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In re Application of:	:	
ADLEM et al.	:	DECISION
Application No.: 14/413,064	:	
PCT No.: PCT/EP2013/001772	:	ON
International Filing Date: June 14, 2013	:	
Priority Date: July 6, 2012	:	PETITION
For: BIMESOGENIC COMPOUNDS AND	:	
MESOGENIC MEDIA	:	

This is a decision on the petition under 37 CFR 1.181 filed on November 9, 2017, requesting that the Director exercise supervisory authority and overturn the decision of September 26, 2017, by the Director of Technology Center 1700 (Technology Center Director), specifically requesting that the request for continued examination of September 14, 2017 be held in abeyance and not treated as mooted the petition to withdraw the finality of the Office action of June 14, 2017, and requesting a refund of the request for continued examination fee and information disclosure statement fee paid on September 14, 2017.

The petition to hold the request for continued examination filed on September 14, 2017 in abeyance, and to not treat this request for continued examination as mooted the petition to withdraw the finality of the Office action of June 14, 2017 is **DENIED**.

The petition to refund the request for continued examination fee paid on September 14, 2017 is **DENIED**.

The petition to refund the information disclosure statement fee paid on September 14, 2017 is **GRANTED**.

RELEVANT BACKGROUND

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on June 14, 2013, and claims priority to a European Patent Office (EPO) application filed July 6, 2012.

On April 16, 2015, 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 January 6, 2015.

Prosecution of the above-identified application resulted in a non-final Office action being issued on November 7, 2016. The Office action of November 7, 2016 included, *inter alia*: (1) a rejection of claims 1, 2 and 5 under 35 U.S.C. § 102(b)¹ as being anticipated by either Martens et al. (Organische Schwefeverbindungen), Basu et al. (Silica-promoted facile synthesis of thioesters and thioethers), Sasin et al (Dithiol Sebacic Esters), Imamoto et al. (A Convenient method for the Preparation of S-esters of Thio Analogs of Malonic Acide), or Purvis et al. (The Colour and Absorption Spectra of Some Sulphur Compounds); and (2) a rejection of claims 1, 2, and 5 under 35 U.S.C. § 103 as being unpatentable over Ogata et al. (Synthesis of Polyamides through Active Diesters).

A reply to the Office action of November 7, 2016, was filed on February 7, 2017. The reply of February 7, 2017, included an amendment amending claims 1 and 2 to address the rejections under 35 U.S.C. § 112(d), 35 U.S.C. § 102(b), and 35 U.S.C. § 103(a).²

A final Office action was issued on June 14, 2017. The final Office action of June 14, 2017 included, *inter alia*: (1) a rejection of claims 1, 2, and 5 under 35 U.S.C. § 102(b) as being anticipated by either Karrer et al. (U.S. Patent No. 3,988,477), Skey et al (Synthesis of Chiral Micelles and Nanoparticles from Amino Acid Based Monomers Using RAFT Polymerization), Tomaszewski et al (Aminolysis of 3-Phenyl Propylthiol Esters Leading to Diverse Sets of Amides), or Janczewski (Effect of molecular structure on optical properties on sulfoxide systems. LV-L VI. Optical relations in the 4-diphenylsulfinylacetic acids group and in their “-tert-butyl derivatives); (2) a rejection of claims 1, 2, 4, 5, and 12 under 35 U.S.C. § 102(b) as being anticipated by Brookes et al. (Toxicity of organic sulfides to the eggs and larvae of the

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 Leahy-Smith America Invents Act (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 after September 16, 2012, but asserts priority to an application with 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.

² Claim 1 is the only independent claim.

two-spotted spider mite. IV. Benzyl phenyl sulfides substituted by halogens and other groups); (3) a rejection of claims 1 through 3, and 5 under 35 U.S.C. § 102(b) as being anticipated by Nowakowska (Electron ionization mass spectrometry in the analysis of substituted stilbenethiols); and (4) a rejection of claims 1, 2, 5 to 7 and 9 through 11 under 35 U.S.C. § 102(b) as being anticipated by Yamashita et al. (JP 63-137985) or Yamashita et al. (JP 64-36683); and (5) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Yamashita et al. (JP 63-137985) or Yamashita et al. (JP 64-36683) in view of Coles et al (GB 2356629). The final Office action stated applicant's amendment necessitated the new ground(s) of rejection made in the Office action.

A reply to the final Office action of June 14, 2017, and a Certification and Request for Consideration under the After Final Consideration Pilot Program 2.0 (AFCP 2.0) were filed on August 7, 2017.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on August 7, 2017. The petition of August 7, 2017 requested the finality of the Office action of June 14, 2017 be withdrawn because the Office action contained new grounds of rejection not necessitated by amendment to the claims.

A request for continued examination, along with the request for continued examination fee of \$1,200 set forth in § 1.17(e), were submitted on September 14, 2017. The request for continued examination of September 14, 2017 indicated that the arguments in the reply filed on August 7, 2017 should be considered a submission under 37 CFR 1.114. An information disclosure statement and fee of \$180 set forth in 37 CFR 1.17(p) were also filed on September 14, 2017.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on September 14, 2017, to supplement the petition under 37 CFR 1.181 filed on August 7, 2017, to withdraw the finality of the Office action issued on June 14, 2017. The petition of September 14, 2017 requested a refund of the request for continued examination fee and the information disclosure statement fee paid on September 14, 2017. Specifically, the petition indicated that the request for continued examination was filed on September 14, 2017, to maintain pendency of the application while awaiting a decision on the petition of August 7, 2017. The petition stated that once finality of the Office action of June 14, 2017 was withdrawn, there would be no basis for the request for continued examination and thus, the request for continued examination fee should be refunded. The petition of September 14, 2017, further stated the fee submitted with the information disclosure statement filed on September 14, 2017, was not required and should be refunded.

The petitions filed on August 7, 2017 and September 14, 2017 were dismissed by the Technology Center Director in a decision issued on September 26, 2017. The decision of September 26, 2017 stated petitioner's argument amounted to a request to treat the request for continued examination filed on September 14, 2017 as a "conditional" request for continued examination. The decision noted the Office will treat a "conditional" request for continued examination as if the request for continued examination had been filed pursuant to MPEP 706.07(h). The decision further noted that the finality of the June 14, 2017 Office action would be withdrawn and the amendments to the claims would be entered due to the filing of the request

for continued examination and not as a result of the petition to withdraw finality filed August 7, 2017. The decision concluded that based on the request for continued examination filed on September 14, 2017, the petition filed August 7, 2017, to withdraw the finality of the Office action of June 14, 2017 was moot.

An AFCP 2.0 decision was issued on October 12, 2017, in response to the AFCP 2.0 request filed August 7, 2017. The AFCP 2.0 decision of October 12, 2017, indicated that the after-final amendment submitted with the request would not be treated under AFCP 2.0, but rather under the pre-pilot procedure because the amendment could not be reviewed and a search conducted within the pilot program guidelines.

An advisory action was also issued on October 12, 2017, responding to the reply filed August 7, 2017, and the Information Disclosure Statements submitted on June 7, 2017 and September 14, 2017. The advisory action stated that the reply filed August 7, 2017, failed to place the application in condition for allowance and that the proposed amendment would not be entered because they raised new issues that would require further consideration and/or search. The advisory action further indicated that the Japanese Office action filed with the information disclosure statement of September 14, 2017, had not been considered because it was not complete.

A petition under 37 CFR 1.181 was filed on November 9, 2017, requesting a supervisory review of the Technology Center Director's decision of September 26, 2017.

STATUTE AND REGULATION

35 U.S.C. § 132 states:

(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 1.114 provides that:

- (a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:
 - (1) Payment of the issue fee, unless a petition under § 1.313 is granted;
 - (2) Abandonment of the application; or
 - (3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under 35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.
- (b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.
- (c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.
- (d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§ 41.37 of this title) or a reply brief (§ 41.41 of this title), or related papers, will not be considered a submission under this section.
- (e) The provisions of this section do not apply to:
 - (1) A provisional application;
 - (2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;
 - (3) An international application filed under 35 U.S.C. 363 before June 8, 1995, or an international application that does not comply with 35 U.S.C. 371;
 - (4) An application for a design patent;
 - (5) An international design application; or
 - (6) A patent under reexamination.

OPINION

Petitioners assert that the request for continued examination filed on September 14, 2017 does not render moot the petitions under 37 CFR 1.181 filed August 7, 2017 and September 14, 2017, to withdraw the finality of the Office action issued on June 14, 2017. Specifically, petitioners argue that a prerequisite for filing an request for continued examination under 37 CFR 1.114 is the “final” status of the Office action of June 14, 2017 must be proper and prosecution of the application must be properly closed. Petitioners assert that if prosecution of the application was

not properly closed, the request for continued examination of September 14, 2017 has no basis and must be vacated. Petitioners' reason that if the request for continued examination of September 14, 2017, is without basis, the filing of such request for continued examination cannot render moot the petitions to withdraw finality filed August 7, 2017 and September 14, 2017. Therefore, petitioners request that the petitions to withdraw finality filed August 7, 2017 and September 14, 2017 be decided on the merits. Petitioners further request a refund of the request for continued examination fee and an information disclosure statement fee paid on September 14, 2017.

With respect to the request to hold the request for continued examination in abeyance, section 706.07(h)(III)(C) of the Manual of Patent Examining Procedure (MPEP) provides that "If a submission is accompanied by a 'conditional' request for continued examination and payment of the request for continued examination fee under 37 CFR 1.17(e) (*i.e.*, an authorization to charge the 37 CFR 1.17(e) fee to a deposit account in the event that the submission would not otherwise be entered), the Office will treat the 'conditional' request for continued examination and payment as if an request for continued examination and payment of the fee set forth in 37 CFR 1.17(e) had been filed."³ Therefore, the Technology Center Director correctly refused petitioners' request (in the petitions of August 7, 2017 and September 14, 2017) that the request for continued examination filed on September 14, 2017 be held in abeyance until a decision on the petitions is rendered.

37 CFR 1.114(a) provides that an applicant may request continued examination of an application if, *inter alia*, prosecution in the application is closed. 37 CFR 1.14(b) defines prosecution of the application being closed for purposes of a request for continued examination as meaning that "the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application." *See* 37 CFR 1.114(b). 37 CFR 1.114(b) does not condition the propriety of the request for continued examination on the propriety of a final Office action (or other action resulting in prosecution being closed for purposes of a request for continued examination). Thus, a determination that the finality of an Office action in an application was improper would not *nunc pro tunc* render improper any previously filed request for continued examination of the application.

When a request for continued examination in compliance with 37 CFR 1.114 is filed after a final Office action is issued, the USPTO will withdraw the finality of the Office action, and the submission will be entered and considered. *See* 37 CFR 1.114(d). In the above-identified application, a request for continued examination, including a submission (after-final amendment filed August 7, 2017) and the fee set forth in § 1.17(e), was timely filed on September 14, 2017. As provided in 37 CFR 1.114(d), the finality of the Office action of June 14, 2017 was

³ There is an exception to this provision in MPEP 706.07(h) that is not applicable to the circumstances of the above-identified application. A request for continued examination filed as part of a Quick Path Information Disclosure Statement (QPIDS) submission will be treated as a "conditional" request for continued examination until the examiner determines whether any item in the information disclosure statement necessitates reopening prosecution. The request for continued examination filed on September 14, 2017, however, was not submitted under the QPIDS pilot program.

withdrawn (and the prosecution reopened) as a consequence of the filing of a request for continued examination on September 14, 2017. Thus, the request for continued examination filed on September 14, 2017 mooted petitioners' previous request to withdraw the finality of the Office action of June 14, 2017. Therefore, the Technology Center Director correctly dismissed petitioners' request to withdraw the finality of the Office action of June 14, 2017 as moot.⁴

With respect to petitioners' reference to petition decisions in two other applications where petitions to withdraw finality were not rendered moot due to the filing of a request for continued examination, decisions by other Technology Center Directors do not set precedent nor govern the outcome of the instant petition in the above-identified application.

With respect to petitioners' request for a refund of the request for continued examination fee paid on September 14, 2017, fees may be refunded (except in situations not applicable in the above-identified application) only if the fee was paid by mistake or in excess of the amount required. *See* 35 U.S.C. § 42(d). The request for continued examination and \$1,200 fee for a request for continued examination paid on September 14, 2017 (and a notice of appeal and the applicable fee) were necessary on September 14, 2017 to continue proceedings in the above-identified application. Therefore, the \$1,200 request for continued examination fee was not paid by mistake or in excess of the amount required within the meaning of 35 U.S.C. § 42(d), regardless of whether the finality of the Office action of June 14, 2017 were withdrawn and prosecution reopened in the above-identified application as a consequence of the petition of August 7, 2017 to withdraw the finality of the Office action of June 14, 2017. *See Miessner v. United States*, 228 F.2d 643 (D.C. Cir. 1955); *Ex parte Grady*, 59 USPQ 276 (Comm'r Pat. 1943).

With respect to petitioners' request for a refund of the information disclosure statement fee paid on September 14, 2017, the information disclosure statement filed September 14, 2017 is properly considered an information disclosure statement filed within the 37 CFR 1.97(b) time period. Accordingly, the information disclosure statement fee set forth in 37 CFR 1.17(p) is not required. The information disclosure statement fee of \$180 paid on September 14, 2017 was paid in excess and therefore, will be refunded and credited to the deposit account of record in due course.

DECISION

For the reasons stated above, the petition is granted to the extent that the Technology Center Director's decision of September 26, 2017 has been reviewed, but the petition is **DENIED** with respect to directing the Technology Center Director to hold the request for continued

⁴ In the petitions to withdraw finality of the Office action of June 14, 2017, petitioners argue that the finality of the June 14, 2017 Office action was improper because the amendments to claims 1 and 2 in the response filed on February 7, 2017, narrowed the scope of the claims in response to the claim rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 presented in the Office action of November 7, 2016. It is brought to petitioners' attention that the narrowing the scope of a claim in response to a rejection of the claim often necessitates a new ground of rejection and thus may be the basis for an Office action being properly made final.

examination filed on September 14, 2017 in abeyance, or to not treat the request for continued examination filed on September 14, 2017 as mooted the petition to withdraw the finality of the Office action of June 14, 2017. As such, neither the Technology Center Director's decision of September 26, 2017, nor entry of the request for continued examination of September 14, 2017, will be disturbed.

The petition is also **DENIED** with respect to refunding the request for continued examination fee paid on September 14, 2017.

The petition is **GRANTED** with respect to refunding the information disclosure statement fee paid on September 14, 2017.

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.

Telephone inquiries concerning this decision should be directed to Vincent Trans at (571) 272-3613.



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy