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JUL 19 2010

OFFICE OF PETITIONS

In re Patent No. 7,259,100 :
Issue Date: August 21, 2007 :
Application No. 11/271,041 : ON PETITION
Filed: November 10, 2005 :
Attorney Docket No. NANO-02402 :

This is a decision on the petition under 37 CFR 1.181(a)(3), filed January 4, 2010, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2800 (Technology Center Director), dated October 1, 2009, which refused to expunge information submitted February 27, 2006. In the alternative the petition requests expungement of the petition to the Technology Center Director, his decision, the instant petition and the resulting decision.

The petition under 37 CFR 1.181(a)(3), to overturn the decision of the Technology Center Director dated October 31, 2008, is **DENIED**¹.

The petition to expunge the petition to the Technology Center Director, his response, the instant petition and this decision under 37 CFR 1.59(b) is **DISMISSED**.

As to the petition under 37 CFR 1.181(a)(3):

BACKGROUND

An Information Disclosure Statement (IDS) was filed March 2, 2006.

A Notice of Allowance and Issue Fee Due was mailed April 16, 2007 and the Issue Fee Payment was filed July 16, 2007.

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

The patent issued on August 21, 2007.

A petition to expunge information under 37 CFR 1.59(b) was filed November 21, 2008 and was dismissed in a decision by the Technology Center Director 2800 on October 1, 2009.

The instant petition was filed January 4, 2010.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.59 reads in part:

§ 1.59 Expungement of information or copy of papers in application file.

- (a)(1) Information in an application will not be expunged, except as provided in paragraph (b) of this section or § 41.7(a) of this title.
- (2) Information forming part of the original disclosure (i.e., written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.
- (b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

37 CFR 1.183 reads:

§ 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.14(a)(1)(i) reads:

§ 1.14 Patent applications preserved in confidence.

- (a) Confidentiality of patent application information. Patent applications that have not been published under 35 U.S.C. 122(b) are generally preserved in confidence pursuant to 35 U.S.C. 122(a). Information concerning the filing,

pendency, or subject matter of an application for patent, including status information, and access to the application, will only be given to the public as set forth in § 1.11 or in this section.

- (1) Records associated with patent applications (see paragraph (g) for international applications) may be available in the following situations:
 - (i) Patented applications and statutory invention registrations. The file of an application that has issued as a patent or published as a statutory invention registration is available to the public as set forth in §1.11(a). A copy of the patent application-as-filed, the file contents of the application, or a specific document in the file of such an application may be provided upon request and payment of the appropriate fee set forth in § 1.19(b).

MPEP 724.05(I) states in part:

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found not to be material to patentability. If the information is found to be material to patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

- (A) a clear identification of the information to be expunged without disclosure of the details thereof;
- (B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;
- (C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;
- (E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) for reexamination proceedings. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is

pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If a petition to expunge is not filed prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process), the mailing of a NIRC for reexamination proceedings, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14.

MPEP 724.05(II) states:

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

- (A) the Office can effect such return prior to the issuance of any patent on the application in issue;
- (B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;
- (C) the information has not otherwise been made public;
- (D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;
- (E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and
- (F) the petition fee as set forth in 37 CFR 1.17(g) is included.

A request to expunge information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

OPINION

The petition to expunge information under 37 CFR 1.59(b) was filed November 21, 2008 which was over a year after the patent issued in August of 2007. The Technology Center Director dismissed the petition as being untimely since it was filed after the patent had issued and was thus not in compliance with MPEP 724.05(I).

Petitioner requests that the decision of the Technology Center Director be overturned. Petitioner's arguments are based on meeting the requirements of 37 CFR 1.183, however, the requirements of 37 CFR 1.183 are not relevant as no petition has been filed under that rule and there is no rule to waive. As noted in the Technology Center Director's decision, the petition to expunge information was not timely filed. MPEP 724.05(I) clearly sets forth the requirement for

timely filing of a petition to expunge information. This requirement is based on 37 CFR 1.14(a)(1)(i) which establishes that once the patent issues, the application file is available to the public and this would include any references cited by applicant. Once the patent has issued, and the file is thus available to the public, applicant cannot then attempt to expunge information from the file.

Even if one were to apply the requirements of 37 CFR 1.183, there is no extraordinary situation, the file contents, including the information petitioner wishes to expunge, has been available to the public for over a year. The Technology Center director was properly following Office procedure in rendering his decision.

Because the requirements of MPEP 724.05(I)(B) and MPEP 725.05(II)(A) cannot be met, the petition is untimely.

For the reasons set forth above, the Technology Center Director's decision to refuse petitioner's request to expunge information from the application file is not shown to be in error.

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 October 1, 2009. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of October 1, 2009 has been reviewed, but is denied with respect to making any change therein. As such, the decision of October 1, 2009 will not be disturbed. The petition is **denied**.

As to the petition under 37 CFR 1.59(b):

Petitioner requests in the alternative, that this decision, the petition under 37 CFR 1.181, the original petition under 37 CFR 1.59(b) and the Technology Center Director's decision be expunged. This request, which is a petition to expunge information under 37 CFR 1.59(b), is dismissed for the same reason the first petition to expunge information filed November 21, 2008 was not granted, it is untimely.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

A handwritten signature in black ink, appearing to read 'R. Bahr', written in a cursive style.

Robert Bahr
Acting Associate Commissioner for
Patent Examination Policy

ak/cf