

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Petitionable Matters and New Grounds of Rejection

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# Agenda

- Petitionable v. appealable subject matter
- New grounds of rejection in examiner's answer
- Examples:
  - New matter/written description
  - Restriction
  - Refusal to enter amendments
- New grounds of rejection in the Board decision
- Assistance

# Petitionable Matters

# “Line of Demarcation”

- In general:
  - “Decisions of the examiner **directly relating** to the rejection of claims are subject to appeal.” *In re Searles*, 422 F.2d 431, 435 (CCPA 1970)
  - “Petition may be taken to the Director: (1) From any action or requirement of any examiner in the **ex parte** prosecution of an application . . . which is not subject to appeal . . .” 37 C.F.R. §1.181(a)
- “The line of demarcation between appealable matters . . . and petitionable matters . . . should be carefully observed.” MPEP §1201
- The “dividing line between the two is often a blurry one.” *Searles*, 422 F.2d at 435

# Common Petitionable Matters

- Restriction requirement – MPEP §1002.02(c)(2)
- Requirement to cancel new matter –(c)(3)(b)
- Refusal to enter an amendment at various points in prosecution –(c)(3)(d)–(f)
- Issues related to objections or requirements made by the examiners –(c)(4)
- Primary examiner's failure to designate a rejection in an answer as a new ground –(c)(6)
- Formal sufficiency and propriety of affidavits under 37 C.F.R. §1.131(a) –(c)(3)(c)

# **New Grounds of Rejection in the Examiner's Answer**

# Board's Role

- Our statutory role as administrative patent judges is to review the grounds of rejection made by the examiner to **determine if the examiner has erred**. 35 U.S.C. §§ 6(b) and 134
- Our statutory role is **not to determine patentability**, but to review rejections made by examiners. 35 U.S.C. § 6(b)(1)

# Examiner's Answer

37 C.F.R. § 41.39(a)(2). An examiner's answer **may include** a new ground of rejection

**(b)** If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must **within two months** from the date of the examiner's answer exercise one of the following **two options** to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection:

# Appellant's Response

(1) **Reopen prosecution**. . . . Request that prosecution be reopened . . . by filing a reply . . . with or without amendment or submission of affidavits . . . or other evidence.

(2) **Maintain appeal**. Request that the appeal be maintained by filing a reply brief . . . . If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened . . .

# Tolling of Time Period for Reply Brief

37 C.F.R. § 41.40(a). Any request to seek review of the primary **examiner's failure to designate a rejection as a new ground** of rejection in an examiner's answer **must be by way of a petition** to the Director under § 1.181 . . . filed within two months from the entry of the examiner's answer and before the filing of any reply brief

# Tolling of Time Period for Reply Brief

- When 37 C.F.R § 41.40(a) was promulgated (in 2011), it was accompanied by a notice explaining the scope of Rule 41.40(a):
  - **the exclusive procedure** for an appellant to request review of the primary examiner's failure to designate a rejection as a new ground of rejection is **via a petition** to the Director under Rule 1.181

# **Example 1: New Matter/Written Description**

# New Matter/Written Description

- Often a **new matter objection and rejection** for lack of written description appear together
- Both generally **turn on the same findings** –whether claim has support in the original disclosure
- Panels may address both on appeal
- “If both the claims and specification contain new matter either directly or indirectly, and there has been **both a rejection and objection** by the examiner, the issue becomes **appealable** and should **not be decided by petition.**” MPEP §2163.06(II)

# Example 2: Restriction

# Restriction

- Background: *In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971)
  - Examiner required restriction between claims  
Applicant believed should have been together
  - Applicant petitioned to Director for review
  - Director denied petition
  - Board determined it lacked jurisdiction to address restriction

# Restriction

- Restriction requirement is **not a “rejection”**
- “[T]he kind of adverse decisions of examiners which are reviewable by the board must be those which relate, at least indirectly, to matters involving the rejection of claims.” *Id. at 1404*
- “[M]atters of a discretionary, procedural or nonsubstantive nature” are **not appealable** *Id. at 1403*

# **Example 3: Refusal to Enter Amendment**

# Refusal to Enter Amendments

- Background: *In re Mindick*, 371 F.2d 892, 894 (CCPA 1967)
  - Appellants offered to amend claim
  - Examiner refused to enter amendment
  - On appeal, Appellants argued that Examiner's refusal to enter amendment was error

# Refusal to Enter Amendments

- Court indicated that matter was **petitionable**
- “[T]he Board of Appeals, does not consider the issue of whether the examiner’s refusal to enter the proposed amendment after final rejection constituted an abuse of discretion on his part.” *Id. at 894 quoted in In re Berger*, 279 F.3d 975, 984 (Fed. Cir. 2002)
- “From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Commissioner under §1.181.” 37 C.F.R. §1.127

# **New Grounds of Rejection By the Board**

# Board May Enter New Grounds of Rejection

- 37 CFR 41.50(b). The Board **may**, in its decision, make a new rejection of one or more of any of the claims pending in the case
- While the Board is authorized to enter new grounds of rejection, this authorization is not intended as an instruction to the Board to examine every claim in every appealed application.
- Since this exercise of authority under Rule 41.50(b) is **discretionary**, no inference should be drawn from a failure to exercise that discretion. See MPEP §1213.02

# Has the Board Made a New Grounds of Rejection?

- “In accordance with the **Administrative Procedure Act**, the agency must assure that an applicant's [appeal] is **fully and fairly treated** at the administrative level, without interim need for judicial intervention.” *In re Kumar*, 418 F.3d 1361,1367 (Fed. Cir. 2005)
- “The ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had **fair opportunity to react to the thrust of the rejection.**” *In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976))

# Appellant's Options

- 37 C.F.R. 41.50. A new ground of rejection is **not a final decision** for judicial review. Within **two months** from the date of the decision, Appellant must either:
  - (b)(1) **Reopen prosecution** – either file an amendment of the claims or submit new evidence
  - (b)(2) **Request rehearing** under § 41.52

# Assistance

# How Can I Get Help?

- Office of Petitions
- Patents Ombudsman's Office

# Office of Petitions: Submission of Petition

- ePetition
- EFS-Web
- Mail
- Central Fax
- Deliver to Customer Service Window at Randolph Bldg.
- **ONLY FOR PETITIONS TO WITHDRAW FROM ISSUE** (in addition to above
  - Fax: (571) 273-0025

# Office of Petitions: Contacts

- Phone Duty Line: (571) 272-3282
  - General inquiries, status requests or routine matters (e.g., maintenance fees, provisional applications, revivals, small entity)
- Office of Petitions website:
  - <https://www.uspto.gov/patents-application-process/petitions>

# Patents Ombudsman

- Webpage: <https://www.uspto.gov/patent/ombudsman-program>
- Call
  - 855-559-8589 (toll free)
  - 571-272-5555
- Email: [OmbudsmanProgram@uspto.gov](mailto:OmbudsmanProgram@uspto.gov)

# Questions

# Upcoming Boardside Chats

Date	Time	Topic
Tuesday, June 7, 2018	Noon to 1 pm Eastern Time	Motions to Exclude and Strike in AIA Trials
Tuesday, October 4, 2018		Motions to Seal, Protective Orders, and Confidential Information in AIA Trials
Tuesday, December 6, 2018		Hearsay and Authentication

# PTAB Judicial Conference

- Thursday, June 28
- Alexandria Headquarters
- Companion events in each Regional Office in July
  - Dates forthcoming

**Thank You**

