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16/599,425	10/11/2019	Christopher Arkwright	REED.00035	5564
101037	7590	12/21/2023	EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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In re Application of :
Arkwright et al. :
Application No. 16/599,425 : **DECISION ON PETITION**
Filed: October 11, 2019 :
For: PORTABLE PUMP :

This is a decision on the petition filed September 25, 2023, which is being treated as a petition under 37 CFR 1.181 requesting that the Director exercise supervisory authority to

(1) overturn the decision of September 1, 2023, by the Director of Technology Center 3700 (Technology Center Director), which Technology Center Director decision refused to reverse the transfer of the application; or, in the alternative

(2) withdraw the finality of the Office action issued June 29, 2023.

The petition to overturn the Technology Center Director's decision of September 1, 2023, and direct the Technology Center Director to reverse the transfer of the above-identified application, or withdraw the finality of the Office action issued June 29, 2023, is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on October 11, 2019.

A non-final Office action was issued on February 25, 2022. The Office action of February 25, 2022, included, *inter alia*: (1) a rejection of claims 1 through 3 and 5 under 35 U.S.C. § 103 as being unpatentable over Kobayashi et al. (U.S. Pat. No. 4,502,515; hereinafter "Kobayashi") in view of Ladd (U.S. Pat. Publ'n No. 2016/0094105; hereinafter "Ladd") and Nelson et al. (U.S. Pat. Publ'n No. 2005/0135945; hereinafter "Nelson"); (2) a rejection of claim 4 under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Ladd and Nelson and further in view of Baranowski et al. (U.S. Pat. Publ'n No. 2009/0058209; hereinafter "Baranowski"); (3) a rejection of claims 6 and 7 under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Ladd and Nelson and further in view of Zoe (U.S. Pat. Publ'n No. 2020/0386354; hereinafter "Zoe"); (4) a rejection of claim 8 under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Ladd and Nelson and further in view of Takano (U.S. Pat. Publ'n No. 2014/0147252; hereinafter "Takano"); and (5) a rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over Kobayashi in view of Ladd and Nelson and further in view of Pleiman et al. (U.S. Pat. Publ'n No. 2006/0000789; hereinafter "Pleiman").

A response to the Office action of February 25, 2022, accompanied by a petition for a two-month extension of time under 37 CFR 1.136(a), was filed on July 25, 2022. The response of July 25, 2022, included *inter alia*, new claim 10.

A non-final Office action was issued on January 30, 2023. The Office action of January 30, 2023, included *inter alia*: (1) an objection to claims 4 and 5; (2) a rejection of claim 10 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or joint inventor regards as the invention; (3) a rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Hackett (U.S. Pat. No. 5,378,121; hereinafter “Hackett”) in view of Shure (U.S. Pat. No. 4,218,195; hereinafter “Shure”) and Yoshikawa (U.S. Pat. No. 3,398,687; hereinafter “Yoshikawa”); (4) a rejection of claims 2 through 5 under 35 U.S.C. § 103 as being unpatentable over Hackett in view of Shure and Yoshikawa and further in view of Nelson; (5) a rejection of claims 6 and 7 under 35 U.S.C. § 103 as being unpatentable over Hackett in view of Shure and Yoshikawa and further in view of Zoe; (6) a rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Hackett in view of Shure and Yoshikawa and further in view of Takano; (7) a rejection of claim 9 under 35 U.S.C. § 103 as being unpatentable over Hackett in view of Shure and Yoshikawa and further in view of Hager et al. (U.S. Pat. No. 4,101,950; hereinafter “Hager”); and (8) a rejection of claim 10 under 35 U.S.C. § 103 as being unpatentable over Hackett in view of Shure and Yoshikawa and further in view of Oberg (26th Edition Machinery Handbook; hereinafter “Oberg”).

An applicant-initiated interview summary was issued on April 21, 2023. The interview summary of April 21, 2023, indicated, *inter alia*, that no agreement was made as to the patentability of the application.

A response to the Office action of January 30, 2023, was filed on May 1, 2023, and supplemented on June 20, 2023. The response of May 1, 2023, included *inter alia*, an amendment to claims 4, 5, and 10, and new claims 11 through 20. The supplemental response on June 20, 2023, included, *inter alia*, an amendment to claims 11, 17, and 18.

The application was transferred to another examiner in the art unit on June 22, 2023.

A final Office action was issued on June 29, 2023. The Office action of June 29, 2023, included *inter alia*: (1) an objection to claims 1 through 10; (2) an objection to the drawings; (3) a rejection of claims 16 through 20 under 35 U.S.C. § 112(a), as failing to comply with the written description requirement; (4) a rejection of claim 16 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or joint inventor regards as the invention; (5) a rejection of claims 11 through 15 and 17 through 20 under 35 U.S.C. § 102(a)(1) as being anticipated by Shure; (6) a rejection of claims 11, 15, and 16 under 35 U.S.C. § 102(a)(1) as being anticipated by Wang (U.S. Pat. Publ’n No. 2019/0154039; hereinafter “Wang”); and (7) a rejection of claim 18 under 35 U.S.C. § 102(a)(1) as being anticipated by Eastman, III et al. (U.S. Pat. No. 6,179,558; hereinafter “Eastman”).

An applicant-initiated interview summary was issued on July 3, 2023. The interview summary of July 3, 2023 indicated, *inter alia*, that no agreement was reached.

A petition under 37 CFR 1.181 to the Technology Center Director was filed on July 27, 2023, requesting reversal of the transfer of the application, or withdrawal of the finality of the June 29, 2023, Office action.

An applicant summary of interview with examiner was also filed on July 27, 2023.

The petition of July 27, 2023, was dismissed by the Technology Center Director in a decision issued on September 1, 2023.

The instant petition under 37 CFR 1.181 was filed on September 25, 2023, requesting supervisory review and reversal of the Technology Center Director's decision of September 1, 2023, refusing to reverse the transfer of the application; or in the alternative, withdraw the finality of the Office action issued on June 29, 2023.

A reply to the final Office action of June 29, 2023, accompanied by a petition for a two-month extension of time under 37 CFR 1.136(a), was filed on November 11, 2023. The reply of November 11, 2023, included, *inter alia*, a proposed amendment to claims 1, 17, and 18, and cancellation of claim 16.

STATUTES AND REGULATIONS

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 therefore.

35 U.S.C § 132(a) provides that:

(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.

37 CFR 1.113 provides that:

- (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's ... reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116.
- (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.
- (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.181 provides, in part, 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.

- (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.

OPINION

Petitioner requests that the transfer of the application from a first examiner (“Examiner A”) to a second examiner (“Examiner B”) be reversed because it is contrary to Office policies. Additionally, petitioner requests withdrawal of the finality of the Office action issued by Examiner B on June 29, 2023, because full faith and credit was not given to Examiner A’s actions.

I. Transfer of application was not improper

Petitioner argues that the transfer of the application after an action on the merits, from Examiner A to Examiner B, is contrary to Office policies disclosed in MPEP §§ 708.03 and 713.01(VI), which limits such transfers to only when an examiner resigns, retires, or is transferred to another Technology Center.¹ Petitioner's argument is not persuasive. MPEP § 708.03 does not provide guidance on the transfer of applications.

The Manual of Patent Examining Procedure (MPEP) § 708.03 provides that:

Whenever an examiner tenders his or her resignation, the supervisory patent examiner should see that the remaining time as far as possible is used in winding up prosecution in those applications with complex issues or involved records that the examiner is already familiar with (e.g., applications with RCEs and continuation applications) and getting as many of his or her amended cases as possible ready for final disposition.

In the instant case, MPEP § 708.03 is not applicable as neither Examiner A nor Examiner B has tendered their resignation. Furthermore, MPEP § 708.03 is not proscriptive and does not prohibit the transfer of an application after an action on the merits. Likewise, MPEP § 713.01(VI) does not preclude the transfer of an application after an action on the merits.

MPEP § 713.01(VI) provides that:

Sometimes the examiner who conducted the interview is transferred to another Technology Center or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See MPEP § 812.01 for a statement of telephone practice in restriction and election of species situations.

MPEP § 713.01(VI) provides guidance to the subsequent examiner of an inherited application on considering an agreement reached in an interview conducted by the previous examiner, where the previous examiner has been transferred to another Technology Center or resigns. Section 713.01(VI) does not limit or otherwise prohibit the transfer of an application after an action on the merits. An applicant is not entitled to choose his or her examiner, SPE, or other deciding official. *See In re Arnott*, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991). A Technology Center Director and SPE have considerable latitude as part of their day-to-day management of a Technology Center or Group Art Unit in deciding the assignment of applications to examiners and the transfer of applications between examiners. Therefore, the transfer of the application

¹ Petition filed on September 25, 2023, pp. 3-4

from Examiner A to Examiner B after an action on the merits is not contrary to Office policies, including those provided in MPEP §§ 708.03 and 713.01(VI).

Furthermore, a petitioner seeking to invoke the Director's supervisory authority to overrule the Technology Center Director and direct the Technology Center Director to assign an application to an examiner must demonstrate improper conduct amounting to bias or the appearance of bias on the part of the current examiner. *See In re Ovshinsky*, 24 USPQ2d 1241, 1251-1252 (Comm'r Pats. 1992). The transfer of the application from Examiner A to Examiner B is not improper conduct amounting to bias or the appearance of bias on the part of the supervisor. Further, the petitioner does not allege and the record of the application file does not demonstrate improper conduct amounting to bias or the appearance of bias on the part of Examiner B or supervisor so as to warrant directing the Technology Center Director to transfer the above-identified application back to Examiner A.

II. Final Office action was not improper

Petitioner argues that the mailing of the final Office action is contrary to Office policy as disclosed in MPEP § 713.01(VI) because full faith and credit was not given to Examiner A's actions after the transfer of the application to Examiner B.² Specifically, petitioner contends that procedural prejudice was caused by the mailing of the final Office action and closing of prosecution while petitioner was still in the midst of discussions on a possible examiner's amendment with Examiner A, contrary to the full faith and credit policy of the Office.³ Petitioner's argument is not persuasive. MPEP § 713.01(VI) provides, "If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached." A review of the record indicates that no agreement was reached between Examiner A and petitioner. Subsequent to the examiner interview summary record mailed on April 21, 2023, in which "No agreement was made as to the patentability of the application," petitioner asserts that telephone interviews were conducted on May 11, 2023; May 22, 2023; June 15, 2023; and June 22, 2023.⁴ Petitioner argues that during these interviews, Examiner A agreed to discuss possible amendments to place the application in condition for allowance and specifically, "In the last substantive communication between them on June 15, 2023, Examiner A left a voicemail message indicating that he believed he had found amendments that were minor departure but would put the claims in condition for allowance and that he was prepared to enter an Examiner's Amendment upon agreement on the exact language of the amendments."⁵ As petitioner admits, any ongoing interviews with Examiner A had not resulted in an agreement on claim amendments or patentability of the application, just the

² *Id.* at 5-6

³ *Id.* at 6

⁴ Petition filed July 27, 2023, p. 3

⁵ *Id.*

possibility of an examiner's amendment. The possibility of an examiner's amendment does not constitute "an agreement reached at the interview" in accordance with MPEP § 713.01(VI). Therefore, Examiner B could not take a position consistent with any agreements previously reached because no agreement was reached between petitioner and Examiner A. The final Office action issued on June 29, 2023, was not contrary to Office policy or MPEP § 713.01(VI). Moreover, a review of the record indicates that the final rejection of claims 11 through 20 in the June 29, 2023, Office action was necessitated by the amendment filed May 1, 2023, and supplemented on June 20, 2023. The June 29, 2023, Office action was properly made final in accordance with 37 CFR 1.113 and MPEP § 706.07(a), thus, prosecution will not be reopened and the finality of the June 29, 2023, Office action will not be withdrawn or otherwise disturbed.

DECISION

For the reasons stated previously, the petition to overturn the Technology Center Director's decision of September 1, 2023, and direct the Technology Center Director to reverse the transfer of the above-identified application or withdraw the finality of the June 29, 2023, Office action, is **DENIED**.

This constitutes a final decision on this petition. No further request 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.

/Brian E. Hanlon/

Brian Hanlon
Deputy Commissioner for
Patents (Acting)