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Hoffberg & Associates 29 Buckout Road West Harrison, NY 10604			EXAMINER ANTHONY, MARIA CATHERINE	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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roberta@hoffberglaw.com  
steve@hoffberglaw.com  
uspto@dockettrak.com



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In re Application of :  
Poltorak, Alexander :  
Application No. 17/532,922 :  
Filed: 22 Nov 2021 : **DECISION ON PETITION**  
For: MULTIPLE PARTIALLY :  
REDUNDANT BIOMETRIC SENSING :  
DEVICES :

This is a decision on the petition filed on October 24, 2024, which is treated as a petition under 37 CFR 1.181, requesting that the Director exercise supervisory authority and overturn the decision of October 23, 2024, by the Director of Technology Center 3700 (Technology Center Director) that refused to withdraw the finality of the Office action issued on July 26, 2024.

The petition to overturn the Technology Center Director's decision of October 23, 2024, and withdraw the finality of the July 26, 2024, Office action is **DENIED**.

**RELEVANT BACKGROUND**

The above-identified application was filed on November 22, 2021.

A non-final Office action was issued on April 3, 2024, which included, *inter alia*: (1) a rejection of claims 1 through 4, 9, 10, 12, 14, 16, 19, and 20 under 35 U.S.C. §§ 102(a)(1) and 102(a)(2) as being unpatentable over U.S. Pat. No. 10,602,987 to Khachaturian et al. (hereinafter "Khachaturian"); (2) a rejection of claims 5 through 8, 11, 13, and 15 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of WO 2016110804 to Burton (hereinafter "Burton"); (3) a rejection of claim 17 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Published U.S. Patent Application No. 2008/0188763 to John et al. (hereinafter "John"); and (4) a rejection of claim 18 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Published U.S. Patent Application No. 2014/0378810 to Davis et al (hereinafter "Davis").

A reply to the Office action of April 3, 2024, was filed on July 3, 2024, and included an amendment to claims 1 through 17, 19, and 20.

A final Office action was issued on July 26, 2024, which included, *inter alia*: (1) a rejection of claims 1 through 4, 9, 10, 12, 14, 16, 19, and 20 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Published U.S. Application No. 2009/0012432 to Sharf (hereinafter “Sharf”); (2) a rejection of claims 5 through 8, 11, 13, and 15 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Sharf, and further in view of Burton; (3) a rejection of claim 17 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Sharf, and further in view of John; and (4) a rejection of claim 18 under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Sharf, and further in view of Davis.

A petition was filed on September 26, 2024, requesting that the finality of the Office action issued on July 26, 2024, be withdrawn.

A response to the final Office action of July 26, 2024, and an amendment under 37 CFR 1.116 were filed on September 26, 2024, which included an amendment to claims 1, 19, and 20 and cancelling claim 4.

An advisory action was issued on October 1, 2024. The advisory action of October 1, 2024, stated that: (1) the proposed amendments of September 26, 2024, would not be entered as they were not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; (2) for purposes of appeal, the proposed amendments of September 26, 2024, would not be entered; and (3) the request for reconsideration had been considered but did not place the application in condition for allowance.

A decision by the Technology Center Director dismissing the petition filed on September 26, 2024, was issued on October 23, 2024.

The present petition, which is being treated under 37 CFR 1.181, was filed on October 24, 2024, seeking review of the Technology Center Director’s decision issued on October 23, 2024.

A response to the final Office action of July 26, 2024, and an amendment under 37 CFR 1.116 were filed on October 28, 2024, which included an amendment to claims 12, 14, and 20.

A further response to the final Office action of July 26, 2024, and an amendment under 37 CFR 1.116 were filed on December 9, 2024, including a request for a two-month extension of time under 37 CFR 1.136(a), and an amendment to claims 1, 12, 14, 16, 19, and 20, and canceling claim 7.

A certification and request for consideration under the after final consideration pilot program were filed on December 9, 2024.

## **STATUTES AND REGULATIONS**

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 the 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.

35 U.S.C. § 134(a) states:

*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.

37 CFR 1.104 provides in part that:

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

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(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the

examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

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 in part 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.

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(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

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(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

37 CFR 1.191 provides that:

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

37 CFR 41.31 provides in part 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.

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(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.

### **OPINION**

Petitioner asserts that the Office action of July 26, 2024, was incomplete and improperly made final because, with regard to claim 4, the examiner failed to fulfill the ministerial action of stating all grounds of rejection then considered applicable to the claims in the application and clearly stating the reasons in support thereof in accordance with 37 CFR 1.113(b). Petitioner also argues that the statutory and regulatory predicates and procedures for issuance of a final rejection have not been met. Specifically, petitioner argues that the limitation of “wherein at least two of the plurality of wearable or implantable sensors sense the same physiological condition” added to claim 4 in the amendment filed with the response of July 3, 2024, was not addressed or considered by the examiner in the final Office action of July 26, 2024, and that merely parroting the limitation in the rejection fails to support the rejection. Therefore, petitioner alleges that they have not been apprised of which sections of Khachaturian and Sharf teach the above-identified claim limitation or the reason why, or the rationale for these references demonstrating the scope of claim 4.

With respect to the finality of the Office action of July 26, 2024, the *Manual of Patent Examining Procedure* (MPEP) § 706.07(a) specifically sets forth the Office's practice on when a second Office action can be properly made final 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. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

MPEP § 707.07(f) specifically sets forth the Office's practice on traversal of any rejection and provides, in part, that:

Where the applicant traverses any rejection, the examiner should, if they repeat the rejection, take note of the applicant's argument and answer the substance of it.

Petitioner does not argue that the Office action of July 26, 2024 was improperly made final because the examiner introduced a new ground of rejection in the final Office action of July 26, 2024, that was neither necessitated by petitioner's amendment of the claims or 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). Nonetheless, the finality of the July 26, 2024, Office action complies with MPEP § 706.07(a). A review of the file record reveals that the reply to the Office action of April 3, 2024, filed on July 3, 2024, included an amendment to claims 1 through 17, 19, and 20. As such, the amendment necessitated the new grounds of rejection of claims 1 through 20 as presented in the Office action of July 26, 2024.

Furthermore, the Office action issued on July 26, 2024, at pages 2 and 5, states that claim 4 is rejected under 35 U.S.C. § 103 as being unpatentable over Khachaturian in view of Sharf, specifically identifying column 1 and lines 28 through 33 in Khachaturian where the limitations of claim 4 are addressed.

While petitioner considers the Office action of July 26, 2024, to be inadequate in addressing petitioner's amendment to claim 4, the Office action of July 26, 2024, does address the limitations of claim 4, as noted above. With respect to the sufficiency of the examiner's rejection of claim 4, the correctness and underlying reasoning of an examiner's consideration of an applicant's traversal goes directly to a rejection of the pending claims and is appropriate for the applicant's substantive challenge to the rejection. *See In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011). The review of the propriety of a rejection *per se* (and its underlying reasoning) is by way of an appeal as provided by 35 U.S.C. § 134, 37 CFR 1.191, and 37 CFR 41.31, and not by way of petition under 37 CFR 1.181, even if a petitioner frames the issues as concerning procedure versus the merits. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468,



1472 (E.D. Va. 2004). As stated by the Court of Customs and Patent Appeals (a predecessor of the U.S. Court of Appeals for the Federal Circuit), the adverse decisions of examiners, which are reviewable by the Board, are those which relate, at least indirectly, to matters involving the rejection of claims. *See In re Hengehold*, 440 F.2d 1395, 1404 (C.C.P.A. 1971). That an applicant casts the argument as directed to a procedural requirement (rather than the merits of a rejection) does not untether the review of the *prima facie* case from the review of the merits of the rejection. *See In re Jung*, 637 F.3d 1356, 1363 (Fed.Cir. 2011) (applicant's procedural arguments concerning the *prima facie* case requirement are the same arguments that would have been made on the merits). An applicant dissatisfied with an examiner's decision in the second or subsequent rejection may appeal to the Patent Trial and Appeal Board. *See* 37 CFR 41.31(a)(1). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Patent Trial and Appeal Board. *See In re Dickinson*, 299 F.2d 954, 958 (C.C.P.A. 1962) (The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented in a matter appealable to the Board). *See also* MPEP § 1201.

The notification requirement of 35 U.S.C. § 132 provides that "if a patent examiner finds that a patent application does not comply with the standards of patentability, the examiner will issue an office action with respect to the application, '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 the prosecution of his application.'" *See Pfizer v. Lee*, 811 F.3d 466, 469 (2016) (quoting 35 U.S.C. § 132(a)). "Section 132 merely ensures that an applicant 'at least be informed of the broad statutory basis for [the rejection of] his claims, so that he may determine what the issues are on which he can or should produce evidence.' Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection. *See Chester v. Miller*, 906 F.2d 1574, 1578 (1990) (citations omitted).

The Office action of July 26, 2024, satisfies the notice requirements of 35 U.S.C. § 132, in that the Office action is sufficiently informative as to place petitioner on notice of the basis for the rejections so as to allow petitioners to recognize and counter the rejections. *See id.* Specifically, the Office action of July 26, 2024, identifies the grounds of rejection being applied and states the reasons for such rejections, including the prior art references and specific column and lines within the references being relied upon, as noted above. Accordingly, the Office action of July 26, 2024 does not violate the procedural requirements of 35 U.S.C. § 132.

For at least the reasons stated above, the finality of the July 26, 2024, Office action will not be withdrawn.

### **DECISION**

For the reasons stated above, the petition to withdraw the finality of the Office action issued on July 26, 2024, is **DENIED**. As such, the Technology Center Director's decision of October 23, 2024, will not be overturned.

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.

Petitioner is reminded that the mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings (*See* 37 CFR 1.181(f)). Petitioner's time period to respond continues to run from the mailing date of the final Office action of July 26, 2024.

/Charles Kim/  
Deputy Commissioner  
for Patents