



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
WWW.USPTO.GOV

Paper No. 35

JOHN B. CONKLIN  
LEYDIG VOIT & MAYER, LTD.  
TWO PRUDENTIAL PLAZA, SUITE 4900  
180 NORTH STETSON STREET  
CHICAGO, IL 60601-6780

COPY MAILED

NOV 14 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of :  
Srinivasa R. Koppolu et al. :  
Reissue Application No. 09/442,070 :  
Filed: November 16, 1999 :  
Reissue of Patent No. 5,801,701 :  
Filed: September 4, 1996 :  
For: METHOD AND SYSTEM FOR :  
IN-PLACE INTERACTION WITH :  
CONTAINED OBJECTS :

This is a decision on the petition under 37 CFR 1.181(a)(3) filed May 7, 2002, to invoke the supervisory authority of the Director<sup>1</sup> to direct the Group Director of Technology Center 2100 (Group Director) to review the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter in the above-identified application.

The petition under 37 CFR 1.181(a)(3) filed May 7, 2002 to direct the Group Director to review the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter in the above-identified application is **DENIED**.

---

<sup>1</sup> The title "Commissioner of Patents and Trademarks" was changed to "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office" by § 4713 of the American Inventors Protection Act of 1999 (AIPA). See Pub. L. 106-113, 113 Stat. 1501, 1501A-575 through 1501A-577 (1999). As used in this decision, "Commissioner" or "Director" means the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, and "Group Director" means the Group Director of Technology Center 2100.

## BACKGROUND

On September 4, 1996, petitioners filed application No. 08/707,684, which issued on September 1, 1998 as U.S. Patent No. 5,801,701. Application No. 08/707,684 claims the benefit (as a divisional application) under 35 U.S.C. § 120 of application No. 08/229,264 filed April 15, 1994 (which issued on March 18, 1997 as U.S. Patent No. 5,613,058).

On November 16, 1999, petitioners filed the above-identified application (application No. 09/442,070), which is an application for reissue of U.S. Patent No. 5,801,701. The above-identified application was filed together with a preliminary amendment that added subject matter to the specification and drawings of the above-identified application and also added claims 40 through 49 that were directed to the subject matter that was added to the specification and drawings of the above-identified application. Specifically, petitioners added the subject matter of pages 168 through 170 of The Windows Interface: An Application Design Guide (1992) (hereinafter "The Windows Interface (1992)") to the specification at column 66, after line 41, and added two drawings from page 170 of The Windows Interface (1992) as new drawing figures 57 and 58. Petitioners asserted that the added subject matter and claims 40 through 49 did not constitute new matter as they found support in the original specification via the incorporation by reference of The Windows Interface (1992) in the specification of application No. 08/229,264 (of which application No. 08/707,684 claims a benefit under 35 U.S.C. § 120).

On April 26, 2001, the examiner issued a non-final Office action (Paper No. 18). The Office action of April 26, 2001 included (*inter alia*): (1) a rejection of claims 1 through 39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 40 through 45 of U.S. Patent No. 5,613,058; (2) an objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter; (3) a rejection of claims 40 through 49 under 35 U.S.C. § 112, ¶ 1, for containing subject matter not described in the specification in such a way to reasonably convey to one skilled in the art that the inventor(s) had possession of the claimed invention at the time the application was filed; and (4) a rejection of claims 9 through 11 and 23 through 27 under 35 U.S.C. § 112, ¶ 2, for failing to particularly point out and distinctly claim the subject matter that petitioners regard as the invention.

On July 25, 2001, petitioners filed an amendment deleting the subject matter previously added to the specification and drawings of the above-identified application, and adding other subject matter to the specification and drawings of the above-identified application (Paper No. 20). Specifically, petitioners added the subject matter of chapters five and nine of The Windows Interface (1992) to the specification at column 12, after line 21, and added thirty-five drawings from chapters five and nine of The Windows Interface (1992) as new drawing figures 57 through 91. Petitioners again asserted that the added subject matter and claims 40 through 49 did not constitute new matter as they found support in the original specification via the incorporation by reference of The Windows Interface (1992) in the specification of application No. 08/229,264.

On September 10, 2001, the examiner issued a final Office action (Paper No. 21), and on October 19, 2001 the examiner issued a supplemental final Office action (Paper No. 23). Each of the final Office action of September 10, 2001 and the supplemental final Office action of October 19, 2001 again included (*inter alia*): (1) an objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter; and (2) a rejection of claims 40 through 49 under 35 U.S.C. § 112, ¶ 1, for containing subject matter not described in the specification in such a way to reasonably convey to one skilled in the art that the inventor(s) had possession of the claimed invention at the time the application was filed.

On November 1, 2001, petitioners filed a "Petition To Invoke The Supervisory Authority Of The Commissioner Pursuant To 37 CFR 1.181" (Paper No. 24). The petition of November 1, 2001 requested a determination of the content of the above-identified application in connection with the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter in the final Office action of October 19, 2001, and also requested clarification of the content of the specification as originally filed on April 15, 1994.

On January 16, 2002, petitioners filed a reply to the final Office action October 19, 2001 (Paper No. 25), and on January 18, 2002, petitioners filed a request for continued examination (RCE) under 35 U.S.C. § 132(b) and 37 CFR 1.114 (Paper No. 29).<sup>2</sup>

On March 7, 2002, the petition filed November 1, 2001 was dismissed on the ground that the disputes on the issues presented are subject to review on appeal by the Board of Patent Appeals and Interferences (BPAI), and are therefore not subject to review by petition (Paper No. 31).

On May 14, 2002, the examiner issued a non-final Office action (Paper No. 33). The Office action of May 14, 2002 included (*inter alia*): (1) a requirement for information under 37 CFR 1.105 requiring that petitioners provide The Windows Interface: An Application Design Guide (1987); (2) an objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter; (3) a rejection of claims 40 through 49 under 35 U.S.C. § 112, ¶ 1, for containing subject matter not described in the specification in such a way to reasonably convey to one skilled in the art that the inventor(s) had possession of the claimed invention at the time the application was filed; and (4) a rejection of claims 40 through 49 under 35 U.S.C. § 112, ¶ 1, for containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention.

On May 8, 2002, the instant "Petition For Review Of The Director's Decision Pursuant To 37 CFR 1.181(a)(3)" was filed (Paper No. 34). Petitioners request that the Group Director be directed to

---

<sup>2</sup> 35 U.S.C. § 132 was amended by § 4403 of the AIPA to permit applicants to request continued examination of an application after a final Office action (as an alternative to appeal). See Pub. L. 106-113, 113 Stat. 1501, 1501A-560.

review the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter.

### STATUTE AND REGULATION

35 U.S.C. § 2(b)(2) provides, in part, that:

The Office . . . may establish regulations, not inconsistent with law, which—  
(A) shall govern the conduct of proceedings in the Office[.]

35 U.S.C. § 6 provides that:

(a) ESTABLISHMENT AND COMPOSITION.— There shall be in the United States Patent and Trademark Office a Board of Patent Appeals and Interferences. The Director, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative patent judges shall constitute the Board. The administrative patent judges shall be persons of competent legal knowledge and scientific ability who are appointed by the Director.

(b) DUTIES.— The Board of Patent Appeals and Interferences shall, on written appeal of an applicant, review adverse decisions of examiners upon applications for patents and shall determine priority and patentability of invention in interferences declared under section 135(a). Each appeal and interference shall be heard by at least three members of the Board, who shall be designated by the Director. Only the Board of Patent Appeals and Interferences may grant rehearings.

35 U.S.C. § 112, ¶ 1, provides that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

35 U.S.C. § 134(a) provides that:

(a) PATENT APPLICANT.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the administrative patent judge to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

35 U.S.C. § 251, ¶ 1, provides that:

Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

37 CFR 1.181(a) provides that:

Petition may be taken to the Commissioner:

- (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;
- (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and
- (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.

37 CFR 1.191(a) provides that:

Every applicant for a patent or for reissue of a patent, and every owner of a patent under *ex parte* reexamination filed under § 1.510 for a patent that issued from an original application filed in the United States before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply. Notwithstanding the above, for an *ex parte* reexamination proceeding filed under § 1.510 for a patent that issued from an original application filed in the United States on or after November 29, 1999, no appeal may be filed until the claims have been finally rejected (§ 1.113). Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

### OPINION

Petitioners assert that the issues presented in the petition of November 1, 2001 are limited to the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter. Petitioners argue (*inter alia*) that: (1) the BPAI does not have jurisdiction over the issues for which review is requested because petitioners have not filed any notice of appeal under 35 U.S.C. § 134 and 37 CFR 1.191; (2) the Group Director's decision is based upon an incorrect interpretation of MPEP 608.02(c); (3) MPEP 1002.02(c)(3) provides that a requirement to cancel new matter from the specification is reviewable on petition by the Technology Center Group Director; and (4) the Group Director's decision is inconsistent with the decision by the United States Patent and Trademark Office (USPTO) in In re Goodwin, 43 USPQ2d 1856 (USPTO Gp. Dir. 1997). Petitioners also request an oral hearing on the instant petition.

37 CFR 1.181 provides that oral hearings will not be granted except when considered necessary by the Director. See 37 CFR 1.181(e). The USPTO has a well-established policy of deciding petitions solely on the basis of the written record. See 37 CFR 1.2 (“[t]he action of the Patent and Trademark Office will be based exclusively on the written record in the Office”). As it is not the practice of the USPTO to grant oral hearings on petitions, and there is no convincing showing as to why the USPTO should deviate from this well-established practice in considering the instant petition, petitioners' request for an oral hearing is **denied**. See Chauvette v. Scartazzini, 206 USPQ 764, 765 (Comm'r Pat. 1979).

A review of the record reveals that the Group Director properly determined that the issues presented in the petition of November 1, 2001 are properly reviewable by appeal of the rejected claims to the BPAI, and are thus not properly reviewable by a petition under 37 CFR 1.181.

The line of demarcation between appealable matters for the BPAI and petitionable matters for the Director is carefully observed. See Manual of Patent Examining Procedure (MPEP) 1201 (8<sup>th</sup> ed. 2001). The BPAI will not ordinarily hear a question which it believes should be decided by the Director, and the Director will not ordinarily entertain a petition where the question presented is an appealable matter. See *id.* In exercising supervisory authority under 37 CFR 1.181, the Director will not usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickinson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962).

37 CFR 1.181(a)(1) provides that petition may be taken to the Director: “[f]rom any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court.” Thus, if an action or requirement of an examiner in the *ex parte* prosecution of an application is subject to appeal to the BPAI (or to the court), that action or requirement is not properly reviewable by a petition (under 37 CFR 1.181 or otherwise). Under 35 U.S.C. §§ 6 and 134, the types of decisions reviewable by the BPAI on appeal are those

that relate to matters involving the rejection of claims. Cf. In re Hengehold, 440 F.2d 1395, 1404, 169 USPQ 473, 480 (CCPA 1971).

In specific regard to whether a new matter objection is reviewable by petition to the Director or by an appeal to the BPAI:

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. **But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also.** 37 CFR 1.181 and 37 CFR 1.191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

See MPEP 608.04(c) (emphasis added).

Thus, the appropriate forum for review of an examiner's objection to the specification and/or drawings for introduction of new matter and requirement to cancel such new matter is well established: (1) if the new matter in question<sup>3</sup> is confined to the specification and/or drawings, and does not relate to a rejection of the claims, review of the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter is by way of petition under 37 CFR 1.181 (Ex parte Wilcox, 39 USPQ 501, 502 (Bd. Pat. App. 1938)); and (2) if the new matter in question is introduced into or affects the claims, thus necessitating their rejection on this ground, review of the objection to the specification and/or drawings for introduction of new matter and requirement to cancel such new matter is by way of an appeal of the rejected claims, and should not be considered on petition even though that new matter has been introduced into the specification and/or drawings as well (Ex parte Coad, 92 USPQ 431, 433 (Bd. Pat. App. 1951)).

A review of the record of this application reveals that claims 40 through 49 stand rejected under 35 U.S.C. 112, ¶ 1, based upon the objection to the specification and drawings for introduction of new matter. There is no dispute that the material objected to by the examiner as being new matter is also introduced into claims 40 through 49, and that the examiner's new matter objection "relates" to the rejection of claims 40 through 49 under 35 U.S.C. 112, ¶ 1. Specifically,

---

<sup>3</sup> Petitioners argue at some length that MPEP 608.04(c) is ambiguous as to what is meant by "the question" (petition of May 2, 2002 at 11-13). As that MPEP provision relates to the review of a new matter holding, MPEP 608.04(c) is reasonably clear that "question" means the question of whether new matter has been introduced into the application (*i.e.*, the question of whether new matter has been introduced into the application becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also).

petitioners' replies of July 25, 2001 (at 5-8) and January 16, 2002 (at 3-5) contain arguments that claims 40 through 49 are not unpatentable under 35 U.S.C. 112, ¶ 1, for lack of written description support because the objection to the specification and drawings for introduction of new matter is improper. Since the objection to the specification and drawings of which petitioners seek review by petition relates to the rejection of claims 40 through 49 under 35 U.S.C. 112, ¶ 1, such objections are properly reviewable by way of an appeal of the rejected claims because the BPAI's decision on the appeal will likely be dispositive of any objection that "relates" to the rejection. See In Ex Parte C, 27 USPQ2d 1491, 1494 (BPAI 1992) (when the specification is "objected to" and the claims are "rejected" for the same reasons, consideration of the propriety of the objection is usually held in abeyance because the Board's decision may well be dispositive of both the "objection" and the "rejection").

Petitioners' contention that the new matter objection at issue is properly reviewable by petition because the BPAI has no jurisdiction over this application absent a request to review a rejection of any claim is not well-founded.<sup>4</sup> The question of whether a new matter objection is reviewable by petition to the Director or by an appeal to the BPAI is not resolved based upon whether the BPAI has present jurisdiction over an application (*e.g.*, that 35 U.S.C. § 134 does not authorize an appeal unless a claim has been "twice rejected" does not make the rejections in an initial Office action properly reviewable by way of a petition under 37 CFR 1.181). The issue is whether the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground. See MPEP 608.04(c).

35 U.S.C. § 2(b)(2) authorizes the USPTO to prescribe regulations for the conduct of proceedings in the USPTO, and does not provide that applicants may determine what procedures are best suited to their needs and then insist that the USPTO follow those procedures during the examination of their applications.<sup>5</sup> The USPTO provides for review of new matter objections that relate to the

---

<sup>4</sup> Claims 40 through 49 were "twice rejected" within the meaning of 35 U.S.C. § 134(a) and 37 CFR 1.191 in the Office action of October 19, 2001. The BPAI has no jurisdiction over this application because petitioners chose to obtain continued examination before the examiner under the RCE provisions of 37 CFR 1.114 rather than appeal the rejection of claims 40 through 49 to the BPAI under 35 U.S.C. § 134(a) and 37 CFR 1.191. While petitioners may reply to the Office action of May 14, 2002 under 37 CFR 1.111, petitioners may also obtain the review of the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter by way of an appeal of the rejection of claims 40 through 49 to the BPAI, as claims 40 through 49 have again been "twice rejected" within the meaning of 35 U.S.C. § 134(a) and 37 CFR 1.191 in the Office action of May 14, 2002.

<sup>5</sup> While 35 U.S.C. § 134(a) gives applicants for patent a statutory right to appeal the rejection of any claim that has been "twice rejected" to the BPAI, the patent statute does not give applicants any "statutory" right to petition objections or requirements to the Director or any particular USPTO official. The Director has the authority under 35 U.S.C. § 2(b)(2) to decide



rejection of a claim on appeal to avoid the situation in which the Director (or his designee) must first rule on the issue on petition and then the BPAI (which also includes the Director) must then again rule on the same issue during an appeal. See Haas, 175 USPQ at 220 (noting that “[i]f the [Director], on petition, in his administrative capacity, affirms the examiner’s procedural treatment of a case, it would be a travesty on proper procedure to have the [Director] and his designees, as an appellate tribunal, rule on the correctness of his decision when he acted administratively”). That petitioners wish to limit the question presented by the instant petition to the procedural issue related to the content of the specification as originally filed is immaterial. The salient point remains that the new matter objection “relates” to the rejection of claims 40 through 49 under 35 U.S.C. 112, ¶ 1, and is thus properly reviewable by way of an appeal under 35 U.S.C. § 134(a) and 37 CFR 1.191 of rejected claims 40 through 49 to the BPAI.

MPEP 1002(c)(3) does not set forth an absolute right to have all requirements to cancel new matter reviewed by the Director on petition. See MPEP 1001.01 (the delegations set forth in MPEP chapter 1000 do not confer a right to have a matter decided by a specific USPTO official, rather, such delegations aid in the efficient treatment of petitions by the USPTO). MPEP 1002(c)(3) simply indicates examples of petitions under 37 CFR 1.181 involving *ex parte* actions or requirements in a patent application by the examiner not subject to appeal that are decided by the Technology Center Group Director. MPEP 608.04(c), however, provides that if the new matter in question is introduced into or affects the claims, thus necessitating their rejection on this ground, review of the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter is by way of an appeal of the rejected claims. Since review of the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter is not properly by way of a petition under 37 CFR 1.181, but is instead by way of an appeal of the rejected claims under 35 U.S.C. § 134(a) and 37 CFR 1.191 to the BPAI, the provisions of MPEP 1002(c)(3) do not apply to the instant petition.

Finally, petitioners’ reliance upon Goodwin is misplaced. Initially, the USPTO has indicated that Goodwin was not prepared for publication and that it is not binding precedent on the USPTO. In addition, Goodwin is the decision of a Technology Center Group Director and is no more binding on the USPTO than is the Technology Center Group Director decision of which petitioners currently request review. In Goodwin, the Technology Center Group Director, as the manager of a Technology Center, took the opportunity presented in the petition to correct an examiner’s misguided views as to the procedural requirements concerning whether an incorporation by reference statement in an application is sufficient to treat the target material as incorporated into the application. That the Technology Center Group Director took this corrective action in a decision on a petition under 37 CFR 1.181 does not require the USPTO to change the line of

---

which objections and requirements will be reviewed by which USPTO officials. Cf. Ex parte Haas, 175 USPQ 217, 221 (Bd. Pat. App. 1972) (concurring opinion noting that the Director can delegate matters other than the review of rejections under 35 U.S.C. § 134(a) to members of the BPAI).

demarcation between when an examiner's new matter objection is reviewable by petition and when it is reviewable by appeal.

### CONCLUSION

For the above-stated reasons, the Group Director has provided a reasonable basis to support her findings and conclusion that review of the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter in the above-identified application is properly subject to review by way of appeal of the rejection of claims 40 through 49 under 35 U.S.C. 112, ¶ 1, to the BPAI, and is not properly subject to review by way of petition. The instant petition is granted to the extent that the Group Director's Decision of March 7, 2002 has been reviewed, but is **denied** with respect to directing the Group Director to review the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter.

This decision refusing to direct the Group Director to review the objection to the specification and drawings for introduction of new matter and requirement to cancel such new matter 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.

The file of the above-identified application is being returned to Technology Center 2100 to await petitioners' reply to the Office action of May 14, 2002.

Telephone inquiries concerning this matter may be directed to Senior Petitions Examiner Brian Hearn at (703) 305-1820, or in his absence, to Petitions Attorney Edward Tannouse at (703) 306-9200.



Stephen G. Kunin  
Deputy Commissioner  
for Patent Examination Policy

et/nj/ps/bh