This is a decision on the petition filed on September 20, 2017 under 37 CFR 1.181, requesting that the Director exercise supervisory authority and overturn the decision of July 20, 2017, by the Director of Technology Center 3700 (Technology Center Director), which decision refused to withdraw finality of the Office action issued on May 5, 2017 and reopen prosecution in the above-identified application.

The petition to withdraw finality of the Office action issued on May 5, 2017 and reopen prosecution in the above-identified application is DENIED.

**RELEVANT BACKGROUND**

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on July 3, 2013, and claims priority to an application filed in Italy on July 6, 2012 (TO2012A000598).


\(^{1}\) 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 after September 16, 2012, but asserts priority to an effective filing date prior to March 16, 2013 for every claim ever contained in the above-identified application, and never contained a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any other patent or application having a claim with an effective filing date on or after March 16, 2013. Therefore, this decision refers to the AIA version of 35 U.S.C. § 112, but the pre-AIA version of 35 U.S.C. §§ 102 and 103.
A reply under 37 CFR 1.111 (a reply to a non-final Office action) to the non-final Office action of December 19, 2016, including an amendment to the claims and the addition of new claims 21 through 29, was filed on March 20, 2017.


A petition under 37 CFR 1.181 was filed on July 5, 2017, and the petition of July 5, 2017 was denied by the Technology Center Director in a decision issued on July 20, 2017.

The instant petition under 37 CFR 1.181 was filed on September 20, 2017 and requests that the Director exercise supervisory authority over the primary examiner and withdraw finality of the Office action issued on May 5, 2017 and reopen prosecution in the above-identified application.
STATUTES AND REGULATIONS

35 U.S.C. § 132(a) states:

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 1.113 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 1.181(a) provides that:

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 11.18(a) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.
(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

**OPINION**

Petitioner asserts that the final Office action issued May 5, 2017 in the above-identified application contains a new ground of rejection, and thus argues that the finality of the Office action is improper. Petitioner asserts that the examiner has changed the rationale of the rejections based on Published U.S. Patent Application No. 2008/0028512 to Hughson and therefore, the final Office action issued May 5, 2017 contains a new ground of rejection that was not necessitated by amendment or the filing of an Information Disclosure Statement (IDS). Petitioner requests that the finality of the Office action be withdrawn and prosecution in the above-identified application be reopened.

MPEP § 706.07(a) specifically sets forth the USPTO’s second action final practice, and provides in part that:

Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant’s amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609.04(b).

Furthermore, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.
Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. See In re Kronig, 539 F.2d 1300, 1303 (CCPA 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rational not previously raised to the applicant. See In re Biedermann, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting In re Leithem, 661 F.3d 1316 at 1319 (Fed. Cir. 2011)). The prior rejection, however, need not be repeated in haec verba to avoid being considered a new ground of rejection. See id. In addition, further explaining and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. See In re Jung, 637 F.3d 1356, 1364-65 (Fed. Cir. 2011).

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

A position or rationale that changes the “basic thrust of the rejection“ will also give rise to a new ground of rejection. In re Kronig, 539 F.2d 1300, 1303 (CCPA 1976). However, the examiner need not use identical language in both the examiner’s answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner’s answer responds to appellant’s arguments using different language, or restates the reasoning of the rejection in a different way, so long as the “basic thrust of the rejection“ is the same. In re Kronig, 539 F.2d at 1303; see also In re Jung, 637 F.3d 1356, 1364-65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time “did not change the rejection“ and appellant had fair opportunity to respond); In re Noznick, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when “explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner“); In re Krammes, 314 F.2d 813, 817 (CCPA 1963) (“It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of aminer“); “ (citations omitted)); In re Cowles, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of “different language“ does not necessarily trigger a new ground of rejection).

The final Office action of May 5, 2017 included, inter alia, a rejection of claims 1, 2, 8, 9, 15, 16, and 18 under 35 U.S.C. § 102(a) as being anticipated by Published U.S. Patent Application No. 2008/0028512 to Hughson.

Petitioner argues that the examiner’s additional note and newly annotated Figure 7 of Hughson, as it relates to claim 1 in the final Office action, constituted a new ground of rejection that was not necessitated by amendment or the filing of an IDS.

Petitioner argues that, in the non-final Office action issued December 19, 2016, the examiner asserted that the term “base“ focused solely on element 21 of Hughson and that the examiner never asserted that any other element disclosed in Hughson constituted a “base”. Petitioner
Petitioner's arguments are not persuasive. The non-final Office action of December 19, 2016 and the final Office action of May 5, 2017 show not only that the rejection of claims 1, 2, 8, 9, 15, 16, and 18 was based on the same reference, but also that the basic thrust of the rejection made in the non-final Office action was not changed because the examiner did not change position with regard to how Hughson teaches the claim limitations. For example, the December 19, 2016 Office action addressed the limitation of a base by stating that the heating device comprises “a base (body 21, Fig. 7)” in the rejection of claim 1. The examiner also stated in the rejection of claim 2 that Hughson teaches that the optical sensor 4 is “inserted into a hole in said base (optical water sensor 4 is threaded into an aperture, Fig. 7), the elongated body (exterior part 8) having a substantially conical extremity (tip 5 of the sensor unit 4 is conically shaped, Fig. 2) that protrudes from said base on the same side as said coil resistor (heating element 1 and optical water sensor unit 4 point in same direction, Fig. 7)”. Although the rejection of the term “base” in claim 1 only referred generally to “body 21, Fig. 7,” the further description in claim 2 that the optical sensor 4 is threaded into the aperture of the base, and the heating element and water sensor protrude from the base, are sufficient to inform applicant that the examiner construed the “base” of claim 1 to include body 21 of Figure 7 and the un-numbered portion to which the optical sensor is inserted. It is this construction of the term “base” which is more clearly depicted as encompassed by the block of annotated Figure 7 in the final Office action of May 5, 2017. Furthermore, this further explanation and annotated Figure 7 of Hughson in the final Office action of May 5, 2017 addressed an argument raised by applicant and is also used in the rejection of newly added claims 21 through 29. See, for example, the final Office action of May 5, 2017, pages 54-56 and pages 13-17.

While the examiner may have provided additional explanation in the final Office action of May 5, 2017 regarding the rejections in response to arguments presented by petitioner, this additional explanation does not change the basic thrust of the rejection of claim 1. See Jung, 637 F.3d at 1364-65. The basic thrust of the examiner’s position in rejecting the claims has remained the same from the non-final Office action of December 19, 2016 to the final Office action of May 5, 2017.

The cases cited by petitioner are readily distinguishable from the circumstances of the above-identified application. The circumstances of the above-identified application do not involve the examiner changing the interpretation of how a claim element was met by a disclosure in the prior art reference for the first time in the examiner’s answer as was the case in Leithem and In re
Imes, 778 F.3d 1250 (Fed. Cir. 2015). The circumstances of the above-identified application are similarly not comparable to the circumstances present in other cases in which a new ground of rejection was found. See, e.g., Biedermann (changing factual basis for combining references); Rambus Inc. v. Rea, 731 F.3d 1248 (Fed. Cir. 2013) (changing factual basis for combining references); In re Stepan Co., 660 F.3d 1341 (Fed. Cir. 2011) (changing the treatment of an applicant-submitted affidavit or declaration); In re Kumar, 418 F.3d 1361 (Fed. Cir. 2005) (providing new calculations to demonstrate that the prior art reference falls within or overlaps with the claimed range); In re DeBlauwe, 736 F.2d 699 (Fed. Cir. 1984) (changing the treatment of applicant’s contentions of unexpected results); In re Waymouth, 486 F.2d 1058 (CCPA 1973) (changing aspect of a claim element relied upon for position that application did not provide written description support under 35 U.S.C. § 112, paragraph 1; In re Eynode, 480 F.2d 1364 (CCPA 1973) (changing factual basis for the position that application did not provide enablement under 35 U.S.C. § 112, paragraph 1); In re Echerd, 471 F.2d 632 (CCPA 1973) (changing portion of a reference relied upon to meet claim limitations); In re Wiechert, 370 F.2d 927 (CCPA 1967) (changing portion of a reference relied upon to meet claim limitations); and In re Hughes, 345 F.2d 184 (CCPA 1965) (changing the statutory basis of the rejection). The circumstances of the above-identified application are most analogous to the circumstances present in Jung (explanation of why the claims are not limited as asserted by the applicant is not a change to the basic thrust of the rejection), and are not analogous to the circumstances in which a new grounds of rejection was found.

Petitioner should also note that review of the propriety of a rejection per se (and its underlying reasoning), is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 41.31, and not by way of petition under 37 CFR 1.181, even if a petitioner frames the issues as concerning procedure versus the merits. See Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468, 1472 (E.D.Va. 2004). As stated by the Court of Customs and Patent Appeals (a predecessor of the U.S. Court of Appeals for the Federal Circuit), the adverse decisions of examiners which are reviewable by the Board are those which relate, at least indirectly, to matters involving the rejection of claims. See In re Hengehold, 440 F.2d 1395, 1404 (CCPA 1971). That an applicant casts the argument as directed to the prima facie case requirement (rather than the merits of the rejection) does not un tether the review of the prima facie case from the review of the merits of the rejection. See Jung, 637 F.3d at 1363 (Fed. Cir. 2011) (applicant’s procedural arguments concerning the prima facie case requirement are the same arguments that would have been made on the merits). An applicant dissatisfied with an examiner’s decision in the second or subsequent rejection may appeal to the Patent Trial and Appeal Board. See 37 CFR 41.31(a)(1). 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.
In conclusion, the final Office action of May 5, 2017 did not change the basic thrust of the rejections, and petitioner has been given a fair opportunity to respond to the rejection of the claims. Accordingly, the final Office action of May 5, 2017 does not contain a new ground of rejection warranting the withdrawal of finality and reopening of prosecution in the above-identified application.

DECISION

For the previously stated reasons, the petition to withdraw the finality of the Office action of May 5, 2017 and that prosecution in the above-identified application be reopened is DENIED.

This constitutes a final decision on the petition. No further requests for reconsideration will be entertained. Judicial review of this decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (e.g., a final decision by the Patent Trial and Appeal Board). See MPEP 1002.02.

Telephone inquiries concerning this decision should be directed to Vanitha Elgart at 571.272.7395.

[Signature]
Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy