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OFFICE OF PETITIONS

In re Application of :  
Tim Klapka et al. :  
Application No. 10/497,852 : ON PETITION  
Filed: June 7, 2004 :  
Attorney Docket No. PIP-93-KLAP-US :

This is a decision on the petition filed March 25, 2010, which is being treated as a petition under 37 CFR 1.181 to review the decision of the Technology Center Director mailed July 21, 2009 and under 37 CFR 1.59 requesting that various Office communications and applicant responses, be expunged from the record.

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

The petition under 37 CFR 1.59 is **DENIED**.

In petitioner's statement of the relief requested, two requests are made. First, petitioner requests reinstatement of applicants' Appeal Brief filed December 6, 2008. Second, petitioner requests that three Office communications and three responses by applicants be "withdrawn" from consideration.

It would appear that petitioner is under the impression that by withdrawing the papers indicated, the Office would, in effect, turn back the examination process to the Appeal Brief filed December 6, 2008. Thus, the request to withdraw papers must be considered first.

As to the petition filed under 37 CFR 1.59:

Petitioner requests that the following papers be "withdrawn" from consideration:

Notice of Non-Compliant Appeal Brief, mailed April 16, 2009

The Non-Final Office action mailed April 21, 2009

The response to the Notice of Non-Compliant Brief, filed May 12, 2009

The Appeal Brief filed July 17, 2009

The Examiner's Answer mailed January 22, 2010

The Reply Brief filed March 3, 2010

The above listed papers, both the Office communications and the responses, were intended for the above identified application and are properly part of the application file. The only mechanism to withdraw them from consideration at this point in prosecution is to have them expunged from the file. Accordingly, the only way to consider petitioner's request is to treat it as a request to expunge papers under 37 CFR 1.59.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

The requested expungement of the contested Office communications would have the effect of vacating those actions. However, vacatur of an Office action is an extreme act and is appropriate only in exceptional situations such as where the examiner clearly lacked jurisdiction of the case at the time that the contested Office communication was issued. See Ex Parte Brunner, 1872 Dec. Comm'r Pat. 62, 63 (Comm'r Pat. 1872) (Commissioner vacating examiner's Office action which reopened prosecution as the examiner then lacked jurisdiction of the case). Merely because an applicant contends that a given action contains an improper rejection or requirement per se is not an adequate reason for removing that action in its entirety from the administrative record, but is merely the basis for seeking reconsideration of the action, see, e.g. 37 CFR 1.111(b).

The exchange of communications (Office actions and replies by the applicant) form the prosecution history of the issued patent, which is relied upon by the courts and the public to determine the scope and meaning of the patent. See, e.g., Phillips v. AWH Corp., 415 F.3d 1303 (Fed. Cir. 2005). Therefore, the Office has a long-established practice of expunging information from the file record of an application only in very limited situations. Indeed, expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. Even where expungement is warranted for an Office communication, a redacted version is maintained in the file; only the offensive language is removed.

While petitioner may disagree with some of the contents of the contested Office communications, the USPTO has also long held that a mere difference in opinion does not warrant expungement of part or all of a contested communication from the file record. See e.g.,

Ex Parte Fox, 1910 Dec. Commissioner Pat. 123 (Comm'r Pat. 1910). The MPEP makes clear that the expungement of record information should occur in very limited situations. See MPEP § 724.05. That particular section of the MPEP and referenced-sections (e.g., MPEP § 724.02) address the following types of information as subject (or susceptible) to possible expungement:

- 1) trade secret information;
- 2) proprietary information;
- 3) protective order material;
- 4) unintentionally-submitted information; and
- 5) information submitted in a wrong application.

The above situations are the only known types of circumstances which have led to information expungement. Clearly none of the above apply here. Petitioner has not alleged that the contested Office communications include any trade secret, are proprietary in nature, are subject to a protective order, or contains language that is inconsistent with the USPTO's own requirement for courtesy and decorum in the written record. It is also evident that the information was not wrongly submitted, and the examiner had jurisdiction of the case at the time the contested communication was issued.

Likewise, applicants' listed responses to be removed from consideration are not seen to meet the above criteria for expungement based on information provided in the instant petition. Should petitioner consider the filed responses as unintentionally-submitted information, it should be noted that MPEP 724.05 II. (B) requires:

It is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

Petitioner made no such statement in the petition. There is no indication of any irreparable harm to the party that submitted the responses. Accordingly, no adequate basis is given or apparent for expunging the contested Office communications.

For the reasons given above, the petition under 37 CFR 1.59 to expunge the Office communications and responses identified in the petition, is **denied**.

The fee for a petition filed under 37 CFR 1.59 has been charged to petitioner's deposit account.

As to the petition filed under 37 CFR 1.181:

Petitioner requests reinstatement of the Appeal Brief filed December 6, 2008. Petitioner's argument with respect to 37 CFR 41.31 is noted. However, petitioner's position that an amendment and an appeal can be filed in response to a second Office action is not well taken. Once an amendment is received from applicant the period for response is tolled and reexamination must occur, see 35 USC 132.

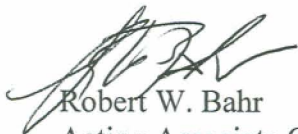
The rules, practices and procedures provide for a method of orderly examination of a patent application and despite his intentions otherwise, it would not be proper to file both a reply to an outstanding Office action in the form of an amendment under 37 CFR 1.111 and an appeal brief. Either one of these responses exclusive of the other would have been an appropriate response to the non-final action mailed July 25, 2008. It was not proper procedure to file both responses and reference is made to the TC Director's petition decision of July 21, 2009 for a discussion of this issue.

Since the request to withdraw from consideration (expunge) the various Office communications and applicants' responses filed after the December 6, 2008 Appeal Brief is dismissed, the Appeal Brief filed December 6, 2008 cannot be reinstated as it has been superseded by the Appeal Brief filed September 11, 2009 and the Reply Brief filed March 3, 2010.

For the reasons set forth above, the petition to reinstate the Appeal Brief filed December 6, 2008 is **denied**.

Petitioner raises the issue of loss of Patent Term Adjustment (PTA) on page 9 of the petition. The patent term adjustment consequences are a result of petitioner's actions during the prosecution of this application. Therefore, patent term adjustment issues are not a basis for granting the requested relief.

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



Robert W. Bahr  
Acting Associate Commissioner  
For Patent Examination Policy

ak/cf