



INNOVATION DIVISION
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MAILED
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OFFICE OF PETITIONS

In re Application of :
Lee Amaitis, et al. :
Application No. 10/446,572 : **ON PETITION**
Filed: May 27, 2003 :
Attorney Docket No. 02-1076 :

This is a decision on the petition filed May 4, 2011, captioned "PETITION FROM DECISION OF TECHNOLOGY CENTER DIRECTOR." This petition is being treated under 37 CFR 1.181 requesting that the Director exercise his supervisory authority to review the decision of the Director, Technology Center 3600 (TC Director), dated March 4, 2011.

The petition under 37 CFR 1.181 is **DENIED**¹.

BACKGROUND

1. The instant application was filed on May 27, 2003.
2. A requirement for restriction was mailed March 18, 2008. The restriction identified three distinct inventions and identified the claims drawn to each invention.
3. A response to the restriction requirement was filed on August 18, 2008.
4. A Notice of Non-Responsive Amendment (Notice) was mailed September 30, 2008. This Notice indicated that applicant had failed to properly elect an invention in the response filed August 18, 2008. The Notice gave the applicant "a TIME PERIOD OF ONE (1) MONTH OR 30 DAYS from the mailing date of this notice, whichever is longer, to elect an invention detailed in the March 18, 2008, restriction requirement (with or without traverse) in order to avoid ABANDONMENT. Pursuant to 37 CFR 1.136(a)(1), (a)(1)(i), and M.P.E.P. 714.03, NO EXTENSIONS OF TIME MAY BE GIVEN. No further non-responsive amendment notices will be given."
5. A Notice of Abandonment was mailed November 13, 2008.

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

6. A petition captioned "PETITION TO VACATE EXAMINER'S PAPERS OF MARCH, SEPTEMBER AND NOVEMBER 2008" was filed January 13, 2009.
7. A petition decision by the TC Director was mailed March 4, 2011 which denied the petition filed January 13, 2009.
8. The instant petition seeking a review of the TC Director's decision was filed May 4, 2011.

STATUTE AND REGULATIONS

35 U.S.C. § 121 states that:

If two or more independent and distinct inventions are claimed in one application, the Director may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent and Trademark Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Director may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Director to require the application to be restricted to one invention.

37 CFR 1.142 states in part that:

(a) If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action.

37 CFR 1.143 states that:

If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor. (See § 1.111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention

shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

37 CFR 1.181 states in part:

(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.

(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.

5 U.S.C. § 555 states in part that:

(b) A person compelled to appear in person before an agency or representative thereof is entitled to be accompanied, represented, and advised by counsel or, if permitted by the agency, by other qualified representative. A party is entitled to appear in person or by or with counsel or other duly qualified representative in an agency proceeding. So far as the orderly conduct of public business permits, an interested person may appear before an agency or its responsible employees for the presentation, adjustment, or determination of an issue, request, or controversy in a proceeding, whether interlocutory, summary, or otherwise, or in connection with an agency function. With due regard for the convenience and necessity of the parties or their representatives and within a reasonable time, each agency shall proceed to conclude a matter presented to it. This subsection does not grant or deny a person who is not a lawyer the right to appear for or represent others before an agency or in an agency proceeding.

* * * * *

(e) Prompt notice shall be given of the denial in whole or in part of a written application, petition, or other request of an interested person made in connection with any agency proceeding.

Manual of Patent Examining Procedure (MPEP) - §803(I)

CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP §802.01, §806.06, §808.01) or distinct as claimed (see MPEP §806.05 - §806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP §803.02, §808, and §808.02).

OPINION

As an initial matter, petitioner's request on "the personal attention of Director Kappos himself" in considering the instant petition, or otherwise intervene herein, is **denied**. The Director of USPTO, pursuant to 37 CFR 1.181(g), may delegate the determination of petitions. Decisions on petitions submitted under 37 CFR 1.181, to review any ex parte action or requirement by the examiner that is not subject to appeal have, in the first instance, been delegated to the Group Director, see MPEP 1002.02(c) – 1002.02 (c)(3). Petitions, as herein, which seek to invoke the supervisory authority of the Director of USPTO and review a decision of a Group Director, have been delegated to the Office of Petitions in the Office of the Associate Commissioner for Patent Examination Policy. See MPEP 1002.02(b).

A party to a proceeding in the Patent and Trademark Office has a right to petition, and may expect to receive a decision by either the Office official delegated authority to render the decision, or the delegating official. See In re Arnott, 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991). While a higher level official, at the request of the party, may further review a decision rendered pursuant to delegated authority, such review is a matter which lies within the sound discretion of that higher level official, and is not a matter of right. Id.

Rather, a decision rendered pursuant to delegated authority will not be reviewed by a higher level official except in unusual or exceptional circumstances. See In re Staeger, 189 USPQ 284 (Comm'r Pat. 1984). That petitioner does not agree with the decision of the Group Director does not adequately demonstrate that such unusual or exceptional circumstances are present herein. Id. at 285.

On March 18, 2008, the examiner issued a restriction requirement under 37 CFR 1.142, indicating three inventions, and advising the applicant that for the reply to the requirement to be

deemed complete, it must include "(i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention." Applicant filed a reply to the restriction requirement on August 18, 2008 along with a request for four (4) months of extension of time. This reply to the restriction requirement did not provide a proper election. Accordingly, the examiner mailed a Notice on September 30, 2008 indicating to applicant that the election was not proper and gave applicant one month to properly respond to the restriction requirement. Applicant failed to respond to the Notice in a timely manner and the application went abandoned on October 31, 2008 for failure to respond to the Notice. A Notice of Abandonment was mailed November 13, 2008.

37 CFR 1.143 provides that "[i]f applicant disagrees with a requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor" and applicant "must provisionally elect one of the inventions for prosecution in the request for reconsideration." Emphasis added.

Applicant's response to the restriction requirement filed August 18, 2008 argued that "[t]he Office Action is too procedurally flawed to raise any requirement, and omits so many essential showings that Applicant is unable to make an informed or binding election." Petitioner further states "[a]pplicant concedes that groups I and II are distinct (criterion (1) of MPEP § 803), but traverses under criterion (2)." In the citation from the MPEP pertaining to "criterion (2)", petitioner has changed the wording in the MPEP. Under the criterion 803(I)(B) of the MPEP ("Criterion (2)" as referred to by the petitioner), for the requirement of restriction to be proper, there would be a serious burden on the examiner if restriction was not required. In responding to that argument, as stated by the examiner in the Notice, with respect to the three distinct inventions that were identified in the Notice, "that creating an index, head-to-head trading, and adjusting criterion for success of an option trade all require different search queries even though the three are classified together. Therefore, a serious search burden on the examiner exist[s] if restriction is not required." Applicant did not respond to the Notice and the application was properly abandoned.

In requesting a "reversal" of TC Director's decision, petitioner is seeking "vacatur (not withdrawal, *vacatur* under MPEP § 711.03(c)) of the Examiner's papers of March 18, 2008, September 2008, and November 2008, because these papers were issued outside the authority of the Office or the Examiner, and statute provides that Applicant's response was fully adequate."

The TC Director's decision of March 4, 2011 in regard to the abandonment of this application has been reviewed and no error discovered in this decision.

Petitioner disagrees with the TC Director's decision because the decision did not vacate the April 25, 2007 memorandum. 37 CFR 1.181 provides for review of actions or requirements of an examiner in the *ex parte* prosecution of an application, and is not a forum for general complaints about USPTO practices or procedures. The April 25, 2007 memorandum is not an action or requirement made in the instant application. The withdrawal of the restriction requirement

(rather than vacatur) is likewise not an action or requirement made in the instant application.² In any event, petitioner's request that the examiner's restriction requirement be vacated is not granted because 37 CFR 1.143 only provides that applicant may request for reconsideration and withdrawal or modification of a restriction requirement. Accordingly, the TC Director's decision addressed all the relevant issues related to actions taken or requirements made in the instant application that were presented in the petition under 37 CFR 1.181 filed on January 13, 2009, and is thus in compliance with 5 U.S.C. § 555(b) and (e).

Petitioner indicates the TC Director's decision referenced "withdrawal" of abandonment whereas petitioner requested the abandonment be "vacated". As review of the Technology Center Director's decision shows that the abandonment of the instant application was proper, neither the restriction requirement nor notice of abandonment will be withdrawn or vacated.

Petitioner should note that any review of issues raised in the petition filed in the application serial number 10/147,218 will be addressed in a decision on the petition filed therein. For the sake of completeness and to the extent necessary, the decision on the similar petition filed in application serial number 10/147,218 is incorporated herein by reference.

Petitioner's arguments in relation to the non-extendable time period of 1 month or 30 days set for reply in the examiner's action of September 30, 2008 have been considered. In section 714.03 of the MPEP, it is stated that the practice set forth in 37 CFR 1.135(c) does not apply to a situation "where there has been a deliberate omission of some necessary part of a complete reply; rather, 37 CFR 1.135(c) is applicable only when the missing matter or lack of compliance is considered by the examiner as being "inadvertently omitted." For example, if an election of species has been required and applicant does not make an election because he or she believes the requirement to be improper, the amendment on its face is not a "bona fide attempt to advance the application to final action" (37 CFR 1.135(c)), and the examiner is without authority to postpone decision as to abandonment." In this instance, the extendable time period for responding to the Restriction requirement would have expired on September 18, 2008. As the reply filed August 18, 2008 was not a bona fide attempt to advance the application to a final Office action, examiner was not bound by 37 CFR 1.135 in providing a further extendable period of reply.

Petitioner also raises 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 (the election by an applicant in reply to a requirement for restriction by the examiner) 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

² Any patent term adjustment under 35 U.S.C. § 154(b) will be indicated on the notice of allowance if the Office subsequently allows the instant application after an examination on the merits. See 37 CFR 1.705. Any complaint about the patent term adjustment indicated on any notice of allowance that issues in the instant application must be presented in compliance with 37 CFR 1.705(b) after the Office issues a notice of allowance in this application.

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 (form PTO/SB/21) for any reply to an Office action.

Petitioner argues that the TC Director’s decision did not rule on petitioner’s request that the PTO comply with the OMB’s Good Guidance Practices directive. Section 11 of Executive order 12866 expressly indicates that: “[t]his Executive order is intended only to improve the internal management of the Federal Government and does not create any right or benefit, substantive or procedural, enforceable at law or equity, against the United States, its agencies or instrumentalities, its officers or employees, or any other person.” See Executive Order 12866 of September 30, 1993; Regulatory Planning and Review, 58 Fed. Reg. 51735 (Oct. 4, 1993). The Bulletin on Good Guidance Practice is a bulletin issued by OMB in a Federal Register notice entitled Final Bulletin for Agency Good Guidance Practices, published at 72 Fed. Reg. 3432 (Jan. 25, 2007). Similar to Executive order 12866, the Final Bulletin for Agency Good Guidance Practices expressly indicates that: “[t]his Bulletin is intended to improve the internal management of the Executive Branch and is not intended to, and does not, create any right or benefit, substantive or procedural, enforceable at law or equity, against the United States, its agencies, or other entities, its officers or employees, or any other person.” See Final Bulletin for Agency Good Guidance Practices, 72 Fed. Reg. at 3440. Any person may bring issues of alleged non-compliance on the part of the USPTO with Executive order 12866 or the Final Bulletin for Agency Good Guidance Practices to the attention of the Department of Commerce or the Office of Management and Budget; however, petitioners’ issues concerning compliance or non-compliance with Executive order 12866 or the Final Bulletin for Agency Good Guidance Practices do not provide a basis for setting aside or otherwise disturbing the Technology Center Director’s decision in the above-identified application. See, e.g., Teledyne, Inc. v. United States, 50 Fed. Cir. 155, 190 (Fed. Cir. 2001) (plaintiff cannot rely upon an Executive order that, by its plain terms, precludes judicial review of an agency’s compliance with its directive as a basis for challenging agency action).

Finally, the rules of practice (37 CFR 1.181(e)) provide that an oral hearing will not be granted except when considered necessary by the Director. The USPTO has a well established policy of deciding petitions solely on the basis of the written record. See In re application of Koppolu, 2002 Comm’r Pat. LEXIS 4, at *12-13 (Comm’r Pat. 2002). Since there is nothing that can be brought to the attention of the USPTO during an interview or hearing that is not more properly brought to the attention of the USPTO in writing in this situation, pursuant to 37 CFR 1.2, the circumstances at issue do not present a circumstance necessitating an interview. Indeed, a review of the instant petition indicates that there is nothing so unusual or extraordinary in this case warranting an interview.

CONCLUSION

The petition is granted to the extent that the decision of the TC Director of March 4, 2011 has been reviewed; however, the petition is **denied** with respect to making any changes to or otherwise disturbing the TC Director's decision of March 4, 2011.

The address listed on the petition differs from the correspondence address of record. While a courtesy copy of this decision is being mailed to the person signing the petition at the address listed on the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.



Andrew H. Hirshfeld
Associate Commissioner for
Patent Examination Policy

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