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MAILED

DEC 19 2011

OFFICE OF PETITIONS

In re Application of :
Anthony R. Eisenhut :
Application No. 11/294,331 :
Filed: December 6, 2005 :
Attorney Docket No. NSR-001 :

ON PETITION

This is a decision on the RENEWED PETITION UNDER RULE 1.181, filed August 23, 2011, requesting that the Director exercise his supervisory authority to review and overturn the decision of the Director, Technology Center 3700 (TC Director), dated July 27, 2011, which denied the petition filed July 13, 2011.

The petition under 37 CFR 1.181, to overturn the decision of the TC Director dated July 27, 2011 is **DENIED**¹.

BACKGROUND

A final Office action was mailed May 16, 2007.

An appeal brief was filed October 16, 2007 and an examiner's answer was mailed February 6, 2008.

A Board of Patent Appeals and Interferences (BPAI) decision was mailed February 8, 2011.

A non-final Office action was mailed June 9, 2011.

A petition to the TC Director under 37 CFR 1.181 was filed on July 13, 2011 and was denied in a decision mailed July 27, 2011.

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 instant renewed petition was filed August 23, 2011.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

35 U.S.C. 131 Examination of application.

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 therefor.

35 U.S.C. 132 Notice of rejection; reexamination.

(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) of this title.

37 CFR § 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 706 states in relevant part:

The goal of examination is to **clearly articulate any rejection** early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. (Emphasis added)

MPEP 1213.02 states in relevant part:

Under 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, including claims which have been

allowed by the examiner.

While the Board is authorized to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. **Since the exercise of authority under 37 CFR 41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion.** (Emphasis added)

MPEP 1214.04 states in relevant part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except upon a showing of good cause, the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

37 CFR 1.104(c)(2) states:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. **The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.** (Emphasis added)

OPINION

Petitioner requests that the examiner's non-final Office action mailed June 9, 2011 be withdrawn as it repeats a rejection of the claims that was presented in the examiner's answer of February 6, 2008 and was reversed by the BPAI in their decision of February 8, 2011.

The USPTO's reviewing courts have specifically held that even a court decision reversing a rejection does not preclude further examination of the application by the USPTO subsequent to examination provided for in 35 U.S.C. §§ 131 and 132 and the BPAI and court review provided for in 35 U.S.C. §§ 134 and 141. See Jeffrey Mfg. Co. v Kingsland, 179 F.2d 35, 83 USPQ 494 (D.C. Cir. 1949), see also In re Gould, 673 F.2d 1385, 1386, 213 USPQ 628, 629 (CCPA 1982) (USPTO can always reopen prosecution in an application under an ex parte court appeal once it regains jurisdiction over the application); In re Arkley, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972) (the USPTO is free to make such other rejections as it consider appropriate subsequent to a court decision reversing a rejection); In re Fisher, 448 F.2d 1406, 1407, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); In re Ruschig, 379 F.2d 990, 993, 154 USPQ 118, 121 (CCPA 1967) (subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); In re Citron, 326 F.2d 418, 418-19, 140 USPQ 220, 221 (CCPA 1964) (following a decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references). Accordingly, it is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the authority, much less the duty, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir. 1896).

In the above-identified application, the reopening of prosecution is for the consideration of matters not already adjudicated. The BPAI does not allow claims: it simply decides on the record before it whether to affirm or reverse the examiner's rejection. See Ex Parte Alpha Industries, Inc., 22 USPQ2d 1851, 1857 (BPAI 1992). While a decision by the BPAI to reverse the examiner's rejection generally results in the allowance of the application, such a decision does not require the examiner to allow the application. See id. In addition, while the BPAI has the authority to issue a new rejection in its decision, the fact that the BPAI does not enter a new ground of rejection in its decision is not an indication that the BPAI considers a claim to be allowable. See id.

A review of the record of the above-identified application indicates that the examiner did **not** reopen prosecution to challenge or disagree with the BPAI decision of February 8, 2011, but rather the examiner reopened prosecution to address matters not adjudicated in the BPAI decision of February 8, 2011. The rejection before the BPAI was a rejection of claims 1-14 under 35 USC 102(b) as being anticipated by Dragan (4,682,950). Claims 1 and 8 were the independent claims. Claim 1 (and dependent claims 2-7 and 9-14) was rejected on one interpretation of Dragan and claim 8 was rejected on a different interpretation of Dragan. The BPAI reversed the rejection of claims 1-7 and 9-14 and affirmed the rejection of claim 8. In the subsequent non-final Office action mailed June 9, 2011 the examiner rejected claims 1-7 and 9-14 again as anticipated by

Dragan. However, in this rejection, the examiner applied the analysis of Dragan that was used to reject claim 8 to now reject claims 1-7 and 9-14.

Petitioner argues the re-opening of prosecution after the BPAI decision is improper as the examiner did not apply new art but instead applied art under a ground of rejection identical to that adjudicated by the BPAI. MPEP 1214.04 indicates the examiner may reopen prosecution if he is aware of a reference that indicates non-patentability of claims the examiner was reversed on. This section of the MPEP does not require new art, only a new rejection. Dragan was re-applied against claims 1-7 and 9-14 under 35 USC 102(b) but Dragan was interpreted in an entirely different manner than it had been when applied against these claims at appeal. This different interpretation constitutes a different rejection of the claims. An explanation of how the reference is applied against the claims is what defines the actual rejection, see MPEP 706 and 37 CFR 1.104(c)(2).

Petitioner argues that the BPAI had the opportunity to apply Dragan against claims 1-7 and 9-14 using the interpretation as used against claim 8. While this is true, MPEP 1213.02 makes it clear that this action by the BPAI is discretionary and also indicates that failure to do so does not infer any position by the BPAI on this issue.

Petitioner argues that the examiner had the opportunity to request rehearing by the BPAI. However, the examiner may do this only when he believes there were points believed to have been misapprehended or overlooked by the BPAI. Since the BPAI appears to have properly understood the positions taken by the appellant and the examiner in the appeal, the examiner was not in a position to request a rehearing based on the requirements to do so.

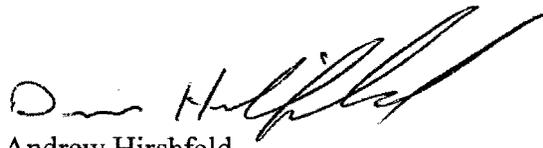
Given the above facts, the examiner had only one option open to him given that he considered that claims 1-7 and 9-14 were not patentable based on a reference (Dragan) that he had knowledge of (MPEP 1214.04). The TC Director's petition decision based on the different interpretation of Dragan as applied against claims 1-7 and 9-14 being proper to reopen prosecution on those claims was correct. In this regard, the TC Director's decision has been reviewed and no error is found in the decision.

DECISION

The decision of the TC Director has been reviewed and no error having been discovered therein, the present petition is **DENIED**.

The above-identified application is being referred to Technology Center 3700 for further processing consistent with this decision.

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

A handwritten signature in black ink, appearing to read "Andrew Hirshfeld". The signature is fluid and cursive, with a large initial "A" and a long, sweeping underline.

Andrew Hirshfeld
Associate Commissioner for
Patent Examination Policy

ak/cf