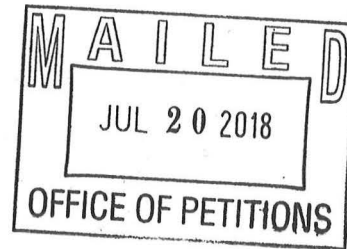




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In re Application of:	:	
T. Eric Chornenky	:	DECISION
Application No.: 14/436,991	:	
PCT No.: PCT/US2013/65628	:	ON
International Filing Date: October 18, 2013	:	
Priority Date: October 18, 2012	:	PETITION
For: APPARATUS AND METHOD FOR	:	
DETERMINING SPATIAL INFORMATION	:	
ABOUT ENVIRONMENT	:	

This is a decision on the petition under 37 CFR 1.181 filed on May 24, 2018, requesting that the Director exercise supervisory authority and overturn the decision of May 9, 2018, by the Director of Technology Center 2400 (Technology Center Director), specifically requesting that the finality of the Office action of January 24, 2018 be withdrawn.

The petition to withdraw the finality of the Office action of January 24, 2018 is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on October 18, 2013, and claims priority to a U.S. provisional application filed on October 18, 2012.

On June 3, 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 April 20, 2015.

A non-final Office action was issued on March 30, 2017. The Office action of March 30, 2017 included, *inter alia*: (1) a rejection of claims 1 through 23 and 26 under 35 U.S.C. § 102(a)¹ as

¹ 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,

being anticipated by Crain (U.S. Patent Application Publication No. 2014/0368373); and (2) a rejection of claims 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Crain and Prechtl et al. (U.S. Patent Application Publication No. 2007/0014347).

A reply to the Office action of March 30, 2017 was filed on August 30, 2017. The reply of August 30, 2017, included an amendment to claims 1 and 23 through 26 (all of the independent claims of the above-identified application).

A final Office action was issued on January 24, 2018. The final Office action of January 24, 2018 included, *inter alia*: (1) a rejection of claims 1 through 23 and 26 under 35 U.S.C. § 103 as being unpatentable over Crain and Uomori et al. (U.S. Patent No. 7,423,658); and (2) a rejection of claims 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Crain, Uomori et al. and Prechtl et al.

A petition under 37 CFR 1.181 to the Technology Center Director was filed on March 26, 2018. The petition of March 26, 2018 requested the finality of the Office action of January 24, 2018 be withdrawn as premature. The petition of March 26, 2018 was dismissed by the Technology Center Director in a decision mailed on May 9, 2018.

A petition under 37 CFR 1.181 was filed on May 24, 2018, requesting a supervisory review of the Technology Center Director's decision of May 9, 2018.

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.

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. 284, 285-293 (2011). The above-identified application claims 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 pre-AIA version of 35 U.S.C. §§ 102 and 103.

(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).

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 1.181 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 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

Petitioners argue that the Office action of January 24, 2018 is premature as Crain is not effective as prior art with respect to the claims of the above-identified application. Petitioners note that: (1) the above-identified application is an international application filed on October 18, 2013 (PCT/US2013/065628), with a priority date based upon a prior U.S. provisional application (application No. 61/715,391) of October 18, 2012; and (2) Crain resulted from application (application No. 14/310,954) that is a continuation of an international application (PCT/US2012/071100) filed on December 20, 2012, which international application has a priority date based upon a prior U.S. provisional application (application No. 61/578,042) of December 20, 2011. Petitioners contend, however, that the Crain provisional application (application No. 61/578,042) does not provide support for the subject matter relied upon in Crain. Petitioners thus argue that the subject matter relied upon in Crain is not entitled to the filing date of the Crain provisional application, citing section 706.02(f)(1) of the Manual of Patent Examining Procedure (MPEP). Petitioners therefore argue that Crain is not effective prior art with respect to the claims of the above-identified application and thus the Office action of January 24, 2018 is premature. Petitioners therefore request that the finality of the Office action of January 24, 2018 be withdrawn.

Prematureness of a final rejection is purely a question of practice that is wholly distinct from the tenability of the rejection. *See* MPEP 706.07(c). Petitioners' argument (that the Crain provisional application does not provide support for the subject matter relied upon in Crain, and thus that Crain is not effective as prior art with respect to the claims of the above-identified application), however, is directed to the tenability of the rejections in the above-identified application. 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.

The Office action of January 24, 2018 indicates that its new ground of rejection were necessitated by the applicant's amendment. The reply of August 30, 2017, included an amendment to claims 1 and 23 through 26 (all of the independent claims of the above-identified application). Petitioners do not contend that this amendment to claims 1 and 23 through 26 did not necessitate the new ground of rejection. Put simply, petitioners present an argument challenging the tenability of the rejections in the above-identified application, but present no arguments pertaining to the propriety of the finality of the Office action of January 24, 2018 *per se*. Therefore, there is no basis for withdrawing the finality of the Office action of January 24, 2018.

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). An applicant dissatisfied with an examiner's decision in the second or subsequent rejection may appeal to the Patent Trial and Appeal Board (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. 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). Petitioners' argument that the Crain provisional application does not provide support for the subject matter relied upon in Crain, and thus that Crain is not effective as prior art with respect to the claims of the above-identified application, go directly to the rejection of claims 1 through 23 and 26 under 35 U.S.C. § 103 as being unpatentable over Crain and Uomori et al., and the rejection of claims 24 and 25 under 35 U.S.C. § 103 as being unpatentable over Crain, Uomori et al. and Precht et al. Therefore, these arguments are appropriate for petitioners' substantive challenge to the rejection. *See In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011).

DECISION

For the reasons stated above, the petition is granted to the extent that the Technology Center Director's decision of May 9, 2018 has been reviewed, but the petition is **DENIED** with respect to withdrawing the finality of the Office action of January 24, 2018.

The Technology Center Director decision of May 9, 2018 reaches the merits of petitioners' arguments and explains where the Crain provisional application is regarded by the Technology Center as providing support for the subject matter relied upon in Crain. Inasmuch as this question is appropriate for resolution by way of an appeal to the Board (in the event petitioners are unable to reach agreement with the examiner on this question), and not by way of petition under 37 CFR 1.181, this decision reaches only the Technology Center Director's decision to refuse to withdraw the finality of the Office action of January 24, 2018 and expresses no view on the question of whether the Crain provisional application provides support for the subject matter relied upon in Crain.

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