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and

(B) The application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.

(6) Patents issued prior to December 10, 2004, from applications filed prior to November 29, 1999, are subject to 35 U.S.C. 103(c) in effect on November 28, 1999.

(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.

(e) *Reasons for allowance.* If the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall be incorporated into an Office action rejecting other claims of the application or patent under reexamination or be the subject of a separate communication to the applicant or patent owner. The applicant or patent owner may file a statement commenting on the reasons for allowance within such time as may be specified by the examiner. Failure by the examiner to respond to any statement commenting on reasons for allowance does not give rise to any implication.

37 CFR 1.181 provides that:

(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 Patent Trial and Appeal Board 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 Patent Trial and Appeal Board, see § 41.3 of this title.

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 § 41.02(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 1.118(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.

OPINION

Petitioner argues that the above-referenced application was incompletely examined because the Office action of July 11, 2017, and previous Office actions, fail to answer the petitioner's traversals of the claim rejections, and that the rejections in the Office action of July 11, 2017 are so uninformative that they fail to meet the notice requirement of 35 U.S.C. § 132(a). Petitioner specifically argues that the Office action of July 11, 2017 fails to address: (1) the claim limitation "dosage of omega-6 fatty acids and antioxidants including polyphenols" of claims 82, 99, and 112 with respect to the rejection under 35 U.S.C. § 101 as not being directed to patent eligible subject matter (petition of October 19, 2017); (2) the substance of petitioner's arguments that the problem addressed by the claims of the above-identified application differs from the applicable claims of copending application No. 13/332,251 and copending application No. 12/426,034 with respect to the rejection under the judicially created double patenting doctrine (petition of October 20, 2017); (3) petitioner's arguments concerning the support for the claims limitation "wherein the product produced is not any single specific variety of a vegetable, a fruit, a grain, a legume, a nut, or a seed" with respect to the rejection under 35 U.S.C. § 112, ¶ 1, as failing to comply with its written description requirement (first petition of October 21, 2017); and (4) petitioner's arguments concerning the term "preferences" with respect to the rejection under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention (second petition of October 21, 2017). Petitioner cites 35 U.S.C. § 132(a), 37 CFR 1.104, MPEP § 707.07(f), and *In re Jung*, 637 F.3d 1356 (Fed. Cir. 2011), in support of these positions.

With respect to compliance with 35 U.S.C. § 132(a) and 37 CFR 1.104, 35 U.S.C. § 132(a) provides that "if a patent examiner finds that a patent application does not comply with the

standards of patentability, the examiner will issue an office action with respect to the application, ‘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.’” *Pfizer v. Lee*, 811 F.3d 466, 469 (Fed. Cir. 2016). 37 CFR 1.104(c)(2) provides that:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

With respect to sufficiency of an Office action under 35 U.S.C. § 132:

Section 132 merely ensures that an applicant “at least be informed of the broad statutory basis for [the rejection of] his claims, so that he may determine what the issues are on which he can or should produce evidence.” Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.

Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (citations omitted).

The Office action of July 11, 2017 satisfies the notice requirements of 35 U.S.C. § 132 and 37 CFR 1.104, in that the Office action is sufficiently informative as to place a reasonable applicant on notice of the basis for the rejections so as to allow the applicant to recognize and counter the rejections. *See id.* Specifically, the Office action of July 11, 2017 sets out the following rejections: (1) a rejection of claims 82 through 96, 99 through 111, 113 and 114 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (2) a provisional rejection of claims 82 through 98, 113 and 114 under the judicially created double patenting doctrine; (3) a rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 1, as failing to comply with its written description requirement; (4) a rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention; and (5) a rejection of claims 82 through 96, 113, and 114 under 35 U.S.C. § 102(b) as being anticipated. The Office action of July 11, 2017 further provides: (1) an explanation of the rejection of claims 82 through 96, 99 through 111, 113 and 114 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter on pages 3 through 8; (2) an explanation of the provisional rejection of claims 82 through 98, 113 and 114 under the judicially created double patenting doctrine on pages 8 through 12; (3) an explanation of the rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 1, as failing to comply with its written description requirement on pages 12 and 13; (4) an explanation of the rejection of claims 82 through 111, 113 and 114 under 35 U.S.C. § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter regarded as the invention on pages 13 through 18; and (5) an explanation of the rejection of claims 82 through 96, 113, and 114 under 35 U.S.C. § 102(b) as being anticipated on pages 18 through 21. The information and references provided in the Office action of July 11, 2017 are more than sufficient to satisfy the notice requirement of 35 U.S.C. § 132 and 37 CFR 1.104.

Therefore, the Office action of July 11, 2017 does not violate the procedural requirements of 35 U.S.C. § 132 and 37 CFR 1.104.

With respect to petitioner's contentions concerning the examiner's treatment of petitioner's traversal, MPEP § 707.07(f) provides, in part, that:

In order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application.

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his or her action on the amendment.

A review of the Office action of July 11, 2017 reveals that: (1) petitioner's arguments regarding the rejection of claims 99 through 111 under 35 U.S.C. § 101 were addressed on pages 21 through 24; (2) petitioner's arguments regarding the obviousness-type double patenting rejection of claims 82 through 98, and 113 through 114 were addressed on pages 9 through 11 and 23 through 24; (3) petitioner's arguments regarding the rejection of claims 82 through 111, 113, and 114, under 35 U.S.C. § 112, ¶ 1 were addressed on pages 12 through 13; and (4) petitioner's arguments regarding the rejection of claims 82 through 111, 113, and 114, under 35 U.S.C. § 112, ¶ 2 were addressed on pages 13 through 18.

While petitioner considers the Office action of July 11, 2017 to be inadequate in addressing petitioner's arguments, the Office action of July 11, 2017 does acknowledge and respond to the arguments submitted by petitioner (as discussed previously). In any event, an examiner is not required to expressly discuss every argument raised by an applicant. *See Synopsys, Inc. v. Mentor Graphics Corp.*, 814 F.3d 1309, 1322 (Fed. Cir. 2016). There is no reason to assume that an examiner failed to consider an applicant's arguments simply because they were not discussed at length in an Office action. *See Novartis AG v. Torrent Pharm. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017).

With respect to the sufficiency of the examiner's response to applicant's traversal of the rejections, the correctness and underlying reasoning of an examiner's consideration of an applicant's traversal goes directly to a rejection of the pending claims and is appropriate for the applicant's substantive challenge to the rejection. *See Jung*, 637 F.3d at 1363.² In this case,

² Petitioner's reliance upon *Jung* is at best misplaced. *Jung* sought to have the PTAB (and Federal Circuit) review of the procedural *prima facie* case aspects of a rejection separate from and prior to a review of the merits of the rejection. The Federal Circuit rejected *Jung*'s suggestion, noting that *Jung*'s arguments concerning the procedural *prima facie* case aspects of the rejection are the same as the arguments one would make concerning the merits of the rejection. *See Jung*, 637 F.3d at 1363. Similarly, petitioner's arguments in the petitions of October 19, 20, and 21, 2017 concerning the "procedural" aspects of the rejections and responses to petitioner's arguments in the Office action of July 21, 2017 are basically arguments concerning the merits of these rejection. The Federal Circuit's decision in *Jung* nowhere

because the correctness and underlying reasoning of the examiner's consideration of petitioner's traversal go directly to the rejections of the pending claims under 35 U.S.C. §§ 101, 112 ¶¶ 1 and 2, and obviousness-type double patenting, any review of the correctness and underlying reasoning of the examiner's consideration of petitioner's traversal is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 1.191, and not by way of petition under 37 CFR 1.181, even if the petitioner frames the issues as concerning procedure versus the merits. *See Boundy v. U.S. 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 (PTAB). *See* 37 CFR 43.31(a)(1). 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

The petitions filed October 19, 20, and 21, 2017, requesting that the Director exercise supervisory authority and overturn the decision of September 29, 2017, by the Director of Technology Center 1600 (Technology Center Director) and to direct the examiner to issue a new Office action in the above-identified application are **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.

suggests that the appropriate avenue for review of petitioner's complaints concerning the rejections in the Office action of July 21, 2017 is by way of a petition under 37 CFR 1.181, but rather stands for the proposition that petitioner's complaints concerning the rejections in the Office action of July 21, 2017 are properly raised by way of an appeal under 35 U.S.C. § 134 and 37 CFR 1.191.

The time period to respond to the non-final Office action of July 11, 2017 continues to run. Failure to file a timely reply under 37 CFR 1.111 to the Office action of July 11, 2017 will result in abandonment of the above-identified application (35 U.S.C. § 133).

A handwritten signature in black ink, appearing to read 'R. W. Bahr', with a stylized flourish at the end.

Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy