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LEGAL DEPARTMENT  
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OCT 24 2002

OFFICE OF PETITIONS

In re Application of  
Dunphy et al  
Application No. 08/346,059  
Filed: November 29, 1994  
Attorney Docket No. NSHN 3472

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ON PETITION

This is a decision on the petition filed July 31, 2002, under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Commissioner to review the July 11, 2002, decision of the Group Director of Technology Center 1700 (Group Director) which refused to direct the examiner to reopen prosecution under 37 CFR 1.198 and enter the amendment of July 12, 2002.

The petition under 37 CFR 1.181(a)(3) to direct the examiner to reopen prosecution under 37 CFR 1.198 and enter the amendment of July 12, 2002 is **DENIED**.

BACKGROUND

Petitioners filed a first Brief on Appeal on September 17, 1996, which was followed by the Examiner's Answers of December 19, 1996 and February 24, 1997.

As the latter Examiner's Answer contained a new ground of rejection, and the examiner had not made clear his treatment of the issues remaining after appellants' Reply Brief of April 15, 1997, the Board of Patent Appeals Interferences (BPAI) remanded the case to the examiner on October 24, 2000.

Prosecution was reopened by the non-final Office action of November 8, 2000. The action (at 1) advised that petitioners could further proceed under the alternate and mutually exclusive provisions of 37 CFR 1.192(b)(2): (1) by replying to the office action under 37 CFR 1.111, or (2) by seeking reinstatement of the appeal.

On February 13, 2001, petitioners filed a request to reinstate the appeal along with the second Brief on Appeal, in lieu of filing a reply under 37 CFR 1.111.

On March 26, 2002, the BPAI rendered a decision on the *ex parte* appeal of claims 1 through 13, all the claims in the case. The decision affirmed the various rejections under 35 U.S.C. §§ 102 and 103.

On May 22, 2002, petitioners filed a request for an extension of time under 37 CFR 1.304 for seeking court review of the BPAI decision of March 26, 2002. The request was granted on May 23, 2002, by the Office of the Solicitor and extended the period for taking an appeal to July 23, 2002.

On July 12, 2002, petitioners filed an amendment and petition under 37 CFR 1.198 seeking reopening of prosecution, based on a statement made by the BPAI in the decision of March 26, 2002.

On July 23, 2002, the Group Director of Technology Center 1700 denied the petition. The Group Director stated that the BPAI "decision does not appear to be reasonably suggestive that claims requiring this limitation would be allowable," and, as such, refused to reopen prosecution to consider the amendment.

On July 23, 2002, petitioners filed another request under 37 CFR 1.304 to further extend the time period for seeking court review of the BPAI decision of March 26, 2002. The request was granted by the Office of the Solicitor on July 24, 2002, which extended the time for filing an appeal to September 26, 2002. The time was subsequently extended for another thirty (30) days (until October 26, 2002).

The instant petition was filed July 31, 2002, and again requests reopening of prosecution and entry of the amendment filed on July 12, 2002.

#### Regulation and Examining Procedure<sup>1</sup>

37 CFR 1.193(b)(2) provides in pertinent part:

Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

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<sup>1</sup> Manual of Patent Examining Procedure (MPEP), 8th Ed. (Aug. 2001)

- (1) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113 if the Office action is final; or
- (2) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131, or 1.132) or other evidence are permitted.

37 CFR 1.197(b) states in pertinent part:

Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds for which rehearing is sought.

37 CFR 1.198 states:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or 1.196 without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

MPEP 1213.01 states in pertinent part:

If the Board's decision includes an explicit statement [under 37 CFR 1.196(c)] that a claim may be allowed in amended form, applicant may amend the claim in conformity with the statement... In the absence of an express statement, a remark that a certain feature does not appear in a claim is not to be taken as a statement that the claim may be allowed if the feature is supplied by amendment. *Ex parte Norlan*, 1913 C.D. 161, 192 O.G. 989 (Comm'r Pat. 1913).

MPEP 1214.07 states in pertinent part:

The Commissioner also entertains petitions under 37 CFR 1.198 to reopen cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable for settlement without the need for going forward with the court proceedings. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision is reasonably suggestive that claims including the limitation or devoid of the defect will be allowable...

#### OPINION

Petitioners contend that in light of a statement made in the BPAI decision, reopening of prosecution in this case is in accordance with 37 CFR 1.198 as further amplified in MPEP 1214.07. Petitioners urge that consonant with paragraph A of that MPEP section, the BPAI decision is reasonably suggestive that claims containing an additional "element" would be allowable, and, as such, the decision of the Group Director cannot stand.

Petitioners and the Group Director have considered the following statement appearing in the BPAI decision (at 7), but differ as to its import:

Admittedly the appellants have discovered the aforesaid physical characteristics stated in the claimed subject matter and that the aforesaid physical characteristics can be utilized as an optical parameter for sensing removal of said coating. The claims before us, however, do not require that the physical characteristics be utilized as an optical parameter for sensing removal of said coating. Indeed, the claimed subject matter is directed exclusively to an optical sensor having the compositional characteristics and the attendant methodology for the preparation set forth in the claimed subject matter.

Inspection of the above-quoted part of the decision fails to reveal either an explicit statement within the meaning of 37 CFR 1.196(c) and MPEP 1213.01, or, contrary to petitioners' assertions, even an *implied* indication that the "element" in issue is of patentable significance, either *per se* or if it were to be included in one or more of the claims that were before the BPAI, within the meaning of MPEP 1414.07, ¶ A. Clearly, the BPAI did not exercise its discretionary authority within the meaning of 37 CFR 1.196(c) to make an explicit recommendation that the claims so amended would be patentable. While petitioners concede that the BPAI decision does not explicitly state that claims with the "element" in question would be allowable, petitioners contend that this is not the test within the meaning of MPEP 1214.07, and thus reopening lies under 37 CFR 1.198.

The BPAI decision of March 26, 2002, however, did not make any suggestion as to whether the utilization of the physical characteristics as an optical parameter for sensing removal of the coating was itself patentable, or would confer patentability on

the claims. While petitioners make detailed analyses of the references, claims before the BPAI, and the decision itself, and then describes the above-quoted section "as a clear acknowledgment by the [BPAI] that the prior art does not disclose or suggest detecting fiber coating grating removal using the claimed article (or an article prepared as recited in the method claims)," petitioners' analysis does not demonstrate any error in the Group Director's decision that the BPAI did not make any express or implied statement as to whether the utilization of the physical characteristics as an optical parameter for sensing removal of the coating was itself patentable, or would confer patentability.

Petitioners are reminded that it is a long standing tenet of prosecution before the USPTO that claims pending before the USPTO are given their broadest reasonable interpretation in light of the specification, and that limitations appearing in the specification will not be read into the claims. See e.g., In re Morris, 127 F.3d 1048, 1053-54, 4 USPQ2d 1023, 1027 (Fed. Cir. 1997), In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The BPAI decision (at 4) directed its initial inquiry to a determination of the scope of the appealed claims, which resulted in the BPAI construction of the claimed subject matter (BPAI decision at 5). That construction manifestly does not include any mention of the very language that petitioners now seek to insert by way of the requested reopening of prosecution. The BPAI also noted (at 8):

based on the above findings and construction of the claimed subject matter, our analysis of the rejections of record focuses exclusively on a determination of the compositional characteristics and method steps required by the claimed subject matter in the formation of the aforesaid optical sensor. For the reasons that follow we conclude that the optical sensor and method for its preparation required by the claimed subject matter are disclosed by each of the rejections of record.

Thus, where as here, the BPAI merely notes in its decision that a limitation, while disclosed, does not appear in the claims, but does not also discuss or reasonably indicate any patentable significance of such limitation, then that omission cannot successfully be urged as a basis for reopening of prosecution under 37 CFR 1.198. The USPTO has long held that such a mere observation by the BPAI, without more, is not a sufficient basis for reopening prosecution in an application after an appeal. See Ex parte Norlund, 1913 Dec. Comm'r Pat. 161, 162 (1913) (statement by the Board that a particular feature is not included in the claims is not a suggestion that the claims would be patentable if amended to include such feature and does not warrant reopening of prosecution after an appeal), Ex parte Smart, 1909 Dec. Comm'r Pat. 127, 128 (Comm'r Pat. 1909) (same), Ex parte Milans, 1908 Dec. Comm'r Pat. 179 (Comm'r Pat. 1908) (that the claims were interpreted more broadly than the applicant contemplated does not warrant reopening of prosecution after an appeal), Ex parte

Leblanc, 1902 Dec. Comm'r Pat. 1, 2 (1901) (statement by the Board that a particular feature is not included in the claims is not a suggestion that the claims would be patentable if amended to include such feature and does not warrant reopening of prosecution after an appeal), and Ex parte Snow, 1897 Dec. Comm'r Pat. 48, 49 (1897) (where only broad claims are adjudicated, there is no intimation that upon reopening narrower claims would be favorably treated). It follows that, under the circumstances of this case, petitioners' mere speculation, without more, that the proposed limitation would obviate the need for going forward with the court proceeding, does not warrant reopening of prosecution within the meaning of 37 CFR 1.198 and MPEP 1214.07.

In addition, petitioners did not request rehearing under 37 CFR 1.197(b) while the case was still before the BPAI, and therein seek directly from the BPAI guidance or amplification regarding the above-quoted language, as did the appellants in Ex parte Gartin, 90 USPQ 392, 395 (Bd. Pat. App. 1950) and in Ex parte Druey, 145 USPQ 219, 221 (Bd. Pat. App. 1964). Thus, petitioners cannot now be heard to complain that reopening of prosecution was properly refused under 37 CFR 1.198. See e.g., Ex parte Bourne, 1904 Dec. Comm'r Pat. (1904) (reopening refused where applicant suggests that proposed claims are patentable but where no tribunal of the USPTO has ever suggested that the proposed claims would be allowable).

Finally, the Office has also taken into account the patent term impact that would result from filing a continuing application<sup>2</sup> (and abandoning this application) to obtain consideration of amendment of July 12, 2002 due to the amendment to 35 U.S.C. § 154 in the Uruguay Round Agreements Act (URAA), Public Law 103-465, 108 Stat. 4809 (1994). Section 532(a)(2)(A) of the URAA authorizes the Office to prescribe regulations to provide for further limited reexamination of applications that have been pending two years or longer as of June 8, 1995, taking into account any reference made in such application to any earlier filed application under 35 U.S.C. § 120, 121, or 365(c). Since this application (having been filed on November 29, 1994) was not pending for two years as of June 8, 1995, this application is not an application for which the Office is authorized to further limited reexamination under § 532(a)(2)(A) of the URAA. It is not appropriate for the Office to extend the provisions of 37 CFR 1.198 (or 37 CFR 1.116) to accomplish an end-run of the two-year pendency requirement of § 532(a)(2)(A) of the URAA. In addition, while the Office reopened prosecution in this application in the Office action of November 8, 2000, petitioners were at that time given the opportunity to continue prosecution before the examiner by replying to the Office action under 37 CFR 1.111 (e.g., with an amendment such as the amendment of July 12, 2002 for which entry is now requested). Petitioners, however, chose instead to reply in February of

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<sup>2</sup> Office records indicate that application No. 10/199,966 (filed July 19, 2002), and PCT application No. PCT/US 95/15163 (filed November 21, 1995), each claim the benefit of application No. 08/346,059 as a continuation application.

2001 with a request to reinstate the appeal and a second Brief on Appeal. Since petitioners chose to proceed with the appeal before the BPAI in February of 2001 rather than continue prosecution of this application before the examiner, petitioners must now accept the consequences of their chosen course of action, namely that prosecution in this application is now closed and that the circumstances of this application do not warrant reopening of prosecution under 37 CFR 1.198.

#### DECISION

For the above-stated reasons, the Group Director has provided a reasonable basis to support his findings and conclusion that the above-mentioned statement by the BPAI is not a suggestion that the claims would be allowable if amended to include utilization of the physical characteristics as an optical parameter for sensing removal of the coating, and also does not warrant reopening of prosecution under 37 CFR 1.198. The instant petition is granted to the extent that the Group Director's Decision of July 23, 2002 has been reviewed, but is **denied** with respect to directing the examiner to reopen prosecution under 37 CFR 1.198 and enter the amendment of July 12, 2002.

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 1001.02.

The above-identified application is being returned to the Office of the Solicitor.

Telephone inquiries regarding this decision should be directed to Senior Petitions Examiner Brian Hearn at (703) 305-1820.



Stephen G. Kunin  
Deputy Commissioner for  
Patent Examination Policy