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In re Application of :
Jayden David Harman :
Application No. 10/882,412 :
Filed: June 30, 2004 :
Attorney Docket No.: PA2780US :

OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition filed October 20, 2008 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3700 (Technology Center Director), dated August 20, 2008, which refused to strike from the record the Examiner's Answers of October 24, 2007 and January 14, 2008 or re-open prosecution.

The petition to overturn the decision of the Technology Center Director dated August 20, 2008, is **DENIED**¹.

BACKGROUND

A final rejection was mailed on June 6, 2006 in which claims 1, 4, 7-14, 18, 22-23, 35, and 37-44 were rejected under 35 USC 112, second paragraph, and claims 1, 4, 7-14, 16, 19, 22, 24-33, 35, and 37-44 were rejected as being anticipated under 35 USC 102(b).

A Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences was filed August 4, 2006 along with an amendment under 37 CFR 1.116(b) canceling all of the finally rejected claims except claim 40. This amendment was approved for entry on August 28, 2006.

On September 22, 2006, an Appeal Brief was filed and contested the rejections of claim 40.

On January 9, 2007, an Examiner's Answer to the September 22, 2006 Brief was mailed. This Examiner's Answer identified claim 40 as rejected under 35 USC 112, second paragraph, and under 35 USC 102 but omitted the explanations for these rejections in the "Grounds of Rejection" section (section 9) of the Examiner's Answer.

The Appeal Center of the USPTO returned the January 9, 2007 Examiner's Answer to the examiner on March 8, 2007 for the presentation of a concise explanation of the grounds of rejection presented in section 9 of the Examiner's Answer and the addition of a claims appendix. This return for correction occurred internal to the USPTO and without Appellant's knowledge.

A Reply Brief to the January 9, 2007 Examiner's Answer was filed on March 9, 2007.

The explanation required by the Appeal Center was provided and a corrected Examiner's Answer was mailed on October 24, 2007. This corrected Examiner's Answer did not indicate that it was a correction of the erroneous January 9, 2007 Examiner's Answer.

The Appeal Center returned the October 24, 2007 corrected Examiner's Answer to the examiner on November 8, 2007 for the addition of the still missing claims appendix section of the brief. This return for correction occurred internal to the USPTO and without Appellant's knowledge.

On December 17, 2007, a petition was filed requesting that the October 24, 2007 Examiner's Answer be "stricken from the prosecution history of the present application" or that prosecution of the present application be re-opened so that the explanation provided in the Examiner's Answer may be addressed.

The claims appendix required by the Appeal Center was added and another corrected Examiner's Answer was mailed on January 14, 2008. This corrected Examiner's Answer did not indicate that it was a correction of the erroneous October 24, 2007 Examiner's Answer.

On February 4, 2008, the Appeal Center required the examiner to acknowledge all previously filed Information Disclosure Statements, which were acknowledged by the examiner on February 13, 2008.

On March 18, 2008, the December 17, 2007 petition was dismissed and a renewed petition was filed May 19, 2008 requesting that the October 24, 2007 and January 14, 2008 Examiner's Answers be "stricken from the prosecution history of the present application" or that prosecution of the present application be re-opened.

The Reply Brief filed March 9, 2007 was acknowledged by the examiner on July 31, 2008.

On August 20, 2008, the May 19, 2008 renewed petition was denied by the Technology Center Director.

The instant petition was filed October 20, 2008.

On February 9, 2009, the Board of Patent Appeals and Interferences returned the present application for consideration of the instant petition.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.116(b)(1) states in pertinent part:

After a final rejection ... but before or on the same date of filing an appeal: an amendment may be made canceling claims.

37 CFR 41.41(a)(1) states:

Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

37 CFR 41.43(b) states:

If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

37 CFR 41.50(a) states in pertinent part:

(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner. The Board may also remand an application to the examiner.

(2) If a supplemental examiner's answer is written in response to a remand by the Board for further consideration of a rejection pursuant to paragraph (a)(1) of this section, the appellant must within two months from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding:

(i) *Reopen prosecution*: Request that prosecution be reopened before the examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131 or 1.132 of this title) or other evidence. Any amendment or submission of affidavits or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. A request that complies with this paragraph will be entered and the

application will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(ii) *Maintain appeal*: Request that the appeal be maintained by filing a reply brief as provided in § 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the examiner under paragraph (a)(2)(i) of this section.

37 CFR 1.114(d) states:

If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief (§41.37 of this title) or a reply brief (§41.41 of this title), or related papers, will not be considered a submission under this section.

37 CFR 1.59(b) states:

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.

MPEP 1207.03 III states in pertinent part:

There is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. See *In re Kronig*, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976). Where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303, 190 USPQ at 427 (reliance upon fewer references in affirming a rejection under 35 U.S.C. 103 does not constitute a new ground of rejection).

MPEP 724.01 states:

It is the intent of the Office that the patent file wrapper be as complete as possible insofar as "material" information is concerned. The Office attempts to minimize the potential conflict between full disclosure of "material" information as required by 37 CFR 1.56 and protection of trade secret, proprietary, and protective order material to the extent possible. The procedures set forth in the following sections are designed to enable the Office to ensure as complete a patent file wrapper as possible while preventing unnecessary public disclosure of trade secrets, proprietary material, and protective order material.

OPINION

Petitioner seeks reversal of the Technology Center Director's decision of August 20, 2008, on the grounds that the arguments presented in the corrected Examiner's Answer of October 24, 2007 were improperly made on appeal. Accordingly, petitioner requests that the Office re-open prosecution and render these arguments rejections or that the January 2008 brief and these arguments be "stricken from the record."

In support of these requests, petitioner contends that the decision of the Technology Center Director to present two differing Examiner's Answers without allowing Appellant an opportunity to amend, to present "new arguments" following the filing of an opening and reply brief, and to create prosecution history through presentation of the second Examiner's Answer after the filing of an opening and reply brief constituted an "arbitrary, capricious" and otherwise discretionary abuse." This contention is not correct.

The decision of the Technology Center Director correctly indicates that new grounds of rejection were not presented in the corrected Examiner's Answer. As noted by petitioner, numerous sections of the January 9, 2007 original Examiner's Answer were removed or revised in the corrected Examiner's Answer of October 24, 2007. However, such correction was necessary to clearly explain the grounds of rejection presented in the original Examiner's Answer as required before the Board of Patent Appeals and Interferences would accept the Examiner's Answer. Since most of the finally rejected claims were canceled by an amendment filed pursuant to 37 CFR 1.116(b)(1) upon filing the Notice of Appeal, the explanation of the grounds of rejection presented in the Final Rejection was revised in section 9 of the corrected Examiner's Answer as necessary to clearly explain the rejection of the single claim remaining on appeal.

Furthermore, the revisions of section 10 of the corrected Examiner's Answer, titled "Response to Argument," merely relate to arguments and do not alter the grounds of rejection presented in section 9 of the corrected Examiner's Answer. Section 10 of the

original Examiner's Answer included various arguments that were substantially copied from the Final Rejection without revision for the numerous claims that were canceled after the final rejection was made. The required presentation of clear and concise arguments relating to the single claim on appeal necessitated revision of the arguments section of the Examiner's Answer to properly account for the canceled claims.

As noted by the Technology Center Director, the grounds of rejection in both the original Examiner's Answer of January 9, 2007 and the corrected Examiner's Answer of October 24, 2007 showed that claim 40 is rejected under 35 USC 112, second paragraph, as being indefinite and under 35 USC 102(b) as being anticipated by Harman (U.S. Patent No. 5,934,877), which grounds of rejection were also presented in the Final Rejection in relation to claim 40. Thus, the basic thrust of the rejection of claim 40 remained the same in the corrected Examiner's Answer as in the original Examiner's Answer and the Final Rejection. Also, the statutory basis for the rejection and the evidence relied upon in support of the rejection remained the same in the corrected Examiner's Answer as in the original Examiner's Answer and the Final Rejection. In such a circumstance, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976); MPEP § 1207.03 III, supra. Furthermore, Appellant had a fair opportunity to react to these revisions in that the filing of a reply brief was permitted under 37 CFR 41.41(a)(1). Therefore, contrary to petitioner's assertion, the present situation is substantially similar to that addressed in In re Kronig and new grounds of rejection were not introduced in the corrected Examiner's Answer of October 24, 2007.

Petitioner should also note that even if the suggestion to characterize the Examiner's Answer of October 24, 2007 as a Supplemental Examiner's Answer were persuasive, which it is not, Appellant still would have had a fair opportunity to react to these revisions in that the filing of a reply brief was permitted under 37 CFR 41.43(b). The governing regulations do not entitle Appellant the opportunity to amend a claim as a response to a revised explanation in an Examiner's Answer. Rather, such a response would involve a reply brief. While the filing of a new reply brief was not required by regulation or necessary since the grounds of rejection did not change, the corresponding creation of additional substance in the prosecution history would not have been undesirable if it gave further clarity to the record. Consequently, the submission of differing Examiner's Answers in this instance was not a prohibited abuse as suggested by petitioner.

In regard to the requested relief, prosecution will not be re-opened as a result of the instant petition since no new grounds of rejection were presented in the corrected Examiner's Answer and a fair opportunity to react to these corrections was already provided. Moreover, legal grounds do not exist for the request to re-open prosecution. Where a second Examiner's Answer is presented, Appellant may only request the re-

opening of prosecution if the second Examiner's Answer is a Supplemental Examiner's Answer that is written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1). See 37 CFR 41.50(a)(2). Here, the second Examiner's Answer was a corrected Examiner's Answer and not a Supplemental Examiner's Answer and it was not written in response to a remand by the Board for further consideration of a rejection pursuant to 37 CFR 41.50(a)(1). Also, 37 CFR 41.50(a)(2)(i) requires that such a request to re-open prosecution include a reply under 37 CFR 1.111 that addresses the new rejection. No such reply was filed after the alleged new grounds of rejection were presented. Therefore, prosecution will not be re-opened as a result of the instant petition. However, Appellant may re-open prosecution prior to a decision on the appeal by filing a Request for Continued Examination pursuant to 37 CFR 1.114(d).

Furthermore, none of the Examiner's Answers will be "stricken from the record." Petitioner fails to explain the meaning of "stricken from the record." This expression is understood to mean having the Examiner's Answers removed, or expunged, from the application file under 37 CFR 1.59. However, the instant petition does not include the required fee for a petition under 37 CFR 1.59 and does not establish to the satisfaction of the Director that the expungement of the information is appropriate.

Merely because an applicant contends that a given action was improper per se is not an adequate reason for deleting that action in its entirety from the administrative record, which the USPTO has long striven to maintain as complete and accurate as possible. While petitioner may disagree with some of the contents of the contested Examiner's Answers, the USPTO has also long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication from the file record. See e.g., Ex Parte Fox, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910).

Expungement of an Office communication would be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. Even where expungement is warranted for an Office communication, a redacted version is maintained in the file; only the offensive language is removed.

The Manual for Patent Examining Procedure (MPEP) makes clear that the USPTO desires to provide as complete a patent file wrapper as possible while permitting the expungement of record information in very limited situations. See MPEP § 724.01. Section 724.05 of the MPEP and referenced-sections (e.g., MPEP § 724.02) address the following types of information as subject (or susceptible) to possible expungement:

- 1) trade secret information;
- 2) proprietary information;

- 3) protective order material;
- 4) unintentionally-submitted information; and
- 5) information submitted in a wrong application.

The above situations are the only known types of circumstances which have led to information expungement. Clearly none of the above apply here. Petitioner has not alleged that the contested Examiner's Answers include any trade secret, are proprietary in nature, are subject to a protective order, or contains language that is inconsistent with the USPTO's own requirement for courtesy and decorum in the written record under 37 CFR 1.3. It is also evident that the information was not wrongly submitted, and the examiner had jurisdiction of the case at the time the contested communication was issued.

Accordingly, no adequate basis is given or apparent for expunging the contested Examiner's Answers, and the USPTO sees no reason to exercise its discretion to deviate from, or expand upon, the above long-established reasons for expungement. See, e.g., Saxbe v. Bustos, 419 U.S. 65, 74 (1974) (acknowledging an agency's right to maintain a "longstanding administrative construction"). Therefore, none of the Examiner's Answers will be "stricken from the record."

DECISION

A review of the record indicates that the Technology Center Director did not abuse her discretion or act in an arbitrary and capricious manner in the petition decision of October 20, 2008. The record establishes that the Technology Center Director had a reasonable basis to support her findings and conclusion.

In the interest of ensuring that Appellant has a fair opportunity to react to the revisions of the corrected Examiner's Answer of January 14, 2008, Appellant may file a reply brief within one month or thirty (30) days, whichever is later, of the date this decision is mailed.

The petition is granted to the extent that the decision of the Technology Center Director of October 20, 2008 has been reviewed, but is denied with respect to making any change therein. As such, the decision of October 20, 2008 will not be disturbed. The petition is **denied**.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.



John J. Love
Deputy Commissioner for
Patent Examination Policy

cp/db

¹ 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. See MPEP 1002.02.