

# Chapter 1000 Petitions: Cases Submitted to Commissioner and Supervisory Examiners

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## 1001 Statutory Authority of Commissioner

*35 U. S. C. 6; R. S. 481, 483. Duties of commissioner.* The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office. (R. S. secs. 481, 483; Feb. 14, 1903, ch. 552, sec. 12, 32 Stat. 830.)

The statutes quoted above state the authority of the Commissioner of Patents to review and supervise all aspects of the Examiner's work in the Office.

### 1001.01 Modes of Exercising Authority

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of Orders, Notices and Memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants, and by the designation of particular questions which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present section deals with the latter two items.

The Commissioner's authority relating to decisions on petitions and to the supervision of the work of the examining corps has, in instances not requiring the personal decision of the Commissioner, been delegated to the Supervisory Examiners, and to the Solicitor and Law Examiners.

## 1002 Petitions

*Rule 131 Petition to the Commissioner.* (a) Petition may be taken to the Commissioner (1) from 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 Appeals 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.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of a final fee (rule 317).

(e) Oral hearings will not be granted except when considered necessary by the Commissioner.

(f) The mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) Determination of petitions of various kinds may be delegated by the Commissioner to the Supervisory Examiners or to the Solicitor and Law Examiners.

### [Old Rule 142]

*Rule 133 Suspension of rules.* In an extraordinary situation, when justice requires, any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

A petition may be taken to the Commissioner on any matter which the petitioner believes warrants his consideration. However, petitions on appealable matters ordinarily are not entertained.

The determination of petitions is, in the vast majority of cases, delegated by the Commissioner to the Supervisory Examiners or to the Solicitor and Law Examiners (Rule 181 (g)).

The mere filing of a petition will not stay the period for replying to an Examiner's action which may be running against an application, nor act as a stay of other proceedings (Rule 181 (f)). For example, if a petition to vacate a final rejection as premature is filed near the end of the statutory period, the statutory period for response to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full response to the rejection *within the statutory period*, the case is not abandoned.

### 1002.01 Procedure

Petitions, together with the respective application files, are sent by the Docket Branch to the Office of the Commissioner or other official having the delegated authority to decide the petition. The petition may be referred to the Examiner for a formal statement under Rule 181 (c) or for an informal memorandum.

Where a statement under Rule 181 (c) is made, a copy thereof is mailed to the petitioner by the Examiner unless the latter is otherwise directed, and the file and petition, accompanied by the original copy of his statement, are returned to the official handling the petition. After the decision has been rendered, the file with the petition and decision is sent to the Docket Branch, where the decision is recorded, the file then being returned to the Primary Examiner, who will act in accordance with the decision.

### 1002.02 Petitionable Subjects

The following is a list of the most common petitions, together with a reference to the sections of this Manual where they are more fully treated:

#### A. REFERRED TO SUPERVISORY EXAMINERS

1. From any ex parte action taken by the Examiner which is not subject to appeal as, for example,
  - (a) prematurity of final rejection
  - (b) refusal to enter an amendment (see Rule 127)
  - (c) holding of abandonment (See 711.03 (c) and 711.03 (d))

2. To make special a division, continuation or continuation-in-part of an earlier application (see 708.02)

3. To amend after decision by Board of Appeals (See Rule 198, 1214.07)

#### B. REFERRED TO SOLICITOR AND LAW EXAMINERS

4. To make an application special on the ground of prospective manufacture or infringement (See 708.02)

5. To revive an abandoned application (See 711.03 (c) and 711.03 (d))

6. For access to an application (See 103 and 104)

7. For certificate of correction (See 1402 to 1402.02)

8. For filing date (See 506)

9. To accept late final fee (See 712)

10. To convert to or from fee-exempt status (See 607.01, 607.01 (b) and 607.01 (c))

### 1003 Cases Submitted to Commissioner

The following is a list of commonly occurring matters which must be submitted by the Examiner to the Commissioner:

1. Amendment after allowance (See 714.16 to 714.16 (e))

2. Where a patent claim is copied outside the time limit set, its entry requires the approval of the Commissioner (See Notice of September 27, 1933, revised; 1101.02 (f))

3. Amendment copying patent claims without identifying patent (Rule 205)

4. Action on amendment copying patent claims in case in issue (See 1101.02 (g))

5. Letter suggesting claims for interference in an application in issue (See 1101.01 (o))

6. Request for jurisdiction of application in interference (See 1101.01 (o))

7. Examiner requests withdrawal of case from issue (See 1308 to 1308.03)

8. Application for reissue filed while patent is in interference (See 1111.08)

9. Return of papers containing discourteous remarks (See 714.25)

10. Return of paper entered on Contents of File Wrapper (See 717.01)

### 1004 Cases Submitted to Supervisory Examiners

Actions which it is proposed to take in the following cases are required to be submitted to the Supervisory Examiners for review:

1. Fourth or subsequent complete actions on the merits which do not close the prosecution.
2. Actions subsequent to the closing of the prosecution before the examiner which would reopen or

afford grounds for reopening the prosecution. (See 706.07 (e) and 1208.01.)

3. Actions in which a shortened statutory period is set. Order No. 3494 requires the Commissioner's approval but authority to pass on these cases has been delegated to the Supervisory Examiners. (See 710.02 to 710.02 (b).) (Notice of August 6, 1942, Revised.)

In addition to the actions specified in the above Notice, the following actions are also required to be submitted to the Supervisory Examiners:

4. Public Law 690 cases in which the priority request is granted or previously allowed priority benefits are withdrawn (See 201.16 (u))

5. Second or subsequent extension of a set shortened statutory period under Rule 136 (b) (See 710.02 (e))

6. Second or subsequent suspension of action under Rule 103 (See 709)

7. Divisional reissue applications filed (See Rule 177)

8. Actions which state that a new application obviously fails to disclose an invention with the clarity required by sec. 4888 R. S., 35 U. S. C. 33 (See 702.01)

9. Actions pertaining to Publication of Abstracts (See 711.06 (b))

10. Actions taken by the Primary Examiner under Rule 237 (a) in an interference involving a patent as set forth in the Notice of March 15, 1950. See 1101.02 (f)

11. Letters to an applicant of an allowed application informing him of a proposal of requesting withdrawal of said application from issue for the purpose of rejecting a claim or claims as fully met by, or obviously unpatentable over, a new reference. See Notice of March 15, 1950 in 1308.01.

In addition to the above, all unusual questions of practice may be referred to the Supervisory Examiners.