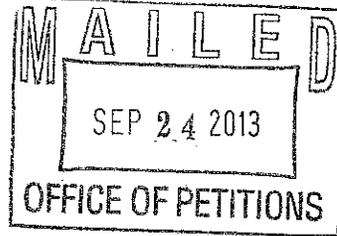




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Lawrence E. Anderson
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In re Application of :
Lawrence E. ANDERSON :
Application No. 13/189,505 : ON PETITION
Filed: July 23, 2011 :
Attorney Docket No. TrafficMonit1 :

This decision is in response to the petition under 37 CFR 1.183 filed June 22, 2013 requesting waiver of the requirements of 37 CFR 41.40(d) to permit designation of a new grounds of rejection in an examiner's answer.

The petition is **DENIED¹**.

BACKGROUND

A final Office action was mailed November 6, 2012.

An amendment under 37 CFR 1.116 was filed November 10, 2012.

A Notice of Appeal and an Appeal Brief were filed November 12, 2012.

An Examiner's Answer was mailed December 5, 2012.

A petition under 37 CFR 1.181(a) requesting that the rejection of claims 1 and 19 under 37 U.S.C. 102(b) set forth in the Examiner's Answer be designated as a new grounds of rejection was filed December 18, 2012.

A Reply Brief was filed January 21, 2013.

A decision dismissing the petition of December 18, 2012 was mailed March 6, 2013.

On March 9, 2013, a petition requesting reconsideration of the petition decision mailed March 6, 2013 was filed.

A decision dismissing the petition of March 9, 2013 was mailed June 6, 2013.

The instant petition was filed June 22, 2013.

STATUTE AND REGULATION

37 CFR 41.40(d) states:

Withdrawal of petition and appeal maintained. If a reply brief under § 41.41 is filed within two months from the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal.

37 CFR 41.41(a) states:

Timing. Appellant may file only a single reply brief to an examiner's answer within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer.

37 CFR 1.183 states:

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).

MPEP 1207.03 states:

IV. REQUEST FOR DESIGNATION AS NEWGROUND OF REJECTION

Appellant cannot request to reopen prosecution pursuant to 37 CFR 41.39(b) if the examiner's answer does not have a new ground of rejection under 37 CFR 41.39. If appellant believes that an examiner's answer contains a new ground of rejection not identified as such, appellant may file a petition under 37 CFR 1.181(a) within two months from the mailing of the examiner's answer requesting that a ground of rejection set forth in the answer be designated as a new ground of rejection. Any such petition must set forth a detailed explanation as to why the ground of rejection set forth in the answer constitutes a new ground of rejection. Any allegation that an examiner's answer contains a new ground of rejection not identified as such is waived if not timely raised (i.e., by filing the petition within two months of the answer) by way of a petition under 37 CFR 1.181(a). The filing of a petition under 37 CFR 1.181 does not toll any time period running. If appellant wishes to present arguments to address the rejection in the examiner's answer,

appellant must file a reply brief to the examiner's answer within two months from the mailing date of the examiner's answer. If the TC Director or designee decides that the rejection is considered a new ground of rejection and approves the new ground of rejection, the examiner would be required to send a corrected examiner's answer that identifies the rejection as a new ground of rejection and includes the approval of the TC Director or designee

OPINION

Petitioner argues that justice is best served by a waiver/suspension of the rules because petitioner was doing what was required by MPEP 1207.03 and should not be penalized for following Office policy. Petitioner requests waiver of 37 CFR 41.40(d) and that the Technology Center Director decide that the rejection is a new grounds of rejection because where there is conflicting policy, it is grossly unfair to deem the petition withdrawn where it is apparent that petitioner was misguided.

Petitioners' arguments have been carefully considered, but are not found to be persuasive.

MPEP 1207.03 states that petitioner should file a petition under 37 CFR 1.181(a) if petitioner believes that an examiner's answer contains a new ground of rejection not identified as such, and further states, if appellant wishes to present arguments to address the rejection in the examiner's answer, appellant must file a reply brief to the examiner's answer within two months from the mailing date of the examiner's answer. There is no doubt that this is the action which was undertaken by petitioner on December 18, 2012 when petitioner filed a petition under 37 CFR 1.181(a) and, on January 21, 2013, when petitioner filed a reply brief. However, it is well settled that when there is conflict between the Code of Federal Regulations and the Manual of Patent Examining Procedure it is the Code of Federal Regulations which takes precedence. As set forth in the Foreword of the MPEP, [T]he Manual does not have the force of law or the force of the rules in Title 37 of the Code of Federal Regulations. Petitioner knew, or should have known, that 37 CFR 41.40(d) states that the filing of a reply brief within two months from the date of the examiner's answer and on or after the filing of a petition under 37 CFR 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, would result in the reply brief being treated as a request to withdraw the petition and to maintain the appeal. Furthermore, petitioner knew, or should have known that the filing of a reply brief may have been filed within the later of two months from the date of either the examiner's answer, or a decision refusing to grant a petition under 37 CFR 1.181 of this title to designate a new ground of rejection in an examiner's answer. See 37 CFR 41.41(a). Thus, despite petitioners arguments to the contrary there is no conflicting policy, *i.e.*, the rules of practice before the USPTO are controlling and permitted petitioner to wait until after a decision on the petition under 37 CFR 1.181(a) to file the reply brief.

The issue at hand is not whether petitioner in good faith followed the rules as he interpreted them; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence herein. In the instant case, petitioner filed a reply brief

before receiving a decision on the petition under 37 CFR 1.181(a). In order for grant of any petition under 37 CFR 1.183, petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioner has not shown that either condition exists in this case, much less that the unfortunate filing of a reply brief prior to a decision on the petition under 37 CFR 1.181(a) was due to circumstances beyond his control. See Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985)(petitioner's failure to take adequate notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO). Petitioners' failure to wait for a decision on the petition under 37 CFR 1.181(a) before filing a reply brief is not an extraordinary situation which, when justice requires, waiver of the rules.

Because the USPTO regulations are published in the Federal Register as required by the Federal Register Act, 44 U.S.C. §1505 (formerly 44 U.S.C. §§5, 7), they are binding, even in the absence of actual knowledge. See e.g., Timber Access Industries Co. v. United States, 213 Ct. Cl. 648, 553 F.2d 1250, 1255 (1977); Andrews v. Knowlton, 509 F.2d 898, 905 (2d Cir.), *cert. denied*, 423 U.S. 873 (1975); United States v. Aarons, 310 F.2d 341, 345-48 (2d Cir. 1962); In re Pacific Far East Line, Inc., 314 F.Supp. 1339, 1348 (N.D. Cal. 1970), *aff'd*, 472 F.2d 1382 (9th Cir. 1973).

Circumstances resulting from petitioner's, or petitioner's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc., 195 USPQ 586, 588 (Comm'r Pats. 1977). The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and petitioner is bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987); Stevens v. Tamai, 366F.3d 1325 (Fed. Cir. 2004)(court denying priority due to counsel's admitted failure to follow the Rules of Practice of the USPTO); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pats. 1985) (counsel's unawareness of 37 C.F.R. 1.8 not extraordinary situation warranting waiver of a rule). Indeed, it is well settled that a party's inadvertent failure to comply with the requirements of the rules or procedures before the USPTO is not deemed to be an extraordinary situation that would warrant waiver of the rules or procedures under 37 CFR 1.183. See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995).

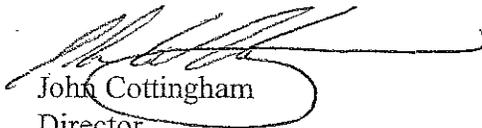
Furthermore, extraordinary relief will not be considered where the rules of practice already provide an avenue for relief. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy, when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pat. 1982). Here, petitioner may reopen prosecution in a request for continued examination by way of 37 CFR 1.114, or in a continuing application by way of 37 CFR 1.53(b). Further in this regard, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the

mention of one thing implies exclusion of another thing), namely absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929) ("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). That is, the patent statute at 35 U.S.C. 120 (and its promulgating regulations 37 CFR 1.53(b) and 37 CFR 1.114) provides a specific mechanism whereby an applicant may file a continuing application or a request for continued prosecution. Since there is a specific mechanism in place to remedy the requested relief then it is inappropriate for the USPTO to contemplate circumventing that mechanism by creating another remedy.

DECISION

For the above stated reasons, petition requesting waiver of 37 CFR 41.40(d) is **DENIED**.

Telephone inquiries related to this decision may be directed to the David Bucci at (571) 272-7099.



John Cottingham
Director
Office of Petitions/
Petitions Officer

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