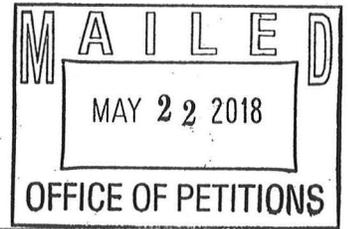




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In re Application of: :
Paul Carter :
Application No.: 13/158,042 :
Filed: June 10, 2011 : **DECISION ON PETITION**
For: ELECTRODE IMPEDANCE :
SPECTROSCOPY :

This is a decision on the petition filed on December 26, 2017 under 37 CFR 1.181, requesting that the Director exercise supervisory authority and overturn the decision of October 24, 2017, by the Director of Technology Center 3700 (Technology Center Director), which Technology Center decision refused to withdraw the finality of the Office action of May 10, 2017 and reopen prosecution in the above-identified application.

The petition to withdraw the finality of the Office action of May 10, 2017 and reopen prosecution in the above-identified application is **DENIED**.

RELEVANT BACKGROUND

The above-identified application was filed on June 10, 2011.

Prosecution of the above-identified application resulted in a non-final Office action being issued on January 25, 2017. The Office action of January 25, 2017, included, *inter alia*: (1) a rejection of claim 50 under 35 U.S.C. § 112 ¶ 2¹ for failure to comply with its written description

¹ Section 4 of the Leahy-Smith America Invents Act (AIA) designated pre-AIA 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 ever having a claim with an effective filing date on or after March 16, 2013, or ever having a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any patent or application that ever contained such a claim with an effective filing date on or after March 16, 2013. *See* Pub. L. No. 112-29, § 3, 125 Stat. at 285

requirement; (2) a rejection of claims 1 through 5, 7 through 12, 15, 16, 18 through 25, 38 through 42, 46 through 54, and 56 through 60 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (3) a rejection of claims 1, 10 through 12, 16, 38 through 42, 46, 51 through 53, 56, and 57 under 35 U.S.C. § 102(a) as being anticipated by Tsampazis et al. (U.S. Patent Application Publication No. 2011/0087085); (4) a rejection of claims 1 through 5, 7, 18, 22, 23, and 54 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni et al. (U.S. Patent No. 8,265,766); (5) a rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni in view of Pearlman (U.S. Patent Application Publication No. 2004/0133122); (6) a rejection of claims 44 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Haller et al. (U.S. Patent Application Publication No. 2010/0114288); (7) a rejection of claims 45 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Ryu et al. (U.S. Patent Application Publication No. 2011/0144510); and (8) a rejection of claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Vanpoucke (U.S. Patent No. 8,532,781).

A reply to the non-final Office action of January 25, 2017 was filed on April 25, 2017. The reply of April 25, 2017 included an amendment adding claims 61 through 66.

A final Office action was issued on May 10, 2017 including, *inter alia*: (1) a rejection of claims 1 through 5, 7 through 12, 15, 16, 18 through 25, 38 through 42, 46 through 54, and 56 through 60 under 35 U.S.C. § 101 as not being directed to patent eligible subject matter; (2) a rejection of claims 1, 10 through 12, 16, 38 through 42, 46, 51 through 53, 56, and 57 under 35 U.S.C. § 102(a) as being anticipated by Tsampazis et al.; (3) a rejection of claims 1 through 5, 7, 18, 22, 23, and 54 and 61 through 64 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni et al.; (4) a rejection of claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni in view of Tsampazis; (5) a rejection of claim 9 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni in view of Stivoric et al. (U.S. Patent Application Publication No. 2007/0100666); (6) a rejection of claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis; (7) a rejection of claims 19 through 21 and 58 through 60 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Heuvel et al. (U.S. Patent Application Publication No. 2012/0286765); (8) a rejection of claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni in view of Pearlman; (9) a rejection of claims 44, 49, and 65 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Haller et al.; (10) a rejection of claims 45 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Ryu et al.; (11) a rejection of claims 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Tsampazis in view of Vanpoucke; and (12) a rejection of claim 66 under 35 U.S.C. § 103(a) as being unpatentable over Kulkarni in view of Heuvel et al.

293. The above-identified application was filed prior to September 16, 2012, asserts priority to an effective filing date prior to March 16, 2013 for every claim ever contained in the above identified application, and never contained a reference under 35 U.S.C. §§ 120, 121, or 365(c) to any other patent or application having a claim with an effective filing date on or after March 16, 2013. Therefore, this decision refers to the pre-AIA version 35 U.S.C. §§ 102, 103 and 112.

A reply to the final Office action of May 10, 2017 was filed on July 10, 2017, and petitioner was notified that the amendment submitted with the after final reply of May 10, 2017 would not be entered in an advisory action issued on August 31, 2017.

A petition under 37 CFR 1.181 to the Technology Center Director was filed on July 10, 2017, requesting the finality of the Office action of May 10, 2017 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 (IDS), and that prosecution be reopened.

The petition of July 10, 2017 was denied by the Technology Center Director in a decision issued on October 24, 2017.

A notice of appeal, a request for pre-appeal brief review, and a petition for a two-month extension of time (and fee) were filed on November 3, 2017.

A decision by the pre-appeal brief conference panel was issued on December 4, 2017, and indicated that the panel decision from the pre-appeal brief review was to proceed to the Patent Trial and Appeal Board (PTAB).

A renewed petition under 37 CFR 1.181 was filed on December 26, 2017, requesting the finality of the May 10, 2017 Office action be withdrawn and that Office action be reissued as a non-final Office action so that prosecution can be reopened to allow petitioner to amend the claims, interview the supervisory patent examiner, and file declarations all as a matter of right.

An appeal brief and a petition for a two-month extension of time (and fee) were filed on March 5, 2018.

STATUTE AND REGULATION

35 U.S.C. § 132(a) states:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified

in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with §1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.181 provides that:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the ex parte prosecution of an application, or in ex parte or inter partes prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

OPINION

Petitioner asserts that the finality of the Office action issued May 10, 2017 was improper because it contained a new grounds of rejection that was not necessitated by amendment or the filing of an IDS. Petitioner specifically argues that claims 1 and 7 were not amended in response to the January 25, 2017 non-final Office action, but the examiner has changed the rationale of the rejections of claims 1 and 7 by statements made in the Response to Arguments section of the Office action. Petitioner requests that the finality of the Office action of May 10, 2017 be withdrawn and prosecution in the above-identified application be reopened.

Section 706.07(a) of the Manual of Patent Examining Procedure (MPEP) specifically sets forth the USPTO's second action final practice, and provides in part that:

Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which

was not necessitated by amendment to the claims is introduced by the examiner. *See* MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art.

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 *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011)). 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). A rejection relying on the same statutory basis and same prior art references, may nevertheless raise a new ground of rejection, when the rejection relies on new facts or rationales not previously raised. *See In re Leithem*, 661 F.3d 1316, 100 USPQ2d 1155 (Fed. Cir. 2011). However, the examiner need not use identical language in both the examiner's answer and the Office action to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the Response to Arguments responds to applicant'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") (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).

Petitioner acknowledges that the body of the claim rejections in the non-final Office action of January 25, 2017 and the final Office action of May 10, 2017 are identical. Petitioner, however, argues that in the Response to Arguments section of the May 10, 2017 final Office action, the

examiner's analogies with respect to the rejection under 35 U.S.C. § 101, the explanation that the plurality of frequencies were modulated with respect to the rejection of claim 1 under 35 U.S.C. § 103, and the alleged benefits of remote surgery, including the example of a DaVinci robot, with respect to the rejection of claim 7 under 35 U.S.C. § 103, constituted new grounds of rejection that were not necessitated by amendment or the filing of an IDS.

Petitioner's arguments are not persuasive. While the examiner may have provided additional explanation in the final Office action of May 10, 2017 regarding the rejections in response to arguments presented by petitioner, this additional explanation does not change the basic thrust of the rejections. *See Jung*, 637 F.3d at 1364-65.

The basic thrust of the claim rejection under 35 U.S.C. § 101 has remained the same from the non-final Office action of January 25, 2017, to the final Office action of May 10, 2017. As noted above, the body of the rejection under 35 U.S.C. § 101 are identical in the two Office actions. In response to the petitioner's challenge of the abstract idea identified in the Office action of January 25, 2017, the examiner cited several court cases in the final Office action of May 10, 2017 that support the original rationale that the claims are directed to the abstract idea identified in the previous Office action.

Section 2106.07(b)(1) of the Manual of Patent Examining Procedure (MPEP) provides, in part:

If applicant challenges the identification of an abstract idea that was based on a court case and the challenge is not persuasive, an appropriate response would be an explanation as to why the abstract idea identified in the claim is similar to the concept in the cited case. If the original rejection did not identify a Supreme Court or Federal Circuit decision in which a similar abstract idea was found and applicant challenges identification of the abstract idea, the examiner would need to point to a case in which a similar abstract idea was identified and explain why the abstract idea recited in the claim corresponds to the abstract idea identified in the case to maintain the rejection. Citation to a case that supports the original rationale would not be considered a new ground of rejection, unless there is a change to the basic thrust of the rejection. *See* MPEP § 706.07(a) for a discussion of new grounds of rejection.

The examiner's citation to court cases in the Response to Arguments section of the May 10, 2017 final Office action is consistent with the practice set forth in MPEP 2106.07(b)(1) and is not considered a new ground of rejection.

Similarly, with the exception of the correction of a typographical error (*i.e.*, deletion of the repeated phrase "at each of the plurality of frequencies"), the examiner's rationale in rejecting claims 1 and 7 under 35 U.S.C. § 103(a) has remained the same from the non-final Office action of January 25, 2017, to the final Office action of May 10, 2017. The additional discussion in the Response to Arguments section of the final Office action of May 10, 2017 amounts only to an elaboration on the rationale set forth in the non-final Office action of January 25, 2017, not a new ground of rejection. Moreover, this additional explanation set forth in the May 10, 2017 final Office action did not change the basic thrust of the invention by introducing new facts or

new rationales; the examiner's arguments were merely providing further clarification in response to arguments presented by petitioner.

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 an examiner's answer as was the case in *Leithem* and *In re Imes*, 778 F.3d 1250 (Fed. Cir. 2015). 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 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 DeBlauwe*, 136 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, paragraph 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, paragraph 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 in which a new grounds of rejection was found.

In conclusion, the final Office action of May 10, 2017 did not change the basic thrust of the rejections or add new facts and rationales, and petitioner has been given a fair opportunity to respond to the rejection of the claims. Accordingly, the final Office action of May 10, 2017 does not contain a new ground of rejection warranting the withdrawal of finality and reopening of prosecution in the above-identified application.

DECISION

For the reasons stated above, the petition to withdraw finality of the May 10, 2017 Office action and reopen prosecution in the above-identified application is **DENIED**.

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.

The application is being forwarded to the Technology Center for consideration of the appeal brief filed March 5, 2018.

A handwritten signature in black ink, appearing to read 'RWB', is positioned above the printed name.

Robert W. Bahr
Deputy Commissioner
for Patent Examination Policy