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OFFICE OF PETITIONS

In re Application of :
Pinchas SHALEV et al. :
Application No. 11/044,881 :
Filed: January 26, 2005 :
Attorney Docket No.: 127/04374 :

ON PETITION

This is a decision on the petition, filed July 14, 2009, under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated May 15, 2009, which refused to compel the entry of the reply brief filed May 30, 2008 and the amendment under 37 CFR 41.37 filed August 25, 2008.

The petition to overturn the decision of the Technology Center Director dated May 15, 2009 is **DENIED**¹.

BACKGROUND

On January 7, 2008 an Appeal Brief was filed.

On March 31, 2008 an Examiner's Answer was mailed.

On May 30, 2008 an amendment and a Reply Brief were filed.

On August 12, 2008 a Notice of Non-Entry of the amendment and the Reply Brief was mailed.

On August 25, 2008 an amendment and a Reply Brief was filed.

On December 2, 2008 a Notice of Non-Entry of the amendment and the Reply Brief was mailed.

On February 2, 2009 a petition requesting entry of the Reply Brief and amendment of May 30, 2008 was filed.

On February 12, 2009 a decision dismissing the petition was mailed.

On April 6, 2009 and April 13, 2009 petitions requesting entry of the amendment of August 25, 2008 and the Reply Brief of May 30, 2008 were filed.

On May 15, 2009 a decision denying the petitions of April 6, 2009 and April 13, 2009 was mailed.

The instant petition was filed July 14, 2009.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 41.31 states:

(c) An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

37 CFR 41.33 states:

(a) Amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to § 41.37 may be admitted as provided in § 1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to § 41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.41 states:

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

MPEP 1206 states:

Amendments filed on or after the date of filing a brief pursuant to 37 CFR 41.37 may be admitted only to:

- (A) cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding; or
- (B) rewrite dependent claims into independent form.

Rewriting dependent claims into independent form as permitted under 37 CFR 41.33(a)(2) includes the following situations:

- (A) rewriting a dependent claim in independent form by adding thereto the limitations of the parent claim(s); and
- (B) rewriting an independent claim to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim.

MPEP 1208 I states:

Any reply brief must also be in compliance with requirements set forth in 37 CFR 41.41. New or non-admitted affidavits, and/or other evidence are not permitted in a reply brief. Any new amendment must be submitted in papers separate from the reply brief, and the entry of such papers is subject to the provisions of 37 CFR 41.33. A paper that contains an amendment is not a reply brief within the meaning of 37 CFR 41.41. Such a paper will not be entitled to entry simply because it is characterized as a reply brief.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of May 15, 2009 because petitioner alleges that the decision improperly: (1) applied the rules and the MPEP regarding an amendment filed after an Appeal Brief; and (2) refused entry of the Reply Brief because it was a confusing. Accordingly, petitioner specifically requests that the Director overturn the Technology Center Director's decision of May 15, 2009 and: (1) enter the amendment after Appeal Brief filed August 25, 2008; (2) enter the Reply Brief filed May 30, 2008; or (3) provide petitioner an opportunity to file a new amendment and Reply Brief.

Petitioner first argues that the amendment filed August 25, 2008 should be entered as MPEP 1206: (1) allows amending an independent claim by adding limitations from a dependent claim; and (2) does not require canceling the claims that previously depend on the amended independent claim. Accordingly, petitioner further contends that the amendment filed August 25, 2008 should be entered.

After the filing of an Appeal Brief an amendment may be admitted only to: (1) cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or (2) rewrite dependent claims into independent form. See 37 CFR 41.33(b), *supra*. MPEP 1206, *supra*. Additionally, MPEP 1206 states that an independent claim may be rewritten to incorporate therein all the subject matter of a dependent claim, canceling the dependent claim and in conjunction therewith changing the dependency of claims which had depended from the dependent claim being canceled to the amended independent claim that incorporates therein all the subject matter of the now canceled dependent claim. Therefore, the rule and the MPEP provided a narrower definition of amendment practice after the filing of an Appeal Brief than that construed by petitioner. While an independent claim may be amended by adding the limitations of a dependent claim to write a dependent claim in independent form there is nothing in the rule nor the MPEP which permits rewriting a claim into independent form and having claims depend therefrom which depending claims had

never previously depended from the subject matter of the now rewritten claim. Additionally, the rules prohibit the cancellation of a claim where such cancellation affects the scope of any other pending claim in the proceeding. As the Technology Center Director correctly noted, the cancellation of claims 20 and 22 would affect the scope of other pending claims as the subject matter of these canceled claims is now incorporated in claims which never previously depended therefrom. Moreover, the non-entered claims submitted on August 25, 2008 were not claims which had been previously rejected. An appeal, when taken, must be taken from the rejection of all claims under rejection which applicant proposes to contest. See 37 CFR 41.31(c), *supra*.

Petitioner further argues that the reply brief of May 30, 2008 should be entered as it provides arguments for both the amended and unamended claims. The current situation is governed by 37 CFR 41.44(b), *supra*. As explained in MPEP 1208 I, a paper that contains an amendment is not a reply brief within the meaning of 37 CFR 41.41. Such a paper will not be entitled to entry simply because it is characterized as a reply brief. Furthermore, as the reply brief includes a non-admitted amendment it is not entered.

With respect to petitioner's request for an opportunity to file another amendment or reply brief, 37 CFR 41.44, only permits the filing of a reply brief within two months from the date of the examiner's answer and does not permit any extensions of this time period.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioners' request to compel the entry of the amendment after Appeal Brief filed August 25, 2008 and the reply brief filed May 30, 2008 is not shown to be in clear error.

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 May 15, 2009. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of May 15, 2009 has been reviewed, but is denied with respect to making any change therein. As such, the decision of May 15, 2009 will not be disturbed. The refusal to enter the amendment of August 25, 2008 and the reply brief of May 30, 2008, will not be disturbed. The petition is **denied**.

Telephone inquiries concerning this decision should be directed to David A. Bucci at (571) 272-7099.

A handwritten signature in black ink, appearing to read "Andrew Hirshfeld". The signature is fluid and cursive, with the first name being more prominent.

Andrew Hirshfeld
Acting Deputy Commissioner for
Patent Examination Policy

Cp

¹ This decision may be viewed as a final agency action within the meaning of 5 U.S.C. § 704 for purposes of seeking judicial review. See MPEP 1002.02