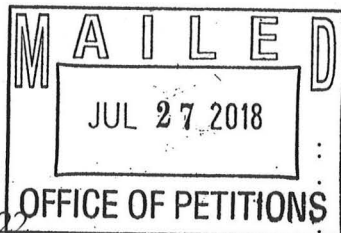




UNITED STATES PATENT AND TRADEMARK OFFICE

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

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.  
2200 CLARENDON BLVD.  
SUITE 1400  
ARLINGTON VA 22201



In re Application of  
Adlem, et al.

Application No. 14/917,312

PCT No.: PCT/EP2014/002224

International Filing Date: August 13, 2014

Priority Date: September 12, 2013

For: MESOGENIC COMPOUNDS AND  
MESOGENIC MEDIA

DECISION

ON

PETITION

This is a decision on the petition under 37 CFR 1.181 filed on March 23, 2018, requesting that the Director exercise supervisory authority and overturn the decision of March 13, 2018, by the Director of Technology Center 1700 (Technology Center Director), specifically requesting that the request for continued examination of February 15, 2018 be held in abeyance and not treated as rendering moot the petition to withdraw the finality of the Office action of September 15, 2017, and requesting a refund of the request for continued examination fee paid on February 15, 2018.

The petition to hold the request for continued examination filed on February 15, 2018 in abeyance, and to not treat this request for continued examination as rendering moot the petition to withdraw the finality of the Office action of September 15, 2017 is **DENIED**.

The petition to refund the request for continued examination fee paid on February 15, 2018 is **DENIED**.

**RELEVANT BACKGROUND**

The above-identified application was filed as a Patent Cooperation Treaty (PCT) international application on August 13, 2014, and claims priority to a European Patent Office (EPO) application filed September 12, 2013.

On April 26, 2016, 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 March 8, 2016.

Prosecution of the above-identified application resulted in a non-final Office action being issued on March 9, 2017. The Office action of March 9, 2017 consisted of a rejection of claims 1-12 under 35 U.S.C. § 112(b) as being indefinite.

A reply to the Office action of March 9, 2017 was filed on June 9, 2017. The reply of June 9, 2017 included an amendment amending claims 1-9 and 11-12 to address the rejections under 35 U.S.C. § 112(b) and adding new dependent claims 13-15.<sup>1</sup>

A final Office action was issued on September 15, 2017. The final Office action of September 15, 2017 included, *inter alia*: (1) rejections of claims 3, 4, and 15 under 35 U.S.C. § 112(b) as being indefinite; (2) a rejection of claims 1-8 and 10-15 under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103 as being obvious over, Yaroshchuk et al. (US 2011/0007255 A1); and (3) a rejection of claim 9 under 35 U.S.C. § 103 as being obvious over Yaroshchuk et al. (US 2011/0007255 A1) in view of Coles et al. (GB 2356629 A). The final Office action stated applicant's amendment of June 9, 2017, necessitated the new ground(s) of rejection made in the Office action.

A reply to the final Office action of September 15, 2017, and a Certification and Request for Consideration under the After Final Consideration Pilot Program 2.0 (AFCP 2.0) were filed on November 9, 2017. The reply to the final Office action of September 15, 2017 included an amendment to amend claims 1, 3, and 4 to address the rejections under 35 U.S.C. § 112(b) and under 35 U.S.C. § 102(b), or in the alternative, under 35 U.S.C. § 103.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on November 9, 2017. The petition of November 9, 2017 requested the finality of the Office action of September 15, 2017 be withdrawn because the Office action contained new grounds of rejection not necessitated by applicant's amendment to the claims.

An AFCP 2.0 decision was issued on January 19, 2018, in response to the AFCP 2.0 request filed November 9, 2017. The AFCP 2.0 decision of January 19, 2018 indicated that the after-final amendment submitted with the request would not be treated under AFCP 2.0, but rather would be treated 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 January 19, 2018, responding to the reply filed November 9, 2017. The advisory action stated that the reply filed November 9, 2017, failed to place the application in condition for allowance and that the proposed amendment would not be entered because it raised new issues that would require further consideration or search.

A request for continued examination, along with the request for continued examination fee of \$1,300 set forth in § 1.17(e), were submitted on February 15, 2018. The request for continued examination of February 15, 2018 indicated that the arguments in the reply filed on November 9, 2017 should be considered a submission under 37 CFR 1.114.

---

<sup>1</sup> Claim 1 is the only independent claim.

The petition filed on November 9, 2017 was dismissed by the Technology Center Director in a decision issued on March 13, 2018. The decision of March 13, 2018 stated that based on the request for continued examination filed on February 15, 2018, the petition filed November 9, 2017, to withdraw the finality of the Office action of September 15, 2017, was moot.

The instant petition under 37 CFR 1.181 was filed on March 23, 2018, requesting supervisory review of the Technology Center Director's decision of March 13, 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.

(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 February 15, 2018 does not render moot the petition under 37 CFR 1.181 filed November 9, 2017 to withdraw the finality of the Office action issued on September 15, 2017. Specifically, petitioners argue that a prerequisite for filing a request for continued examination under 37 CFR 1.114 is that the “final” status of the Office action of September 15, 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, then the request for continued examination of February 15, 2018 has no basis and must be vacated. Petitioners reason that if the request for continued examination of February 15, 2018 is without basis, then the filing of such request for continued examination cannot render moot the petition to withdraw finality filed November 9, 2017. Therefore, petitioners request that the petition to withdraw finality filed November 9, 2017 be decided on the merits. Petitioners further request a refund of the request for continued examination fee paid on February 15, 2018.

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.”<sup>2</sup>

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 November 9, 2017) and the fee set forth in § 1.17(e), was timely filed on February 15, 2018. As provided in 37 CFR 1.114(d), the finality of the Office action of September 15, 2017 was withdrawn (and the prosecution reopened) as a consequence of the filing of the request for continued examination on February 15, 2018. Thus, the request for continued examination filed on February 15, 2018, rendered moot petitioners’ previous request to withdraw the finality of the Office action of September 15, 2017. Therefore, the Technology Center Director correctly dismissed petitioners’ request to withdraw the finality of the Office action of September 15, 2017 as moot.

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 February 15, 2018, 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 \$1,300 fee for a request for continued examination paid on February 15, 2018 (or a notice of appeal and the applicable fee)

---

<sup>2</sup> 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 February 15, 2018, however, was not submitted under the QPIDS Pilot Program.

were necessary on February 15, 2018 to continue proceedings in the above-identified application. Therefore, the \$ 1,300 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 any decision by the Office with respect to the petition of November 9, 2017 to withdraw the finality of the Office action of September 15, 2017. *See Miessner v. United States*, 228 F.2d 643 (D.C. Cir. 1955); *Ex parte Grady*, 59 USPQ 276 (Comm'r Pat. 1943).

### **DECISION**

For the reasons stated above, the petition is granted to the extent that the Technology Center Director's decision of March 13, 2018 has been reviewed, but the petition is **DENIED** with respect to directing the Technology Center Director to hold the request for continued examination filed on February 15, 2018 in abeyance, or to not treat the request for continued examination filed on February 15, 2018 as rendering moot the petition to withdraw the finality of the Office action of September 15, 2017. As such, neither the Technology Center Director's decision of March 13, 2018, nor entry of the request for continued examination of February 15, 2018, will be disturbed.

The petition is also **DENIED** with respect to refunding the request for continued examination fee paid on February 15, 2018.

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.



Robert W. Bahr  
Deputy Commissioner  
For Patent Examination Policy