



Paper No. 22

JAGTIANI + GUTTAG
10363-A DEMOCRACY LANE
FAIRFAX VA 22030

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JAN 12 2006

OFFICE OF PETITIONS

**DECISION ON
PETITION**

In re Application of
Voelkel
Application No.: 09/562,817
Filed: May 1, 2000
For: SHOCK ABSORBER

This is a decision on the petition under 37 CFR 1.181(a)(3) filed on October 18, 2002, requesting that the supervisory authority of the Director be invoked to overturn the decision of the Group Director of Technology Center 3600 (Group Director) mailed August 20, 2002.

The petition under 37 CFR 1.181(a)(3) to overturn the decision of the Group Director is **DENIED**.

BACKGROUND

A non final office action was mailed June 6, 2001, in which claims 1 through 6 and 8 through 16 were rejected as anticipated by the Kovosladanyi et al. reference, and held claims 7 and 17 through 21 withdrawn from further consideration as drawn to the non-elected invention.

An interview was held on July 18, 2001 and as memorialized by the Examiner's Interview Summary dated July 18, 2001, the forthcoming amendment would focus on claiming the top pieces of the shock absorber specifically in the area of the distal mount.

A reply was filed on September 6, 2001, which referred to above-noted interview and presented extensive amendments to the specification and claims along the lines discussed during the interview.

A final office action was mailed October 16, 2001, which rejected claims 1 through 6 and 8 through 16, and held claims 7 and 17 through 21 withdrawn for consideration. The final Office action contained a rejection under 35 U.S.C. 112 ¶ 2 of claim 12 as indefinite; a rejection of claims 1 through 3, 5, 6, and 8 through 16 under 35 U.S.C. § 102(b) as anticipated by Gilsdorf et al. (Gilsdorf); a rejection of claims 1 through 3, 5, 6, and 8 through 16 under 35 U.S.C. § 102(e) as anticipated by Raulf et al. (Raulf); and a rejection of claim 4 under 35 U.S.C. § 103(a) as obvious over Gilsdorf taken with Marshall.

A reply after final rejection under 37 CFR 1.116 and a Notice of Appeal were filed January 16, 2002. The reply amended claim 12 to overcome the rejection on indefiniteness, and requested that the examiner provide an affidavit under 37 CFR 1.104(d)(2) to support the examiner's assertions made in the statements of the rejections, in that as the applied references did not specifically disclose several features mentioned by the examiner, the examiner must be relying on facts solely within his personal knowledge.

An Advisory Action (Advisory) was mailed January 28, 2002, which refused entry of the amendment of January 16, 2002, on the grounds that no apparent changes to the claims had been made. The Advisory Action also included an additional statement wherein the examiner elaborated on his interpretation of the disclosures of the applied references.

The Appeal Brief (Brief) was filed March 18, 2002. The Brief, contended, *inter alia*, that the rejections on the grounds of anticipation must necessarily fall, as the applied references failed to teach or suggest all the elements recited in the claims.

A petition was filed March 28, 2002. The petition requested, *inter alia*, that the Group Director review and withdraw the finality of the Office action of October 16, 2001, as premature; complained that the Advisory raised a new ground of rejection, requested that the examiner be required to furnish an affidavit under 37 CFR 1.104(d)(2), and requested entry of the amendment filed January 16, 2002.

The Examiner's Answer (Answer) was mailed March 29, 2002. The Answer newly indicated (at 2) that the reply filed under 37 CFR 1.116 on January 16, 2002, had been entered as overcoming the indefiniteness rejection, and that claim 4 contained allowable subject matter. The Answer also contained (at 3, 8) the examiner's continued refusal to supply the affidavit requested by applicant in that the references, as interpreted by the examiner, were considered to clearly disclose the claimed invention.

On May 29, 2002, appellant filed a Reply Brief.

The petition was denied in the Group Director's decision of August 20, 2002. The decision, *inter alia*, upheld the finality of the Office action of October 16, 2001, declined to compel the examiner to produce an affidavit under 37 CFR 1.104(d)(2), and noted that the Answer's entry of the January 16, 2002, reply mooted the need for review of that issue.

The instant petition was filed October 18, 2002.

On November 15, 2002, the Board of Patent Appeals and Interferences returned this application to the examiner in that the examiner had not treated the reply brief.

STATUTE, REGULATION, AND EXAMINING PROCEDURE¹

35 U.S.C. § 2(b)(2)(A) provides that:

The USPTOmay, subject to the policy direction of the Secretary of Commerce, establish regulations, not inconsistent with law, which shall govern the conduct of proceedings within the Office.

37 CFR 1.104 provides in pertinent part²:

(c)(3) In rejecting claims, the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceedings, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section....

(d)(2) When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant or other persons.

MPEP 2144.03 states in pertinent part:

Reliance on Common Knowledge in the Art or "Well Known" Prior Art

In limited circumstances, it is appropriate for an examiner to take official notice of facts not in the record or to rely on "common knowledge" in making a rejection, however such rejections should be judiciously applied.

PROCEDURE FOR RELYING ON COMMON KNOWLEDGE OR TAKING OFFICIAL NOTICE

The standard of review applied to findings of fact is the "substantial evidence" standard under the Administrative Procedure Act (APA). See *In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000). See also MPEP § 1216.01. In light of recent

¹Manual of Patent Examining Procedure, ("MPEP")(8th Ed., Aug. 2001)

² The notice "Changes to Patent Practice and Procedure; Final Rule" set forth at 62 FR 53132, 53150 (Oct. 10, 1997), removed and reserved 37 CFR 1.107 which contained sections (a) and (b) (respectively: citation of references, and affidavits attesting to personal knowledge of a USPTO employee) and that subject matter was transferred to § 1.104(d)(1) and (2), respectively.

Federal Circuit decisions as discussed below and the substantial evidence standard of review now applied to USPTO Board decisions, the following guidance is provided in order to assist the examiners in determining when it is appropriate to take official notice of facts without supporting documentary evidence or to rely on common knowledge in the art in making a rejection, and if such official notice is taken, what evidence is necessary to support the examiner's conclusion of common knowledge in the art...

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding With Adequate Evidence

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. If applicant adequately traverses the examiner's assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 ("[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings" to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2).

OPINION

Petitioner requests that the Group Director's decision be overturned such that the examiner be directed to (1) re-open prosecution to provide the requested affidavit under 37 CFR 1.104(d)(2), or, in the alternative, (2) withdraw the rejection that prompted applicant's request for the affidavit.

However, a review of the record fails to reveal reversible error in the decision of the Group Director. That review further fails to reveal that the examiner has, either expressly or by implication, based any rejection in whole or in part on a fact(s) within his personal knowledge within the meaning of 37 CFR 1.104(d)(2) and MPEP 2144.03, such that an examiner affidavit or declaration was properly requested by applicant.

The statement of the rejections made in the final Office action of October 16, 2001, includes the examiner's comments: (at 2) "[p]lease note *Gilsdorf et al.* discloses (sic) all the features required by claim 1. Note figure 2a. Note the distal mount at 19 to which the rubber element is attached.

Note the piston assembly in the area of 36 and that the rod appears to move through element 19. Note the contacting means could be that portion (unlabeled) at the top of the rod;" at (3) "claims 5, 6, 8 through 16 these requirements are met as clearly seen in the drawings;" further at (3) "regarding claims 1-3, 5, 6, 8-16 Raulf et al. shows (sic) all the features required as clearly seen in the drawings," which all demonstrate that the examiner was relying on the disclosures --including the drawings--of the Gildsorf and Raulf references, and all reasonable inferences therefrom to reject the claims. Inspection of the comments made by the examiner in the Advisory Action of which petitioner complains reveals that the examiner was still relying on the facts disclosed in, and any inferences from, the Gildsorf and Raulf references: e.g., "note that as broadly claimed by applicants 'slidably' only requires that the mount 19 of Gildsorf et al. be capable of sliding along the rod...It is at least 'slidably engaging' the rod...during assembly of the device."

As noted in In re Hilmer, 359 F.2d 859, 879, 149 USPQ 480, 496 (CCPA 1966):

Much confused thinking could be avoided by realizing that rejections are based on statutory provisions, not on references, and that the references merely supply the evidence of lack of novelty, obviousness, loss of right or whatever may be the ground of rejection.

Here, the statements of the rejections by examiner rely exclusively on the evidence supplied by the Gildsorf, Raulf, and Marshall references; there is simply no additional, extrinsic evidence being relied upon. In neither the final Office action nor the Advisory Action did the examiner expressly or impliedly also make a finding as to what was known in the art, or make any statement as to his personal knowledge or finding as to what was known in the art. The examiner's statements of the rejections are conspicuously devoid of any language indicating that "official notice" was being taken, or that the examiner was relying upon "common knowledge" or that something was "well known" or "conventional in the art" or "old in the art," which are common indicia of the taking of official notice, or the advancement of a fact within the knowledge of the USPTO employee. See e.g., In re Shapleigh, 115 USPQ 129, 133, n.2 (CCPA 1957)([t]he board's statement as to what was conventional in the tubular furnace art is a statement of fact within the knowledge of an employee of the Patent Office...). In other words, the examiner did not advance or try to prove any fact(s) whatsoever beyond those already disclosed in, or what could be inferred from, the Gildsorf Raulf, and Marshall references. It is well settled that the express, implicit, and inherent disclosures in a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. § 102 or § 103. See In re Napier, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995)("[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness."); In re Preda, 401 F.2d 825, 828, 159 USPQ 342, 344 (CCPA 1968)("[i]n considering the disclosure of a reference, it is proper to take into account not only specific teachings of the reference but also inferences which one skilled in the art would reasonably be expected to draw therefrom."); In re Shepard, 319 F.2d 194, 138 USPQ 148 (CCPA 1963)(same).

While petitioner obviously does not agree with the examiner's determination as to whether the limitations of the instant claims are found in the specific disclosures of the Gildsorf, Raulf, and

Marshall references, or by way of any inferences that he may have also drawn therefrom, this difference(s) of opinion(s) does not mean that the examiner has, *ipso facto*, made a rejection in whole or in part on a fact(s) within his personal knowledge. Rather, when, as here, the examiner's rejections are solely based on facts and inferences drawn from the references as the sole evidence of record, and is not based on additional facts within the personal knowledge of the examiner, a requested declaration under 37 CFR 1.104 is properly refused. See In re Uhlig, 376 F.2d 320, 324, 153 USPQ 460, 463 (CCPA 1967)(when the rejection of the claims is based upon conclusions drawn from the evidence in the record and is not based on facts within the personal knowledge of any employee in the Patent Office, there is no cause for producing a Rule 1.104 affidavit); see also In re Jacobson, 407 F.2d 890, 896, 160 USPQ 795, 800 (CCPA 1969)([t]he mere failure of a reference to state the obvious is not cause for producing an affidavit [under 37 CFR 1.104]).

Petitioners' remaining arguments are, in essence, that the contents of the references, or the form of the rejections and the supportive reasoning, or both, are facially insufficient to sustain the rejection(s) of record, and as such, the rejection(s) should be withdrawn in the absence of the requested affidavit. Nevertheless, as such arguments go more to the merits of the rejections, as opposed to the procedural question of supplying an affidavit under 37 CFR 1.104(d)(2), they will not be further addressed on petition. See Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468 (DC EVa 2004), *appeal dismissed*, 2004 U.S. App. LEXIS 26384 (Fed. Cir. 2004). Any review of the rejection(s) of which petitioner complains is limited to a merits appeal as provided by 35 U.S.C. § 134, and not by way of petition. Id. It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the BPAI. See In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA 1962); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat. 1971).

DECISION

The instant petition is granted to the extent that the decision of the Group Director has been reviewed, but is **denied** as to making any change therein. Prosecution remains closed, and the examiner will **not** be instructed to prepare an affidavit or declaration under 37 CFR 1.104(d)(2). Likewise, the request for withdrawal, on petition, of any rejection of record is **denied**. This decision may be regarded as a **final agency action** within the meaning of 5 U.S.C. § 704.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.



Robert W. Bahr
Senior Patent Attorney
Office of the Deputy Commissioner
for Patent Examination Policy