Commissioner of Patents and Trademarks
Patent and Trademark Office (P.T.O.)

IN RE TOMOKI OKU
Application No. 07/453,762
October 27, 1992
***1** Filed: December 20, 1989

For: A SEMICONDUCTOR DEVICE

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Acting Commissioner of Patents and Trademarks

DECISION ON PETITION

MEMORANDUM OPINION AND ORDER

Petitioner requests that the Commissioner exercise his supervisory authority, pursuant to 37 CFR § 1.181(a)(3), to direct the Board of Patent Appeals and Interferences (Board) to designate its decision entered February 18, 1992, as a new ground of rejection under 37 CFR § 1.196(b) so that petitioner may further prosecute the application before the examiner pursuant to 37 CFR § 1.196(b)(1).

Petitioner's request is granted only to the extent that prosecution of the application is reopened before the examiner under 37 CFR § 1.198.

Background

On February 18, 1992, the Board entered a decision (Paper No. 26) affirming an examiner's rejection of claims 3 and 5 in petitioner's application as unpatentable under 35 U.S.C. § 103. According to the Board's summary of the examiner's rejection: "the examiner relies on either Imamura or Kitahata in combination with any one of Codella, Terada, Kayama, Sato and Ueno" (Board decision at 3). The Board affirmed the obviousness conclusion stating: "there are sufficient reasons or motives in the appellant's description of the prior art in the specification, particularly with reference to Figure 4, for the artisan to have structured an asymmetric Schottky barrier gate field effect transistor like the appellant did" (Board decision at 6). The examiner did not expressly rely on the description of the prior art in the specification.

On March 18, 1992, petitioner filed a REQUEST FOR RECONSIDERATION AND MODIFICATION OF DECISION (Paper no. 27) requesting the Board to reconsider and modify its decision by stating that the decision is based on a new ground of rejection under 37 CFR § 1.196(b) so that petitioner might exercise his options for further prosecution under § 1.196(b)(1) or (b)(2).

On March 31, 1992, the Board entered a decision on request for reconsideration (Paper No. 28) denying the request to modify its decision. The Board stated that it had affirmed the ground of rejection before it, 35 U.S.C. § 103, and that the reliance on different evidence did not constitute a new ground of rejection.

On April 4, 1992, petitioner filed a PETITION TO EXERCISE SUPERVISORY AUTHORITY OVER THE BOARD OF PATENT APPEALS AND INTERFERENCES (Paper No. 29), requesting the Commissioner to exercise his supervisory authority, pursuant to 37 CFR § 1.181(a)(3), to direct the Board to designate its decision as a new rejection under 37 CFR § 1.196(b) so that petitioner could further prosecute the application before the examiner pursuant to 37 CFR § 1.196(b)(1).

***2** On April 28, 1992, the Chairman of the Board entered a decision dismissing the petition (Paper No. 30), stating that "[s]ince the matter is reviewable by a court, it is not properly subject to review via a petition under 37 CFR 1.181."

On May 5, 1992, petitioner filed a REQUEST FOR RECONSIDERATION OF DECISION ON PETITION PURSUANT TO 37 C.F.R. § 1.181 (Paper No. 31) requesting reconsideration of the Chairman's decision on the grounds that "the Petition was decided by the wrong and a potentially interested person and because the Chairman's Decision is legally erroneous." Petitioner argues that a new ground of rejection is a petitionable matter under In re Weiss, 160 USPQ 423 (Comm'r Pat.1967). Petitioner states that "In re Weiss applies here because Petitioner does not intend to appeal the merits of the Board's rejection to the court."

On April 12, 1992, the Commissioner sua sponte entered an order extending the time to file a notice of appeal until twenty (20) days after action by the Commissioner on the request (Paper No. 32).

## Decision

The Commissioner's supervisory authority under 35 U.S.C. § 6(a) is exercised sparingly. As a general rule, as stated in Goss v. Scott, 1901 Dec.Comm'r Pat. 80, 84 (Comm'r Pat.1901):

> This discretionary power of the Commissioner should be exercised, however, only in exceptional cases, and then only to correct some palpable error which is clear and evident on its face.

However, proper petitions to exercise the Commissioner's supervisory authority have the salutary effect of establishing uniform operating procedures within the Patent and Trademark Office (PTO) and of conserving judicial resources until cases have been handled in accordance with the rules. Cf. Oriskasa v. Oonishi, 10 U.S.P.Q.2d 1996, 1997 (Comm'r Pat.1989).

Review of adverse decisions of examiners is committed to the Board by statute. 35 U.S.C. § 7(b) and § 134. An applicant dissatisfied with a decision of the Board may seek judicial review. 35 U.S.C. § § 141-145. The Commissioner does not review the merits of final decisions of the Board. Cf. In re Dickerson, 299 F.2d 954, 958, 133 USPQ 39, 43 (CCPA1962) ("[I]n performing his duties, the Commissioner cannot usurp the functions or impinge upon the jurisdiction of the Board ... established by 35 U.S.C. 135."); Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43, 44 (Comm'r Pat.1971) ("The Commissioner will not intervene with respect to a question which by law is committed to the Trademark Trial and Appeal Board.").

***3** Whether or not the Board made a new ground of rejection can be an issue reviewable on appeal. In re Waymouth, 486 F.2d 1058, 1060-61, 179 USPQ 627, 629 (CCPA1973), supp. op., 489 F.2d 1297, 180 USPQ 453 (1974). Petitioner correctly notes, however, that the existence of a new ground of rejection is an ancillary question on judicial review. The designation of a new ground of rejection, while involving a consideration of the merits, also involves the important question of whether the Board followed PTO regulations established by the Commissioner. In appropriate circumstances the Commissioner may exercise his supervisory authority on petition to reopen prosecution. As stated in In re Weiss, 160 USPQ at 424:

> A decision of the Board on such a matter [of new ground of rejection] will not be disturbed on petition unless it involves manifest error or abuse of discretion....

A decision to reopen prosecution notwithstanding an adverse decision by the Board is a question solely within the discretion of the Commissioner and is in no way a review of a merits decision by the Board.

The Board's reliance for the first time on appeal in this case on petitioner's description of the prior art constitutes a new basis for refusing a patent and petitioner has not had an adequate opportunity to respond to the precise basis upon which the rejection is based.

Under the circumstances of this case, it is an appropriate exercise of his supervisory authority to order reopening of prosecution under 37 CFR § 1.198.

ORDER

Upon consideration of petitions of April 3, 1992, and May 5, 1992, it is

ORDERED that the petitions are granted to the extent that prosecution of the application is reopened under 37 CFR § 1.198; and it is

FURTHER ORDERED that petitioner is given two (2) months from the date of this order to file any amendment and/or response. The time period for response may not be extended under 37 CFR § 1.136(a). Failure to file an amendment or response will result in the application being deemed abandoned; and it is

FURTHER ORDERED that the petitions are otherwise denied.

25 U.S.P.Q.2d 1155

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