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**DEC 14 2006**

**OFFICE OF PETITIONS**

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In re Application of	:	
JACOBS	:	DECISION
Application No. 10/176,850	:	ON PETITION
Filed: June 20, 2002	:	
Attorney Docket No. (None)	:	

This is a decision on the petition filed January 20, 2006 under 37 CFR 1.181, requesting review of the decision of the Technology Center (TC) Director mailed January 12, 2006 and a status letter filed on August 28, 2006.

The petition is **DENIED**.

On October 6, 2005, a petition under 37 CFR 1.181 was filed, requesting assistance writing an allowable claim. The petitioner also asked for entry of the July 15, 2005 amendment filed after the mailing of the final Office action of February 15, 2005. On January 12, 2006, the Director for TC 3600 upheld the examiner's actions and denied<sup>1</sup> petitioner's requests to assist in writing an allowable claim and to enter the amendment of July 15, 2005. The instant petition seeks review of the TC Director's decision.

Petitioner reiterates in the January 12, 2006 petition his request for the Office to assist in writing an allowable claim. The language of MPEP 707.07(j)(I) clearly indicates that the assistance by the Office to draft a claim for the applicant is not automatic and is conditional. MPEP 707.07(j)(I) states:

**when, during the examination of a pro se application it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, the examiner should draft one or more claims for the applicant and indicate in his or her action that such claims would be allowed if incorporated in the application by amendment. (Emphasis added)**

The above Office policy permits the examiner (and not other staff within the Office) to draft a claim only when there is apparent patentable subject matter disclosed in the application. As previously stated in the TC Director's decision of January 12, 2006, "the examiner has taken the position that she cannot identify any allowable subject matter" and, therefore, has not drafted a claim. Additionally in each Office action mailed (the March 26, 2003 Office action, the

<sup>1</sup> Because this decision was not a final agency action, the decision was technically a denial without prejudice. See MPEP 1002.02.

November 19, 2003 Office action and the February 15, 2005 Office action), the examiner has noted numerous clarity problems arising from the drawings, specification and claims in the above-identified application, making the identification of any apparently patentable subject matter that much more difficult. This is exemplified by the discussion in TC Director's decision regarding the rejection of the claims as vague and indefinite under 35 U.S.C. § 112, ¶2 in the non-final Office actions dated March 26, 2003 and November 19, 2003 and the final Office action dated February 15, 2005. Based on the above explanation, the Office has shown a rational basis for the examiner's refusal to draft an allowable claim in the above-identified application and for the TC Director's decision to uphold the examiner's action.

Petitioner also appears to request a review of the TC Director's decision to uphold the examiner's refusal to enter the after-final amendment filed July 15, 2005, without specifically pointing out any errors in the decision. Once an action is made final, prosecution is closed, and there are limited actions that the applicant is permitted to take as a matter of right. As 37 CFR 1.113(c) states, in pertinent part, a "[r]eply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim." Thus, the only replies after a final Office action that will be entered into the application as a matter of right are amendments canceling each rejected claim or the filing of an appeal. Because the amendment filed on July 15, 2005 did not cancel each rejected claim, the examiner's refusal to enter the amendment was not in error, and the TC Director's decision to uphold the examiner's refusal to enter the July 15, 2005 amendment is consistent with Title 37 of the Code of Federal Regulations and Office policy.

Other amendments are permitted entry after the mailing of the final Office action only if approved by the examiner. The following amendments may be entered pursuant to 37 CFR 1.116: (1) an amendment canceling claims or complying with any requirement of form expressly set forth in a previous Office action; (2) an amendment presenting rejected claims in better form for consideration on appeal; or (3) an amendment touching the merits of the application, upon a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. Upon reviewing the July 15, 2005 amendment after final action, the amendment does not cancel claims nor has the Petitioner show good and sufficient reasons why the amendment was necessary and was not earlier presented. Also consistent with the MPEP 714.19(A), an amendment presenting a claim requiring a new search or otherwise raising a new issue in an application whose prosecution before the primary examiner has been closed is a type of amendment ordinarily denied entry. The examiner determined in the August 5, 2005 Advisory Action that the amendment after final to the claims raised new issues that would require additional consideration and/or search and included new matter.<sup>2</sup> The TC Director's decision also concurred that the amendment to the claims raised new issues because they "were never before considered by the examiner." Based on this explanation, the amendment after final was

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<sup>2</sup> 35 U.S.C. 132(a) prohibits the addition of new matter into the disclosure or the introduction of subject matter (i.e., by amendment) not disclosed in the original disclosure into the abstract, specification, claims or drawings after the filing date.

properly not entered, and the examiner's refusal to enter the amendment and the TC Director's decision to uphold the examiner's action has not been shown to be clear error.

Furthermore, while the TC Director conceded in the January 12, 2006 decision that the substitute specification does have support for the term, "wings," the decision additionally and correctly points out the substitute specification is not in compliance with 37 CFR 1.74 and MPEP 608.01(f). Pursuant to 37 CFR 1.74, "[w]hen there are drawings, there shall be a brief description of the several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures and to the different parts by use of reference letters or numerals (preferably the latter)." The first three paragraphs of the "Brief Description of the Drawings" of the substitute specification submitted July 15, 2005 contains more than a brief description of the several views of the drawings. The "Detailed Description of the Invention" section of the substitute specification does not refer to all the different views by specifying numbers of the figures and fails to refer to any of the different parts by use of reference letters or numerals. The amendment, therefore, did not comply with a requirement of form expressly set forth in a previous Office action. For all the reasons listed above, the decision of examiner and TC Director to deny entry of the substitute specification and the amendment filed on July 15, 2005 after the final Office action of February 15, 2005 had a rational basis and was not an abuse of discretion.

The Petitioner also asks, in general, to hold the objections and requirements as to form in the February 15, 2005 Office action in abeyance until allowable subject matter has been indicated under 37 CFR 1.111(b). While this request was not before the TC Director in the petition filed October 6, 2005, this issue will be addressed for the sake of expediency. MPEP 714.02 states, in pertinent part,

[i]n all cases where reply to a requirement is indicated as necessary for further consideration of the claims, or where allowable subject matter has been indicated in an application, a complete reply must either comply with the formal requirements or specifically traverse each one not complied with.

In the final action of February 15, 2005, page 11 explicitly states the "objection to the drawings will not be held in abeyance." The examiner, therefore, determined that the drawing requirement was necessary for further consideration of the claims, and a complete reply must include compliance with the drawing requirements or a traversal of the requirement. Moreover, this request to hold formal matters in abeyance seems irrelevant in light of the fact that Petitioner did respond to the objections and requirements in the Office action on July 15, 2005. Petitioner cannot respond to such objections and requirements and, then, later demand such formal matters be held in abeyance.

Petitioner requests review of the art rejections presented in the February 15, 2005 Office action. 37 CFR 1.181 permits a petition to the Director on any action or requirement of any examiner in the *ex parte* prosecution of an application, which is not subject to appeal to the Board of Patent Appeals and Interferences (Board). A review of the disputed rejections in the February 15, 2005

Office action is the type of action subject to appeal and must be addressed by Board. See 35 U.S.C. § 134(a) and Boundy v. U.S. Patent & Trademark Office, 73 USPQ2d 1468, 1472 (E.D. Va. June 15, 2004). Therefore, it would be inappropriate for the Director to review the disputed rejections.

Finally, the petition includes several questions for the Office related to *pro se* applicants. Petitioner's attention is directed to the Office's Freedom of Information Act (FOIA) webpage at <http://www.uspto.gov/web/offices/com/sol/foia/index.html>. If Petitioner is still unable to obtain the information, he should consider submitting a formal FOIA request. See <http://www.uspto.gov/web/offices/com/sol/foia/submit.htm>.

Any remaining requests or inquiries, such as those presented in the status letter filed August 28, 2006, were not before the TC Director and, therefore, will not be reviewed.

In conclusion, Petitioner has been treated fairly during examination and on petition. The Office has provided specific guidance on several occasions in the manner of how to make amendments to the specification.<sup>3</sup> Even with this assistance, an examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

For the above reason, the Office once again<sup>4</sup> strongly advises Petitioner to hire a registered practitioner to prosecute this application since the value of a patent is largely dependent upon skilled preparation and prosecution. The Office cannot aid in selecting a practitioner. A listing of registered patent attorneys and agents is available on the USPTO Internet web site <http://www.uspto.gov> in the Site Index under "Agent and Attorney Roster, Patents". Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450.

#### 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 January 20, 2006, has been reviewed but is **denied** as to the request that the aforementioned decision be overturned. The Office's decision not to draft an allowable claim and to refuse entry of the amendment or substitute specification of July 15, 2005 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.

<sup>3</sup> For example, see Office actions mailed March 26, 2003, November 19, 2003, and February 15, 2005.

<sup>4</sup> The March 26, 2003, November 19, 2003, and February 15, 2005 Office actions each include a recommendation to hire a registered practitioner.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

John Doll   
Commissioner for Patents

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