

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# Petitions Decided by the TC

Scarlett Goon  
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# Petition to the Director

37 CFR 1.181(g) states:

The Director may delegate to appropriate Patent and Trademark officials the determination of petitions

# Petitions decided in TC 1600

- Petitions and requests decided by the TC Director (MPEP 1002.02(c))
- Petitions and requests decided by Supervisory Patent Examiners (MPEP 1002.02(d))

# Petitions and requests decided by the TC Directors (MPEP § 1002.02(c))

- Petitions from a final decision of the examiner requiring restriction under 37 CFR 1.144
- Petitions under 37 CFR 1.181 relating to actions or requirements in a patent application which are not subject to appeal
- Petitions under 37 CFR 41.40 related to examiner's failure to designate a rejection in the examiner's answer as a new ground of rejection
- Petitions to expunge papers under 37 CFR 1.59 which were submitted under MPEP § 724.02, or as part of an information disclosure statement
- Petitions to withdraw patent application from issue under 37 CFR 1.313
- Request by applicant for a second suspension of action in patent applications under 37 CFR 1.103

# Petition from requirement for restriction under 37 CFR 1.144

- The election must have been made with traverse, with all errors relied upon in the petition being distinctly and specifically pointed out in the traversal.
- The requirement must have been made final.
- Petition may be deferred until after final action or allowance of claims to the invention elected, but must be filed not later than appeal.

# Useful points to address in a petition under 37 CFR 1.144

- Explain how the examiner has not established why it would be a serious search burden to search the particular inventions or species
- Explain why it is improper to restrict a particular first claim from a second claim that lies within its scope
- Provide lack of unity-specific arguments in a case filed under 35 U.S.C. 371; provide U.S. restriction practice arguments in a case filed under 35 U.S.C. 111

# Petition to the Director under 37 CFR 1.181

37 CFR 1.181(a)(1) states:

Petition may be taken to the Director:

From an action or requirement of any examiner in the *ex parte* prosecution of an application...which is not subject to appeal to the Patent Trial and Appeal Board or to the court.



# Petitions filed under 37 CFR 1.181

- Prematurity of final rejection
- Requirement to cancel “new matter” from specification
- Relative to formal sufficiency and propriety of declarations under 37 CFR 1.132
- Refusal to enter amendment (MPEP §§ 714.03(a) and 714.19)
- Resetting period for reply when the delivery of mailed correspondence was delayed by USPS or USPTO
- Requirement for information under 37 CFR 1.105

# Petition to the Director under 37 CFR 1.181

37 CFR 1.181(f) states:

The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

# Reasons for dismissal of petition under 37 CFR 1.181

- Arguments touch on the merits of the case (*e.g.*, not all claims rejected in the prior art rejection, missed limitations)
- Untimely filed petition
- Petition moot because examiner has reopened prosecution to consider/address the issue raised in the petition

# Petition to the Director under 37 CFR 41.40

- Any request to seek review of the primary examiner's failure to designate as a new ground of rejection in an examiner's answer must be filed before the filing of any reply brief. See 37 CFR 41.40(a).
- If a reply brief is filed within two months of the date of the examiner's answer and on or after the filing of a petition under § 1.181 to designate a new ground of rejection in an examiner's answer, but before a decision on the petition, the reply brief will be treated as a request to withdraw the petition and to maintain the appeal. See 37 CFR 41.40(d).

# Petition to expunge (MPEP § 724.05)

- Information submitted under MPEP § 724.02
- Information unintentionally submitted in application
- Information submitted in an incorrect application

# Reasons for dismissal of TC petition under 37 CFR 1.59 to expunge

- It has not been determined whether the information is material to patentability because prosecution is still ongoing
- Petition does not include a statement that there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to the information requested to be expunged
- Petition requests expungement of select references on an IDS containing other references
- Petition does not indicate that the information submitted was unintentionally submitted and that failure to obtain its return would cause irreparable harm to the party who submitted the information (applicable to petition for expungement of information unintentionally submitted)

# Suspension of action under 37 CFR 1.103(a)

37 CFR 1.103(a) states:

*Suspension for cause.* On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:

- (1) A showing of good and sufficient cause for suspension of action; and
- (2) The fee set forth in § 1.17(g), unless such cause is the fault of the Office.

# **Suspension of action by USPTO under 37 CFR 1.103(a) (MPEP § 709)**

- First suspension request is decided by the primary examiner
- Second suspension request is decided by the TC Director
- Suspension period begins on the date a request for suspension of action was filed, not the date the suspension was granted



# Reasons a petition for suspension under 37 CFR 1.103(a) may be dismissed

- Unacceptable explanation for “good and sufficient cause”
- The application is currently suspended and the time period of that suspension has not lapsed
- A reply by applicant to an Office action is outstanding

# Examples of what may constitute “good and sufficient cause”

- Inventor is unavailable because they are in the military and stationed in an active combat zone overseas.
- Applicant needs additional time to gather evidence/perform experiments to support their arguments.
- Inventor has been incapacitated and is in the hospital.

# Examples of what may not constitute “good and sufficient cause”

- Applicant is short on funds
- Inventor/attorney is on vacation
- Applicant is unsure if they want to continue prosecution
- Applicant is waiting for the outcome in another pending application
- Inventor/Applicant has been affected by the Covid-19 outbreak

# **Petitions Decided by Supervisory Patent Examiners (SPEs)**

# Petitions and matters decided by SPEs (MPEP § 1002.02(d))

- Requests for certificate of correction under 37 CFR 1.322 or 1.323
- Requests under 37 CFR 1.324 to correct inventorship
- Petitions under 37 CFR 1.84 to accept color drawings
- Requests for deferral of examination under 37 CFR 1.103(d)

# Requests for deferral of examination under 37 CFR 1.103(d) (MPEP § 709)

37 CFR 1.103(d) states:

On request of the applicant, the Office may grant a deferral of examination under the conditions specified in this paragraph for a period not extending beyond three years from the earliest filing date for which a benefit is claimed under title 35, United States Code.



# Requirements for a request for deferral of examination

- The application must be an original utility or plant application, or a national stage application under 35 U.S.C. 371
- The application must not have an active nonpublication request in the file
- The application must be in condition for publication
- The Office must not have issued either an Office action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151

# Time period for deferral of examination

- Period of deferral starts from the date the Office grants the request
- Maximum period of deferral is three years, calculated from the earliest filing date from which benefit is claimed
- As an example:
  - Six month deferral filed on 2/10/2019
  - Application claims priority to a foreign application filed on 2/10/2018
  - Request granted on 8/15/20
  - The application will only be deferred until 2/10/2021.
  - Although 6 months from the grant date is 2/15/2021, the maximum period of deferral is 36 months from the earliest filing date from which priority is claimed. The deferral date cannot extend beyond 2/10/2021.



# Drawings under 37 CFR 1.84(a)(2)

37 CFR 1.84(a)(2) states:

...On rare occasions, color drawings may be necessary as the only practical medium by which to disclose the subject matter sought to be patented in a utility patent application. The color drawings must be of sufficient quality such that all details in the drawings are reproducible in black and white in the printed patent. Color drawings are not permitted in international applications (see PCT Rule 11.13 ). The Office will accept color drawings in utility patent applications only after granting a petition filed under this paragraph explaining why the color drawings are necessary. Any such petition must include the following:

- (i) The fee set forth in § 1.17(h);
- (ii) One (1) set of color drawings if submitted via the Office electronic filing system, or three (3) sets of color drawings if not submitted via the Office electronic filing system; and
- (iii) An amendment to the specification to insert (unless the specification contains or has been previously amended to contain) the following language as the first paragraph of the brief description of the drawings:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

# MPEP § 608.02(VIII)

- Unless a petition is filed and granted, color drawings or color photographs will not be accepted in a utility patent application filed under 35 U.S.C. 111.
- It is anticipated that such a petition will be granted only when the U.S. Patent and Trademark Office has determined that a color drawing or color photograph is the only practical medium by which to disclose in a printed utility patent the subject matter to be patented.

# National stage applications under 35 U.S.C. 371

- Since color drawings are not permitted in PCT applications, they will be treated as an amendment in a 371 application
- Color drawings in a 371 application will be reviewed by the examiner to ensure they do not introduce new matter

# Submission of photographs and drawings via EFS-Web (MPEP 502.05(I), part K)

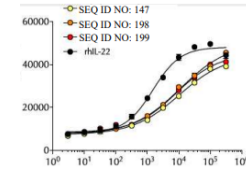
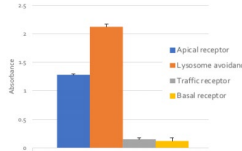
- Photographs, color drawings, grayscale drawings, and other drawings that are not black and white line drawings should be submitted using document code DRW.NONBW
- Images should be at a minimum resolution of 300 DPI
- Color drawings must include a petition under 37 CFR 1.84(a)(2)

# Common reasons for dismissals of color drawings petitions

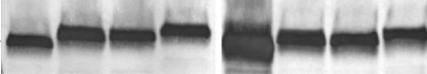
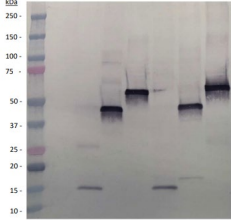
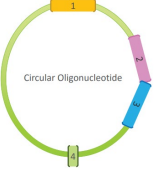
- Missing requisite statement in the specification
- Requisite statement is not present as the first paragraph under the "Brief Description to Drawings"
- Fee not paid with filing and/or not authorized in the petition
- Petition does not explain why color drawings are the only practical medium by which to disclose the subject matter

# Situations when color drawings are not considered necessary

- Bar graphs or line graphs
- To highlight particular features in the figure



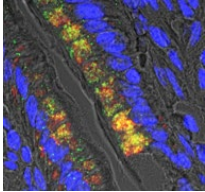
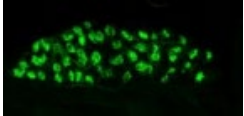
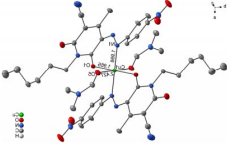



SEQ ID NO: 3  
 5' TTAACC CACGCCGAATCCTAGACT CAAAGT AGTCTAGGATT CGGCGTG

- Grayscale 
- Immunoblots/gels 
- For visualization effects 



# Situations when color drawings may be necessary

- Chromatograms 
- Color variation in flowers 
- Immunostains containing multiple colors 
- Fluorescence microscopy images 
- Molecular model of compounds containing multiple atoms 
- Heat maps 

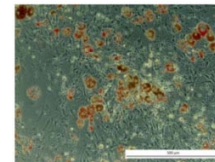
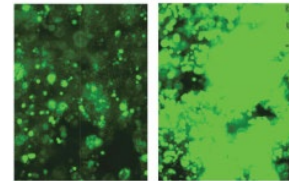
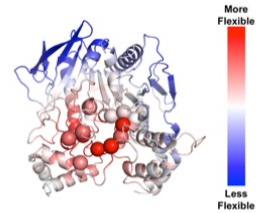
# Examples of insufficient explanation for necessity of color drawings

- The color drawings are necessary as the only practical medium by which aspects of the claimed subject matter may be accurately conveyed.
- The color drawings are necessary because color is required to provide clarity and demonstrate operation of the present invention as described in the specification.
- Important features of the sequences are referred to throughout the specification, and the color figures permit visualization of the features in the sequences in a manner that would not be achieved in a black and white drawing.
- Merely copying the figure legend from the specification into the petition without any additional explanation.



# Examples of sufficient explanation for necessity of color drawings

- Color drawings are necessary to show the key residues and structural motifs that in Figure 1 that is not visible in black and white drawings.
- Color drawings show the transfection efficiency in the presence and absence of PEI for Figure 2.
- Figure 3 shows the effects of cells dyed with oil-red O dye.



# Responding to a dismissed petition

- File a renewed petition that corrects the deficiency indicated in the petition decision
  - No additional fee is required if the renewed petition is filed within two months of the decision date
  - A petition received after two months of the decision date will be dismissed unless it is accompanied by a new fee payment

# Responding to a dismissed petition

- Cancel the color drawings or provide substitute black and white drawings (See MPEP § 608.02, part VIII)
- Amend the specification to remove the requisite paragraph required for color drawings under 37 CFR 1.84(a)(2)

# Questions?

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