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**OFFICE OF PETITIONS**

In re Application of  
Richard G. Hyatt, Jr.  
Application No. 10/440,308  
Filed: May 19, 2003  
Attorney Docket No.: P56895

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**ON PETITION**

This is a decision on the petition filed July 23, 2007 under 37 CFR 1.181(a)(3) requesting that the Director exercise his supervisory authority and overturn the decision of the Director, Technology Center 3600 (Technology Center Director), dated May 23, 2007, which refused to compel the entry of the Reply Brief filed July 7, 2006 and the Substitute Reply brief filed October 11, 2006.

The petition to overturn the decision of the Technology Center Director dated May 23, 2007, is **DENIED**<sup>1</sup>.

### BACKGROUND

An Appeal Brief was filed on March 11, 2005 and a Substitute to the March 11, 2005 Appeal Brief was filed March 9, 2005.

On April 1, 2005, a Notification of Non-Compliant Appeal Brief was mailed indicating that the Substitute Appeal Brief does not present an argument under a separate heading for each ground of rejection on appeal.

A Supplement to the Appeal Brief was filed August 1, 2005.

On November 14, 2005, a Notification of Non-Compliant Appeal Brief was mailed indicating that the brief does not contain a statement of the status of all claims or does not identify the appealed claims.

A Supplement to the Appeal Brief was filed December 14, 2005 with a Petition to the Technology Center Director under 37 CFR 1.181 requesting entry of this Supplement to the Appeal Brief.

The petition to the Technology Center Director was granted on April 10, 2006.

On May 2, 2006, an Examiner's Answer was mailed.

A Reply Brief and Request for Oral Hearing was filed on July 7, 2006.

On August 7, 2006, a letter was mailed indicating that the Reply Brief was not considered because it contained new evidence and thus, was not in compliance with 37 CFR 41.41(a), and that the Information Disclosure Statement (IDS) filed with the reply brief did not comply with 37 CFR 1.97 and 1.98.

On October 10, 2006, a petition was filed requesting entry of a Substitute Reply Brief, which was filed October 11, 2006.

On December 14, 2006, a decision denying the October 10, 2006 petition was mailed, and, on December 20, 2006, a letter was mailed indicating that the Substitute Reply Brief would not be entered for the same reasons the Reply Brief was not entered.

On February 14, 2007, a request for reconsideration of the petition decision of December 14, 2006 was filed.

On May 23, 2007, a decision was mailed denying the February 14, 2007 request for reconsideration.

The instant petition was filed July 23, 2007.

On February 4, 2008, the Board of Patent Appeals and Interferences returned the present application for consideration of the instant petition.

#### **STATUTE, REGULATION, AND EXAMINING PROCEDURE**

37 CFR 41.33(d)(2) states:

All other affidavits or other evidence filed after the date of filing an appeal pursuant to § 41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

37 CFR 41.41 states:

(a)(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(2) A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(b) A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.

(c) Extensions of time under § 1.136 (a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136 (b) of this title for extensions of time to reply for patent applications and § 1.550 (c) of this title for extensions of time to reply for ex parte reexamination proceedings.

37 CFR 1.97 (d) states:

(d) An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

- (1) The statement specified in paragraph (e) of this section; and
- (2) The fee set forth in § 1.17(p).

37 CFR 1.98 states:

(a) Any information disclosure statement filed under § 1.97 shall include the items listed in paragraphs (a)(1), (a)(2) and (a)(3) of this section.

(1) A list of all patents, publications, applications, or other information submitted for consideration by the Office. U.S. patents and U.S. patent application publications must be listed in a section separately from citations of other documents. Each page of the list must include:

(i) The application number of the application in which the information disclosure statement is being submitted;

(ii) A column that provides a space, next to each document to be considered, for the examiner's initials; and

(iii) A heading that clearly indicates that the list is an information disclosure statement.

- (2) A legible copy of:

- (i) Each foreign patent;
  - (ii) Each publication or that portion which caused it to be listed, other than U.S. patents and U.S. patent application publications unless required by the Office;
  - (iii) For each cited pending unpublished U.S. application, the application specification including the claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and
  - (iv) All other information or that portion which caused it to be listed.
- (3)(i) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein.
- (ii) A copy of the translation if a written English-language translation of a non-English-language document, or portion thereof, is within the possession, custody, or control of, or is readily available to any individual designated in § 1.56(c).
- (b)(1) Each U.S. patent listed in an information disclosure statement must be identified by inventor, patent number, and issue date.
- (2) Each U.S. patent application publication listed in an information disclosure statement shall be identified by applicant, patent application publication number, and publication date.
  - (3) Each U.S. application listed in an information disclosure statement must be identified by the inventor, application number, and filing date.
  - (4) Each foreign patent or published foreign patent application listed in an information disclosure statement must be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application.
  - (5) Each publication listed in an information disclosure statement must be identified by publisher, author (if any), title, relevant pages of the publication, date, and place of publication.
- (c) When the disclosures of two or more patents or publications listed in an information disclosure statement are substantively cumulative, a copy of one of the patents or publications as specified in paragraph (a) of this section may be submitted without copies of the other patents or publications, provided that it is stated that these other patents or publications are cumulative.
- (d) A copy of any patent, publication, pending U.S. application or other information, as specified in paragraph (a) of this section, listed in an information disclosure statement is required to be provided, even if the patent, publication, pending U.S. application or other information was previously submitted to, or cited by, the Office in an earlier application, unless:

- (1) The earlier application is properly identified in the information disclosure statement and is relied on for an earlier effective filing date under 35 U.S.C. 120; and
- (2) The information disclosure statement submitted in the earlier application complies with paragraphs (a) through (c) of this section.

MPEP 609.05(c) states in pertinent part:

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

For example, if applicant submits and relies on three patents as evidence in reply to the first Office action and also lists those patents on a \*\* PTO/SB/08A and 08B along with two journal articles, but does not file a statement under 37 CFR 1.97(e) or the fee set forth in 37 CFR 1.17(p), it would be appropriate for the examiner to indicate that the teachings relied on by applicant in the three patents have been considered, but to line through the citation of all five documents on the \*\* PTO/SB/08A and 08B and to inform applicant that the information disclosure statement did not comply with 37 CFR 1.97(c).

MPEP 1205.02 (ix) states in pertinent part:

An appendix containing copies of any evidence submitted pursuant to 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See 37 CFR 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

### OPINION

Petitioner seeks reversal of the Technology Center Director's decision of May 23, 2007, on the grounds that the decision is contrary to the revised Rules and ignores the underlying factual basis presented by the prosecution history of this application.



Accordingly, petitioner requests that the Reply Brief and Substitute Reply Brief be entered and forwarded to the Board of Patent Appeals and Interferences (the Board); that each item of "new evidence" alluded to in the Office communication characterized as paper number 20060803 be identified; and that applicant be accorded an opportunity to revise the Reply Brief or Substitute Reply Brief to remove the "new evidence." Alternatively, petitioner requests confirmation that the Director has delegated to the Technology Center authorization to refuse to determine the scope and content of the prior art or to ascertain the difference between the prior art and the claims at issue.

In support of these requests, petitioner contends that the decision of the Technology Center Director lacked a legal and factual basis; that no new evidence is presented in either the Reply Brief or Substitute Reply Brief; that Office communication characterized as paper number 20060803 did not state a reason for non-compliance with 37 CFR 41.41 since no non-admitted affidavit or other evidence was identified, and the new evidence and reason for non-compliance identified in the Technology Center Director's decision ignored the function of the Reply Brief and the novel statements, assertions and interpretations contained in the Examiner's Answer; that no non-admitted affidavit or other evidence is present in either the Reply Brief or Substitute Reply Brief; and that discussion of the references introduced in the Reply Brief and repeated in the Substitute Reply Brief is necessary to address the arguments presented in the Examiner's Answer in regard to the rejection of the claims under 35 USC 103.

The decision of the Technology Center Director cites the "new evidence" at issue as 22 references listed on the PTO 1449, Information Disclosure Statement (IDS), located in the Evidence Appendix of the Reply Brief and Substitute Reply Brief, which fulfills the request that each item of "new evidence" be identified. Also, a careful review of the prosecution history of the present application reveals that the US patents identified in the Evidence Appendix of the Reply Brief and Substitute Reply Brief in relation to US patent number 5,552,777 were cited on IDSs filed prior to the final rejection and considered by the examiner in this application. However, four European patents and one Swiss patent identified in relation to US patent number 5,542,274 were not previously cited on an IDS or on a PTO 892, Notice of References Cited by the examiner, in this application.

The fact that a patent is "evidence" with respect to the prosecution of a patent application is well established. For example, MPEP section 609.05(c) recognizes that a patent is a type of document that may be submitted in a patent application as evidence directed to an issue of patentability raised in an Office action. Also, both the Reply Brief and Substitute Reply Brief identify the foreign patents in question in an "Evidence" Appendix.

The issue is whether these foreign patents are "new" evidence under 37 CFR 41.41. Petitioner asserts that these patents are not "new" evidence since they were discussed in US 5,542,274, which was considered by the examiner. However, these references were only briefly mentioned in the background section of US 5,542,274 in relation to the state of the art, and were not incorporated in their entirety into US 5,542,274 for full consideration of their respective disclosures. As correctly recognized by the Technology Center Director, these foreign patents are new evidence under 37 CFR 41.41 since the examiner did not previously confirm their full consideration on an IDS or a Notice of References Cited.

An orderly and fair administrative process necessitates that, in the context of patent appellate review, a reviewing body not consider prior art references that were not previously considered. See In re Thrift, 298 F.3d 1357, 1367 [63 USPQ2d 2002] (Fed. Cir. 2002)(refusing to sustain an obviousness rejection based on a new prior art reference not relied on by the Board because it would require a determination of the scope of that reference and whether it provided a motivation to combine); In re Margolis, 785 F.2d 1029, 1031-32 [228 USPQ 940] (Fed. Cir. 1986)(refusing to consider anticipation and obviousness grounds based on prior art references submitted to the examiner but not considered by the examiner or the Board). Therefore, in accordance with the regulations governing appeal to the Board of Patent Appeals and Interferences, references presented to the Board in support of appellant's arguments against obviousness must have been considered by the examiner and not merely available to the examiner.

The Technology Center Director's reference to 37 CFR §§ 41.41, 1.97 and 1.98 and the corresponding explanation as to how these regulations pertain to the circumstances of the present application provided sufficient legal and factual basis for his decision. Moreover, the Technology Center Director correctly recognized the function of the Reply Brief within an orderly and fair appeal process in denying the admission of new evidence. 37 CFR 41.33(d)(2) is clear that evidence filed after the date of filing an appeal may only be introduced if prosecution is reopened and the appeal withdrawn. Also, MPEP 1205.02 (ix) notes, in regard to an evidence appendix in the appeal process, that unentered evidence is not permitted and that 37 CFR 41.33 governs the treatment of evidence presented after appeal. Since prosecution has not been reopened in this application and the statements, assertions, and interpretations presented in the Examiner's Answer do not amount to new grounds of rejection, the Technology Center Director was correct to prevent the entry of the new evidence in reply to the Examiner's Answer. Moreover, preventing the entry of the new evidence does not deny appellant his last word arbitrarily since 37 CFR 41.41 forbids the entry of new evidence in a reply brief.

In regard to the requested revision of the Reply Brief and Substitute Reply Brief to remove the new evidence, the issue at hand is not whether petitioner in good faith

followed the rules as he interpreted them; rather it is whether petitioner has properly followed the statutes and regulations with the exercise of reasonable care and diligence in this instance. In the present case, petitioner filed a Reply Brief and a Substitute Reply Brief with new or non-admitted evidence therein. As the Technology Center Director correctly noted, a revised Reply Brief cannot be filed at this time since it would be outside the time period for filing a Reply Brief set forth in 37 CFR 41.41(a)(1). Also, petitioner has not shown that the failure to timely file an acceptable Reply Brief is an extraordinary situation in which justice requires waiver of the rules. Circumstances resulting from Appellant's, or Appellant's counsel's, failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

For the reasons set forth above, the Technology Center Director's decisions to refuse petitioners' request to have the Reply Brief filed June 7, 2006 and the Substitute Reply Brief filed October 11, 2006 entered and forwarded to the Board are not shown to be in clear error. Also, the Technology Center Director's decision not to allow revision of the Reply Brief and Substitute Reply Brief to remove the new evidence is not shown to be in clear error.

Furthermore, the Director has not delegated to the Technology Center authorization to refuse to determine the scope and content of the prior art or to ascertain the difference between the prior art and the claims at issue. Determining the scope and content of the prior art and the difference between the prior art and the claims at issue does not require the full consideration of every item of prior art in existence. Here, the Technology Center correctly considered what was determined to be an appropriate amount of prior art to support the opinion on the patentability of the claimed invention presented by the examiner. The scope and content of the considered prior art was determined and the difference between the considered prior art and the claims at issue was ascertained, as demonstrated in the examiner's rejections and Answer to the Appeal Brief.

Petitioner further complains that the examiner has ignored the requirements of 35 USC 103. Petitioner appears to be unaware that a rejection, or the continuation of a rejection, of a claim 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 USC 134 and 37 CFR 1.191. The issues of whether, e.g., the examiner properly analyzed the claims in light of the specification disclosure before making the rejections, or whether the rejections over prior art were properly maintained relate to the merits of those rejections and such can only be considered on appeal and will not be considered on petition. See 37 CFR 1.181(a); see also Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d



1468 (DC Eva 2004), appeal dismissed, 2004 U.S. App. Lexis 26384 (Fed. Cir. 2004). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Board of Patent Appeals and Interferences. 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

A review of the record indicates that the Technology Center Director did not abuse his discretion or act in an arbitrary and capricious manner in the petition decision of May 23, 2007. The record establishes that the Technology Center Director had a reasonable basis to support his findings and conclusion.

The petition is granted to the extent that the decision of the Technology Center Director of May 23, 2007 has been reviewed, but is denied with respect to making any change therein. As such, the decision of May 23, 2007 will not be disturbed. The petition is **denied**.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692.

  
John J. Love  
Deputy Commissioner for  
Patent Examination Policy

cp/db

<sup>1</sup> 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. See MPEP 1002.02.