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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
16/873,593	05/14/2020	Jay R. Maners	011003010200	8840
	7590	10/24/2023	EXAMINER	
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			ART UNIT	PAPER NUMBER
			3612	
			MAIL DATE	DELIVERY MODE
			10/24/2023	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.



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In re Application of :  
Maners et al. :  
Application No. 16/873,593 : DECISION ON PETITION  
Filed: 14 May 2020 :  
Attorney Docket Number: 011003010200 :  
For: Pivotal Tie-Down :

This is a decision on the petition filed May 24, 2023, pursuant to 37 CFR 1.181(a)(3), requesting supervisory review and reconsideration of a decision issued May 3, 2023, by the Director of Technology Center 3600 (“Technology Center Director”), which decision refused to vacate the notices of withdrawal of the application from issue, issued October 20, 2022, and October 27, 2022, and also dismissed the petition under 37 CFR 1.181(a)(3) filed November 17, 2022. Petitioner also seeks additional relief as set forth in items (A) through (H) listed on page 2 of the petition filed May 24, 2023.

The petition to overturn the decision issued May 3, 2023, by the Technology Center Director along with the request for additional items of relief set forth in items (A) through (H) of the instant petition are **DENIED**.

**BACKGROUND**

The above-identified application was filed on May 14, 2020, and included claims 1 through 40.

A non-final Office action was issued on May 6, 2022. The non-final Office action included: a rejection of claims 25-29 under 35 U.S.C. 102(a)(2) as being anticipated by Heider (U.S. 5,664,918), and a rejection of claims 1-2, 13, and 15-17 under 35 U.S.C. 103 as being unpatentable over Heider in view of Woodruff (U.S. 6,558,092). Claims 22-24 and 35-40 were allowed. Claims 2-6, 10-12, 14, 18-21, and 30-31 were objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

A reply was filed on May 13, 2022, that listed a number of alleged deficiencies with the Office action including *inter alia* a lack of examination of claims 32 through 34.

A Notice of allowance and fee(s) due was issued on August 2, 2022, that indicated all the pending claims 1 through 40 were allowed and set a statutory deadline of November 2, 2022, for payment of the issue fee.

On August 19, 2022, a petition to withdraw the application from issue was filed under 37 CFR 1.313(a) for “good and sufficient reasons,” requesting vacatur of the notice of allowance and “the subsequent completion of examination of said Application, and particularly with respect to *inter alia* Claim 29.”

The Technology Center Director issued a Notice of Withdrawal from Issue on October 20, 2022, and a corrected Notice of Withdrawal from Issue on October 27, 2022, with both notices indicating that the application is being withdrawn from issue in view of the unpatentability of one or more claims, and that the prosecution is being reopened.

The issue fee was paid on November 17, 2022.

A petition under 37 CFR 1.137(a) to revive the application was filed on November 17, 2022, with the petition stating that the application was abandoned for late payment of the issue fee.

A petition was also filed on November 17, 2022, under the provisions of 37 CFR 1.181 requesting review of the Notice of Withdrawal from Issue of October 20, 2022 and the Notice of Withdrawal from Issue of October 27, 2022. The petition also requested (A) that the concurrently filed petition under 37 CFR 1.137(a) be granted, (B) that the petition of August 19, 2022 to withdraw the application from issue filed under 37 CFR 1.313(a) be decided on the merits, (C) the vacating of, and subsequent withdrawal of the Notice of Allowability of August 2, 2022, (D) the subsequent completion of examination of the application, particularly with respect to *inter alia* claim 29, (E) application of the issue fee paid on November 17, 2022 to any subsequent Notice of Allowability, or refunding the issue fee upon a subsequent Notice of Abandonment, and (F) determination that the circumstances of prosecution were exceptional, warranting a refund of the petition fee pursuant to 37 CFR 1.17(m) accompanying the petition under 37 CFR 1.137(a).

The Office of Petitions issued a decision on March 2, 2023, dismissing the petition to revive on the basis that the application was not abandoned in view of reopening the prosecution via the notices of withdrawal of the application from issue.

The Technology Center Director issued a decision on May 3, 2023 (“Decision”), dismissing the petition under 37 CFR 1.181 filed November 17, 2022, as well as the petition filed August 19, 2022, under the provisions of 37 CFR 1.313(a).

The instant petition was filed May 24, 2023, pursuant to 37 CFR 1.181(a)(3), requesting supervisory review and reconsideration of the Decision.

### **STATUTES AND REGULATIONS**

35 U.S.C. 41 provides, in part, that:

## (a) GENERAL FEES

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(7) REVIVAL FEES. — On filing each petition for the revival of an abandoned application for a patent, for the delayed payment of the fee for issuing each patent, for the delayed response by the patent owner in any reexamination proceeding, for the delayed payment of the fee for maintaining a patent in force, for the delayed submission of a priority or benefit claim, or for the extension of the 12-month period for filing a subsequent application, \$1,700.00. The Director may refund any part of the fee specified in this paragraph, in exceptional circumstances as determined by the Director.

35 U.S.C. 42 provides, in part, that:

(d) The Director may refund any fee paid by mistake or any amount paid in excess of that required.

37 CFR 1.104 provides, in part, that:

## (a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(3) An international-type search will be made in all national applications filed on and after June 1, 1978.

(4) Any national application may also have an international-type search report prepared thereon at the time of the national examination on the merits, upon specific written request therefor and payment of the international-type search report fee set forth in § 1.21(e). The Patent and Trademark Office does not require that a formal report of an international-type search be prepared in order to obtain a search fee refund in a later filed international application.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

37 CFR 1.26 provides, in part, that:

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee...

(b) Any request for refund must be filed within two years from the date the fee was paid, except as otherwise provided in this paragraph or in § 1.28(a). If the Office charges a deposit account by an amount other than an amount specifically indicated in an authorization (§ 1.25(b)), any request for refund based upon such charge must be filed within two years from the date of the deposit account statement indicating such charge, and include a copy of that deposit account statement. The time periods set forth in this paragraph are not extendable.

37 CFR 1.181 provides, in part, 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.

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(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 1.313 provides, in part, that:

(a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

(b) Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:

- (1) A mistake on the part of the Office;
- (2) A violation of § 1.56 or illegality in the application;
- (3) Unpatentability of one or more claims; or
- (4) For an interference or derivation proceeding.

### OPINION

In the petition filed May 24, 2023, besides seeking a reconsideration of the decision by the Technology Center Director issued May 3, 2023 (“Decision”), the petitioner has listed specific items on which relief is sought. The items (A) through (H) identifying the specific issues in the petition are addressed below.

#### (B) - Decision issued March 2, 2023 on the petition to revive

Petitioner had filed a petition to revive on November 17, 2022, asserting that the application had become abandoned for the lack of timely payment of the issue fee on or before the statutory deadline of November 2, 2022, and that the Office did not timely provide a written communication by a competent authority that the application was withdrawn from issue. In the notice withdrawing the application from issue, issued October 20, 2022, and the corrected notice issued October 27, 2022, signed by the Technology Center Director, it was clearly indicated that the prosecution was being reopened to address the unpatentability of one or more claims. Accordingly, with the reopening of the prosecution, the application was no longer in an allowed status whereby the Notice of Allowance issued August 2, 2022, stood vacated and the issue fee was not due as of August 2, 2022. MPEP § 1308(I)(A) clearly states that “[u]nless applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue fee must be timely submitted to avoid abandonment.” The petitioner herein was provided with a written communication from the proper authority that the application was withdrawn from issue. Accordingly, the issue fee was no longer due and as such the application did not go abandoned for lack of timely payment of the issue fee. The decision issued March 2, 2023, dismissing the petition to revive being proper, will not be vacated or otherwise disturbed.

#### (D) - Decision on the petition filed August 19, 2022 by competent authority of USPTO Director

Petitioner filed a petition to withdraw the application from issue on August 19, 2022, under the provisions of 37 CFR 1.313(a) for “good and sufficient reasons,” alleging that the examination of the application was incomplete, that there were errors in search and that the record was not clear regarding the reasons for allowing the claims in the notice of allowance issued August 2, 2022. In a notice issued October 20, 2022, and a corrected notice issued October 27, 2022, the Technology Center Director informed the petitioner that the application was being withdrawn from issue due to unpatentability of one or more claims. The corrected notice inadvertently referenced 37 CFR 1.313(b) instead of 37 CFR 1.313(a). However, the content of the notice clearly set forth that the

issue and publication fees have not been paid thereby indicating that the application was being effectively withdrawn under the provisions of 37 CFR 1.313(a). The reference to 37 CFR 1.313(b) in the notices was inadvertent.

37 CFR 1.181(g) provides that "The Director may delegate to appropriate Patent and Trademark Office officials the determination of petitions."

As stated in MPEP § 1001.01,

The delegations set forth in this Chapter do not confer a right to have a matter decided by a specific Office official, rather, such delegations aid in the efficient treatment of petitions by the Office.

In BlackLight Power Inc. v. Rogan, 295 F.3d 1269, 1273, 63 USPQ2d 1534, 1537 (Fed. Cir. 2002) the court, while stating that "responsibility for issuing sound and reliable patents is critical to the nation," and relying on the decision in In re Alappat, 33 F.3d 1526, 1535, 31 USPQ2d 1545, 1550 (Fed.Cir.1994) (en banc) noted that:

this court sustained extraordinary action when the Commissioner in good faith believed that such action was required to ensure the issuance of valid patents, observing that "the Commissioner has an obligation to refuse to grant a patent if he believes that doing so would be contrary to law."

The authority to review a petition as well as requests at the initiative of the Office for withdrawal of an application from issue, either before or after the payment of the issue fee, has been delegated by the authority of the Director to the Technology Center Director. *See* MPEP § 1002.02(c)(16) and § 1002.02(c)(17) and also MPEP § 1308 (I)(A)) and MPEP § 1308 (I)(B).

Petitioner appears to be arguing that neither of the notices to withdraw the application from issue, issued by the Technology Center Director, responded to the specific issues raised by the petitioner in the petition filed August 17, 2022. While the reasons set forth by the petitioner may be different from the rationale for withdrawal from issue in the notices issued by the Technology Center Director, the application was nevertheless withdrawn from issue and the prosecution was reopened. Accordingly, as the Technology Center Director had the authority to withdraw the application from issue prior to the payment of the issue, the petition filed August 19, 2022, was decided by a competent authority of the Office. Furthermore, the decision provided the end relief sought in the petition, i.e., withdrawal of the application from issue and reopening of the prosecution.

(A), (C) and (E) – Vacatur of prosecution papers

(A) - The Decision correctly indicated that the notices of withdrawal of the application from issue were directed to reopening the prosecution to address unpatentability of one or more claims and that the reference in the notices to 37 CFR 1.313(b) rather than 37 CFR 1.313(a) was inadvertent. By withdrawing the application from issue, the Technology Center Director

granted the request in the petition filed August 19, 2022, that sought the same relief. Accordingly, the request to vacate the Decision is not grantable.

(C) - Vacatur of papers filed after November 2, 2022, is not warranted as the application was not abandoned as of November 2, 2022, for reasons set forth above.

(E) - The Notice of Allowance and fee(s) due issued August 2, 2022, was effectively vacated in view of the reopening of the prosecution via the withdrawal of the application from issue on October 20, 2022.

(F) - Subsequent examination of the application in compliance with 37 CFR 1.104

After the withdrawal of the application from issue on October 20, 2022, a non-final Office action was issued on February 22, 2023, that considered all the pending claims 1 through 40. The examination of the application subsequent to the withdrawal from issue is in compliance with 37 CFR 1.104 and Office practice<sup>1</sup>.

(G) - Refund/reapplication of the issue fee

As indicated in the notices of withdrawal of the application from issue and reiterated in the Decision, the issue fee paid November 17, 2022, could be either refunded or reapplied.

(H) - Refund of the petition fee paid for the petition to revive

On the request to refund the petition fee paid under 37 CFR 1.17(m) for the petition to revive filed November 17, 2022, the Office will not refund the petition fee required by 37 CFR 1.17(m) regardless of whether the petition under 37 CFR 1.137 is dismissed or denied unless there are exceptional circumstances as determined by the Director (MPEP § 711.03(c)(II)(B)). The Director has determined that there is no exceptional circumstance in the prosecution of the instant application such that, under the provisions of 35 U.S.C. 41(a)(7), the petition fee would be refunded. *See* Changes To Implement the Patent Law Treaty, 78 FR 62388–89 (October 21, 2013), for further discussion on the exceptional circumstances provision in 35 U.S.C. 41(a)(7). Furthermore, in accordance with the provisions of 35 U.S.C. 42(d) and 37 CFR 1.26, the petition fee is not refundable as it was neither paid by mistake nor in excess of the amount required.

## **DECISION**

The petition is granted to the extent that the decision of the Technology Center Director issued May 3, 2023, has been reviewed. However, for the previously stated reasons, the petition to overturn the decision issued May 3, 2023, by the Technology Center Director is DENIED. Accordingly, none of the documents in the application's prosecution history to date, as identified in the instant petition, will be disturbed or vacated.

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<sup>1</sup> Petitioner filed two separate petitions on February 27, 2023, alleging improprieties with the non-final Office action issued February 22, 2023. In a decision issued June 6, 2023, the Technology Center Director has responded to the issues raised in the petition of February 27, 2023.



This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition 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.

The application is being forwarded to Technology Center 3600 for consideration of the reply filed May 24, 2023.

/Brian E. Hanlon/

Brian E. Hanlon  
Deputy Commissioner for  
Patents (Acting)