



INNOVATION DIVISION
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MAILED
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OFFICE OF PETITIONS

In re Application of :
Howard W. Lutnick et al. :
Application No. 10/938,143 : ON PETITION
Filed: September 10, 2004 :
Attorney Docket No. 03-1089CIP :

This is a decision on the petition under 37 CFR 1.181(a)(1) and (3) (entitled "PETITION REQUESTING BONA FIDE DECISION ON PETITION") filed February 17, 2010, requesting that the Director exercise his supervisory authority to review the decision of the Director, Technology Center 3600 (TC Director), dated December 18, 2009, for compliance with 5 U.S.C. § 555(b) and (e) and 37 CFR 1.181(b). The petition also requests that instructions be given to TC Directors to cease reframing issues on petition, and that a bona fide decision be given to the petition filed November 17, 2009.

The petition under 37 CFR 1.181(a)(1) and (3) filed February 17, 2010, is **DENIED**.

BACKGROUND

A requirement for restriction was mailed August 7, 2008.

A response to the restriction requirement was filed on November 7, 2008.

A Notice of Non-Compliant Amendment was mailed January 5, 2009. This Notice indicated that applicant had failed to elect an invention.

A Notice of Abandonment was mailed May 21, 2009.

A petition to the TC Director was filed November 17, 2009.

A petition decision by the TC Director, dismissing the November 17, 2009 petition was mailed December 18, 2009. The decision by the TC Director of December 18, 2009, however, determined that the requirement for restriction was improper, withdrew the requirement for restriction and the holding of abandonment, and returned the application to the examiner to reopen prosecution and consider claims 150 through 186.

A non-final Office action was mailed on January 13, 2010. The Office action of January 13, 2010 does not contain any requirement for restriction.

The instant petition to the Director was filed February 17, 2010.

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 1.144 states that:

After a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested (see § 1.181).

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.

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.

OPINION

Petitioners filed a petition under 37 CFR 1.181(a)(1) and (3) on February 17, 2010, requesting a review of the TC Director's decision mailed December 18, 2009, for compliance with 5 U.S.C. § 555(b) and (e) and 37 CFR 1.181(b). Petitioners also request that instructions be given to TC Directors to cease reframing issues on petition, and that a bona fide decision be given to the petition filed November 17, 2009, which requested that: (1) the requirement for restriction mailed August 7, 2008, the notice of noncompliant amendment mailed January 5, 2009, and the notice of abandonment mailed May 21, 2009 be vacated; (2) the Memorandum entitled "Changes to Restriction form paragraphs" signed by John Love, Deputy Commissioner for Patent Examination Policy on April 25, 2007 (hereafter "the April 25, 2007 memorandum") be vacated; and (3) instructions issued by the President of the United States be implemented.

On August 7, 2008, the examiner issued a restriction requirement under 37 CFR 1.142. Applicant filed a reply to the restriction requirement on November 7, 2008, and subsequently a petition under 37 CFR 1.181 on November 17, 2009.

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 therefore" and applicant must provisionally elect one of the inventions for prosecution in the request for reconsideration. 37 CFR 1.144 provides that "[a]fter a final requirement for restriction, the applicant, in addition to making any reply due on the remainder of the action, may petition the Director to review the requirement." 37 CFR 1.181 provides that a petition may be taken "[f]rom 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."

Petitioners' complaint that the TC Director treated the petition filed on November 17, 2009, as a petition to seek review of the examiner's restriction requirement merely exalts form over substance. 37 CFR 1.181 provides generally for petitions from actions or requirements of an examiner in the *ex parte* prosecution of an application, where 37 CFR 1.144 provides specifically for review of a final restriction requirement by an examiner. 37 CFR 1.144 is specifically applicable to the instant application in which the examiner made a restriction requirement under 37 CFR 1.142, and 37 CFR 1.143 permits applicant to request reconsideration and withdrawal of

a restriction requirement. The TC Director's decision indicated that the TC Director reviewed applicant's arguments and the examiner's restriction requirement, and determined to withdraw the examiner's restriction requirement, which is the result that the TC Director would reach whether the petition is considered as one filed under 37 CFR 1.144 or one filed under 37 CFR 1.181. Thus, the issue of whether the examiner's restriction requirement is proper was decided and resolved in the TC Director's decision. The notice of noncompliant amendment mailed on January 5, 2009, and notice of abandonment mailed on May 21, 2009, were subsequently withdrawn. An Office action on the merits was mailed on January 13, 2010. The petition sought review of the examiner's restriction requirement and petitioners received the full measure of relief that any applicant petitioning from a restriction requirement is entitled to under 37 CFR 1.143, 1.144, and 1.181: withdrawal or modification of the restriction requirement. See 37 CFR 1.143.

Petitioners seem to be unsatisfied with the TC Director's decision because the decision did not vacate the April 25, 2007 memorandum, and the examiner's restriction requirement was withdrawn rather than vacated. 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.¹ In any event, petitioners' 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 November 17, 2009, and is thus in compliance with 5 U.S.C. § 555(b) and (e).

Petitioners' also raise 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 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

¹ 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.

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 for any reply to an Office action, namely the transmittal form PTO/SB/21. As the requirement for restriction has in any event been withdrawn, petitioners' contentions concerning the Paperwork Reduction Act are inapt as well as amiss.

Finally, a significant portion of the petition addresses whether the USPTO guidance and other informational documents (e.g., MPEP and memoranda to the Patent Examining Corps) complies with Executive order 12866 (Sept. 30, 1993) (Regulatory Planning and Review)² and the Office of Management and Budget (OMB) Bulletin on Good Guidance Practice. 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 TC Director's decision in the above-identified application. See, e.g., Teledyne, Inc. v. United States, 50 Fed. Cl. 155, 190 (Fed. Cl. 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).

CONCLUSION

The petition is granted to the extent that the decision of the TC Director of December 18, 2009 has been reviewed; however, the petition is **denied** with respect to making any change to or otherwise disturbing the TC Director's decision of December 18, 2009.

² Executive order 12866 (Sept. 30, 1993) was amended by Executive order 13258 (Feb. 26, 2002), Executive order 13422 (Jan. 18, 2007), and Executive order 13497 (Jan. 30, 2009). Executive order 13497 revoked Executive orders 13258 and 13422 and directed OMB to promptly rescind any guidelines or policies implementing or enforcing Executive orders 13258 and 13422.

The application is being returned to Technology Center 3600 for consideration of petitioners' reply to the Office action of January 13, 2010.



Robert W. Bahr
Acting Associate Commissioner for
Patent Examination Policy