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**MAILED**

**APR 23 2012**

**OFFICE OF PETITIONS**

In re Application of :  
Michael Kyba et al. :  
Application No. 11/404,213 :  
Filed: April 14, 2006 :  
Attorney Docket No. UTSD:1715 :

**ON PETITION**

This is a decision on the PETITION UNDER 37 CFR 1.182 - TO BE DECIDED BY OFFICE OF PETITIONS, filed January 26, 2012, which is being treated as a petition under 37 CFR 1.181 requesting that the Director exercise his supervisory authority to review and overturn the decision of the Director, Technology Center 1600 (TC Director), dated January 24, 2012, which denied the renewed petition filed December 4, 2011.

The petition under 37 CFR 1.181, to overturn the decision of the TC Director dated January 24, 2012 is **DENIED**<sup>1</sup>.

**BACKGROUND**

A final Office action was mailed August 13, 2009.

An appeal brief was filed January 10, 2010 and an examiner's answer was mailed April 2, 2010.

A reply brief was filed May 1, 2010.

A Board of Patent Appeals and Interferences (BPAI) decision was mailed February 25, 2011.

A non-final Office action was mailed June 8, 2011.

A petition to the TC Director was filed on August 14, 2011 and was denied in a decision mailed December 1, 2011.

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<sup>1</sup> 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.

A renewed petition to the TC Director was filed on December 4, 2011 and was denied in a decision mailed January 24, 2012.

The instant petition was filed January 26, 2012.

**STATUTE, REGULATION, AND EXAMINING PROCEDURE**

37 CFR 1.181(a) Petition to the Director.

- (a) Petition may be taken to the Director:
- (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 Director; and
  - (3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

37 CFR 1.182 Questions not specifically provided for.

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Director, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in § 1.17(f).

35 U.S.C. 131 Examination of application.

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. 132 Notice of rejection; reexamination.

- (a) Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.
- (b) The Director shall prescribe regulations to provide for the continued examination of applications for patent at the request of the applicant. The Director may

establish appropriate fees for such continued examination and shall provide a 50 percent reduction in such fees for small entities that qualify for reduced fees under section 41(h)(1) of this title.

37 CFR § 1.198 Reopening after a final decision of the Board of Patent Appeals and Interferences.

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 1002.02(c) states in relevant part:

1002.02(c) [R-2] Petitions and Requests Decided by the Technology Center Directors

3. Petitions invoking the supervisory authority of the Director of the USPTO under 37 CFR 1.181 involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.191) and not otherwise provided for

MPEP 1213.02 states in relevant part:

Under 37 CFR 41.50(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.

While the Board is authorized to reject allowed claims, this authorization is not intended as an instruction to the Board to examine every allowed claim in every appealed application. It is, rather, intended to give the Board express authority to act when it becomes apparent, during the consideration of rejected claims, that one or more allowed claims may be subject to rejection on either the same or on different grounds from those applied against the rejected claims. **Since the exercise of authority under 37 CFR 41.50(b) is discretionary, no inference should be drawn from a failure to exercise that discretion.** (Emphasis added)

MPEP 1214.04 states in relevant part:

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center

(TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the answers before the Board and evidence not previously relied upon in the answers are not permitted in the request for rehearing except upon a showing of good cause, the examiner may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.

### OPINION

This petition was filed under 37 CFR 1.182 which is for situations not specifically provided for in the regulations. Petitioner is requesting review of a TC Director's decision which is provided for under 37 CFR 1.181 and the petition is decided thusly.

Petitioner argues that the decisions by the TC Director were not proper since the TC Director was the person who had to approve the examiner's new non-final Office action and thus whose conduct was the subject of the petitions. MPEP 1002.02(c)(3) sets forth that petitions invoking supervisory authority of the Director of actions taken by the examiner is decided by the TC Director. Although requiring approval of the TC Director (MPEP 1214.04) an examiner's reopening of prosecution after a decision by the BPAI is an action taken by the examiner. The petition filed August 14, 2011 was directed to and requested review of the examiner's Office action and such petition was properly decided by the TC Director. The second petition, filed December 4, 2011 was titled as a renewed petition and was thus properly decided by the same TC Director.

The issue raised by petitioner in the first petition to the TC Director, the renewed petition and the instant petition is that the examiner should convert claim 5 into independent form and cancel the other claims by examiner's amendment, and pass the application to issue. This request is based on the fact that the BPAI, in their decision of February 25, 2011, reversed the examiner in the only rejection of claim 5. Instead of amending the application and sending it to issue, the examiner mailed a new non-final Office action which included a new rejection of claim 5. Petitioner argues that this rejection of claim 5 is a "reshuffling art already considered by the Board, and that is insufficient cause to invoke the procedures of 37 CFR 1.198."

Petitioner twice petitioned to the TC Director for the above relief and was twice denied.

The USPTO's reviewing courts have specifically held that even a court decision reversing a rejection does not preclude further examination of the application by the USPTO subsequent to examination provided for in 35 U.S.C. §§ 131 and 132 and the BPAI and court review provided for in 35 U.S.C. §§ 134 and 141. See Jeffrey Mfg. Co. v Kingsland, 179 F.2d 35, 83 USPQ 494 (D.C. Cir. 1949), see also In re Gould, 673 F.2d 1385, 1386, 213 USPQ 628, 629 (CCPA 1982) (USPTO can always reopen prosecution in an application under an ex parte court appeal once it regains jurisdiction over the application); In re Arkley, 455 F.2d 586, 589, 172 USPQ 524, 527 (CCPA 1972) (the USPTO is free to make such other rejections as it consider appropriate subsequent to a court decision reversing a rejection); In re Fisher, 448 F.2d 1406, 1407, 171 USPQ 292, 293 (CCPA 1971) (reversal of rejection does not mandate issuance of a patent); In re Ruschig, 379 F.2d 990, 993, 154 USPQ 118, 121 (CCPA 1967) (subsequent to a court decision reversing a rejection, the USPTO may reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the decision reversing the rejection); In re Citron, 326 F.2d 418, 418-19, 140 USPQ 220, 221 (CCPA 1964) (following a decision reversing a rejection of claims, the USPTO has not only the right but the duty to reject claims deemed unpatentable over new references). Accordingly, it is well established that if there is any substantial, reasonable ground within the knowledge or cognizance of the Director why the application should not issue, the Director has the authority, much less the duty, to refuse to issue the application. See In re Drawbaugh, 9 App. D.C. 219, 240 (D.C. Cir. 1896).

In the above-identified application, the reopening of prosecution is for the consideration of matters not already adjudicated. The BPAI does not allow claims: it simply decides on the record before it whether to affirm or reverse the examiner's rejection. See Ex Parte Alpha Industries, Inc., 22 USPQ2d 1851, 1857 (BPAI 1992). While a decision by the BPAI to reverse the examiner's rejection generally results in the allowance of the application, such a decision does not require the examiner to allow the application. See id. In addition, while the BPAI has the authority to issue a new rejection in its decision, the fact that the BPAI does not enter a new ground of rejection in its decision is not an indication that the BPAI considers a claim to be allowable. See id.

A review of the record of the above-identified application indicates that the examiner did not reopen prosecution to challenge or disagree with the BPAI decision of February 25, 2011, but rather the examiner reopened prosecution to address matters not adjudicated in the BPAI decision of February 25, 2011. The rejection before the BPAI was a rejection of claims 1 and 4-6 under 35 USC 103(a) as being unpatentable over Kyba et al, Manferedini et al, NCBI and Ahmed et al or Gandhi et al. The BPAI reversed the examiner on this rejection. In the subsequent non-final Office action mailed June 8, 2011 the examiner rejected claim 5 under 35 USC 103(a) as being unpatentable over Largman, Manferedini et al, NCBI, Gandhi et al as previously applied to claim 1 and further in view of Kyba et al. This was a different rejection than that applied against claim 5 (claims 1 and 4-6) before the BPAI.

Petitioner argues the re-opening of prosecution after the BPAI decision is improper as the examiner did not apply new art but instead applied art that had already been considered by the BPAI (in the rejection of claim 1). MPEP 1214.04 indicates the examiner may reopen prosecution if he is aware of a reference that indicates non-patentability of claims the examiner

was reversed on. This section of the MPEP does not require new art, only a new rejection. The references applied against claim 5 in the new non-final Office action included Largman which had not previously been applied against the claim. The rejection was a different rejection than that considered by the BPAI. The fact that Largman had been applied against claims other than claim 5 in the final Office action is not relevant. The only issue is whether the rejection of claim 5 as presented before the BPAI and the later rejection of claim 5 in the new non-final Office action were different, and clearly they were.

Petitioner argues that the BPAI had the opportunity to apply the references of record implying that since they did not formulate their own new rejection of claim 5 the examiner was somehow prohibited from doing so. MPEP 1213.02 makes it clear that this action by the BPAI is discretionary and also indicates that failure to do so does not infer any position by the BPAI on this issue.

Petitioner argues that the examiner had the opportunity to request rehearing by the BPAI. However, the examiner may do this only when he believes there were points believed to have been misapprehended or overlooked by the BPAI. Since the BPAI appears to have properly understood the positions taken by the appellant and the examiner in the appeal, the examiner was not in a position to request a rehearing based on the requirements to do so.

Given the above facts, the examiner had only one option open to him in that he considered claim 5 was not patentable based on the combination of references that he had knowledge of (MPEP 1214.04). The TC Director's petition decision based on the references applied against claim 5 being proper to reopen prosecution on claim 5 was correct. In this regard, the TC Director's decision has been reviewed and no error is found in the decision.

### DECISION

The decision of the TC Director has been reviewed and no error having been discovered therein, the present petition is **DENIED**.

The above-identified application is being referred to Technology Center 3700 for further processing consistent with this decision.

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



Andrew Hirshfeld  
Deputy Commissioner for  
Patent Examination Policy

ak/cf