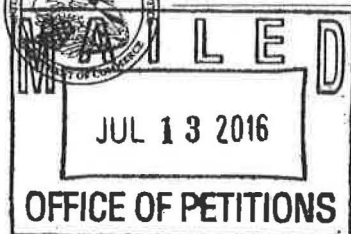




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Uri Cohen
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In re Application of
Uri Cohen
Application No. 14/619,334
Filed: February 11, 2015
Attorney Docket Number: SL-16

DECISION ON PETITION

This is a decision on the petition filed June 29, 2015, which is being treated as a petition under 37 CFR 1.181(a)(3) in the above-identified application¹ requesting that the Director of USPTO (“the Director”) exercise her supervisory authority and overturn the decision of the Director of Technology Center 2800 (“Technology Center Director”) mailed April 23, 2015, which decision refuse to reassign the above-identified application to a new examiner.

The petition to overturn the decision of the Technology Center Director of April 23, 2015 and reassign the above-identified application to a new examiner is **DENIED**.

BACKGROUND

1. The instant application was filed February 11, 2015.
2. A petition under 37 CFR 1.181 was filed February 26, 2015 requesting that the “Director assign the above-identified application (Application No. 14/619,334) from examiner Bradley K. Smith of Group Art Unit 2817 (Smith) to another examiner and/or group art unit (GAU).”
3. A non-final Office action signed by examiner Smith was mailed March 25, 2015.
4. On April 23, 2015, the Director of Technology Center 2800 issued a decision on the petition filed February 26, 2015 dismissing the petitioner’s request that the application be assigned to a different examiner.

¹ The instant petition also raises concerns regarding the examination of Application No. 14/077,058 (also assigned to examiner Smith). Any complaints concerning the treatment of Application No. 14/077,058 must be submitted for consideration in the Application No. 14/077,058. Petitioner should note that this decision is limited to consideration of matter specifically pertaining to Application No. 14/619,334.

5. A petition requesting reconsideration of the decision of April 23, 2015 was filed on April 29, 2015.
6. A reply to the Office action of March 25, 2015 was filed on June 29, 2015 (certificate of mailing dated June 25, 2015).
7. The instant petition was filed June 29, 2015 requesting a review of the decision mailed April 23, 2015.
8. A decision from the Technology Center Director was mailed on July 9, 2015 in response to the request for reconsideration filed April 29, 2015.
9. A final Office action was mailed on August 21, 2015.
10. An after-final reply was filed October 28, 2015.
11. An advisory action was mailed on November 10, 2015.
12. A request for continued examination accompanied by an affidavit under 37 CFR 1.132 was filed on November 23, 2015.
13. A non-final Office action was mailed on December 15, 2015.
14. A notice of appeal was filed January 14, 2016, followed by the filing of an appeal brief on January 21, 2016.
15. An examiner's answer was mailed July 5, 2016.

STATUTE AND REGULATION

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 § 1.181 provides that (in part):

(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.*

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

OPINION

Petitioner specifically requests the Director for “Reconsideration of Petition Decision Regarding Reassignment of Applications 14/619,334 & 14/077,058 to Another Examiner.”

As an initial matter, it is noted that the instant petition is directed to the “Office of Patent Legal Administration (OPLA).” The Director, pursuant to 37 CFR 1.181(g), may delegate the determination of petitions. As stated in MPEP § 1001.01,

The delegations set forth in this Chapter do not confer a right to have a matter decided by a specific Office official, rather, such delegations aid in the efficient treatment of petitions by the Office.

The review of a petition seeking to invoke the supervisory authority of the Director of the USPTO in reviewing a decision of a Group Director has been delegated to the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP § 1002.02(b).

Petitioner's request to have a new examiner appointed: In the decisions mailed April 23, 2015 and on July 9, 2015, the Technology Center Director dismissed the petitioner's request that the application be assigned to a different examiner, setting forth reasons therefor.

In the instant petition, petitioner has listed the issues involved in the form of an itemized list numbered from 1 – 17. Items 1 – 4 state the background for the instant petition.

Regarding the assignment of the instant application to examiner Smith prior to a decision by the Director on the petition filed February 28, 2015 (items 5 and 6), as noted in the decision by the Technology Center Director, this application was placed on Examiner Smith's docket as a matter of routine operating procedure because he had been assigned to the parent application ('058 application). In view of the statutory authority given to the Director to provide management supervision over the USPTO and the patent examination process (see 35 U.S.C. §§ 3 and 131), the Director delegates this authority for the day-to-day examination of patent applications to the primary examiners, via their Technology Center Directors and supervisory patent examiners (SPEs) to act on behalf of the Director in the examination process. An applicant is not entitled to have his or her application assigned to the group art unit or examiner of the applicant's choosing. See In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991).

Regarding items 7 – 9, the fact that the applications listed therein are before the Patent Trial and Appeal Board ("the Board") is not indicative of any improper examination process. As stated by the Technology Center Director in the decision mailed July 9, 2015, these facts merely establish that the applicant does not agree with the examiner's position. They are not evidentiary of any abuse of authority or other impropriety on the part of the examiner during the examination process. As pointed out in the previous decision by the Technology Center Director dated April 23, 2015, the history of all related applications has been reviewed and this review does not reveal any abuse of authority or other impropriety on the part of Examiner Smith.

In item 14, petitioner states, "[i]n writing the Director's Decision, Supervisor Montalvo indicated that a review of the previous Office Actions by Examiner Smith were in accordance with standard examination practice." It is noted that petitioner's characterization of the role of Supervisor Montalvo in the above-identified decision of the Technology Center Director as having written the decision is not accurate. A Technology Center Group Director may assign the drafting and/or preparation of a decision to a subordinate, provided that the decision signed by the Technology Center Group Director and issued by the USPTO is the decision of the Technology Center Group Director and is not simply the decision of the subordinate. While Supervisor Montalvo may have been consulted with on the decision, the decision has been signed by the Technology Center Director and as such the determinations therein are those of the Technology Center Director.

Additionally, in item 14, applicant has commented on alleged textual errors in the Office action(s) of examiner Smith. While it is appreciated that applicant has brought his opinion of the examiner's work to the attention of the examiner's supervisor and the Technology Center Director, to the extent that it affects the merits of the rejections set forth therein, such must be set forth within a response to the Office action and is properly the subject matter that may constitute grounds for appeal to the Board.

In items 10 – 13 and 15, to the extent that they pertain to the instant application, it is noted that the petitioner raises issues that are specific to examination of applications and thus are indicative of disagreement between the petitioner and the examiner on the merits of the examiner's action on the claims. It should be noted that reasonable people can disagree as to whether a given claim is patentable and on what basis. See Lear, Inc. v. Adkins, 162 USPQ 1 (U.S.1969). A mere difference of opinion between the examiner and the applicant as to the patentability of one or more claims does not evidence bias or a lack of understanding on the part of the examiner, much less that his replacement is justified.

In regard to items 16 and 17, issues raised by the petitioner pertaining to other applications are appropriately submitted for consideration in such other application. As requested in item 16, the decision of the Technology Center Director of April 23, 2015 is being reviewed by the undersigned in this decision.

The substantive issues raised in the petitions filed April 29, 2015 and June 29, 2015 respectively, relate to the sufficiency of the rejections made by the examiner. The mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Board under 35 U.S.C. § 134 and 37 CFR 1.191. The issues of whether the rejections set forth in an office action are proper relates to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board. See In re Dickinson and Zenitz, 299 F.2d 954, 958; 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

As noted in In re Ovshinsky, 24 USPQ2d 1241,1251-2 (Comm'r Pat.1992), the issue is not whether the perceptions of an applicant regarding alleged bias are reasonable; rather the issue is whether an applicant has demonstrated improper conduct, including bias or the appearance of bias, on the part of the examiner or Technology Center Director. A full investigation of the facts set forth in the petitions, as well as a full consideration of the entire record of this application fails to reveal bias or improper conduct on the part of either the Technology Center Director or the examiner, or, the examiner's supervisor, and as such, there is no reversible error in the Technology Center Director's decision.

For the above reasons, the Technology Center Director's decision to refuse petitioners' request to assign a new primary examiner to this application is upheld.

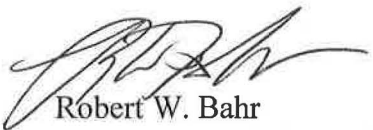
DECISION

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of April 23, 2015. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

For the reasons given above, petitioner has failed to adequately demonstrate bias or the appearance of bias towards applicant by the Technology Center Director, or the examiner or the examiner's supervisor. The petition is granted to the extent that the decision of the Technology Center Director of April 23, 2015 has been reviewed, but is **denied** with respect to reassigning the above-identified application to a new examiner.

The petition is **denied**. 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 if the USPTO issues a final agency action adverse to the petitioner in the underlying proceeding or examination to which it relates, or, if this decision does not relate to any ongoing proceeding or examination, if it otherwise constitutes final agency action under 5 U.S.C. §§704.

As noted in the examiner's answer mailed July 5, 2016, in order to avoid dismissal of the instant appeal in any application or ex parte reexamination proceeding, 37 CFR 41.45 requires payment of an appeal forwarding fee within the time permitted by 37 CFR 41.45(a). Petitioner is further reminded that the filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. See 37 CFR 1.181(f).



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