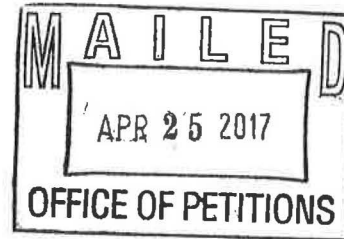




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In re Application of: Walker et al.
Appl. No.: 13/041,254
Filed: March 4, 2011
Attorney's Docket No.: 247261-1
Title: METHODS AND SYSTEMS FOR
EMISSIONS CONTROL IN A DUAL FUEL
ENGINE

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR 1.181 filed June 21, 2016, requesting that the examiner's answer of February 12, 2016 be designated as containing a new ground of rejection.

The examiner's answer of September 24, 2015, is hereby withdrawn. The petition to designate the examiner's answer of February 12, 2016, as containing a new ground of rejection is **GRANTED**.

RELEVANT BACKGROUND

The above-identified application was filed on March 4, 2011.

A final Office action was mailed on September 24, 2014. The Office action of September 24, 2014 included, *inter alia*, (1) a rejection of claims 1 through 3, 5, 7, 10 through 12 and 15 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll (US 7,428,810) in view of Ritter (US 2007/0125321); (2) a rejection of claims 4, 6, 18 through 20 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll (US 7,428,810) in view of Ritter (US 2007/0125321), in further view of Uhrich et al. (US 2010/0263639); (3) a rejection of claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll in view of Ritter, in further view of Kato et al. (US 2002/0162325); (4) a rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Driscoll in view of Ritter, in further view of Hepburn et al. (US 2011/0131957).

A notice of appeal to the Patent Trial and Appeal Board (Board) under 35 U.S.C. § 134 and 37 CFR 41.31 was filed on January 22, 2015. An appeal brief was filed on March 20, 2015.

An examiner's answer was mailed on September 24, 2015. The examiner's answer of September 24, 2015: (1) indicated that the ground of rejection set forth in the final office action of September 24, 2014 is being maintained, and no new grounds of rejection is being presented; and (2) included a "Response to Argument" section responding to the arguments set forth by the petitioner in the appeal brief of March 20, 2015. The "Response to Argument" section included a reference to the article "Power Electronics and Renewable Energy Systems," by C. Kamalakannan et al., Chapter 103, page 1061 (Kamalakannan).

A petition under 37 CFR 1.181 was filed on November 24, 2015, requesting that the rejection in the examiner's answer of September 24, 2015, be designated as a new ground of rejection and that a two-month time period be provided to file a reply under 37 CFR 1.111 to reopen prosecution.

A revised examiner's answer was mailed on February 12, 2016. The revised examiner's answer of February 12, 2016: (1) indicated that the ground of rejection set forth in the final office action of September 24, 2014 is being maintained, and no new grounds of rejection is being presented; and (2) included a "Response to Argument" section responding to the arguments set forth by the petitioner in the appeal brief of March 20, 2015. The "Response to Argument" section noted that the examiner's answer was being revised to delete reference to Kamalakannan and instead refer to the Fiber Optics Illustrated Dictionary and the Academic Press Dictionary of Science and Technology.

The petition of November 24, 2015, was dismissed as moot by the Director of Technology Center 3700 (Technology Center Director) on March 4, 2016.

A renewed petition under 37 CFR 1.181 was filed on April 8, 2016. The renewed petition of April 8, 2016 was denied by the Technology Center Director in a decision mailed on April 25, 2016.

The instant petition under 37 CFR 1.181 was filed on June 21, 2016, and requests that the rejection in the examiner's answer of February 12, 2016, be designated as a new ground of rejection and that a two-month time period be provided to file a reply under 37 CFR 1.111 to reopen prosecution.

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 1.18(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 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 argues that the revised examiner's answer of February 12, 2016, contains new grounds of rejection and should be designated as such. Petitioner specifically asserts that the reference to the Fiber Optics Illustrated Dictionary and the Academic Press Dictionary of Science and Technology in the revised examiner's answer changes the thrust of the rejection set forth in the final Office action of September 24, 2014, because the revised examiner's answer contains new reasoning not found in the final Office action. Petitioner further argues that the examiner's answer of September 24, 2015, also contains a new grounds of rejection, and the revised examiner's answer of February 12, 2016, should not have been issued.

Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. See *Kronig*, 539 F.2d 1300, 1303. 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 1316, 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 rules of practice in *ex parte* appeal before the Board permit appellants to submit dictionaries for the first time in an appeal brief and also permit examiners to cite to a dictionary for the first time in the examiner’s answer without such citation automatically resulting in a new ground of rejection:

Final Bd.R. 41.30 adopts the definition of “Evidence” from Black’s Law Dictionary to provide clarity regarding the use of that term in Subpart B. Toward that end, final Bd.R. 41.30 makes clear that for the purposes of Subpart B, “Evidence” does not encompass dictionaries. Excluding dictionaries from the definition of “Evidence” thus allows appellants to refer to dictionaries in their briefs, which would otherwise be precluded under final Bd.R. 41.33(d)(2) (absent existence of one of the enumerated exceptions). It further allows examiners to refer to dictionaries in the examiner’s answers without automatically rendering a rejection a new ground under final Bd.R. 41.39(a)(2). Treating dictionaries in this manner is consistent with Supreme Court and Federal Circuit precedent, which contemplate that such materials may be consulted by tribunals “at any time.” *See, e.g., Nix v. Hedden*, 149 U.S. 304, 307 (1893) (citations omitted) (admitting dictionaries to understand the ordinary meaning of terms “not as evidence, but only as aids to the memory and understanding of the court”); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1322-23 (Fed. Cir. 2005) (*en banc*) (“[J]udges are free to consult dictionaries and technical treatises at any time in order to better understand the underlying technology and may also rely on dictionary definitions when construing claim terms, so long as the dictionary definition does not contradict any definition found in or ascertained by a reading of the patent documents.”) (citation omitted); *In re Boon*, 439 F.2d 724, 727-28 (CCPA 1971) (holding citation to dictionary was not tantamount to the assertion of a new ground of rejection “where such a reference is a standard work, cited only to support a fact judicially noticed and, as here, the fact so noticed plays a minor role, serving only to fill in the gaps which might exist in the evidentiary showing made by the Examiner to support a particular ground for rejection.” (emphasis and internal quotations omitted)). Thus, the Office feels it is logical to permit the applicant and examiner to submit them to the Board during the briefing stage.

See Rule of Practice Before the Board of Patent Appeals and Interferences in Ex Parte Appeals, 76 Fed. Reg. 72270, 72272-73 (Nov. 22, 2011). Whether citation to a dictionary for the first time in an examiner's answer constitutes a new ground of rejection must be determined based on controlling case law and the facts of the particular application. *See id.* at 72281 (response to comment 14).

The revised examiner's answer of February 12, 2016, included a reference to the Academic Press Dictionary of Science and Technology to show that stepper motors are actuated by the frequency of a pulse width signal. The revised examiner's answer further included a reference to the Fiber Optics Illustrated Dictionary to show that pulse width modulation controls the actuation of the stepper motor. The revised examiner's answer relied on these two dictionaries to show that Driscoll and Ritter inherently disclose delivering fuel in proportion to a pulse width, as recited in claims 1 and 10. The reliance on dictionary definitions to provide an inherency-based rationale in support of the obviousness rejection of claims 1 and 10, as set forth in the revised examiner's answer, goes beyond reliance upon a dictionary definition to construe a term in the claims or support a matter appropriate for judicial notice. Moreover, the inherency-based rationale provided in the revised examiner's answer was not previously raised in the final Office action and therefore, the petitioner was not given a fair opportunity to react to the thrust of the rejection. Accordingly, the revised examiner's answer included a rejection of claims 1 and 10 under 35 U.S.C. § 103(a) that should have been designated as a new ground of rejection. *See Leithem*, 661 F.3d at 1319 (holding that the "ultimate criterion of whether a rejection is considered 'new' ... is whether applicants have had fair opportunity to react to the thrust of the rejection.").

DECISION

For the previously stated reasons, the petition to designate the examiner's answer of February 12, 2016, as containing a new ground of rejection is **granted**.

The examiner's answer of September 24, 2015 is hereby withdrawn.

The examiner's answer of February 12, 2016 is hereby designated as containing a new ground of rejection. Petitioners must exercise one of the following two options to avoid dismissal of the appeal as to the claims subject to the new ground of rejection within **TWO MONTHS** from the date of this decision:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened 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 37 CFR 41.41. Such a reply brief must address each new ground of

rejection as set forth in 37 CFR 41.37(c)(1) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) 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 37 CFR 41.39(b)(1). Petitioners are also reminded that the exercise of this option requires that the appeal forwarding fee (37 CFR 41.20(b)(4)) be paid within **two (2) months** from the mailing date of this decision in order to avoid dismissal of the appeal. *See* 37 CFR 41.45.

Extensions of time under 37 CFR 1.136(a) are **not** applicable to the two-month time periods set forth in this decision. *See* 37 CFR 41.39(c) and 41.45(c).

The application is being referred to Technology Center 3700 for further processing.



Robert W. Bahr

Deputy Commissioner

for Patent Examination Policy