UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED
AUG 10 2016
OFFICE OF PETITIONS

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DOW AGROSCIENCES LLC
9330 ZIONSVILLE RD
INDIANAPOLIS IN 46268

In re Application of	:	
Kari Greason	:	
Patent No.9,288,960	:	ON PETITION
Issued: March 22, 2016	:	
Application No. 14/548,798	:	
Filed: November 20, 2014	:	
Attorney Docket No.: 75316-US-NP	:	

This is a decision on the petition under 37 CFR 1.181, filed June 7, 2016 and supplemented July 20, 2016, requesting that the Director exercise her supervisory authority and overturn the decision of a Technology Center 1600 Group Director (Technology Center Director), dated April 14, 2016, which decision refused to expunge the declaration under 37 CFR 1.132 filed on October 15, 2015 in the above-identified application.

The petition to overturn the decision of the Technology Center Director and expunge the declaration under 37 CFR 1.132 in the above-identified application is **DENIED**.

BACKGROUND

A non-final Office action was mailed on July 15, 2015. The non-final Office action of July 15, 2015 included a requirement for information under 37 CFR 1.105. The non-final Office action of July 15, 2015 also stated that "If Applicant views any or all of the ... requested information as a Trade Secret, then Applicant should follow the guidance of [the Manual of Patent Examination Procedure] MPEP § 724.02 when submitting the requested information."

A reply to the non-final Office action of July 15, 2015 was filed on October 15, 2015. The reply of October 15, 2015 included a declaration under 37 CFR 1.132 in response to the requirement for information under 37 CFR 1.105 in the non-final Office action of July 15, 2015. The reply of October 15, 2015 was submitted under the procedures set forth in MPEP § 724.02, and included a petition requesting that the United States Patent

and Trademark Office (USPTO) expunge the declaration under 37 CFR 1.132 filed on October 15, 2015 "if the information contained in the Declaration is found not to be important to a reasonable Examiner in deciding whether to issue the application as a patent."

A notice of allowance under 35 U.S.C. § 151 and notice of allowability were mailed on November 5, 2015. The notice of allowability of November 5, 2015 included a reasons for allowance in which the examiner stated "Applicant's response to the Request for Information made under 37 CFR 1.105 provides a sufficient showing that the deposited variety is genetically distinct from the soybean plant cited in the prior art rejection. Accordingly, all of the prior art rejections made in the Office Action have been withdrawn."

The petition to expunge submitted with the declaration under 37 CFR 1.132 of October 15, 2015 was dismissed in a decision by the Technology Center Quality Assurance Specialist mailed on November 13, 2015. The decision of November 13, 2015 indicated that the notice of allowability of November 5, 2015 indicated that the information in the declaration under 37 CFR 1.132 of October 15, 2015 was considered material to patentability. A request for reconsideration of the decision of November 13, 2015 was filed on January 13, 2016, and was denied in a decision by the Technology Center Quality Assurance Specialist mailed on January 28, 2016.

The issue fee for the application was paid on February 5, 2016, and the application was issued as a patent on March 22, 2016.

A petition for reconsideration of the decision of January 28, 2016 was filed on March 24, 2016, and was denied in a decision by the Technology Center Director mailed on April 14, 2016.

The instant petition was filed on July 7, 2016 and supplemented on July 20, 2016.[1]

STATUTE AND REGULATION

35 U.S.C. § 2(b)(2) provides, in part, that the USPTO:

> "may establish regulations, not inconsistent with law, which— (A) shall govern the conduct of proceedings in the [USPTO]."

---

[1] The undersigned conducted a personal interview over this matter with petitioner's representatives on July 11, 2016.

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.

37 CFR 1.59 provides that:

> (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) or § 42.7(a) of this title.
> (2) Information forming part of the original disclosure (*i.e.,* written specification including the claims, drawings, and any preliminary amendment present on the filing date of the application) will not be expunged from the application file.
> (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

OPINION

Petitioner requests reversal of the decision of the Technology Center Director and expungement of the declaration filed under 37 CFR 1.132. Petitioner argues that: (1) the standard of materiality in MPEP § 724 is the standard of materiality as defined in 37 CFR 1.56; (2) information that is relied upon by the examiner to withdraw a rejection cannot be standard of materiality as defined in 37 CFR 1.56, as such information is limited to information that is used to make a *prima facie* case of unpatentability or refute a position in favor of patentability taken by an applicant; and (3) it is permissible for one to have a patent and trade secret on the same technology.[2]

Petitioner's arguments have been carefully considered but are not persuasive. The USPTO has a long standing practice of ensuring that the patent file wrapper is as complete as possible, particularly with regard to information that is considered

---

[2] The USPTO appreciates that one may have a patent and trade secret on the same technology. *See* MPEP § 724. However, where an applicant submits trade secret information to the USPTO in a patent application or during the prosecution of a patent application, it is the exception, and not the rule, that such information will expunged and not retained as part of the records of any patent resulting from the application.

"material." The USPTO recognizes the potential conflict between full disclosure of "material" information as required by 37 CFR 1.56 and protection of trade secret information. As such, the USPTO has set forth procedures in MPEP § 724 designed to enable the USPTO to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets. *See* MPEP § 724.01.

The expungement practice set forth in MPEP § 724 applies to the situation in which an applicant is submitting information to comply with the duty of disclosure under 37 CFR 1.56 (or a patentee in reexamination is submitting information to comply with the duty of disclosure under 37 CFR 1.555). MPEP § 724.03 specifically provides that:

> The types of materials or information contemplated for submission under MPEP § 724.02 include information "material to patentability" but does not include information favorable to patentability. Thus, any trade secret, proprietary, and/or protective order materials which are required to be submitted on behalf of a patent applicant under 37 CFR 1.56 or patent owner under 37 CFR 1.555 can be submitted in accordance with MPEP § 724.02. Neither 37 CFR 1.56 nor 1.555 require the disclosure of information favorable to patentability, e.g., evidence of commercial success of the invention (see 42 FR 5590). Such information should not be submitted in accordance with MPEP § 724.02. If any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.130, 1.131 or 1.132, they will be made of record in the file and will not be given any special status.

See MPEP § 724.03. Here, the declaration under 37 CFR 1.132 of October 15, 2015 was not submitted to comply with petitioner's duty of disclosure under 37 CFR 1.56, but was submitted in response to a requirement for information under 37 CFR 1.105. Therefore, the provisions of MPEP § 724 are inapplicable to the declaration under 37 CFR 1.132 of October 15, 2015 submitted in the above-identified application.[3]

In addition, the section of MPEP § 724.05 referencing "material information under 37 CFR 1.56" pertains to information unintentionally submitted in an application. *See*

---

[3] The discussion of MPEP § 724.02 in the requirement for information under 37 CFR 1.105 is regretted. The requirement for information under 37 CFR 1.105, however, required that petitioner provide: (1) the breeding methodology and history regarding the claimed seed variety; and (2) the serial number and names of any sibling or parent applications for the claimed plant, if any exist. The requirement for information under 37 CFR 1.105 did not require the disclosure of information favorable to patentability in a declaration under 37 CFR 1.132, and MPEP § 724.03 places applicants on notice such that petitioner should have been aware that information favorable to patentability in a declaration under 37 CFR 1.132 is not the proper subject of a petition to expunge.

MPEP § 724.05 (item II). The section of MPEP § 724.05 generally discussing information submitted under MPEP § 724.02 states "material to patentability" without a reference to 37 CFR 1.56. *See* MPEP § 724.05 (item I). While 37 CFR 1.56(b) states the USPTO's current standard for information that is material to patentability under 37 CFR 1.56, that provision sets out but one of several meanings that have been attributed to the phrase "material to patentability." *See Therasense v. Becton, Dickinson & Co.*, 649 F.3d 1276, 1291 (Fed. Cir. 2011) (rejecting the 37 CFR 1.56(b) materiality standard); *Digital Control Inc. Charles Machine Works*, 437 F.3d 1309 (Fed. Cir. 2006) (discussing the four materiality standards, one of which that there is substantial likelihood that a reasonable examiner would consider it important in deciding whether to allow the application to issue as a patent). Where an application is allowed following the submission of an affidavit or declaration under 37 CFR 1.132, the affidavit or declaration is virtually always important in the decision to allow the application to issue as a patent.[4]

The petition also presents seven (7) decisions in which the Technology Center Quality Assurance Specialist granted a similar request to expunge Trade Secret information, where the request was made on behalf of the same company making the request in this application. However, the facts of those seven applications are different than the facts of this application.[5] In those applications, the examiner did not state that the information was important to the allowance of a claim, but in this application the examiner stated that the information was important. In particular, the examiner here stated "Applicant's response to the Request for Information made under 37 CFR § 1.105 provides a sufficient showing that the deposited variety is genetically distinct from the soybean plant cited in the prior art rejection. Accordingly, all of the prior art rejections made in the Office Action have been withdrawn." Thus, the circumstances of the above-identified application are different from the circumstances of the seven applications in

---

[4] The Federal Circuit has long held, both before and after *Therasense*, that there is no room to argue that the submission of a false affidavit is not material. *Therasense*, 649 F.3d at 1292; *Rohm & Haas Co. v. Crystal Chem. Co.*, 722 F.2d 1556, 1571 (Fed. Cir. 1983).

[5] To the extent that the Technology Center Quality Assurance Specialist decisions were not consistent with the provisions of MPEP § 724.03 (provides that "[i]f any trade secret, proprietary, and/or protective order materials are submitted in amendments, arguments in favor of patentability, or affidavits under 37 CFR 1.130, 1.131 or 1.132, they will be made of record in the file and will not be given any special status"), the error was in granting the petitions to expunge in those applications and not in the decision under review. A Technology Center Quality Assurance Specialist decision is not binding on the undersigned and such decisions would not require that the USPTO forgo the practice set out in MPEP § 724.03 and follow such a decision. *See In re Nett Designs*, 236 F.3d 1339, 1342 (Fed. Cir. 2001).

which the Technology Center Quality Assurance Specialist granted a request to expunge Trade Secret information. *See Daiichi Sankyo Co. v. Lee*, 791 F.3d 1373, 1380 (Fed. Cir. 2015) (not arbitrary or capricious to treat differently situated requests differently).

Lastly, it is noted that in the petition filed October 15, 2015, Applicant requested the expungement of the declaration "if the information contained in the Declaration is not found to be important to a reasonable Examiner in deciding whether to issue the application as a patent." As noted above, the examiner found the information included in the declaration to be important in deciding whether to issue the application as a patent. Consequently, the USPTO's refusal to expunge the information in the declaration is consistent with petitioner's request in the petition filed October 15, 2015.

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of June 15, 2016. The petition is granted to the extent that the decision of the Technology Center Director of April 14, 2016 has been reviewed, but is **denied** with respect to overturning the decision of the Technology Center Director or expunging the declaration under 37 CFR 1.132 in the above-identified application

This decision is a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. *See* MPEP § 1002.02.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.

Robert W. Bahr
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer

CK/RK