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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/943,677	11/17/2015	Yaakov Elchonon Oppen		1365

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Yaakov Elchonon Oppen
3908 Bancroft Road
Baltimore, MD 21215

EXAMINER

ROJAS, BERNARD

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2837

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of :
Oppen, Yaakov Elchonon :
Application No. 14/943,677 : **DECISION ON PETITION**
Filed: 17 Nov 2015 :
For: Magnetic field force energy/water :

This is a decision on the petition under 37 CFR 1.181 filed on July 9, 2024, and supplemented on August 2, 2024, and September 25, 2024, requesting that the Director exercise supervisory authority and overturn the decision of May 20, 2024, by the Director of Technology Center 2800 (Technology Center Director), which Technology Center Director decision dismissed the request to suspend action in the present application under 37 CFR 1.103(a) filed on March 20, 2024.

The petition requesting to suspend action under 37 CFR 1.103(a) in the present application is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on November 17, 2015.

Prosecution in the above-identified application led to a fourth final Office action being issued on February 20, 2024, and included, *inter alia*: (1) a rejection of claims 1 through 25 under 35 U.S.C. § 101 based on the disclosed invention being inoperative and therefore lacking utility; (2) a rejection of claims 1 through 25 under 35 U.S. C. § 112(a) as failing to comply with the written description requirement; and (3) a rejection of claims 1 through 25 under 35 U.S. C. § 112(b) as failing to define the invention.

A request for a one-month extension of time, along with the required fee, was filed on March 5, 2024.

A petition was filed on March 20, 2024, requesting a suspension of action under 37 CFR 1.103(a) for an undisclosed period of time. The petition was dismissed by the Technology Center Director in a decision issued on May 20, 2024. The request for suspension of action was dismissed because an Office action was issued on February 20, 2024, to which a reply was outstanding.

A notice of appeal and pre-appeal brief conference request were filed on June 6, 2024.

A petition was filed on July 9, 2024, under 37 CFR 1.181, requesting whether a suspension of action under either 37 CFR 1.182 or 37 CFR 1.183 could be filed. A supplemental petition was filed on August 2, 2024, requesting reconsideration of a suspension of action request under 37 CFR 1.103(a).

A Notice of Panel Decision from Pre-Appeal Brief Review issued on July 12, 2024, indicating that the instant application would proceed to the Patent Trial and Appeal Board.

An appeal brief was filed on August 6, 2024.

A response to the final Office action of February 20, 2024, including an amendment to the claims, was filed on August 6, 2024. Supplemental responses were filed on August 22, 2024; August 23, 2024; and August 27, 2024.

An advisory action was issued on September 4, 2024.

A notification of non-compliant appeal brief was issued on September 17, 2024.

The present petition was filed on September 25, 2024, requesting: (1) reconsideration of the decision issued on May 20, 2024, dismissing the request to suspend action in the present application under 37 CFR 1.103(a) filed on March 20, 2024; (2) reconsideration of the suspension of action requests made under 37 CFR 1.103(c) with the filing of a request for continued examination (RCE) on November 19, 2019, and January 25, 2022, to which the Technology Center did not respond and the decision issued by the Technology Center Director on February 13, 2024, regarding numerous suspension of action requests filed in 2022 and 2023; (3) a suspension of action under 37 CFR 1.182 or 1.183; (4) reconsideration of a decision dismissing a refund request; (5) an interview with the examiner; and (6) guidance on expunging papers.

A corrected appeal brief was filed on October 8, 2024.

STATUTE AND REGULATIONS

35 U.S.C. § 2 provides, in part, that:

(a) IN GENERAL. —The United States Patent and Trademark Office, subject to the policy direction of the Secretary of Commerce—

(1) shall be responsible for the granting and issuing of patents and the registration of trademarks; and

(2) shall be responsible for disseminating to the public information with respect to patents and trademarks.

(b) **SPECIFIC POWERS.** —The Office—

(1) shall adopt and use a seal of the Office, which shall be judicially noticed and with which letters patent, certificates of trademark registrations, and papers issued by the Office shall be authenticated;

(2) may establish regulations, not inconsistent with law, which—

(A) shall govern the conduct of proceedings in the Office;

(B) shall be made in accordance with section 553 of title 5;

(C) shall facilitate and expedite the processing of patent applications, particularly those which can be filed, stored, processed, searched, and retrieved electronically, subject to the provisions of section 122 relating to the confidential status of applications;

(D) may govern the recognition and conduct of agents, attorneys, or other persons representing applicants or other parties before the Office, and may require them, before being recognized as representatives of applicants or other persons, to show that they are of good moral character and reputation and are possessed of the necessary qualifications to render to applicants or other persons valuable service, advice, and assistance in the presentation or prosecution of their applications or other business before the Office;

(E) shall recognize the public interest in continuing to safeguard broad access to the United States patent system through the reduced fee structure for small entities under section 41(h)(1);

(F) provide for the development of a performance-based process that includes quantitative and qualitative measures and standards for evaluating cost-effectiveness and is consistent with the principles of impartiality and competitiveness; and

(G) may, subject to any conditions prescribed by the Director and at the request of the patent applicant, provide for prioritization of examination of applications for products, processes, or technologies that are important to the national economy or national competitiveness without recovering the aggregate extra cost of providing such prioritization, notwithstanding section 41 or any other provision of law;

(3) may acquire, construct, purchase, lease, hold, manage, operate, improve, alter, and renovate any real, personal, or mixed property, or any interest therein, as it considers necessary to carry out its functions;

(4)

(A) may make such purchases, contracts for the construction, or management and operation of facilities, and contracts for supplies or services, without regard to the provisions of subtitle I and chapter 33 of title 40, division C (except sections 3302, 3501(b), 3509, 3906, 4710, and 4711) of subtitle I of title 41, and the McKinney-Vento Homeless Assistance Act (42 U.S.C. 11301 et seq.);

(B) may enter into and perform such purchases and contracts for printing services, including the process of composition, platemaking, presswork, silk screen processes, binding, microform, and the products of such processes, as it considers necessary to carry out the functions of the Office, without regard to sections 501 through 517 and 1101 through 1123 of title 44;

(5) may use, with their consent, services, equipment, personnel, and facilities of other departments, agencies, and instrumentalities of the Federal Government, on a reimbursable basis, and cooperate with such other departments, agencies, and instrumentalities in the establishment and use of services, equipment, and facilities of the Office;

(6) may, when the Director determines that it is practicable, efficient, and cost-effective to do so, use, with the consent of the United States and the agency, instrumentality, Patent and Trademark Office, or international organization concerned, the services, records, facilities, or personnel of any State or local government agency or instrumentality or foreign patent and trademark office or international organization to perform functions on its behalf;

(7) may retain and use all of its revenues and receipts, including revenues from the sale, lease, or disposal of any real, personal, or mixed property, or any interest therein, of the Office;

(8) shall advise the President, through the Secretary of Commerce, on national and certain international intellectual property policy issues;

(9) shall advise Federal departments and agencies on matters of intellectual property policy in the United States and intellectual property protection in other countries;

(10) shall provide guidance, as appropriate, with respect to proposals by agencies to assist foreign governments and international intergovernmental organizations on matters of intellectual property protection;

(11) may conduct programs, studies, or exchanges of items or services regarding domestic and international intellectual property law and the effectiveness of intellectual property protection domestically and throughout the world, and the Office is authorized to expend funds to cover the subsistence expenses and travel-related expenses, including

per diem, lodging costs, and transportation costs, of persons attending such programs who are not Federal employees;

(12)

(A) shall advise the Secretary of Commerce on programs and studies relating to intellectual property policy that are conducted, or authorized to be conducted, cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) may conduct programs and studies described in subparagraph (A); and

(13)

(A) in coordination with the Department of State, may conduct programs and studies cooperatively with foreign intellectual property offices and international intergovernmental organizations; and

(B) with the concurrence of the Secretary of State, may authorize the transfer of not to exceed \$100,000 in any year to the Department of State for the purpose of making special payments to international intergovernmental organizations for studies and programs for advancing international cooperation concerning patents, trademarks, and other matters.

37 CFR 1.4 provides, in part, that:

(c) Since different matters may be considered by different branches or sections of the Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects. Subjects provided for on a single Office or World Intellectual Property Organization form may be contained in a single paper

37 CFR 1.103 provides, in part, that:

(a) *Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

(1) A showing of good and sufficient cause for suspension of action; and

(2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

(b) *Limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d).* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph in a continued prosecution application filed under § 1.53(d) for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for an application filed under § 1.53(d), specify the period of suspension, and include the processing fee set forth in § 1.17(i).

(c) *Limited suspension of action after a request for continued examination (RCE) under § 1.114.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph after the filing of a request for continued examination in compliance with § 1.114 for a period not exceeding three months. Any request for suspension of action under this paragraph must be filed with the request for continued examination under § 1.114, specify the period of suspension, and include the processing fee set forth in § 1.17(i).

37 CFR 1.181 provides that:

(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 Patent Trial and Appeal Board 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 Patent Trial and Appeal Board, see § 41.3 of this title.

(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 or declarations (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, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(d) Where a fee is required for a petition to the Director the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

(g) The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions.

37 CFR 1.182 provides that:

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 section must be accompanied by the petition fee set forth in § 1.17(f).

37 CFR 1.183 provides that:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

OPINION

Petitioner requests: (1) reconsideration of the decision issued on May 20, 2024, dismissing the request to suspend action in the present application under 37 CFR 1.103(a) filed on March 20, 2024; (2) reconsideration of the suspension of action requests made under 37 CFR 1.103(c) with the filing of an RCE on November 19, 2019, and January 25, 2022, to which the Technology Center did not respond and the decision issued by the Technology Center Director on February 13, 2024, regarding numerous suspension of action requests filed in 2022 and 2023; (3) a

suspension of action under 37 CFR 1.182 or 1.183; (4) reconsideration of the decision dismissing a refund request; (5) an interview with the examiner; and (6) guidance on expunging papers.

Reconsideration of the decision dismissing the request to suspend action under 37 CFR 1.103(a)

Petitioner requests reconsideration of the dismissal of the request to suspend action filed on March 20, 2024, under 37 CFR 1.103(a). The basis for petitioner's request is to request an interview with the examiner. The Office may grant a suspension of action, on request by applicant, for good and sufficient cause. However, the Office will not suspend action if a reply by applicant to an Office action is outstanding. The fee set forth in § 1.17(g) must also be submitted with the request. In the present case, a final Office action was issued on February 20, 2024, to which a reply was outstanding, and the required fee was not submitted with the request under 37 CFR 1.103(a). Therefore, the request was appropriately dismissed in accordance with 37 CFR 1.103(a).

Reconsideration of the suspension of action requests made under 37 CFR 1.103(c) with the filing of an RCE on November 19, 2019, and January 25, 2022

With the instant petition, petitioner argues that the Technology Center did not properly respond to the request for suspension of action submitted with the requests for continued examination filed on November 19, 2019, and January 25, 2022, and requests reconsideration of the decision issued by the Technology Center Director on February 13, 2024, regarding numerous suspension of action requests filed in 2022 and 2023. In accordance with 37 CFR 1.181(f), the instant petition is untimely since it was not filed within two months of the mailing date of the action or notice (i.e., the decision of February 13, 2024) from which relief is requested. Therefore, the request for reconsideration is dismissed as untimely.

Request for suspension of action under 37 CFR 1.182 or 1.183

A request for suspension of action is provided for under 37 CFR 1.103. A petition may be filed under 37 CFR 1.182 when a situation is not specifically provided for in the regulations. A petition may be filed under 37 CFR 1.183 when, in an extraordinary situation, justice requires a waiver or suspension of a requirement of the regulations. Since a request for suspension of action is a situation specifically provided for in the regulations and is not a request for a waiver or suspension of a requirement, neither 37 CFR 1.182 nor 37 CFR 1.183 is a proper avenue for filing such a request. Furthermore, the situation presented in the present petition is specifically provided for under 37 CFR 1.181 in so far as petitioner is seeking reconsideration of the decisions dismissing the requests to suspend action in the present application.

Reconsideration of the decision dismissing a refund request and request for an interview with the examiner

In accordance with 37 CFR 1.4(c), since different matters may be considered by different branches or sections of the Office, a separate petition is required for each distinct subject, inquiry, or order to avoid confusion and delay in answering the petition, with a separate decision being rendered for each petition. Therefore, the request for reconsideration of a refund request and request for an interview with the examiner will not be treated with the present decision and may be filed as two separate requests in order to be considered.

Guidance on expunging papers

Petitioner seeks guidance on expunging papers filed in the present application. A petition to expunge information unintentionally filed in an application may be filed under 37 CFR 1.59 and requires the petition fee set forth in 37 CFR 1.17(g). See the *Manual of Patent Examining Procedure* (MPEP) § 724.05. The steps for filing a petition to expunge papers may be found on the USPTO website at:

<https://www.uspto.gov/patents/apply/petitions/24-expungement-papers>

Petitioner may also contact the Office of Petition's Help Desk at: 571.272.3282 for further assistance.

DECISION

For the reasons stated above, the petition requesting a suspension of action in the present application under 37 CFR 1.103(a) is **DENIED**.

This constitutes a final decision on the petition. No further requests for reconsideration will be entertained. Judicial review of this decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (*e.g.*, a final decision by the Patent Trial and Appeal Board). See MPEP § 1002.02

/Charles Kim/
Deputy Commissioner for Patents