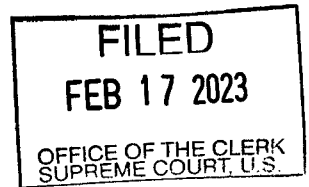


No. **22-794**



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IN THE  
**Supreme Court of the United States**

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EURICA CALIFORNIAA,  
*Petitioner,*

*v.*

KATHERINE K. VIDAL,  
Under Secretary of Commerce for Intellectual  
Property and Director of the United States Patent  
and Trademark Office,  
*Respondent.*

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On Petition for a Writ of Certiorari to the United  
States Court of Appeals for the Federal Circuit

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**PETITION FOR A WRIT OF CERTIORARI**

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EURICA CALIFORNIAA  
*Pro Se*  
57 CIRCLE WAY  
MAHOPAC, NY 10541-1736  
(310) 804-0727  
amb@juridic.org

FEBRUARY 2023

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### Questions Presented

Petitioner wholly owns United States Patent No. 10,245,075 directed to a “nondestructive means of ectopic pregnancy management,” which teaches a non-homicidal alternative to traditional abortion. He appeals from respondent’s 51-day reduction of his patent term. The questions presented are:

1. Whether *United States v. Vuitch*, 402 U.S. 62 (1971), should be overruled in favor of equality with the unborn?

2. Whether 37 C.F.R. § 1.704(c)(10) lawfully reduces the patent term for an applicant’s refusal to surrender stewardship of the specification claims to the Examiner in deference to an unauthorized claim amendment contained in a notice of allowance?

## **PARTIES TO THE PROCEEDING**

Petitioner, who was patentee in the United States Patent and Trademark Office and plaintiff in the district court and appellant in the court of appeals, is Eurica California.

Respondent, acting in her official capacity as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office, is Katherine K. Vidal.

**RELATED PROCEEDINGS**

*In re* Patent No. 10,245,075 (Eurica California), United States Patent and Trademark Office. Petition decision denying request for redetermination of patent term adjustment entered March 3, 2020.

*California v. Hirshfeld*, No. 1-20-cv-00985-MSN-TCB, United States District Court for the Eastern District of Virginia, Alexandria Division. Judgment entered December 30, 2021. Petition for rehearing denied February 16, 2022.

*Eurica California v. Vidal*, No. 2022-1640, United States Court of Appeals for the Federal Circuit. Judgment entered November 7, 2022. Petition for rehearing or rehearing en banc denied December 21, 2022.

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Petitioner respectfully requests that the Court grant certiorari to review the judgment below.

### **OPINIONS BELOW**

The unpublished opinion of the Federal Circuit directly at issue in this appeal is reproduced at Appendix A. The unpublished decision of the district court from which the appeal to the Federal Circuit was taken is reproduced at Appendix B. The petition decision the United States Patent and Trademark Office (“Office”) denying patentee’s request for redetermination of patent term adjustment (“PTA”) is set forth at Appendix C. The unpublished order of the Federal Circuit denying rehearing or rehearing en banc is reproduced at Appendix D. The unpublished order of the district court denying rehearing is reproduced at Appendix E.

### **JURISDICTION**

The Federal Circuit decision affirming the final judgment that respondent did not err in reducing the patent term by 51 days was entered on November 7, 2022. Petitioner’s timely-filed petition for rehearing or rehearing en banc was denied on December 21, 2022.

This Court has jurisdiction under 28 U.S.C. § 1254(1).

### **RELEVANT PROVISIONS**

Set forth in Appendix F are relevant provisions of the Manual of Patent Examining Procedure (“MPEP”), 37 C.F.R. § 1.704(c)(10), 35 U.S.C. § 154, and the Fifth and Fourteenth Amendments to the Constitution of the United States.

### STATEMENT OF THE CASE

This is a case that offends the senses.

When the claims of a patent application are twice rejected, the second is normally made final. But in this case, the application received *five* Office actions on the merits before a notice of allowance. What happened in the end was that the Examiner realized that claim 30 had to be rejected for indefiniteness. But that would have been a new ground for rejection requiring a *sixth* non-final Office action. So the Examiner devised a work-around: he amended the claim himself to overcome his indefiniteness concerns and issued the notice of allowance.

Finding the Examiner's amendment to be unacceptable—and after learning for the first time in an interview about the Examiner's indefiniteness concerns regarding claim 30—the applicant filed a mutually acceptable post-allowance amendment. However, for having filed the post-allowance amendment rather than accepting the Examiner's amendment outright, the Office attributed to the applicant a failure to engage in reasonable efforts to conclude prosecution and reduced the patent term by 51 days under 37 C.F.R. § 1.704(c)(10).

On request for reconsideration, the patentee argued that, in spite of § 1.704(c)(10), the applicant should not be required either to accept outright an unauthorized Examiner's amendment of the specification claims or face a penalty. The Office denied the request and the district court and Federal Circuit affirmed.

The case now comes before this Court.

Because only this Court can overrule its own precedents, petitioner also presents for the first time his request that the Court overrule *United States v.*

*Vuitch*, 402 U.S. 62 (1971), in favor of equality with the unborn. The relevance of this request is as follows.

Petitioner wholly owns the subject United States Patent No. 10,245,075 directed to a “nondestructive means of ectopic pregnancy management,” which teaches means for delivering a baby from an ectopic pregnancy safely, with an option to reimplant the baby in a woman’s uterus, i.e., a means of non-homicidal abortion, also called non-concepticidal abortion (col. 60, line 44—col. 61, line 18). If the Court overrules *Vuitch* in favor of equality with the unborn, then any abortions performed in the United States would have to be limited to the non-homicidal procedures taught by the subject patent.

Accordingly, if the Court overrules *Vuitch* in favor of equality with the unborn, physicians would no longer have the option of homicide, thus making the 51 days in question—and for that matter the entire patent term—financially more valuable to the petitioner.

### REASONS FOR GRANTING THE WRIT

**1. Whether *United States v. Vuitch*, 402 U.S. 62 (1971), should be overruled in favor of equality with the unborn?**

The abortion policy set forth in *Roe v. Wade*, 410 U.S. 113 (1973), has its fundamental roots in *Vuitch*. See *Roe*, 410 U.S. 158-159. Recently, in *Dobbs v. Jackson Women’s Health Organization*, 597 U.S. \_\_\_, 142 S.Ct. 2228 (2022), the Court overruled *Roe* and its sequelae. Yet *Dobbs* did nothing to disturb the roots of abortion policy supplied by *Vuitch*. In support of overruling *Vuitch* in favor of equality with

the unborn, the policies announced in *Roe*, *Dobbs*, and *Vuitch* are addressed as follows.

### A. The Policy Announced in *Roe*

A succinct rendition of the tripartite *Roe*-era policy on pregnancy abatement was given by Justice Douglas: I) As the path of least resistance, let women make the “basic” decision to volunteer;<sup>1</sup> II) if given not enough volunteers or, conversely, too many, let states override that decision;<sup>2</sup> and III) muster a brigade to perform the abatement by creating a safe haven for physicians not competent enough to stay in practice otherwise.<sup>3</sup> *Doe v. Bolton*, 410 U.S. 179, 209-221 (1973) (Douglas, J., concurring).

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<sup>1</sup> “[A] woman is free to make the basic decision whether to bear an unwanted child.” 410 U.S. at 214.

<sup>2</sup> “Such reasoning [in favor of a woman’s autonomy] is, however, only the beginning of the problem. The State has interests to protect. [A. The state has an interest in overriding her decision if a lack of volunteers threatens an epidemic of unwanted births.] Vaccinations to prevent epidemics are one example, as *Jacobson, supra*, holds. The Court held that compulsory sterilization of imbeciles afflicted with hereditary forms of insanity or imbecility is another. *Buck v. Bell*, 274 U. S. 200. Abortion affects another. [B. The state also has an interest in overriding her decision if, conversely, a surplus of volunteers threatens a healthy fertility rate.] While childbirth endangers the lives of some women, voluntary abortion at any time and place regardless of medical standards would impinge on a rightful concern of society. The woman’s health is part of that concern; as is the life of the fetus after quickening. These concerns justify the State in treating the procedure as a medical one.” 410 U.S. at 215.

<sup>3</sup> “In short, I agree with the Court that endangering the life of the woman or seriously and permanently injuring her health [at the hands of incompetent physicians given free reign to practice under a safe haven] are standards too narrow for the right of privacy that is at stake.” 410 U.S. at 220-221.

*Roe* was particularly concerned that volunteerism would underwhelm, especially among the drug-crazed women of the era. As Justice Marshall reflects on this concern two months later in *San Antonio Independent School Dist. v. Rodriguez*, 411 U.S. 1, 100-101 (1973) (Marshall, J., dissenting):

Recently, in *Roe v. Wade*, 410 U. S. 113, 152-154 (1973), the importance of procreation has, indeed, been explained on the basis of its intimate relationship with the constitutional right of privacy which we have recognized. Yet the limited stature thereby accorded any "right" to procreate is evident from the fact that at the same time the Court reaffirmed its initial decision in *Buck v. Bell*. See *Roe v. Wade, supra*, at 154.

Authored by Justice Douglas for a unanimous Court, *Skinner v. Oklahoma ex rel. Williamson*, 316 U.S. 535 (1942), modified the initial decision in *Buck v. Bell*, 274 U.S. 200 (1927), to prohibit involuntary measures to control of reproduction based on crime or poverty. But seeing that this limitation would prevent states from pressuring women to abort on the basis of criminal drug use, *Roe* quietly disavowed *Skinner's* applicability to abortion so as to revert to the *initial* decision in *Buck v. Bell*. See *Roe*, 410 U.S. at 159 ("The situation [of pregnancy] therefore is inherently different from ... procreation ... with which ... *Skinner* ... [was] concerned.")

Joined by Justice Douglas, the point Justice Marshall was making in *San Antonio* was that, in addition to using criminal drug use as a basis for pressuring women to abort, another aspect of



disavowing *Skinner* for abortion is that states can also pressure them to abort on the basis of poverty. In other words, rather than allowing states to provide separate quality schools for rich and poor children, Justice Marshall was suggesting that states take the alternative of pressuring poor women to abort. See *San Antonio*, 411 U.S. at 100-101.

In *Casey*, Justice O'Connor's plurality predicted that, given a *Dobbs*-like decision, "the State might as readily restrict a woman's right to choose to carry a pregnancy to term as to terminate it..." *Planned Parenthood of Southeastern Pa. v. Casey*, 505 U.S. 833, 859 (1992). In contrast, states under *Roe* were required to at least observe a basic preference for volunteerism. In the wake of *Dobbs*, however, several states have made haste to codify into law their newly expanded authority to restrict a woman's right to choose to carry a pregnancy to term, much as *Casey* had predicted.

For example, the California Constitution, Art. I, Sec. 1.1, was amended to recognize a "fundamental right to choose or refuse contraceptives." According to the canons of statutory interpretation, here the addition of the term "refuse" means that the "right to choose" is interpreted to not inherently include the "right to refuse." This situation leaves the right to refuse an abortion conspicuously absent, given that the amendment only recognizes a "fundamental right to choose to have an abortion..." *Ibid.* To give an analogy, under present policy a man has the right to choose military service, but not the right to refuse being drafted. *Cf. Buck v. Bell*, 274 U.S. at 207.

To give another example, the Michigan Constitution, Art. 1, Sec. 28, Cl. 1, was amended to recognize that "an individual's right to personal

reproductive autonomy ... shall not be denied or infringed unless justified by a compelling State interest achieved by the least restrictive means." To give yet another example, the Vermont Constitution, Ch. I, Sec. 22, was similarly amended to recognize that "an individual's right to personal reproductive autonomy ... shall not be denied or infringed unless justified by a compelling State interest achieved by the least restrictive means." Both amendments contain the identical "compelling State interest" caveat, which serves to codify into law the state's authority to override a woman's voluntarism in either alternative.

As Justice Douglas reflects on his own support for the extreme measures undertaken in *Roe* to ensure pregnancy abatement, *Doe v. Bolton*, 410 U.S. at 220-221:

In short, I agree with the Court that endangering the life of the woman or seriously and permanently injuring her health [at the hands of incompetent physicians given free reign to practice under a safe haven] are standards too narrow for the right of privacy that is at stake.

Yet if *Roe* had truly sought a right of privacy for the *individual* woman, then neither such risks nor the authority to restrict her right to choose to carry a pregnancy to term would have ever been put on the table. Instead, such extreme measures were legalized because what *Roe* really sought was the *collective* privacy of the Nation as a whole, by disposing of women's pregnancies in private to limit the public's growing embarrassment.

Because *Roe* viewed this collective perception of privacy as what was ultimately “at stake” for the Nation, the decision sought to ensure pregnancy abatement one way or another, even at the risk of “endangering the life of the woman or seriously and permanently injuring her health”<sup>4</sup> and even by pressuring women to abort in connection with crime and poverty by reaffirming “the initial decision in *Buck v. Bell*.”<sup>5</sup> But by no means was *Roe* alone in this attitude of extreme desperation.

For example, when issuing its first policy statement supporting abortion-on-demand in 1970, the American College of Obstetricians and Gynecologists (ACOG)—in the same policy statement—reaffirmed support for the forced sterilization of women.<sup>6</sup> And, the year before, the ACOG withdrew its age-parity restriction on sterilization so that young women could be sterilized indiscriminately.<sup>7</sup>

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<sup>4</sup> *Doe v. Bolton*, 410 U.S. at 220-221.

<sup>5</sup> *San Antonio*, 411 U.S. at 101.

<sup>6</sup> “College policy on abortion and sterilization,” ACOG Nurses Bulletin, 1970 Fall; 4: 2, PubMed ID: 12305531 (“In cases of sterilization, a recorded opinion of a knowledgeable consultant should be obtained, unless the procedure is requested by the patient.”); see also, “College policy on abortion and sterilization,” ACOG Newsletter, 1970 Sept.; 14: 2.

<sup>7</sup> Caress B, “Sterilization: Women fit to be tied,” Health PAC Bulletin, 1975 Jan-Feb; 62: 1-6, at 4, PubMed ID: 10237673 (“Official accommodation to liberalization of sterilization practices in the US came in 1969, when the American College of Obstetricians and Gynecologists (ACOG) withdrew its age-parity formula.”); see also, Porter CW Jr, Hulka JF, “Female sterilization in current clinical practice,” Family Planning Perspectives, 1974 Winter; 6(1): 30-38, at 30, PubMed ID: 4282075.

That the ACOG reaffirmed support for forced sterilization in the same policy statement announcing support for abortion parallels Justice Marshall's observation that, in *Roe*, "the limited stature thereby accorded any 'right' to procreate is evident from the fact that at the same time the Court reaffirmed its initial decision in *Buck v. Bell*." *San Antonio*, 411 U.S. at 101. It is thus evident that, at the time of *Roe*, key members of both the medical and legal professions thought extreme measures were necessary "in order to prevent our being swamped with [female sexual] incompetence." *Buck v. Bell*, 274 U.S. at 207.

Hence, though clothed as an expansion of women's rights, the policy announced in *Roe* was in fact nothing short of a pregnancy abatement program.

#### **B. The Policy Announced in Dobbs**

*Roe* and *Dobbs* both share with *Dred Scott v. Sandford*, 19 How. 393 (1857), the fundamental proposition that the beings in question are "beings of an inferior order ... and so far inferior, that they [have] no rights which [others of us are] bound to respect...." 19 How. at 407. Regarding the unborn, "no Member of the Court has ever questioned this fundamental proposition." *Casey*, 505 U.S. at 913 (Stevens, J., concurring in part and dissenting in part.) Nor has the Solicitor General ever questioned it either regarding the unborn. See 505 U.S. at 932 (Blackmun, J., concurring in part, concurring in the judgment in part, and dissenting in part.)

As was done in *Dred Scott* with slavery, *Dobbs* allows states to regulate abortion. A notable difference is that *Dred Scott* specifically voided the

authority of Congress to prohibit slavery in certain territories of the United States, 19 How. at 452, whereas *Dobbs*, 142 S.Ct. at 2243, by contrast, left the door open for Congress to regulate abortion. See also 142 S.Ct. at 2303 (Thomas, J., concurring); and, at 2305 (Kavanaugh, J., concurring). In contrast, *Roe* took the more radical approach of giving private individuals basic control over abortion, irrespective of Congress or the states.

Ironically, if with slavery the Court had initially taken *Roe's* more radical approach, the decision in *Dred Scott* would have been subsequently celebrated for the same reasons that *Dobbs* is being celebrated today. This shows in an historical light why *Dobbs* is better than *Roe*, but no better than *Dred Scott*.

Yet what is particularly disturbing—and what really makes *Dobbs* worse than *Dred Scott*—is that the decision was handed down despite the advent of the Fourteenth Amendment. *Dobbs* attempts to summarily evade the subject of whether the Fourteenth Amendment applies to the unborn by disappearing into a rabbit hole: that the Constitution does not require the Court to adopt a “theory of life.” 142 S.Ct. at 2261. Yet the Fourteenth Amendment does not require the Court to adopt a theory of life any more than a theory of evolution.

Imagine if the Thirteenth Amendment had abolished abortion instead of slavery. In such an event, it would be quite the irony if the Fourteenth Amendment, written word-for-word as it is today, was held inapplicable to African Americans.

The Court posited in *Roe*, 410 U.S. at 162, that “the unborn have never been recognized in the law as persons in the whole sense.” Yet the same could be said of African Americans prior to the Fourteenth

Amendment, as the Three-fifths Compromise makes evident, being that three-fifths is less than "whole." See U.S. Constitution, Art. I, Sec. 2, Cl. 3. Indeed, prior to the Fourteenth Amendment, the Court's opinion of African Americans was quite opposed to recognizing them in the law as persons in the whole sense. See *Dred Scott*, 19 How. at 407:

They had for more than a century before been regarded as beings of an inferior order, and altogether unfit to associate with the white race, either in social or political relations; and so far inferior, that they had no rights which the white man was bound to respect....

And for more than half a century after the Fourteenth Amendment was ratified, women were still denied the right to vote. See U.S. Constitution, Amend. XIX. It would thus be hard to say that women had been recognized in the law as persons in the whole sense prior to the Nineteenth Amendment.

From this it is evident that having already been recognized in the law as a person in the whole sense cannot be a prerequisite to one's inclusion under the Fourteenth Amendment, or else neither women nor African Americans would have ever been included. Accordingly, given that the Fourteenth Amendment is dedicated to inclusion, the Constitution should be interpreted to apply equally to the unborn members of the population as well.

### **C. The Policy Announced in *Vuitch***

The relevance to *Roe* of the policy announced in *Vuitch* was an inferential one—at least ostensibly.<sup>8</sup> As stated in *Roe*, 410 U.S. 158-159:

Indeed, our decision in *United States v. Vuitch*, 402 U. S. 62 (1971), inferentially is to the same effect [of persuading us that the word “person,” as used in the Fourteenth Amendment, does not include the unborn], for we there would not have indulged in statutory interpretation favorable to abortion in specified circumstances if the necessary consequence was the termination of life entitled to Fourteenth Amendment protection.

Rather than denying that the unborn had ever been recognized in the law as persons, *Roe* fabricated an indefinite standard, which it called persons in the “whole” sense, and declared that for this standard the unborn did not qualify. 410 U.S. at 162 (“In short, the unborn have never been recognized in the law as persons in the whole sense.”)

In support of this standard, *Roe* recalled that, in the history of the English statutory law, the use of the term “unlawfully” in the Offences Against the Person Act of 1861, 24 & 25 Vict., c. 100, §§ 58 and 59 (“unlawfully ... procure the miscarriage of any woman”), was interpreted in a 1939 case to imply that the mother’s condition was the sole determinant

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<sup>8</sup> As if testing the waters, the Court may have used *Vuitch* to see whether the Nixon Administration would invoke the Fourteenth Amendment on behalf of the unborn, which it did not. Though *Roe* and *Doe v. Bolton* were both on the docket before *Vuitch*, the Court did not agree to hear them until the day after *Vuitch* was decided. Both relied on *Vuitch*.

of the lawfulness of an abortion. 410 U.S. at 136-137. See also 410 U.S. at 157-158 & n. 54:

But if the fetus is a person who is not to be deprived of life without due process of law, and if the mother's condition is the sole determinant, does not the Texas exception appear to be out of line with the [Fourteenth] Amendment's command?

In former times, however, the definition of murder often included the word "unlawfully" in the statute. For example, as the Tennessee Supreme Court stated its law in 1923, *Morgan v. State*, 148 Tenn. 417, 420 (1923):

The definition of murder contained in our Code is as follows:

"If any person of sound memory and discretion, unlawfully kill any reasonable creature in being, and under the peace of the state, with malice aforethought, either express or implied, such person shall be guilty of murder." Thompson's-Shannon's Code, § 6438.

This is the same definition given by Lord Coke, Co. 3 Inst. 47, and by Blackstone, 4 Bl. Com. 195, except that in England the act is committed "under the king's peace" and here it is committed "under the peace of the state."

Hence, though some killing may be taken to be lawful according to such a statute—or at least not murder—it bears not at all on whether the victim is a person having constitutional rights. Accordingly, whether a particular exception comports with the



Constitution is a completely different question than whether the victim is a person.

Using exceptionally weak reasoning, *Roe* posited as its fundamental proposition that the unborn are beings so far inferior that they have no rights which others of us are bound to respect. Yet *Dobbs* did the same. *Dobbs* did nothing to disturb *Roe*'s most egregious wrong: the denial of our equality with the unborn. Instead, having accepted from *Roe* the fundamental proposition of inequality, *Dobbs* did no more than to reassign to elected representatives the control *Roe* claimed over the unborn.

Accordingly, to redress this egregious wrong at its roots, the Court should overrule *Vuitch* in favor of equality with the unborn.

**2. Whether 37 C.F.R. § 1.704(c)(10) lawfully reduces the patent term for an applicant's refusal to surrender stewardship of the specification claims to the Examiner in deference to an unauthorized claim amendment contained in a notice of allowance?**

The importance to a patent of the specification claims cannot be understated. "It is the claims which define the metes and bounds of the invention entitled to the protection of the patent system," *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994), and which provide "the public ... fair notice" of what an issued patent protects, *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538 (Fed. Cir. 1991). The applicant is the steward of what the inventor claims by oath or declaration as his or her invention. See 37 C.F.R. § 1.63. The question is whether the Examiner can usurp the applicant's stewardship role to expedite processing of a patent application.

Patent prosecution begins with the filing of an application and involves a “back and forth” between the applicant and Examiner. If the application is allowable, the Examiner issues a notice of allowance, which terminates prosecution. If not allowable, the Examiner issues an Office action as notice of the reasons for the “rejection.” The applicant then has an opportunity to respond in the form of a “reply.” Such notice and the opportunity to respond is a hallmark of procedural due process protected by the Due Process clause of the Fifth Amendment. See *Mullane v. Cent. Hanover Bank & Trust Co.*, 339 U.S. 306, 313 (1950).

In this case, however, the Federal Circuit upheld a workaround to shortcut the time it takes for the back-and-forth process to fully play out: Without giving prior notice to the applicant of a suggested Examiner’s amendment to the claims, prosecution can be concluded by issuing a notice of allowance upon claims amended in whatever way makes sense to the Examiner acting alone. According to the Federal Circuit, the applicant must accept the shortcut and silently acquiesce to the Examiner’s amendment—or be penalized with reduction of the patent term for delaying prosecution.

#### **A. Why Did the Examiner Take a Shortcut?**

In the ideal rejection scenario, the first rejection is non-final and the second is final. The classic exception is “where the examiner introduces a new ground of rejection” that is not necessitated by something new coming from the applicant. See MPEP § 706.07(a). This is meant to prevent the Examiner from sidestepping the back-and-forth process by “going final” in a way that deprives the

applicant of the opportunity to respond to a ground for rejection that could have been raised earlier in a non-final rejection. There are also cases which may require finality to be withdrawn.

In this case, the first rejection mailed March 31, 2016 was non-final. The second rejection mailed September 26, 2016 was final; however, finality was withdrawn and the action vacated because the Supervisory Patent Examiner (SPE) agreed that a new ground for rejection was made which not necessitated by the applicant's amendment. See Applicant-Initiated Interview Summary, mailed December 7, 2016. The third rejection mailed February 13, 2020 was non-final. The fourth rejection mailed October 31, 2017 was final; however, finality was ultimately withdrawn because the SPE agreed that claims withdrawn from consideration by the Examiner should have been examined. See Applicant-Initiated Interview Summary, mailed December 29, 2017; Applicant-Initiated Interview Summary, mailed April 4, 2018. The fifth rejection mailed May 31, 2018 was non-final.

What happened next was that the Examiner realized that claim 30 needed to be rejected for indefiniteness under 35 U.S.C. § 112, second paragraph. As reported by the Examiner in a post-allowance interview summary: "With regards to claim 30, Applicant asked about the change in claim 30. Examiner clarified that it was due to correct a 112 2nd issue." See Applicant-Initiated Interview Summary, mailed February 26, 2019. As the applicant's own interview summary explains in more detail: "[T]he Examiner indicated that the 'wherein' clause had been added by the Examiner's amendment of claim 30 with respect to --enclosure

walls- to avoid indefiniteness with respect to a previous instance of --enclosure walls-....” See Applicant Summary of Interview with Examiner, filed January 10, 2019.

However, from taking a look at the applicant’s amendment of claim 30 in the reply filed August 30, 2018, it is evident that both instances of --enclosure walls- were *already present* prior to the fifth non-final rejection mailed May 31, 2018. Accordingly, the rejection of claim 30 for indefiniteness would have been a new ground for rejection not necessitated by the applicant’s amendment. Consequently, a *sixth* non-final action would have been required to make such a rejection in proper fashion.

Unfortunately, as part of their performance metric, Examiners are under a great deal of pressure from the Office to conclude prosecution within no more than two actions on the merits, the exception being if the applicant files a request for continued examination. So it is easy to appreciate why this innovative shortcut was so tempting for the Examiner. However, petitioner does not want to in any way paint a bad picture of Examiner Lannu. On the contrary, without his great helpfulness and exceptionally great patience, the subject application might never have been patented.<sup>9</sup>

Nonetheless, petitioner does not want the patent term to be reduced because of it either.

### **B. Applicant’s Response to the Shortcut**

“The patent prosecution process involves significant back and forth, during which it is assumed that the PTO will sometimes make

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<sup>9</sup> Input from his primary, Examiner Matthews, is also appreciated.

mistakes and applicants will have the opportunity to correct those mistakes.” *Univ. of Mass. v. Kappos*, 903 F. Supp. 2d 77, 86 (D.D.C. 2012). For example, in response to a final action, the applicant has many such opportunities, including by reply, request for withdrawal of finality, request for restart of the action, participation in the After-Final Consideration Pilot 2.0, request for continued examination, and appeal to the Patent Trial and Appeal Board. In contrast, none of these opportunities are available in response to a notice of allowance; instead, the applicant’s opportunity to correct Office mistakes is limited because issuing the notice has the effect of closing prosecution on the merits.

In any event, the object is to correct the mistake, not to hammer out exactly what the Office did wrong. In this case, exactly what the Office did wrong was to issue a notice of allowance upon an Examiner’s amendment making substantive changes to the specification claims without prior authorization from the applicant. See MPEP § 1302.04 (“No examiner’s amendment may make substantive changes to the written portions of the specification, including the abstract, without first obtaining applicant’s approval.”)

One way to hammer this out would have been to petition the Office to withdraw the application from issue due to “[a] mistake on the part of the Office.” See 37 C.F.R. § 1.313(b)(1). However, withdrawal from issue generally requires the approval of the Technology Center (TC) Director. But before approaching the TC Director, the usual recourse is to first approach the Examiner and, if unsuccessful, the SPE. In this case, however, when the applicant approached the Examiner, an agreement was

reached in the form of a mutually acceptable post-allowance amendment.

The applicant's post-allowance success in negotiating with the Examiner obviated any need to hammer out the Office mistake and withdraw the application from issue. Accordingly, the applicant's recourse eliminated the tremendous delay in patent issuance presented by the alternative: petition to withdraw from issue, withdrawal from issue, issue of a sixth non-final action including a new ground for rejection and the Examiner's suggestion of an amendment of the claims to make the application allowable, applicant's reply, and issuance of a new notice of allowance—all of this just to end up with the same claims that were agreed upon by way of the post-allowance amendment.

### **C. Office Response to Applicant's Recourse**

In cases where the patent term would otherwise be extended by a period of adjustment under 35 U.S.C. § 154(b) to account for Office delays, reduction of the period of adjustment is provided under § 154(b)(2)(C)(i) to account for the period of time during which the applicant "failed to engage in reasonable efforts to conclude prosecution of the application." Congress specified one example of such failure under § 154(b)(2)(C)(ii), and left it to the Director of the Office under § 154(b)(2)(C)(iii) to prescribe other examples by regulation. Under 37 C.F.R. § 1.704(c)(10), the Director provided one such example for filing a post-allowance amendment.

In this case, based on manual entries to the application transaction history, the Office computer system automatically flagged what was labeled as a post-allowance amendment and the patent term was

reduced by 51 days. Although the computer system itself cannot make value judgments, patentee petitioned the Director for reconsideration under 35 U.S.C. § 154(b)(3)(B)(ii).

The Director denied reconsideration, finding no exception for the applicant's post-allowance amendment. See App. a25.

#### **D. Matters Requiring Clarification**

The Federal Circuit opinion reports incorrectly that “[a]fter an extensive prosecution involving numerous amendments, the examiner found that Californiaa’s patent could issue if *minor* additional changes [emphasis added] were made to the claim language. C.A. 101–03. [Footnote 4: “C.A.” refers to Appellee’s Corrected Appendix.]” App. a4. As reported by the Examiner in a post-allowance interview summary: “With regards to claim 30, Applicant asked about the change in claim 30. Examiner clarified that it was due to correct a 112 2nd issue.” C.A. 130. Hence, because the changes were made to overcome a ground for rejection and thus implicate patentability, the changes were therefore *substantive*, not minor.

The Federal Circuit opinion reports incorrectly that “[t]he examiner made the amendment on his own *authority* [emphasis added] and mailed the Notice of Allowance on December 11, 2018. C.A. 100.” App. a4. Though the Examiner made the amendment on his own *initiative*, he was without authority to do so, given that it is expressly prohibited to make such changes without first obtaining approval from the applicant. See MPEP § 1302.04 (“No examiner’s amendment may make substantive changes to the written portions of the specification, including the

abstract, without first obtaining applicant's approval.") MPEP § 1302.04 enumerates only three circumstances in which the Examiner may amend the claims prior to allowance without prior applicant authorization, but in each case these are limited to clerical matters that are not at issue here. See App. a47-48 (## A, D-E).

Defendant is incorrect to say at the Federal Circuit that "Plaintiff also argued for the first time [at the district court] that he had not approved the examiner's amendment...." See Defendant's Response Brief, p. 9(#2), ECF p. 15. On the contrary, in the decision denying the request for PTA reconsideration, the Office states: "In particular, patentee asserts: The Notice of Allowance contained an Examiner's Amendment not previously discussed with the applicant...." App. a31.

MPEP § 1302.04 provides that "[a]n examiner's amendment should include form paragraph 13.02 [Examiner's Amendment] and form paragraph 13.02.01 [Examiner's Amendment Authorized]." Form paragraph 13.02.01 reads: "Authorization for this examiner's amendment was given in an interview with [1] on [2]." However, the Examiner's amendment included with the notice of allowance does not contain form paragraph 13.02.01. See C.A. 101(#2). This is because the amendment was never authorized by the applicant.

In denying reconsideration, the district court acknowledged that (App. a42, 44):

Plaintiff contends the Court committed clear error ... (5) by finding the "rulemaking [in which the USPTO rejected an exception to PTA reduction when an applicant files an



amendment on the basis that the changes or additions made by an examiner's amendment are unacceptable] only contemplated an 'examiner's amendment' in the ordinary sense of the term, rather than in an exceptional sense...."

However, the district court then goes on to state incorrectly that (App. a44 & n. 5):

Plaintiff failed to raise this argument in his summary judgment papers despite defendant mentioning the rulemaking comment in their brief. *Pac. Ins. Co.*, 148 F.3d at 403; *Def. Br.* (Dkt. No. 14) at 11 (USPTO received and rejected a comment that suggested each application should be reviewed on a case-by-case basis "to determine [whether] a reduction of PTA is warranted").

On the contrary, plaintiff raised this argument in *both* of his summary judgment papers, including in reply to defendant's brief. See *Pl. Br.* (Dkt. No. 12) at 13, ECF p. 18 (also included at the Federal Circuit in *App. Pl. Br.* (Dkt. No. 5) at App. 19). See also *Pl. Reply Br.* (Dkt. No. 23) at 26(#6), ECF p. 34 (also included at the Federal Circuit in *App. Pl. Br.* (Dkt. No. 5) at App. 65 (#6)):

Defendant's memorandum sidesteps the fact the Examiner's Amendment contained by the Notice of Allowance was not merely unauthorized, but more specifically it was unauthorized contrary to MPEP § 1302.04 because it made "substantive changes" to the

specification claims not authorized by the applicant in advance. AR69-71. The petition decision asserts (AR144) that the PTO already addressed in the negative a rulemaking comment which objected that “a paper filed to correct an examiner’s amendment . . . should not be construed as a failure to engage in reasonable efforts to conclude prosecution.” See *Changes To Implement Patent Term Adjustment Under Twenty-Year Patent Term*, 65 Fed. Reg. at 56387 (comment 41 and response). See also Df. Mem., p. 17, #10.b. However, because the plain and ordinary meaning of “examiner’s amendment” is one in accord with MPEP § 1302.04, the rulemaking was “without observance of procedure required by law” under 5 U.S.C. § 706(2)(D) in terms of any asserted capacity to address the unusual circumstances presented by the present case.

Appellant raised this same issue at the Federal Circuit in his opening brief under the heading, “Did the trial court fail to consider important grounds for relief?” See Pl. Br. (Dkt. No. 4) at 2(#4A). But the Federal Circuit ignored it. Instead, its opinion simply states (App. a5), “The PTO found that the situation still fell within the rule,” without ever considering whether the rulemaking in support of 37 C.F.R. § 1.704(c)(10) fairly contemplated an Examiner’s amendment not conforming to MPEP § 1302.04, as is presented by the specifics of the present case.

The Federal Circuit opinion reports incorrectly that “Californiaa filed a *substantive* after-allowance amendment unrelated to the *minor* amendment made by the examiner....” Emphasis added. App.

a11. The Examiner amended claims 29, 30, 55, 56, 57, 60, 61, 63, 65, and 66. C.A. 101-103. As stated above, the Examiner's amendment of claim 30 was substantive, not minor, because it was made to overcome an unpatentability issue under 35 U.S.C. § 112, second paragraph. C.A. 159. The Examiner's treatment of claim 29 was similar. Applicant's post-allowance amendment was limited to claims 29, 30, and 37. C.A. 135. Only the post-allowance amendment of claim 37 was unrelated to the Examiner's amendment. C.A. 136. Parties agree that the post-allowance amendment of claim 37 involved only a minor grammatical revision. See Appellee's Br. (Dkt. No. 16) at 19, ECF p. 25:

In addition, as the USPTO also observed, in this case the changes to the patent that plaintiff proposed after the notice of allowance were not limited to responses to the examiner's amendments. Instead, plaintiff made minor grammatical changes to a claim that the examiner had not amended. See Appx126-127 (plaintiff's amendment to claim 37); Appx101-103 (examiner's amendments).

In other words, the Federal Circuit got matters completely backwards. Instead, the Federal Circuit opinion should have correctly reported that 'Californiaa filed a *minor grammatical* after-allowance amendment unrelated to the *substantive* amendment made by the examiner....' Cf. App. a11.

The Federal Circuit opinion reports incorrectly that that the post-allowance amendment made "several substantive changes (e.g., the deletion of limitations) unrelated to the examiner amendment.

C.A. 117-36.” App. a4-5. The reason why the post-allowance amendment of claims 29 and 30 cannot be “unrelated” to the Examiner’s amendment is that the post-allowance amendment overcame the Examiner’s patentability concerns, albeit in a different way than was done in the Examiner’s amendment.

At the district court, defendant incorrectly states that “during administrative proceedings before the USPTO, plaintiff acknowledged that the examiner’s amendment was actually a proper exercise of the examiner’s authority to assist *pro se* inventors in drafting proper patent claims. A133 (citing *MPEP* § 707.07(j)).” See Def. Br. (Dkt. No. 15) at 18 & n. 10, ECF p. 19. On the contrary, *MPEP* § 707.07(j) provides that the Examiner should “indicate in his or her action that such claims *would be* allowed *if* incorporated in the application by amendment.” Emphasis added. App. a47. From context (i.e., “would be allowed”), it is evident that under *MPEP* § 707.07(j) a notice of allowance is not the proper place for the Examiner to present Examiner-drafted claims to the applicant for the first time. See also the corresponding form paragraph for this procedure, ¶ 7.43.04 (Suggestion of Allowable Drafted Claim(s), Pro Se): “The following claim [1] drafted by the examiner and considered to distinguish patentably over the art of record in this application, [is/are] presented to applicant *for consideration*: [insert claim].” Emphasis added. App. a47.

Accordingly, during administrative proceedings before the Office, patentee argued that “an amendment under Rule 312 [post-allowance amendment under 37 C.F.R. § 1.312] is the **only** procedure available for an applicant to suggest changes to an Examiner’s amendment drafted under

MPEP 707.07(j) and presented for the first time in a notice of allowance.” C.A. 165. Not only is this the only procedure for suggesting changes, for reasons discussed above it was more expedient in this case than seeking outright withdrawal of the application from issue under 37 C.F.R. § 1.313(b)(1).

Finally, defendant is incorrect to say at the Federal Circuit that “plaintiff would not have been entitled to any additional PTA if the examiner had not made an examiner’s amendment and mailed a notice of allowance but had instead simply rejected the claims and left plaintiff to make the amendment himself through a request for continued examination.” Appellee’s Br. (Dkt. No. 16) at 11, ECF p. 17. As an initial matter, a request for continued examination only pertains to a final action; yet, for reasons discussed above, a non-final action would have been required to make a new ground for rejecting claim 30. Moreover, a non-final action would have enabled the applicant to enter any amendment under the Sun as a matter of right.

However, even if the Examiner had gone final and the finality was not withdrawn, recourse to a request for continued examination would have been unnecessary given the facts of the case. Even in the event of a final action, for reasons discussed above the Examiner still would have been expected under MPEP § 707.07(j) to include a draft of his suggestion of a claim amendment to make the application allowable using form paragraph 7.43.04. Under the After Final Consideration Pilot 2.0, the applicant would have then been entitled to present the same claims presented in the after-allowance amendment. See 78 Fed. Reg. 29117. And even under pre-pilot practice (see 37 C.F.R. § 1.116), entry of the same

claims presented in the after-allowance amendment would have been within the Examiner's discretion, given that the changes made by the applicant to claims 29, 30, and 37 in adopting the Examiner's suggestions required only "cursory review" by the Examiner (see MPEP § 714.13), as evidenced by the post-allowance interview success. C.A. 159.

Hence, if instead the Examiner had gone final or non-final, either way the applicant would not have had to file a request for continued examination and would thus have been entitled to an additional amount of PTA based on the usual Office delays accorded to normal operating procedures.<sup>10</sup>

### **E. Summary of Issues Before Federal Circuit**

During administrative proceedings before the Office, the patentee claimed that no amount of reduction in the period of PTA was proper. C.A. 163-165.

At the district court, there was disagreement between parties over the standard of review. Plaintiff asserted that the agency decision was entitled to no more than *Skidmore* deference. See *Skidmore v. Swift & Co.*, 323 U.S. 134 (1944). Defendant asserted entitlement to *Chevron* deference. See *Chevron U.S.A. Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837 (1984). The district court noted that "the Federal Circuit has reached inconsistent conclusions on this very point." App. a42, #1 & n. 2. Under the *Chevron* framework, "First, always, is the question whether Congress has directly spoken to the precise question at issue." 467 U.S. at 842. Accordingly, in response to defendant's assertion of

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<sup>10</sup> Likely at least up to 4-6 months.

*Chevron* deference, plaintiff offered a statement of the precise question at issue should the district court pursue *Chevron* deference. In contrast, defendant offered no such statement, not even in reply to the one offered by plaintiff. But when applying *Chevron* deference, the district court ignored plaintiff's statement and instead fashioned one of its own to cover for the defendant's lack of a statement. See App. a21. In denying reconsideration, the district court acknowledged that it had considered plaintiff's statement. See App. a44-45, #6 & n. 6.

At the district court, plaintiff argued that even if some PTA reduction is proper, the Office reduced it improperly, either because it failed to apply the decision in *Supernus Pharms., Inc. v. Iancu*, 913 F.3d 1351 (Fed. Cir. 2019), decided months before the patent issued, or because manual entry of the transaction history mistakenly labeled an interview request as a post-allowance amendment. Defendant argued that new arguments cannot be raised in a proceeding under 35 U.S.C. § 154(b)(4). On the authority of *Kappos v. Hyatt*, 566 U.S. 431 (2012), and *Troy v. Samson Mfg. Corp.*, 758 F.3d 1322 (Fed. Cir. 2014), plaintiff argued that § 154(b)(4) institutes *de novo* review of the agency's PTA reconsideration. Plaintiff also argued that his newly reformulated arguments in support of his claim of improper PTA reduction are admissible at any rate under *Yee v. Escondido*, 503 U.S. 519, 534 (1992) ("Once a federal claim is properly presented, a party can make any argument in support of that claim; parties are not limited to the precise arguments they made below." Internal citations omitted.) The district court refused to consider new arguments. See App. a23-24 & n. 3.

All of these issues were before the Federal Circuit. However, defendant argued that the issue of the mistakenly labeled interview request was not adequately developed in plaintiff's opening brief on appeal. See Appellee's Br. at 23(#D), ECF p. 29. Plaintiff responded that favorable resolution of the new arguments issue would require remand to the district court to determine the interview request issue should the Federal Circuit decline to address it itself. See Appellant's Mem. in Lieu of Oral Arg. at 2 (decision flowchart) as described at 5.

#### **F. Response to Federal Circuit's Reasoning**

What is so troubling about the Federal Circuit's opinion is its offensiveness to the patent system. The opinion allows the Examiner to shortcut any further back and forth with the applicant simply by issuing a notice of allowance upon an application amended in whatever way makes sense to the Examiner acting alone. Accordingly, the opinion gives the Examiner the unilateral option of becoming the final steward of the specification claims when closing prosecution by way of allowance, such that a penalty must be paid in the form of a reduction of the period of PTA should the applicant question his or her loss of stewardship after allowance.

As to how the Federal Circuit came to its decision, six examples of its reasoning stand out.

##### 1.

Reflecting on *Supernus*, the opinion states (App. a8-9):

Where the facts of *Supernus* and the present case differ, however, is that the



applicant in *Supernus* had no feasible actions it could have taken to conclude prosecution between the filing of its Request for Continued Examination and the European Patent Office's Notice of Opposition. Here, Californiaa could have, at any time in the 51 days between the filing of his after-allowance amendment and the examiner's acceptance of the proposal, withdrawn his after-allowance amendment, concluding prosecution. Therefore, unlike in *Supernus*, there was an "identifiable effort" in which Californiaa could have engaged to conclude prosecution.

Yet abandoning stewardship of the claims is in principle little different than outright abandonment of the entire application. With this in mind, the applicant in *Supernus* could have easily 'concluded prosecution' in like fashion simply by at any time filing a letter of express abandonment under 37 C.F.R. § 1.138. Yet the Federal Circuit seems to think there is some sort of fundamental difference between abandoning stewardship of the claims and abandoning the entire application. Simply put, the opinion is premised on the offensive insistence that the applicant can be expected to sacrifice his or her stewardship of the claims in deference to Examiner efforts to conclude prosecution more swiftly than the traditional back and forth would allow.

2.

Plaintiff provided a flowchart to keep track of the four decisions (D) presented for the Federal Circuit's consideration. See Appellant's Mem. in Lieu of Oral Arg. at 2 (decision flowchart). The first (D1) asks

whether 37 C.F.R. § 1.704(c)(10) Revised as of March 10, 2015 should apply indiscriminately so as to shield the Office in the instant circumstances. If answering D1=Yes, the second (D2) asks whether new or newly formulated arguments can be presented for the first time at the district court. If answering D2=Yes, the third (D3) asks whether PTA reduction is governed by pre-*Supernus* standards in the instant case. If answering D3=Yes, the fourth (D4) asks whether a post-allowance interview request counts toward the reduction of PTA.

Without addressing D2 (new arguments issue), the Federal Circuit found D3=Yes (that pre-*Supernus* standards apply even though the patent issued after *Supernus*). From this the opinion incorrectly concludes: “Because we resolve this issue [D3] on the merits, we do not reach the issue of forfeiture [D2].” App. a9. But as the flowchart shows, in order to avoid having to reach the issue of forfeiture (D2) (aka the new arguments issue), the Federal Circuit would have first needed to resolve the interview request issue (D4) on the merits and, in so doing, find that D4=Yes. Hence, because it did not do so, the Federal Circuit was not entitled to sidestep the issue of forfeiture as it did. See App. a7-9.

3.

When all was said and done, the Federal Circuit sidestepped making any decision on D1 (whether 37 C.F.R. § 1.704(c)(10) shields the Office no matter what the circumstances), D2 (whether new or newly formulated arguments are forfeited at the district court by not raising them at the Office), and D4 (whether a post-allowance interview request should result in a reduction in PTA). Instead, the Federal

Circuit only addressed D3 (whether PTA reduction is governed by pre-*Supernus* standards in the instant case). Though D1 is the *main issue* of the case, the opinion sidestepped it as follows (App. a11):

Californiaa asserts that an exception should be made for after-allowance amendments made in response to examiner-made amendments in the Notice of Allowance, as they could not have been raised earlier. But this is not the situation at hand. Californiaa filed a substantive after-allowance amendment unrelated to the minor amendment made by the examiner and he has not provided any reason that the amendment could not have been made earlier. C.A. 101–136. We decline to consider a situation not before us.

As discussed above, the Federal Circuit muddled up which claim amendments were substantive versus which were minor. Additionally, the opinion widens defendant's proffered rabbit hole, namely, that the applicant somehow needed to establish why his amendments were not made prior to allowance. The defendant's rabbit hole was limited to the post-allowance amendment making minor grammatical revision of claim 37. See Appellee's Br. (Dkt. No. 16) at 19, ECF 25. But the Federal Circuit widened it by including the entire amendment.

Needless to say, since the applicant is not the Examiner, he would not have known to submit an amendment to claims 29 and 30 to overcome a rejection that the Examiner had not made yet. As to the amendment of claim 37, a minor grammatical change not required for patentability is generally

unwarranted, save for when it piggybacks a needed amendment being made at the same time; hence, along with the need to amend claims 29 and 30 came the opportunity to make a grammatical change to claim 37.

Even aside from this, the opinion's assessment of the "situation" is incorrect at any rate. By diving into a rabbit hole, the Federal Circuit tacitly *ruled* on the merits of the rabbit hole itself. As discussed above, if the Examiner had gone non-final with his new ground for rejecting claim 30, applicant's reply would have been entitled to make any amendment under the Sun as a matter of right; likewise, even if the Examiner had gone final with the rejection and the finality was maintained, applicant still would have been allowed to present the very same claim listing in a response after final.

So though the opinion sidesteps the issue, nothing fairly suggests that an applicant's response to an unauthorized Examiner-made amendment presented for the first time in a notice of allowance must at least be somehow restricted if to avoid penalty under § 1.704(c)(10). For example, suppose the Examiner had refused to enter the post-allowance amendment. At that point, the applicant could have still had the application withdrawn from issue due a mistake on the part of the Office for failure to obtain applicant authorization for the Examiner's amendment; in this scenario, there would be no cause for PTA reduction and an appropriate Office action (e.g., non-final) would ensue. It follows that there can be no cause for PTA reduction when, instead, as in the present case, the applicant works things out with the Examiner to avoid having to withdraw the application from issue in the first place.

Noted is that a reply to a rejection must be “fully responsive” to the Examiner’s concerns. See MPEP § 714.02. But a responsive amendment need not be precisely limited to those concerns. Here the Examiner addressed his patentability concerns by way of an unauthorized Examiner’s amendment, thereby shortcutting issuance of a claim rejection. Yet applicant’s post-allowance amendment was *fully responsive* to those concerns, seeing how the patent issued upon it. Accordingly, the minor grammatical revision of claim 37 did not render the post-allowance amendment nonresponsive.

## 4.

As discussed above, the district court recognized that the Federal Circuit has reached inconsistent conclusions on whether *Skidmore* or *Chevron* deference applies to the PTA determination. Yet the Federal Circuit presumed to summarily resolve the discord in a *nonprecedential* opinion. See App. a7.

## 5.

Congress set forth one example of an applicant’s failure to engage in reasonable efforts to conclude prosecution. See 35 U.S.C. § 154(b)(2)(C)(ii). But Congress instructed the Office *not* to interpret this as including circumstances beyond the applicant’s control. See § 154(b)(3)(C). Hence, when directing the Office to set forth other examples of such failure under § 154(b)(2)(C)(iii), Congress must be understood to have excluded from the meaning of “failure to engage in reasonable efforts” any circumstances beyond the applicant’s control; otherwise, the meaning of the term would not be interpreted *consistently* throughout § 154(b)(2)(C).

See *Strategic Housing Fin. Corp. v. United States*, 608 F.3d 1317, 1330 (Fed. Cir. 2010) (“[C]ourts should interpret statutes with similar language that generally address the same subject matter together, ‘as if they were one law.’” (quoting *Erlenbaugh v. United States*, 409 U.S. 239, 243 (1972))).

But rather than interpreting “reasonable efforts” consistently, the Federal Circuit put blinders on—as if §§ 154(b)(2)(C)(i) and 154(b)(2)(C)(iii) existed alone by themselves—and ignored the valuable guidance § 154(b)(3)(C) provides for interpreting this term in § 154(b)(2)(C)(ii). The opinion thus came to the absurd conclusion that the patent applicant can be penalized for serving as the sole steward of what the inventor claims as his or her invention. See App. a6-11.

6.

As to whether 37 C.F.R. § 1.704(c)(10) is based on a permissible construction of 35 U.S.C. § 154(b)(2)(C)(iii), the Federal Circuit concludes step two of its *Chevron* analysis as follows (App. a11):

After-allowance amendments predictably delay the close of prosecution, and we cannot say that it was arbitrary for the PTO to conclude that applicants that elect to file amendments after having *their* claims allowed [emphasis added] generally should be charged with delay. We therefore find that the PTO’s interpretation of the statute was permissible here.

But this is not a situation where “their” claims were allowed. Rather, the situation at hand is where

“their” claims were *rejected* in favor of unauthorized claims entered by the Examiner acting alone.

CONCLUSION

The petition should be granted.

Respectfully submitted,

Eurica Californiaa  
*Pro Se*  
57 Circle Way  
Mahopac, NY 10541-1736  
(310) 804-0727  
amb@juridic.org

*Petitioner*

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