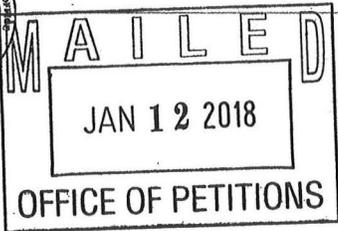




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In re Application of: :
Udo Vogt :
Application No. 12/999,224 : DECISION ON PETITION
Filed: December 15, 2010 :
Attorney Docket No.: 713-2121 (22182) :
For: **PAD PRINTING MACHINE** :

This is a decision on the petition under 37 CFR 1.181 filed on November 13, 2017, requesting that the Director exercise supervisory authority and overturn the decision of September 13, 2017, by the Director of Technology Center 2800 (Technology Center Director), which Technology Center decision refused to designate the examiner's answer of November 18, 2016 as containing a new ground of rejection and reopen prosecution of the application or issue a new examiner's answer that does not contain a rejection of claim 18.

The petition to direct the Technology Center Director to designate the examiner's answer of November 18, 2016 as containing a new ground of rejection and reopen prosecution of the application or issue a new examiner's answer that does not contain a rejection of claim 18 in the above-identified application is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on December 15, 2010.

Prosecution of the above-identified application resulted in a non-final Office action was issued on March 4, 2015. The Office action of March 4, 2015 included, *inter alia*: (1) a rejection of claims 1 through 11, 16 through 18, and 21 under 35 U.S.C. § 103¹ as being unpatentable over

¹ Section 3 of the Leahy-Smith America Invents Act (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 application only has claims with an effective filing date prior to March 16, 2013, this decision refers to the pre-AIA version of 35 U.S.C. §§ 102 and 103.

Binnen (U.S. Patent No. 5,383,398) in view of Suenaga *et al.* (JP 07-17029 A); and (2) a rejection of claims 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*, and further in view of Onozuka *et al.* (JP 06-134977 A).

A reply to the Office action of March 4, 2015, was filed on July 6, 2015, including an amendment to the claims. The amendment of July 6, 2015, included an amendment amending claims 1 and 9, cancelling claim 8, and adding new claim 22.

A final Office action was issued on November 5, 2015. The Office action of November 5, 2015 included, *inter alia*: (1) a rejection of claims 1 through 7, 9 through 11, 16 through 18, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*; and (2) a rejection of claims 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*, and further in view of Onozuka *et al.* (JP 06-134977 A).

A reply to the Office action of November 5, 2015 was filed on January 5, 2016. The reply of January 5, 2016, included an amendment to the claims 1, 11, and 18 and a request for reconsideration.

A petition under 37 CFR 1.181 to the Technology Center Director was also filed on January 5, 2016. The petition of January 5, 2016 requested the finality of the Office action of November 5, 2015 be withdrawn because the Office action contained new grounds of rejection not necessitated by any amendment to the claims or the filing of an Information Disclosure Statement.

An advisory action was issued on February 9, 2016. The advisory action of February 9, 2016 notified applicant that: (1) the reply of January 5, 2016 failed to place the application in condition for allowance; (2) the proposed amendments would be entered for purposes of appeal and explained how the new or amended claims would be rejected; and (3) the request for reconsideration had been considered but did not place the application in condition for allowance and reasons why.

A notice of appeal and a request for pre-appeal brief review were filed on March 7, 2016.

A decision by the pre-appeal brief conference panel was issued on April 13, 2016, and indicated that the panel decision from the pre-appeal brief review was to proceed to the Patent Trial and Appeal Board (PTAB).

The petition filed January 5, 2016, was denied by the Technology Center Director in a decision issued on April 20, 2016.

An appeal brief, which appeals the rejections of claims 1, 16 through 18, and 21, and a one-month extension of time were filed on June 13, 2016.

A renewed petition under 37 CFR 1.181 was filed on June 20, 2016, requesting: (1) the finality of the Office action issued November 5, 2015 be withdrawn; (2) prosecution be reopened to

amend the claims and add new claims; and (3) a refund of the notice of appeal and extension of time fees.

An examiner's answer was issued on November 18, 2016. The examiner's answer maintained (1) the rejection of claims 1 through 7, 9 through 11, 16 through 18, 21, and 22 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*; and (2) the rejection of claims 19 and 20 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*, and further in view of Onozuka *et al.*

A petition under 37 CFR 1.181 was filed on January 18, 2017, requesting: (1) reopening of prosecution; and/or (2) withdrawal of the examiner's answer of November 18, 2016; and/or (3) issuance of a new examiner's answer that does not contain a rejection of claim 18; and (4) a refund of the fees incurred as a result of filing the notice of appeal on March 7, 2016.

A communication regarding appeal was issued on July 21, 2017, stating the appeal was dismissed because of failure to pay the appeal forwarding fee and that the application is before the examiner for consideration.

A petition under 37 CFR 1.181 was filed on August 1, 2017, requesting that the dismissal of the appeal issued on July 21, 2017, be vacated and the appeal be reinstated.

The petitions filed on June 20, 2016, and January 18, 2017, were denied by the Technology Center Director in a decision issued on September 13, 2017. Specifically, the Technology Center Director determined that no new grounds of rejection were made in the Office action of November 5, 2015 or in the examiner's answer of November 18, 2016, and therefore, denied the requests to withdraw the finality of the Office action of November 5, 2015, reopen prosecution and/or withdraw the examiner's answer of November 18, 2016, and refund the fees incurred associated with the filing of the notice of appeal on March 7, 2016. The petition filed on August 1, 2017, was also addressed in the decision issued on September 13, 2017, to the extent the Technology Director required petitioner to reply to the examiner's answer by filing, if desired, a reply brief and paying an appeal forwarding fee within two months from the September 13, 2017 mailing date of the decision. As the decision denied the January 18, 2017 petition requesting designation of a new ground of rejection in the examiner's amendment, jurisdiction reverted back to the Patent Trial and Appeal Board (PTAB).

A reply brief, a request for an oral hearing, and payment of the oral hearing fee and appeal forwarding fee were filed on November 13, 2017.

A petition under 37 CFR 1.181 was also filed on November 13, 2017, directing the Technology Center Director to: (1) designate the examiner's answer of November 18, 2016 as containing a new ground of rejection; (2) reopen prosecution; (3) withdraw the examiner's answer of November 18, 2016; and/or (4) issue a new examiner's answer that does not contain a rejection of claim 18; and (5) refund fees incurred as a result of filing the notice of appeal.

An Order Remanding Appeal to Examiner was entered on November 30, 2017 by the PTAB that administratively remanded the application for appropriate action on the petition under 37 CFR 1.181 filed on November 13, 2017.

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 Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

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

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 § 41.20(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 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 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 final Office action of November 5, 2015 contained new grounds of rejection, and because the examiner's answer of November 18, 2016 relies on the new grounds of rejection, the examiner's answer of November 18, 2016 should be withdrawn and prosecution should be reopened. Alternatively, petitioner requests that a new examiner's answer that does not contain a rejection of claim 18 be issued.²

Petitioner indicates that the examiner cited sections within Suenaga for the rejection of claim 18 for the first time in the final Office action issued November 5, 2015, and therefore, requests that the rejection of claim 18 in both the final Office action issued on November 5, 2015, and the examiner's answer on issued November 18, 2016, be designated a new ground of rejection.³

² Petitioner also requests a refund of the appeal fees paid in the above-identified application. The appeal fees paid in this 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).

³ Petitioner makes a general statement that the rejection of claim 21 under 35 U.S.C. § 103 constitutes a new ground of rejection not necessitated by amendment or the filing of an IDS (*see* page 10 of the petition of November 13, 2017). This allegation of a new ground of rejection of

Petitioner cites to *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.

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 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 explanation 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. 2001) (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).

The Office action of March 4, 2015 included, *inter alia*, a rejection of claim 18 under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.*⁴ The rejection of claim 18 stated that "Suenaga et al. teach the image recorder is generating a continuous sequence of images and the comparator is comparing the reference image with the second images as recited." Petitioner argues that the examiner never cited anything against claim 18. However, since claim

claim 21 was not previously presented to the Technology Center Director for review; and thus, will not be reviewed and considered at this time.

⁴ Claim 18 depends from the independent claim 16, and thus, the antecedent basis for the image recorder and the comparator as recited in claim 16 was inherited for the corresponding elements of claim 18. Similarly, the citations and explanations provided in rejecting claim 16 would have to be consistent with those provided when rejecting claim 18 because of the dependency.

18 depended from independent claim 16 and the antecedent basis for “image recorder”, “the comparator”, “the reference image”, and “the second images” comes from claim 16. Therefore, the rejection of these elements in claim 18 needs be consistent with how these elements were rejected in claim 16, which references to paragraphs 0037-43 of Suenaga *et al.* Further, when the rejection states “as recited”, it is referring to the antecedent basis of these elements and the previously referenced sections.

In the response of March 4, 2015, petitioner indicated that the Office failed to indicate any paragraph numbers of Suenaga *et al.* showing the features. In response to the petitioner’s statements, the final Office action issued on November 5, 2015 included the statement “as recited” along with directing particular attention to paragraphs 0038-41, a subset of the paragraphs previously cited for the claim elements of claim 18.

The basic thrust of the examiner’s position in rejection claim 18 has remained the same from the non-final Office action issued March 4, 2015 to the final Office action of November 5, 2015. The claim remains rejected under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.* The examiner does not expand the paragraphs cited or the explanation given in rejecting these claims.

Similarly, the basic thrust of the examiner’s position in rejecting claim 18 has remained the same from the final Office action issued November 5, 2015 to the examiner’s answer issued November 18, 2016. The claim remains rejected under 35 U.S.C. § 103 as being unpatentable over Binnen in view of Suenaga *et al.* The examiner maintained that “the image recorder is configured to generate a continuous sequence of individual second images of the second printing plate zone, and the comparator is configured to compare the first image with the continuous sequence of individual second images of the second printing plate zone in real time” were taught by the description of paragraphs 0038-41 of Suenaga *et al.* and cited more particularly paragraphs 0040 and 0041 and provided explanations to elaborate how these two paragraphs taught the functions performed by the image recorder and the comparator.

The additional discussion in the final Office action issued on November 5, 2015, and in the examiner’s answer of November 18, 2016 amounts only to an elaboration on the rationale set forth in the non-final Office action of March 4, 2015. *See Jung*, 637 F.3d at 1364-65.

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, supra* (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 1248 (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 references fall 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.

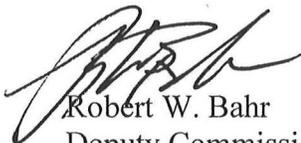
In conclusion, the examiner's answer of November 18, 2016 did not change the basic thrust of the rejection and petitioner has been given a fair opportunity to respond to the rejection of the claims (specifically, claim 18). Accordingly, the examiner's answer of November 18, 2016 does not contain a new ground of rejection warranting the reopening of prosecution in the above-identified application.

DECISION

For the reasons stated above, the petition is granted to the extent that the Technology Center Director's decision of September 13, 2017 has been reviewed, but the petition is **DENIED** with respect to designating the examiner's answer of November 18, 2016 as containing a new ground of rejection or generating a new examiner's answer. As such, neither the Technology Center Director decision of September 13, 2017 nor the examiner's answer of November 18, 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 Vincent Trans at (571) 272-3613.



Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy