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OFFICE OF PETITIONS

In re Application of	:	
SLADE	:	DECISION
Application No. 09/193,293	:	ON PETITION
Filed: November 17, 1998	:	
Attorney Docket No. (None)	:	

This is a decision on the petition filed August 8, 2005 under 37 CFR 1.181, requesting review of the decision of the Technology Center Director mailed May 12, 2005.

The petition is **DENIED**.

On January 18, 2005, petitioner filed a petition under 37 CFR 1.181, requesting that the finality¹ of the Office action mailed December 28, 2004 be withdrawn. Petitioner also requests that the amendment filed August 6, 2003² be entered into the application, and the application proceed on appeal. On May 12, 2005, the Director for Technology Center (TC) 2600 vacated the final Office action of December 28, 2004 and the non-final Office action of July 1, 2003. Based on the above Office actions being vacated, the decision also indicated that the application was not ripe for appeal.³ The instant petition seeks review of the TC Director's decision, specifically requesting the amendment filed August 6, 2003 be entered and disputing the decision to reopen prosecution of the application after the filing of the notice of appeal and an appeal brief.

At the outset, the Petitioner appears to protest the January 1, 2005 petition being decided by a TC Director rather than the Commissioner for Patents. 37 CFR 1.181(g) states, "[t]he Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions." The Director⁴ has delegated to the TC Directors the authority to decide petitions invoking the supervisory authority of the Director under 37 CFR 1.181 and involving an *ex parte* action or requirement in a patent application by the examiner, which is not subject to appeal. See MPEP 1002.02(c). Consistent with Office policy, a TC 2600 Director decided the petition filed on January 18, 2005 under 37 CFR 1.181. Similarly, petitions to review a decision of a TC Director

¹ The exact language of the August 8, 2005 petition states, "Applicant disputes Examiner's Final Office Action." For purposes of this decision, it is assumed that the petitioner was challenging the finality of the Office Action. A review of disputed rejections in the December 28, 2004 Office Action must be addressed with Board of Patent Appeals and Interferences. See *Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468, 1469 n.3 (E.D. Va. June 15, 2004).

² Petitioner refers to this amendment in the petition as "Amendment G."

³ The decision states, "the errant second non-final Office action mailed July 1, 2003, is also hereby vacated, thereby dismissing applicant's faulty appeal."

⁴ The Director referred to in this rule is the Director of United States Patent and Trademark Office.

under 37 CFR 1.181 are delegated to the Office of the Deputy Commissioner for Patent Examination Policy. See MPEP 1002.02(b).

Petitioner requests that the amendment filed August 6, 2003 be entered in the application. The actions of examiner and TC Director not to enter the August 6, 2003 amendment were consistent with Title 37 of the Code of Federal Regulations and Office policy. MPEP 719.14 lists the types of amendments ordinarily denied entry. These amendments include changes to the specification or claims, which are not in compliance with 37 CFR 1.121. See MPEP 719.14(O). In the final Office action mailed December 28, 2004, the Examiner wrote in paragraph 3 that the August 6, 2003 amendment was not entered because the changes were based on the non-entered July 9, 2001 amendment. The July 9, 2001 amendment had not been entered because it did not comply with 37 CFR 1.121, including the requirement to have a marked-up version of the specification. Petitioner was provided notice of this requirement on several occasions, including five Notices of Non-Compliant Amendment (37 CFR 1.121) mailed on August 13, 2001, October 2, 2001, July 5, 2002, September 20, 2002 and December 16, 2002. The examiner reiterated this requirement in Office actions mailed July 1, 2003 and December 28, 2004. Paragraph 4 of the TC Director's decision of May 12, 2005 repeats this point by quoting the relevant portion of 37 CFR 1.121 and 1.125 and bolding the portion requiring that the substitute specification must be submitted with markings showing the changes relative to the immediate prior version of the entered specification of record. Moreover 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., Federal Crop Ins. Corp. v. Merrill, 332 U.S. 380, 385 (1947); Timber Access Industries Co. Inc. v United States, 553 F.2d 1250, 1255 (Ct. Cl. 1977); Andrews v. Knowlton, 509 F.2d 898, 905 (2d Cir. 1975), cert. denied, 423 U.S. 873 (1975); 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). The examiner and TC Director's decision not to enter the August 6, 2003 amendment, thus, had a rational basis and was not an abuse of discretion.

Additionally due to the numerous errors made by both the Office and the petitioner during the prosecution of the application, the TC Director in decision of May 12, 2005 vacated both the final Office action of December 28, 2004 and the non-final Office action of July 1, 2003 and returned the status of the application to a position where applicant had attempted to respond to the original Office action mailed May 23, 2001. Consistent with the TC Director's decision, a new examiner was assigned to the application, and a second non-final Office action was mailed June 28, 2005. Entry of the August 6, 2003 amendment at this juncture, which was intended to respond to a vacated July 1, 2003 non-final Office action, would be non-responsive to the Office action of May 23, 2001 and would only further confuse the record. Moreover while it remains unclear why Petitioner wants the August 6, 2003 amendment to be entered, especially in light of another and different amendment filed on August 8, 2005, Petitioner can incorporate any of the changes to the claims submitted with the August 6, 2003 amendment in her response to the June 28, 2005 Office action, as long as such amendments are in compliance with 37 CFR 1.121.

Petitioner next argues that reopening prosecution after filing of the appeal on September 2, 2003 was "illegal" and that the application should proceed on appeal, requiring the examiner to write an examiner's answer. A review of the record shows a rational basis for examiner's actions to reopen prosecution after the filing of a notice of appeal and appeal brief and the TC Director's decision to support the examiner's actions. At the time the notice of appeal and appeal brief were filed in the instant application, 37 CFR 1.193(a)(2) stated that in the "instance of a new grounds of rejection, the examiner should reopen prosecution." The Petitioner appears to dispute that the December 28, 2004 Office action included a new ground of rejection, alleging that the Office action only dropped the Hoffman⁵ rejection of claim 12 but maintained the rejections of Sekiya and Wilson. A review of the record reflects something different. The July 1, 2003 Office action included rejections of claims 11 and 12 under 35 U.S.C. § 112, ¶¶ 1 and 2 and 35 U.S.C. § 103. The December 28, 2004 Office action rejected claims 1 through 9 under 35 U.S.C. § 112, ¶¶ 1 and 2, claim 1 under 35 U.S.C. § 102 and claims 2 through 9 under 35 U.S.C. § 103. Thus, new grounds of rejection were presented in the December 28, 2004 Office action, and different claims were rejected. Office policy outlined in then MPEP 1208, 1208.01, 1208.02 and 706.07(e) also permitted the reopening of prosecution after the filing of an appeal brief in order to enter new grounds of rejection upon supervisory approval, as was done with the instant application.⁶ The above discussion confirms that new grounds of rejection were presented, and the decision to reopen prosecution by the Office with the mailing of the December 28, 2004 Office action was not an abuse of the Office's discretion.

Furthermore, the examiner's action to reopen prosecution of the application on December 28, 2004 was to Petitioner's benefit. A notice of appeal and appeal brief were simultaneously filed on September 2, 2003 along with \$160 for the notice of appeal. The fee for the appeal brief, as required by 35 U.S.C. § 41(a)(6)(B), was not included or paid within the permissible period of time. As MPEP 1205.02 outlines when no fee for the appeal brief is paid within the permissible period of time, the appeal stands dismissed. Additionally once the TC Director vacated the July 1, 2003 and December 28, 2004 Office actions, the filing of the notice of appeal and appeal brief was defective. 35 U.S.C. § 134(a) states "[a]n applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal." As of the mailing of the decision of the TC Director of May 12, 2005, no claim had been twice rejected. As the application was not ripe for appeal, the decision by the TC Director to dismiss the appeal as untimely⁷ was not an abuse of the Office's discretion.

Since the TC Director's decision, an Office action has been mailed on June 28, 2005, and claims 1 through 9 have now been rejected twice. Petitioner may wish to reinstate the appeal. MPEP 1204.01 indicates that,

⁵ The petition states, "Hoffa." For purposes of this decision, an assumption that "Hoffa" was meant to be Hoffman will be made. If this assumption is incorrect, Petitioner must notify the Office.

⁶ Supervisory Patent Examiner Amelia M. Au signed the December 28, 2004 Office action reopening prosecution.

⁷ The May 12, 2005 decision states that it is "dismissing applicant's faulty appeal."

[i]f an appellant wishes to reinstate an appeal after prosecution is reopened, appellant must file a new notice of appeal in compliance with 37 CFR 41.31 and a complete new appeal brief in compliance with 37 CFR 41.37. Any previously paid appeal fees set forth in 37 CFR 41.20 for filing a notice of appeal, filing an appeal brief, and requesting an oral hearing (if applicable) will be applied to the new appeal on the same application as long as a final Board decision has not been made on the prior appeal. If, however, the appeal fees have increased since they were previously paid, then appellant must pay the difference between the current fee(s) and the amount previously paid. Appellant must file a complete new appeal brief in compliance with the format and content requirements of 37 CFR 41.37(c) within two months from the date of filing the new notice of appeal.

If Petitioner elects to reinstate her appeal, she must pay the difference between the current notice of appeal and appeal brief fees and what was previously paid (\$500-\$160=\$340). Additionally, please note that effective September 13, 2004, the rules relating to appeals have changed.⁸ Petitioner must comply with 37 CFR 41.31 relating to filing a Notice of Appeal and 37 CFR 41.37 relating to filing an appeal brief.

The remaining comments made by Petitioner, such as those hand-written into the copy of the Office action provided with the instant petition, will not be addressed. 37 CFR 1.181 permits Petitioner to petition the Director on any action or requirement of any examiner in the *ex parte* prosecution of an application, which is not subject to appeal to the Board of Patent Appeals and Interferences. These comments relate to issues subject to appeal to the Board in accordance with 35 U.S.C. § 134(a). Therefore, it would be inappropriate for the Director to review such actions.

In conclusion, Petitioner has been treated fairly and legally during examination and on petition. The Office has provided specific guidance, on more than one occasion, in the manner of how to make amendments to the specification, claims and drawings. For example, the latest Office action mailed June 28, 2005 has outlined in great detail how to submit amendments in compliance with 37 CFR 1.121 and proposed allowable subject matter. Even with this assistance, an examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

For the above reason, the Office once again strongly advises Petitioner to hire a registered practitioner to prosecute this application since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting a practitioner. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Agent and Attorney Roster, Patents". Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

⁸ 37 CFR 1.191 now reads, "[a]ppeals to the Board of Patent Appeals and Interferences under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title."

DECISION

For the reasons given above, petitioner has failed to adequately demonstrate reversible error in the decision of the Technology Center Director. The petition is granted to the extent that the decision of the Technology Center Director dated May 12, 2005, has been reviewed but is **denied** as to the request that the aforementioned decision be overturned. The reopening of prosecution, after the filing of a notice of appeal and appeal brief on September 2, 2003, and the refusal to enter the amendment of August 6, 2003 will not be disturbed.

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 of the petitionable questions only. See MPEP 1002.02.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

The application matter is being forwarded to Technology Center Art Unit 2624 for further processing.



John Love
Deputy Commissioner
for Patent Examination Policy (Acting)

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