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ISHIMARU & ZAHRT LLP
333 W. EL CAMINO REAL
SUITE 330
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OFFICE OF PETITIONS

In re Application of :
Frederick G. KING et al. :
Application No. 10/358,813 : DECISION ON PETITION
Filed: February 4, 2003 :
Attorney Docket No. 21-009 :

This is a decision on the petition under 37 CFR 1.181 (a)(3), filed July 25, 2006, requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 2600 (Technology Center Director), dated May 25, 2006, which refused to withdraw the requirement by the examiner to provide suitable legends for the drawings.

The petition to overturn the decision of the Technology Center Director dated May 25, 2005, is **denied**.

Petitioner seeks reversal of the Technology Center Director's decision of May 25, 2006, on the grounds that the examiner failed to follow established PTO practice and procedures in making and improperly maintaining an unnecessary and inappropriate drawing requirement, and that the Director, Technology Center 2600, erred in denying the petition for relief from the examiner's drawing requirement. Petitioner relies, *inter alia*, on MPEP 707.07(f) and PCT Rule 11.11 in support of his contention that the examiner's position is inconsistent with the Rules of the USPTO and his contention that the requirement of the Examiner is virtually prohibited by modern international (PCT) practice. Petitioner further contends that the examiner continually refused to respond to the Applicants' arguments traversing the drawing requirement, such refusal being at odds with MPEP 707.07(f).

The Technology Center Director correctly noted that 37 CFR 1.84(o) permits the use of legends, which can be required by the examiner for proper understanding of the drawings. Although not germane to the present application filed under 35 USC 111(a), PCT Rule 11.11 also permits the use of legends to facilitate understanding of the drawings, especially when such legends are used in conjunction with diagrams of electric circuits and block schematic or flow sheet diagrams.

37 CFR 1.84(n) and (o) permit *use of symbols* which are not universally recognized, subject to approval by the Office, if they are not likely to be confused with existing conventional symbols, and *if they are readily identifiable*. In addition, *suitable descriptive legends* may be used subject

to approval by the Office, or *may be required by the examiner* where necessary for understanding of the drawing (emphasis added). Thus the examiner may require, on a case-by-case basis, the use of descriptive legends where it is believed that such will facilitate a clear understanding of the drawings without undue reliance on the specification for understanding of the subject matter depicted therein. "When possible, a drawing should be so complete that the purpose and operation of the invention may be readily understood by one skilled in the art by means of a mere inspection of said drawing. The necessity of reading the specification in connection with the drawing should be avoided, if possible." See Ex Parte Hartley, 1901 C.D. 247 (Comm'r Pat. 1901). It follows that the Technology Center Director did not clearly err in upholding the Examiner's objection to the drawings.

Petitioner's contention that MPEP 707.07(f) expressly requires that the examiner answer or rebut the Applicants' response(s) is unpersuasive. Petitioner relies upon MPEP 707.07(f), in part:

> "Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it."
>
> and
>
> "The importance of answering applicant's arguments is illustrated by *In re Herrmann*, 261 F.2d 598, 120 USPQ 182 (CCPA 1958) where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable. See also *In re Soni*, 54 F.3d 746, 751, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (Office failed to rebut applicant's argument)."

The selections from MPEP 707.07(f) relied upon by petitioner speak to developing the prosecution history with respect to certain rejections and claimed features of the invention, rather than addressing certain objections made on the record.

Petitioner additionally relies upon the an unpublished decision by the Board of Patent Appeals and Interferences in *Ex parte Schricker*:

> "The examiner has left applicant and the board to guess at the basis of the rejection and after having us guess would have us figure out (i.e. further guess) what part of which [prior art] document supports the rejection. We are not good at guessing; hence, we decline to guess." *Ex parte Schricker*, 56 USPQ2d 1723 (B.P.A.I. 2000) (unpublished).

Petitioner seems to be unaware that a rejection, or the continuation of a rejection, cannot be reviewed on petition; rather, as explained in MPEP 1201, the mechanism for having the propriety of a given rejection reviewed is by way of appeal before the Board of Patent Appeals and Interferences under 35 U.S.C. §134 and 37 C.F.R. 41.31.

In the final Office action, mailed January 10, 2006, the examiner addresses petitioner's arguments, but maintains his position. To this end, petitioner provides copies of other patent

drawings seen in numerous U.S. patents issuing every week that have what petitioner deems to be "complex" drawings without textual legends, and in which, in petitioner's opinion, the drawings are virtually impossible to understand without reference to the accompanying specification. Petitioner speculates:

> "...it is considered and understood that these drawings can be understood without textual matter in the drawings and that such textual matter is not necessary for the understanding thereof. Representative examples from numerous arts are attached hereto in the Exhibit at the end of this Petition. The drawings of the present application are in complete accord therewith, being fully explained in the application specification as shown in the Responses quoted in the Appendix." (emphasis by petitioner).

Petitioner's speculation that the above-mentioned drawings are complex in nature is misplaced in view of 37 CFR 1.84 (n) and (o) which bestow upon *the examiner* the discretion to require symbols and descriptive legends where deemed necessary for understanding of the drawing (emphasis added). Petitioner's arguments are also contrary to the admonition against relying solely upon a reading of the specification in connection with the drawing to gain an understanding of the drawings. See Hartley, supra. Petitioner has not, at any point in the prosecution, demonstrated that the symbols used in the drawings of the *instant application* have a universally-recognized conventional meaning and are generally accepted in the art (emphasis added).

While petitioner is understandably unhappy with the need to provide amended drawings sheets in the instant application, petitioner has not demonstrated that either the examiner or the Technology Center have acted out of administrative arbitrariness in either making or sustaining, respectively, the objection to the drawing figures.

DECISION

For the reasons given above, petitioner has failed to adequately demonstrate reversible error in the decision of the Technology Center Director. The petition is granted to the extent that the decision of the Technology Center Director, dated May 25, 2006, has been reviewed but is **denied** as to the request that the aforementioned decision be overturned The objection to the drawings advanced in the Office letters of November 4, 2004, January 10, 2006, and July 19, 2006, will not be disturbed. This decision may be viewed as a final agency action within the meaning of 5 U.S.C. §704 for purposes of seeking judicial review of the petitionable questions only. See MPEP 1002.02.

This application is being returned to Technology Center 2600 for further processing.

Telephone inquiries related to this decision should be addressed to Petitions Examiner BethAnne Dayoan at (571) 272-3209.

John J. Love
Deputy Commissioner for
Patent Examination Policy

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