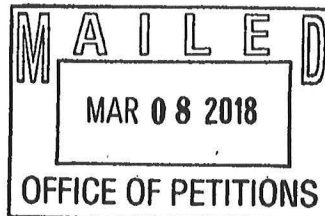




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In re Application of	:	DECISION
SMITH et al.	:	
Application No. 14/063,671	:	ON
Filed: October 25, 2013	:	
Attorney Docket No.: 5441-332	:	PETITION
For: VIBRATING INSERTION TOOL	:	

This is a decision on the petitions under 37 CFR 1.181 filed on December 26, 2017, requesting that the Director exercise supervisory authority and overturn the decision of October 24, 2017 by the Director of Technology Center 3700 (Technology Center Director), which Technology Center decision refused to: (1) withdraw the finality of the Office action of October 12, 2016 and reopen prosecution; (2) to enter and examine the amendment to the claims submitted with the supplemental response of February 6, 2017; and (3) withdraw the finality of the Office action of February 8, 2017 and reopen prosecution.

The petition to enter the amendment of February 6, 2017 is **GRANTED**. The petition to withdraw the finality of the Office action of February 8, 2017 is **DISMISSED AS MOOT**. The petition to withdraw the finality of the Office action of October 12, 2016 is **DENIED**.

**RELEVANT BACKGROUND**

The above-identified application was filed on October 25, 2013.

Prosecution of the above-identified application resulted in a final Office action being issued on October 12, 2016.

A reply to the final Office action of October 12, 2016, was filed on December 12, 2016. The reply of December 12, 2016 included an amendment to claims 28 through 30 and arguments traversing the examiner's rejection.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on December 12, 2016, requesting the finality of the Office action of October 12, 2016 be withdrawn and the

Office action be reissued as a new non-final Office (or the period to reply be “reset” to the mailing date of the grant of the petition) so that prosecution could be reopened to, *inter alia*, amend the claims, add new claims and file declaration(s).

The petition of December 12, 2016 was granted the Technology Center Director in a decision issued on January 30, 2017. The decision of January 30, 2017 withdrew the finality of the Office action of October 12, 2016 as being premature and entered the response of December 12, 2016 as an amendment under 37 CFR 1.111. The application was forwarded to the examiner for consideration of the October 12, 2016 response.

In response to the decision of January 30, 2017, withdrawing the finality of the Office action of October 12, 2016, a supplemental response was filed on February 6, 2017. The supplemental response of February 6, 2017 consisted of an amendment amending claims 28 through 30 and adding new claims 31 through 35 and arguments traversing the examiner’s rejection. Claims 1 through 5, 7 through 8, 10 through 14 and 21 through 30 were pending. Petitioners stated the supplemental response was submitted “under the assumption that the claim amendments of the Response filed in December 2016, have been entered.”

A final Office action was issued on February 8, 2017 in response to the reply filed December 12, 2016.<sup>1</sup> The final Office action did not consider claims 31 through 35 that were newly added in the February 6, 2017 reply.<sup>2</sup>

A renewed petition under 37 CFR 1.181 was filed on March 30, 2017, disputing the remedy provided in the decision of January 20, 2017, and again requesting that the October 12, 2016 Office action be reissued as a new non-final Office action (or the period to reply be “reset” to the mailing date of the grant of the petition) so that prosecution be reopened to allow petitioners to, *inter alia*, file amendments, provide declaration(s) and have an interview with the supervisor.

A reply to the final Office action of February 8, 2017 was filed on April 10, 2017.

A petition under 37 CFR 1.181 was filed on April 10, 2017, seeking to have the claim amendments filed on February 6, 2017 entered and examined. A second petition under 37 CFR 1.181 was filed on April 10, 2017, requesting the finality of the February 2017 Office Action be withdrawn and that Office Action be reissued as a new non-final Office action (or that that Office action be declared non-Final and the time to reply be “reset” to the mailing date of the grant of the petition) so that prosecution could be reopened to allow petitioners to, *inter alia*, amend the claims, add new claims, file declaration(s).

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<sup>1</sup> The Office action incorrectly lists the date of the reply filed as August 12, 2016 as also acknowledged in the decision by the Technology Center Director, issued on June 9, 2017.

<sup>2</sup> As noted in the decision by Technology Center Director issued on June 9, 2017, a review of the timeline shows that the examiner had already considered the reply of December 12, 2016 and submitted a final Office action for mailing on February 2, 2017 before the filing of the reply on February 6, 2017.

On June 9, 2017, the Technology Center Director issued a decision dismissing the petition filed on March 30, 2017 and the two petitions filed on April 20, 2017. The decision held that the amendment filed on February 6, 2017 was a supplemental reply and would not be entered as a matter of right pursuant to 37 CFR 1.111(a)(2). The decision also noted that the addition of new claims 31 through 35 in the reply is not one of the listed items in 37 CFR 1.111(a)(2)(i)(A)-(F) that may allow for entry of the supplemental reply. The decision dismissed the request for withdrawal of finality of the Office action issued on February 8, 2017, noting that the final Office action did not introduce any new grounds of rejection.

An advisory action was issued on June 27, 2017 responding to the arguments set forth in the after-final reply filed April 10, 2017.

On July 24, 2017, three renewed petitions under 37 CFR 1.181 were filed. The renewed petitions of July 24, 2017 requested the finality of the Office action issued on October 12, 2016 be withdrawn and the October 12, 2016 Office action be reissued as a non-final action (or the period for reply be reset by the mail date of the January 30, 2017 petition decision). Additionally, the renewed petitions included requests for withdrawal of the finality of the February 8, 2017 Office action and entry of the amendment filed February 6, 2017.

A notice of appeal and a Pre-Appeal Brief Conference Request were filed on August 8, 2017.

A Notice of Panel Decision from Pre-Appeal Brief Conference Request was issued on August 30, 2017, indicating the application remains under appeal and that petitioners must submit an appeal brief in accordance with the provisions of 37 CFR 41.37.

The renewed petitions of July 24, 2017 were denied by the Technology Center Director in a decision issued on October 24, 2017.

An appeal brief was filed December 8, 2017.

On December 26, 2017, petitioners filed the instant petitions requesting the finality of the Office actions issued on October 12, 2016 and February 8, 2017 be withdrawn and the claims filed on February 6, 2017 be entered and examined.

#### **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. § 133 provides that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Director in such action, the application shall be regarded as abandoned by the parties thereto.

37 CFR 1.111(a) provides:

(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.

(2) *Supplemental replies.*

(i) A reply that is supplemental to a reply that is in compliance with § 1.111(b) will not be entered as a matter of right except as provided in paragraph (a)(2)(ii) of this section. The Office may enter a supplemental reply if the supplemental reply is clearly limited to:

- (A) Cancellation of a claim(s);
- (B) Adoption of the examiner suggestion(s);
- (C) Placement of the application in condition for allowance;
- (D) Reply to an Office requirement made after the first reply was filed;
- (E) Correction of informalities (e.g., typographical errors); or
- (F) Simplification of issues for appeal.

(ii) A supplemental reply will be entered if the supplemental reply is filed within the period during which action by the Office is suspended under § 1.103(a) or (c).

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.116 provides that:

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

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

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

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

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

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

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

(2) Notwithstanding the provisions of paragraph (b) of this section, an amendment made after a final rejection or other final action (§ 1.113) in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 may not cancel claims where such cancellation affects the scope of any other pending claim in the reexamination proceeding except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(e) An affidavit or other evidence submitted after a final rejection or other final action (§ 1.113) in an application or in an ex parte reexamination filed under § 1.510, or an action closing prosecution (§ 1.949) in an inter partes reexamination filed under § 1.913 but before or on the same date of filing an appeal (§ 41.31 or § 41.61 of this title), may be admitted upon a showing of good

and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented.

(f) Notwithstanding the provisions of paragraph (e) of this section, no affidavit or other evidence can be made in an inter partes reexamination proceeding after the right of appeal notice under § 1.953 except as provided in § 1.981 or as permitted by § 41.77(b)(1) of this title.

(g) After decision on appeal, amendments, affidavits and other evidence can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 41.50(c) of this title.

37 CFR 1.134 provides that:

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 CFR 1.135 provides that:

(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 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.



### OPINION

Petitioners seek to have the claim amendments filed on February 6, 2017, entered and examined. Petitioners also seek a withdrawal of finality of the Office actions issued on October 12, 2016 and February 8, 2017, respectively.

*With respect to petitioners' arguments concerning the entry of the amendment filed February 6, 2017:*

The October 12, 2016 Office action was designated as a final Office action; an amendment under 37 CFR 1.116 was filed on December 12, 2016, along with a petition contending the finality of the Office action of October 12, 2016. A decision on the December 12, 2016 petition was issued on January 30, 2017 notifying petitioners that the finality of the October 12, 2016 Office action was withdrawn. A supplemental amendment was filed on February 6, 2017, which was within one week of the date petitioners was notified that the finality of the October 12, 2016 Office action was withdrawn.

The January 30, 2017 decision by the Technology Center Director treated the amendment filed on December 12, 2016 as an amendment under 37 CFR 1.111. However, the December 12, 2016 amendment was submitted by petitioners as an amendment under 37 CFR 1.116. The provisions of 37 CFR 1.116 are more limiting on filing an amendment than the provisions of 37 CFR 1.111.

MPEP § 714.12 sets out the USPTO's practice on the entry of amendments and other replies after final rejection or action and provides as follows—

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

Thus, under the circumstances set forth, petitioners cannot reasonably be expected to have filed the same amendment under 37 CFR 1.116 on December 12, 2016 that petitioners could have filed under 37 CFR 1.111 had the Office action of October 12, 2016 been designated as a non-final Office action prior to December 12, 2016. The treatment of the amendment filed on December 12, 2016 as an amendment under 37 CFR 1.111 for purposes of meeting the reply requirement of 35 U.S.C. § 133 and 37 CFR 1.134 to the now non-final Office action of October 12, 2016 was appropriate. However, the treatment of the February 6, 2017 amendment as a

supplemental amendment under 37 CFR 1.111(a)(2) had the effect of precluding petitioners from filing the amendment that petitioners could have filed under 37 CFR 1.111 had petitioners been on notice prior to December 12, 2016 that the October 12, 2016 Office action was a non-final Office action. Treating the amendment filed on December 12, 2016 as an amendment under 37 CFR 1.111 for the purpose of considering the amendment filed on February 6, 2017 as a supplemental amendment under 37 CFR 1.111(a)(2), was not appropriate. Accordingly, petitioners' request for entry of the amendment filed February 6, 2017 is **GRANTED**.

***With respect to petitioners' arguments concerning the withdrawal of the finality of the Office action issued February 8, 2017:***

The Technology Center Director has indicated that a new Office action responsive to the entry of the amendment filed February 6, 2017 is forthcoming. In view thereof, the request to withdraw the finality of the Office action issued February 8, 2017 is **DISMISSED AS MOOT**.

***With respect to petitioners' arguments concerning the withdrawal of the finality of the Office action issued October 12, 2016:***

As previously discussed, in response to the final Office action of October 12, 2016, petitioners filed a reply and petition on December 12, 2016, including: (i) arguments traversing the examiner's rejection, (ii) amendments to claims 28 through 30, and (iii) a petition to withdraw finality, arguing the examiner had improperly introduced new grounds of rejection.

On January 30, 2017, the Technology Center Director issued a decision granting petitioners' request to withdraw the finality of the October 12, 2016 Office action, entered the December 12, 2016 reply, which included an amendment under 37 CFR 1.111, and forwarded the application to the examiner to consider the reply.

The gravamen of petitioners' request is that the January 30, 2017 petition decision should have reopened prosecution for a period of time to afford petitioners time to, *inter alia*, amend the claims, provide declaration(s) and have an interview with the supervisor. The amendment filed December 12, 2016 has been entered and considered by the examiner. As noted above, the amendment filed February 6, 2016 is being considered in a forthcoming Office action. Petitioners had an interview with the examiner and the examiner's supervisor on July 31, 2017 as memorialized in the interview summary of August 3, 2017. Accordingly, as petitioners have already been granted the requested relief, the request to withdraw the finality of the October 12, 2016 is **DENIED**.

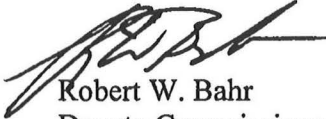
### **DECISION**

The decision of the Technology Center Director decision of October 24, 2017 has been reviewed. Petitioners' request for the entry of the amendment filed February 6, 2017 is **GRANTED**. The request to withdraw the finality of the Office action issued on February 8, 2017 is **DISMISSED AS MOOT**. The request to withdraw the finality of the Office action issued on October 12, 2016 is **DENIED**.



Petitioners should await an Office action in response to the amendment filed February 6, 2017.<sup>3</sup>

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



Robert W. Bahr  
Deputy Commissioner for  
Patent Examination Policy

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<sup>3</sup> Petitioners should note the Office will not be refunding any fees paid subsequent to the Office action issued February 8, 2017. The fees accompanied actions taken to preserve the pendency of the application under 37 CFR 1.135. The fees were not paid in excess or by mistake. *See* MPEP § 607.02.