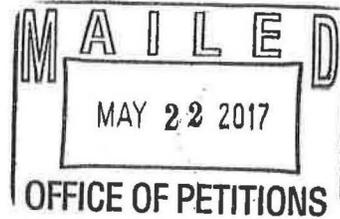




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In re Application of: Peter B.J. Van Gerwen :
Appl. No.: 12/957,085 :
Filed: November 30, 2010 :
Attorney's Docket No.: 5441-366 :
Title: HEARING PROSTHESIS HAVING A :
FLEXIBLE ELONGATE ENERGY TRANSFER :
MECHANISM :

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.181 filed March 17, 2017, requesting that the Director exercise her supervisory authority and overturn the decision of January 17, 2017, by the Director of Technology Center 3700 (Technology Center Director), which decision refused to designate the examiner's answer of August 29, 2016 as containing a new ground of rejection and reopen prosecution of the application or generate a new examiner's answer.

The petition to overturn the decision of the Technology Center Director and designate the examiner's answer of August 29, 2016 as containing a new ground of rejection or generate a new examiner's answer is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on November 30, 2010.

Prosecution of the above-identified application resulted in a final Office action being issued on July 15, 2015. Claim 27 was rejected under 35 U.S.C. § 112, ¶ 1,¹ as failing to comply with the written

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated 35 U.S.C. § 112, ¶¶ 1 through 6, as 35 U.S.C. §§ 112(a) through (f), effective as to applications filed on or after September 16, 2012. See Pub. L. No. 112-29, § 4, 125 Stat. 284, 293-97 (2011). Section 3 of the AIA revised 35 U.S.C. §§ 102 and 103, effective as to applications having any claim with an effective filing date on or after March 16, 2013. See Pub. L. No. 112-29, § 3, 125 Stat. at 285-293. Since the above-identified

description requirement. Claims 1, 4, 5, 9 through 15, 17, 20, 22, 23, 25 through 30 and 35 were rejected under 35 U.S.C. § 112, ¶ 2, as being indefinite. Claims 31 through 38 and 41 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ball (U.S. Patent No. 6,139,488). Claims 1, 4, 5, 9 through 11, 13-15, 17, 20, 23 and 25 through 30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gilman (U.S. Patent No. 5,176,620) and Hortmann (U.S. Patent No. 5,411,467). Claim 12 was rejected under 35 U.S.C. § 103(a) as unpatentable over Gilman, Hortmann, and Leysieffer (U.S. Patent Application Publication No. 2001/0031996). Claims 1, 39 and 40 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ball and Saadat (U.S. Patent No. 6,051,008). Claim 22 was rejected under 35 U.S.C. § 103(a) as unpatentable over Ball, Saadat, and Schaefer (U.S. Patent No. 4,729,366).

A notice of appeal (and notice of appeal fee) was filed on December 15, 2015 along with a pre-appeal conference request. The pre-appeal conference decision made by the panel on February 2, 2016 was to proceed to the Patent Trial and Appeal Board (the Board). An appeal brief was filed on March 20, 2016.

An examiner's answer was issued on August 29, 2016. The examiner withdrew the rejection of claim 27 under 35 U.S.C. § 112, ¶ 1, as well as the rejection of claims 1, 4, 5, 9 through 15, 17, 20, 22, 23, 25 through 30 and 35 under 35 U.S.C. § 112, ¶ 2.

A petition under 37 CFR 1.181 was filed on October 28, 2016. Petitioner argued that the examiner's answer included new grounds of rejection by including other new facts/rationales (*i.e.*, new grounds of rejections) throughout the "Response to Arguments" section.

The petition of October 28, 2016 was denied by the Technology Center Director in a decision mailed on January 17, 2017.

A reply brief (and appeal forwarding fee) was filed on March 17, 2017.

The instant renewed petition under 37 CFR 1.181 was filed on March 17, 2017, and again requests that the examiner's answer of August 29, 2016 be designated as containing a new ground of rejection and prosecution of the application be reopened or a new examiner's answer be generated.

application was filed prior to September 16, 2012, and has only claims with an effective filing date prior to March 16, 2013, this decision refers to the pre-AIA versions of 35 U.S.C. §§ 102, 103, and 112.

STATUTE AND REGULATION

35 U.S.C. § 134 provides that:

(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 Patent Trial and Appeal Board, having once paid the fee for such appeal.

(b) PATENT OWNER.— A patent owner in a reexamination may appeal from the final rejection of any claim by the primary examiner to the Patent Trial and Appeal Board, having once paid the fee for such appeal.

37 CFR 41.31 provides that:

(a) Who may appeal and how to file an appeal. An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.02(b)(1) within the time period provided under § 1.134 of this title for reply.

(2) Every owner of a patent under ex parte reexamination filed under § 1.510 of this title before November 29, 1999, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(3) Every 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 (§ 1.113 of this title) rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(b) The signature requirements of §§ 1.33 and 11.18(a) of this title do not apply to a notice of appeal filed under this section.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

37 CFR 41.39 provides that:

(a) *Content of examiner's answer.* The primary examiner may, within such time as may be directed by the Director, furnish a written answer to the appeal brief.

(1) An examiner's answer is deemed to incorporate all of the grounds of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory action and pre-appeal brief conference decision), unless the examiner's answer expressly indicates that a ground of rejection has been withdrawn.

(2) An examiner's answer may include a new ground of rejection. For purposes of the examiner's answer, any rejection that relies upon any Evidence not relied upon in the Office action from which the appeal is taken (as modified by any advisory action) shall be designated by the primary examiner as a new ground of rejection. The examiner must obtain the approval of the Director to furnish an answer that includes a new ground of rejection.

(b) *Appellant's response to new ground of rejection.* If an examiner's answer contains a rejection designated as a new ground of rejection, appellant must within two months from the date of the examiner's answer exercise one of the following two options to avoid sua sponte dismissal of the appeal as to the claims subject to the new ground of rejection:

(1) *Reopen prosecution.* Request that prosecution be reopened before the primary examiner by filing a reply under § 1.111 of this title with or without amendment or submission of affidavits (§§ 1.130, 1.131, or 1.132 of this title) or other Evidence. Any amendment or submission of affidavits or other Evidence must be relevant to the new ground of rejection. A request that complies with this paragraph will be entered and the application or the patent under ex parte reexamination will be reconsidered by the examiner under the provisions of § 1.112 of this title. Any request that prosecution be reopened under this paragraph will be treated as a request to withdraw the appeal.

(2) *Maintain appeal.* Request that the appeal be maintained by filing a reply brief as set forth in § 41.41. Such a reply brief must address as set forth in § 41.37(c)(1)(iv) each new ground of rejection and should follow the other requirements of a brief as set forth in § 41.37(c). A reply brief may not be accompanied by any amendment, affidavit (§§ 1.130, 1.131, or 1.132 of this title) or other Evidence. If a reply brief filed pursuant to this section is accompanied by any amendment, affidavit or other Evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under paragraph (b)(1) of this section.

(c) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

37 CFR 41.40 provides that:

(a) *Timing.* Any request to seek review of the primary examiner's failure to designate a rejection as a new ground of rejection in an examiner's answer must be by way of a petition to the Director under § 1.181 of this title filed within two months from the entry of the examiner's answer and before the filing of any reply brief. Failure of

appellant to timely file such a petition will constitute a waiver of any arguments that a rejection must be designated as a new ground of rejection.

(b) *Petition granted and prosecution reopened.* A decision granting a petition under § 1.181 to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant must file a reply under § 1.111 of this title to reopen the prosecution before the primary examiner. On failure to timely file a reply under § 1.111, the appeal will stand dismissed.

(c) *Petition not granted and appeal maintained.* A decision refusing to grant a petition under § 1.181 of this title to designate a new ground of rejection in an examiner's answer will provide a two-month time period in which appellant may file only a single reply brief under § 41.41.

(d) *Withdrawal of petition and appeal maintained.* If a reply brief under § 41.41 is filed within two months from 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.

(e) *Extensions of time.* Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.

OPINION

Petitioner asserts that the examiner's answer of August 29, 2016 contains a new ground of rejection, and thus, argues that prosecution should be reopened. Alternatively, petitioner requests that a new examiner's answer be generated.² The petition presents numerous examples of changes between the explanations given in the final Office action of July 15, 2015 and the examiner's answer of August 29, 2016, and cites *In re Imes*, 778 F.3d 1250 (Fed. Cir. 2015), and *In re Leithem*, 661 F.3d 1316 (Fed. Cir. 2011), in support of the argument the examiner's answer of August 29, 2016 contains a new ground of rejection.

Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. See *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the

² Petitioner also requests a refund of the appeal fees paid in the above-identified application. The appeal fees paid in the above-identified application were necessary to continue proceedings in the above-identified application. Therefore, the appeal fees were not paid by mistake or in excess within the meaning of 35 U.S.C. § 42(d), regardless of whether prosecution is reopened in the above-identified application. See *Miessner v. United States*, 228 F.2d 643 (D.C. Cir. 1955); *Opinion of the Comptroller General of the United States*, 113 USPQ 28 (Comp. Gen. 1957); *Ex parte Grady*, 59 USPQ 276 (Comm'r Pat. 1943).

applicant. See *In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting *Leithem*, 661 F.3d at 1319). The prior rejection, however, need not be repeated *in haec verba* to avoid being considered a new ground of rejection. See *id.* In addition, further explaining and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. See *In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2011).

Section 1207.03(III) of the Manual of Patent Examining Procedure (MPEP) specifically provides that:

A position or rationale that changes the "basic thrust of the rejection" will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the "basic thrust of the rejection" is the same. *In re Kronig*, 539 F.2d at 1303; see also *In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2011) (additional explanation responding to arguments offered for the first time "did not change the rejection" and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when "explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner"); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) ("It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection." (citations omitted)); *In re Cowles*, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of "different language" does not necessarily trigger a new ground of rejection).

See MPEP §1207.03(III).

The final Office action of July 15, 2015 included a rejection of claim 27 under 35 U.S.C § 103 as being unpatentable over Gilman in view of Hortmann.³ The rejection included a citation to Gilman column 3, lines 41 through 47 and column 5, lines 5-15 and an explanation that "[f]lexing conductor around the malleus is considered to obviate flexing about a portion of the mastoid bone since this is done adjacent the mastoid bone".⁴

In the appeal brief of March 2, 2016, petitioner argued, *inter alia*, that "[c]laim 27 explicitly requires the action of flexing the conductor about a portion of the mastoid bone of the recipient. This action is not met by leading the alleged conductor around the bones of the middle ear."⁵ The "Response to Argument" section of the examiner's answer of August 29, 2016 responded to the petitioner's argument

³ See Office action dated July 15, 2015 at page 6.

⁴ *Id.* at page 8.

⁵ See appeal brief filed March 2, 2016 at page 111.

by indicating that “Gilman discloses the conductor is inserted through the mastoid bone and led around the malleus and incus.”⁶ Therefore, the conductor is being moved around the mastoid bone because it is being moved around “structures near the mastoid bone after exiting the mastoid bone.”⁷

The basic thrust of the examiner’s position in rejecting claim 27 has remained the same from the final Office action of July 15, 2015 to the examiner’s answer of August 29, 2016. The claim remains rejected under 35 U.S.C. § 103 as being unpatentable over Gilman in view of Hortmann. The examiner maintains that the conductor is flexed around the malleus and the mastoid bone. The “Response to Argument” section of the examiner’s answer of August 29, 2016 does include additional explanation in response to arguments presented by the petitioner in the appeal brief of March 2, 2016. Such additional explanation, however, does not change the basic thrust of the rejection of claim 27 under 35 U.S.C. § 103 as set forth in the final Office action of July 15, 2015. The additional discussion in the examiner’s answer of August 29, 2016 relative to the final Office action of July 15, 2015 amounts only to an elaboration on the rationale set forth in the final Office action of July 15, 2015. *See Jung*, 637 F.3d at 1364-65. An examiner is not required to anticipate an applicant’s arguments concerning the scope of the claims in advance and preemptively respond to those arguments. *See id.* at 1363. Although the examiner did not use identical language in both the “Response to Argument” section of the examiner’s answer of August 29, 2016, and the final Office action of July 15, 2015, the use of different language in responding to an applicant’s arguments is not considered a new grounds of rejection, provided that the “basic thrust of the rejection” is the same. *See Leithem*, 661 F.3d at 1319 (a prior rejection need not be repeated *in haec verba* to avoid being considered a new ground of rejection).

Additionally, the final Office action of July 15, 2015 included the rejection of claim 35 under 35 U.S.C. § 102(b) as being anticipated by Ball.⁸ The rejection included a citation to Ball, figure 4, reference number 10, and an explanation that “the vibrations are conducted from the actuator to the ear component with the conductor body fixed to a mastoid bone of the recipient. The conductor body being fixed to the mastoid bone is also considered to read on the conductor body being static relative to the mastoid bone.”⁹

In the appeal brief of March 2, 2016, petitioner requests, *inter alia*, clarification on whether “Ball expressly discloses that housing 10 is fixed to the bone, and if so, cite exactly where such a teaching exists in Ball,” or whether “Ball inherently discloses that housing 10 is fixed to the bone, and if so, explain why.”¹⁰ The “Response to Argument” section of the examiner’s answer of August 29, 2016 the examiner responded to the petitioner’s requests by stating, “it would be clear to one of ordinary skill in the art that such device would be fixed relative to the mastoid bone, otherwise the device could become

⁶ See examiner’s answer dated August 29, 2016 at page 9.

⁷ *Id.*

⁸ See Office action dated July 15, 2015 at page 4.

⁹ *Id.* at 5.

¹⁰ See appeal brief filed March 2, 2016 at page 37.

dislodged or “rattle” around within the mastoid bone or middle ear, therefore the conductor is fixed (and thus static) relative to the mastoid bone.”¹¹

As with the rejection of claim 27, the basic thrust of the examiner’s position in rejection claim 36 has remained the same from the final Office action of July 15, 2015 to the examiner’s answer of August 29, 2016. The claim remains rejected under 35 U.S.C. § 102(b) as being unpatentable over Ball. The examiner maintains that the conductor body is fixed to the mastoid bone of the recipient. Additional explanation is given in the “Response to Argument” section of the examiner’s answer of August 29, 2016 in response to arguments presented by the petitioner in the appeal brief of March 2, 2016. As above however, the additional explanation does not change the basic thrust of the rejection of claim 35 under 35 U.S.C. § 102(b) as set forth in the final Office action of July 15, 2015.

Petitioner provides other instances where there is an alleged new grounds of rejection; however, petitioner provides no specific explanation as to how the rejections given in the final Office action of July 15, 2015 differ from the “Response to Arguments” section in the examiner’s answer of August 29, 2016. Additionally, a review of these instances reveals that, while the examiner has included additional explanation when responding to petitioner’s arguments, the examiner has not changed the basic thrust of the rejections given in the final Office action of July 15, 2015.

The cases cited by petitioner are readily distinguishable from the circumstances of the above-identified application. The circumstances of the above-identified application do not involve the examiner changing the interpretation of how a claim element was met by a disclosure in the prior art reference for the first time in the examiner’s answer as was the case in *Leithem* and *Imes*. The circumstances of the above-identified application are similarly not comparable to the circumstances present in other cases in which a new ground of rejection was found. *See, e.g., Biedermann* (changing factual basis for combining references); *Rambus Inc. v. Rea*, 731 F.3d 1248 (Fed. Cir. 2013) (changing factual basis for combining references); *In re Stepan Co.*, 660 F.3d 1341 (Fed. Cir. 2011) (changing the treatment of an applicant-submitted affidavit or declaration); *In re Kumar*, 418 F.3d 1361 (Fed. Cir. 2005) (providing new calculations to demonstrate that the prior art reference falls within or overlaps with the claimed range); *In re De Blauwe*, 736 F.2d 699 (Fed. Cir. 1984) (changing the treatment of applicant’s contentions of unexpected results); *In re Waymouth*, 486 F.2d 1058 (CCPA 1973) (changing aspect of a claim element relied upon for position that application did not provide written description support under 35 U.S.C. § 112, ¶ 1); *In re Eynde*, 480 F.2d 1364 (CCPA 1973) (changing factual basis for the position that application did not provide enablement under 35 U.S.C. § 112, ¶ 1); *In re Echerd*, 471 F.2d 632 (CCPA 1973) (changing portion of a reference relied upon to meet claim limitations); *In re Wiechert*, 370 F.2d 927 (CCPA 1967) (changing portion of a reference relied upon to meet claim limitations); and *In re Hughes*, 345 F.2d 184 (CCPA 1965) (changing the statutory basis of the rejection). The circumstances of the above-identified application are most analogous to the circumstances present in *Jung* (explanation of why the claims are not limited as asserted by the applicant is not a change to the basic thrust of the rejection), and are not analogous to the circumstances which a new grounds of rejection was found.

¹¹ See examiner’s answer dated August 29, 2016 at page 3.

In conclusion, the examiner's answer of August 29, 2016 did not change the basic thrust of the rejections and the petitioner has been given a fair opportunity to respond to the rejection of the claims. Accordingly, the examiner's answer of August 29, 2016 does not contain a new ground of rejection warranting the reopening of prosecution in the above-identified application.

DECISION

For the previously stated reasons, the petition is granted to the extent that the Technology Center Director decision of January 17, 2017 has been reviewed, but the petition is **DENIED** with respect to designating the examiner's answer of August 29, 2016 as containing a new ground of rejection or generating a new examiner's answer. As such, neither the Technology Center Director decision of January 17, 2017 nor the examiner's answer of August 29, 2016 will be disturbed.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final agency action adverse to the petitioner in the instant application (*e.g.*, a final decision by the Patent Trial and Appeal Board). *See* MPEP 1002.02.

Telephone inquiries concerning this decision should be directed to Chris Bottorff at (571) 272-6692



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy