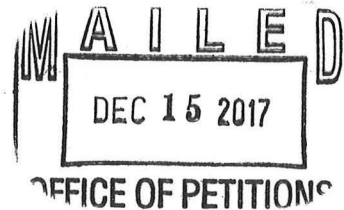




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Asha Nutrition Sciences, Inc.
P.O. Box 1000
Palo Alto CA 94302



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 petition under 37 CFR 1.181 filed October 30, 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 Technology Center Director decision refused to grant petitioner's request to assign the application to another examiner.

The petition to direct the Technology Center Director to assign the application to a new examiner is **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.

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.

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 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 the 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 applicant's 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, 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: (1) claims 1 through 81 have been canceled; (2) claims 82 through 112, 113, and 114 are pending; (3) claim 112 is withdrawn from consideration; and (4) "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 and issuance of a new, complete Office action including examination of Group IV (claim 112).

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.

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

A petition under 37 CFR 1.181 was filed on October 30, 2017, requesting review of the September 29, 2017 decision by the Technology Center Director and reassignment of the above-identified application to a different examiner.

STATUTE AND REGULATION

35 U.S.C. § 131 provides that:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. § 132 provides that:

(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 1.181(f) provides that:

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.

OPINION

Petitioner requests that the application be assigned to a new examiner. Specifically, petitioner asserts that the examiner's actions and conduct during prosecution of the instant application were improper, alleging "evidence of arbitrary/capricious rejections and bias."²

A petitioner is not entitled to choose his or her examiner, Supervisory Patent Examiner, or other deciding official. *See In re Arnott*, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991). A Technology Center Director and Supervisory Patent Examiner have considerable latitude as part of their day-to-day management of a Technology Center or Group Art Unit (respectively) in deciding the assignment of applications to examiners and the transfer of applications between examiners. A petitioner seeking to invoke the Director's supervisory authority to overrule the Technology Center Director and direct the Technology Center to assign an application to a new examiner must demonstrate improper conduct amounting to bias or the appearance of bias on the part of the examiner. *See In re Ovshinsky*, 24 USPQ2d 1241, 1251-1252 (Comm'r Pats. 1992). The record of the instant application does not indicate improper conduct amounting to bias or the appearance of bias on the part of the examiner so as to warrant directing the Technology Center Director to transfer the above-identified application to a new examiner.³

Petitioner's complaint alleges that, despite numerous Office actions on the merits and numerous interviews, the examiner continues to reject claims on various statutory grounds while maintaining the lack of unity finding. Petitioner disagrees with the rejections and lack of unity

² The affidavit by petitioner filed on October 30, 2017 in the above-identified application has also been considered. The comment discussed in the affidavit (from several years ago) is far less disparaging than the discussion at issue in *Ovshinsky*, and does not support the conclusions that petitioner now draws from this comment, nor support the position that there is bias or improper conduct on the part of the examiner.

³ Petitioner's argument that the examiner's actions in the above-identified application are arbitrary and/or capricious is noted. A determination that an examiner's objection, requirement, or other action is arbitrary or capricious would warrant reversing the examiner's objection, requirement, or other action; however, such a determination would not by itself also warrant transferring an application to a new examiner.

finding contained in the Office actions. The examination of the application has been carefully reviewed and there is no evidence of bias or improper conduct therein on the part of the examiner that would warrant replacing him with another to examine the above-identified application. The alleged improprieties cited by petitioner do not evidence bias or prejudice on the part of the examiner. Reasonable people can disagree as to whether a given claim is patentable and on what basis. *See Lear, Inc. v. Adkins*, 395 U.S. 653, 670 (1969). A mere difference of opinion between the examiner and the petitioner as to the patentability of one or more claims or the lack of unity in the claims does not evidence bias or improper conduct on the part of the examiner, much less that his replacement is justified. Petitioner's contention of improper actions (e.g., presenting rejections and lack of unity findings with which petitioner disagrees) are not improper conduct on the part of the examiner, nor is there any evidence of bias or the appearance of bias on behalf of the examiner.

DECISION

The petition to direct the Technology Center Director to transfer the above-identified application to a new examiner 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.

It is brought to petitioner's attention that the U.S. Patent and Trademark Office (USPTO) recently created an art unit (Art Unit 3649) that specializes in the examination of *pro se* patent applications. More information regarding the *Pro Se* Examining Art Unit and other information concerning assistance for *pro se* patent applicants may be found at <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>. While the circumstances of the above-identified application do not warrant directing the Technology Center Director to assign the above-identified application to another examiner, the Technology Center Director has determined that the preferable course of action is to transfer the above-identified application to the *Pro Se* Examining Art Unit 3649 for examination.

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).



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy