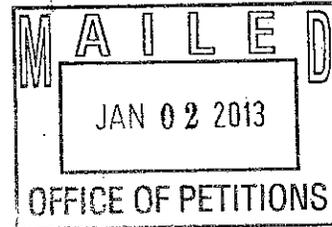




INNOVATION DIVISION
CANTOR FITZGERALD, L.P.
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NEW YORK NY 10022



In re Application of :
Bruce Usher et al. :
Application No. 09/858,844 : ON PETITION
Filed: May 16, 2001 :
Attorney Docket No: 00-TC001 :

This is a decision on the Petition For Review of T.C. Director's Decision And Renewed Petition For Vacatur Of Action Issued Without Observance Of Procedure, filed July 23, 2012, which is being treated as a petition under 37 CFR 1.181 requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated May 22, 2012, which denied the petition filed December 21, 2011.

The petition is **DENIED**¹.

BACKGROUND

The relevant history of this application is set forth below:

An appeal was filed and a decision by the Board of Appeals and Patent Interferences (BPAI) was rendered on June 8, 2011 which reversed the examiner and presented a new ground of rejection of claims 1, 40 and 127.

In response to the BPAI decision, applicant filed an amendment and request to reopen prosecution on August 8, 2011.

The examiner issued a non-final action mailed October 21, 2011. This action rejected all claims in the application.

A petition for Withdrawal of Improper Action Reopening After Appeal was filed December 21, 2011 and was dismissed by the Director of Technology Center 3600 on May 22, 2012.

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. The USPTO will not further consider or reconsider this matter.

The instant petition was filed July 23, 2012.

STATUTE, REGULATION, AND EXAMINING PROCEDURE

37 CFR 1.198 states:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1214.04 states:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 41.50 of this title without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

37 CFR 41.50(b) states in relevant part:

- (b) *New ground of rejection.* Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, and designate such a statement as a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:
 - (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

MPEP 1214.01 states in relevant part:

When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

(A) reopening prosecution before the examiner by submitting an appropriate amendment and/or new evidence (37 CFR 41.50(b)(1));

And further;

I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE

37 CFR 41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits “an appropriate amendment” of the claims rejected by the Board, “or new evidence relating to the claims so rejected, or both.”

OPINION

Petitioner requests review of the Technology Center Director’s decision of May 22, 2012 and vacatur of the non-final Office action mailed October 21, 2011.

With respect to the request to vacate the October 21, 2011 Office action, petitioner argues that the Office is failing to follow 37 CFR 1.198 and the procedures set forth in MPEP 1207.02-.06 and 1214.04-.06. In essence, petitioner wants the prior BPAI decision to be conclusive and controlling. It should be pointed out that MPEP 1207 deals with the Examiner’s Answer and thus this section of the Manual does not apply to the facts at hand since the action being petitioned is not an Examiner’s Answer. Likewise, MPEP 1214.04-.06 does not apply but rather MPEP 1214.01 does. MPEP 1214.01 is directed to “Procedure Following New Ground of Rejection by Board”. MPEP 1214.04-.06 are drawn to situations where the examiner is reversed or sustained in whole or in part but do not apply in situations where the BPAI has made a new ground of rejection. Nevertheless, the BPAI itself lacks authority to allow a claim; the examiner is not required to allow an application after reversal of a rejection(s) by the Board of Patent Appeals and Interferences. See Ex Parte Alpha Industries, Inc., 22 USPQ2d 1851,1857 (BPAI 1992). 37 CFR 1.198 permits the reopening of prosecution by and through the delegated authority to the Technology Center Director, whose approval must be obtained. Petitioner argues that no such approval was made and therefore the non-final Office action was improper. However, a review of the file history shows that the non-final Office action was not subject to the requirements of 37 CFR 1.198. The BPAI, in their decision, reversed the examiner in all rejections under appeal but also set forth a new ground of rejection of certain claims pursuant to 37 CFR 41.50(b) under 35 USC 103(a). The BPAI went on to state that the decision was not a final agency action. In accordance with 37 CFR 41.50(b), applicants filed an amendment to the claims and requested

reopening of prosecution. Because the decision by the BPAI was not a final action and because applicants requested reopening of prosecution, the application was no longer subject to the requirements of 37 CFR 1.198. The Technology Center Director did not ignore or err in interpretation of 37 CFR 1.198 as the requirements of that rule did not apply and any arguments presented in this petition that are directed to the Technology Center Director's decision failing to properly follow the requirements of 37 CFR 1.198 are not convincing.

37 CFR 41.50(b)(1) indicates that the new ground of rejection by the BPAI is binding upon the examiner unless an amendment is made which, in the opinion of the examiner, overcomes the new rejection. Clearly, the examiner did not find that the amendment overcame the rejection and further, the amendment changed the limitations of the claimed invention such that additional rejections could be made.

Petitioner raises issues that are, in essence, that the contents of the Office action, or the form of the rejection and its supportive reasoning are insufficient or improper. Since such arguments go more to the merits of the rejection set forth in that Office action, as opposed to the procedural question of reopening by way of that Office action, they will not be further addressed on petition. See Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC EDVA 2004), appeal dismissed, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). Any review of the rejections of which petitioner complains (and its underlying reasoning) is limited to a merits appeal as provided by 35 U.S.C. § 134, and not by way of petition. *Id.* It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r pat. 1971).

Petitioner presents general comments regarding the lengthy prosecution of this application and such comments are noted. However, this decision is based solely on a review of the Technology Center Director's petition decision.

Finally, petitioners also raise issues under the Paperwork Reduction Act of 1995, 44 U.S.C. § 3501 et seq. (Paperwork Reduction Act). The collection of information pertaining to the filing of applications has been reviewed and approved by OMB under control number 0651-0032 and the collection of information pertaining to replies to Office action up to allowance of an application has been reviewed and approved by OMB under control number 0651-0031. The collection of information at issue has been reviewed and approved by OMB under control number 0651-0031. The public protection provision of the Paperwork Reduction Act provides in part that: "no person shall be subject to any penalty for failing to comply with a collection of information that is subject to this subchapter if- (1) the collection of information does not display a valid control number assigned by the Director in accordance with this subchapter; or (2) the agency fails to inform the person who is to respond to the collection of information that such person is not required to respond to the collection of information unless it displays a valid control number." See 44 U.S.C. § 3512(a). Thus, the Paperwork Reduction Act does not create private right of

action, but is only defense to enforcement actions. See Ass'n of Am. Physicians & Surgs. v. United States HHS, 224 F. Supp. 2d 1115, 1128 (S.D.Tex. 2002). The information required by the public protection provision of the Paperwork Reduction Act is provided on the transmittal form the USPTO provides for any reply to an Office action, namely the transmittal form PTO/SB/21.

DECISION

The instant petition is granted to the extent that the action of the Technology Center Director has been reviewed, but is denied as to making any change therein. As the reopening of prosecution was not inconsistent with 37 CFR 1.198 and MPEP 1214.04, the Technology Center Director's decision will not be disturbed. The Office action which reopened prosecution remains in full force and effect.

This application is being referred to Technology Center 3600 for further processing.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Carl Friedman at (571) 272-6842.



Andrew Hirshfeld
Deputy Commissioner for
Patent Examination Policy/
Petitions Officer

tk/cf