

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte CATALINA MARKETING INTERNATIONAL, INC.

Appeal No. 2006-1585
Reexamination Control No. 90/005,888

ON BRIEF

Before McQUADE, SCHAFER and BARRETT, Administrative Patent Judges.
McQUADE, Administrative Patent Judge.

ORDER DISMISSING THE APPEAL AND REMANDING THE REEXAMINATION PROCEEDING TO THE EXAMINER

This appeal involves a reexamination proceeding relating to U.S. Patent No. 6,014,634.

The record in the proceeding is in the form of an Image File Wrapper (IFW). The IFW shows that:

- a) on January 30, 2004, an examiner issued a final rejection in which claims 1-39 were found to be patentable and/or confirmed and claims 40-49 were rejected;
- b) on March 30, 2004, the patent owner filed a notice of appeal (the first appeal) to this Board “from the decision dated JANUARY 30, 2004”;
- c) on June 30, 2004, the patent owner submitted a brief in furtherance of the first appeal;

d) on May 10, 2005, a different examiner took charge of the proceeding, reopened prosecution and issued a non-final Office action containing various new rejections of claims 1-49;

e) on June 24, 2005, the patent owner filed a “37 CFR 41.31 NOTICE OF APPEAL” (the second appeal) and a “37 CFR 41.39(b)(2) REQUEST TO MAINTAIN THE APPEAL BY FILING A 37 CFR 41.41 REPLY APPEAL BRIEF” (the first reply brief) in response to the non-final Office action;

f) on August 30, 2005, the examiner issued an answer to the first reply brief;

g) on October 3, 2005, the patent owner submitted a “37 CFR 41.41 SECOND REPLY BRIEF” (the second reply brief) in response to the answer; and

h) on January 23, 2006, the examiner issued a paper acknowledging receipt of the second reply brief and forwarded the proceeding to this Board.

As a preliminary matter, we note that at the time the non-final Office action dated May 10, 2005 was mailed, Manual of Patent Examining Procedure (MPEP) §§ 706.07(e), 1002.02(d) and 1208.01 (8th ed., Rev. 2, May 2004) required the approval of a supervisory patent examiner for any new ground of rejection made in an Office action reopening prosecution after the filing of an appeal brief. MPEP § 2275 (8th ed., Rev. 2, May 2004) made it clear that the requirement applied to appeals in patents undergoing ex parte reexamination proceedings.¹ Notwithstanding this directive, the electronic copy of the non-final Office action appearing in the IFW does not show that the new grounds of rejection set forth in the action were approved by a supervisory patent examiner. The lack of supervisory approval was subsequently cured, however, by a decision on petition mailed June 27, 2005. Although the decision on petition dealt with an unrelated matter, it referred twice to the “non-final Office action” over the signature of a Director of Technology Center 3600 and hence implicitly ratified the action and the new grounds of rejection contained therein. Moreover, and in any event, the patent owner did not challenge the

¹ Although the MPEP has since been revised, §§ 706.07(e), 1002.02(d), 1207.04 and 2275 (8th ed., Rev. 4, Oct. 2005), which are currently in effect, carry forward the requirement for supervisory approval in this circumstance.

lack of supervisory approval for the examiner’s decision to reopen prosecution and enter the new rejections in the non-final Office action, and thus waived any objection thereto. Consequently, on the record before us, the procedural propriety of the non-final Office action is not at issue.

On appeal, the patent owner seeks review by this Board of the new rejections of claims 1-49 entered in the non-final Office action.

Section 306 of Title 35, United States Code, grants the patent owner in a reexamination proceeding the right to “appeal under the provisions of section 134 of this title.” Section 134 reads as follows:

§ 134 Appeal to the Board of Patent Appeals and Interferences

(a) *Patent applicant*.— An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

(b) *Patent owner*.— A patent owner in any reexamination proceeding may appeal from the final rejection of any claim by the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.^[2]

(c) *Third-party*.— A third-party requester in an inter partes proceeding may appeal to the Board of Patent Appeals and Interferences from the final decision of the primary examiner favorable to the patentability of any original or proposed amended or new claim of a patent, having once paid the fee for such appeal.

On its face, § 134 does not allow for an appeal to this Board by a patent owner in a reexamination proceeding from anything other than a final rejection. Section 41.31(a)(3) of Title 37, Code of Federal Regulations, mirrors the statute by providing in pertinent part that “[e]very owner of a patent under *ex parte* reexamination filed under § 1.510 of this title on or after November 29, 1999, any of whose claims has been finally

² This provision applies to reexamination proceedings filed on or after November 29, 1999. See MPEP § 2273 (8th ed., Rev. 4, Oct. 2005)). The instant reexamination proceeding was filed December 12, 2000.

(§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board.” MPEP § 2273 (8th ed., Rev. 4, Oct. 2005)) goes somewhat further in stating that “[i]n an *ex parte* reexamination filed on or after November 29, 1999, the patent owner may appeal to the Board only after the final rejection of the claims.”

By reopening prosecution in the non-final Office action, the examiner in effect withdrew the finality of the Office action mailed January 30, 2004. Therefore, at the present time claims 1-49 are not under final rejection. The record indicates that the patent owner was well aware of this fact and the problems it might pose in pursuing an appeal at this juncture of the reexamination proceeding. For example, in the second notice of appeal filed June 24, 2005, the patent owner pointedly left blank the space provided for insertion of the date of the “final office action” being appealed, signifying an awareness that the Office action being appealed was not a final rejection. In contrast, the first notice of appeal filed March 30, 2004 specified the January 30, 2004 date of the final rejection (since withdrawn) being appealed. Furthermore, the curious submission of the request that the appeal, i.e., the first appeal, be maintained and the first reply brief suggests that the patent owner appreciated the questionable nature of an appeal from a non-final Office action.

At this point, we would note that in the non-final Office action (see page 2) the examiner, citing 37 CFR § 1.193(b)(2), directed the patent owner to respond by filing either a reply under 37 CFR § 1.111 or a request for reinstatement of the appeal and a supplemental brief. This instruction was erroneous because 37 CFR § 1.193 previously had been withdrawn in its entirety effective September 13, 2004. See 69 FR 49960, 50000, August 12, 2004; and 1286 OG 21, 54, September 7, 2004. The patent owner, in apparent recognition of the examiner’s error, instead chose to file the unorthodox

combination of (1) a request that the first appeal be maintained with an accompanying reply brief pursuant to 37 CFR § 41.39(b)(2), and (2) a second appeal pursuant to 37 CFR § 41.31.

The patent owner's reliance on § 41.39(b)(2) as authority for requesting that the first appeal be maintained is untenable. Such provision pertains solely to responses to new grounds of rejection in an examiner's answer. To justify the request, the patent owner urged that the non-final Office action "although styled as an office action, was in fact in response to the appeal brief originally filed in the USPTO June 30, 2004 . . . [i]n other words, the paper mailed by the USPTO May 10, 2005 was an examiners' answer" (second reply brief, page 2). Clearly, however, the non-final Office action was not an examiner's answer in either styling or substance.

The reopening of prosecution by the examiner in the non-final Office action removed the basis for the first appeal mandated by statute, i.e., the final rejection mailed January 30, 2004, and thus rendered the first appeal moot. The patent owner's request to maintain such appeal has no basis in law or reason. That the examiner tacitly approved the patent owner's submissions by mailing an answer to the first reply brief, acknowledging receipt of the second reply brief and forwarding the proceeding to the Board is of no moment. Once prosecution was reopened in the non-final Office action, the first appeal stood terminated.

The second appeal filed pursuant to 37 CFR § 41.31 in response to the non-final Office action did not solve the patent owner's plight. The pertinent portion of § 41.31(a)(3) reproduced above, which echoes 35 U.S.C. § 134(b), does not support, and

in fact belies, any notion that the patent owner had a right to appeal to this Board from the non-final Office action.

We are therefore constrained to conclude that this Board lacks jurisdiction under 35 U.S.C. § 134(b) to hear the patent owner's appeal, essentially because claims 1-49 are not under final rejection. Accordingly, the appeal is dismissed and the reexamination proceeding is remanded to the examiner for further action consistent with USPTO practice.

DISMISSED and REMANDED

JOHN P. McQUADE)
Administrative Patent Judge)
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)
) BOARD OF PATENT
RICHARD E. SCHAFER) APPEALS
Administrative Patent Judge) AND
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LEE E. BARRETT)
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