

REDACTED

EXHIBIT A

REDACTED

Serial No. [REDACTED]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)
 [REDACTED])
 Serial No.: [REDACTED])
 Filed: [REDACTED])
 Docket No.: [REDACTED])
 For: [REDACTED])
 [REDACTED])
 [REDACTED])
 [REDACTED])

Group Art Unit: [REDACTED]
 Examiner: [REDACTED]

**PETITION TO WITHDRAW THE 37 CFR 1.105
REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.181(A)(3)**

Hon. Commissioner For Patents
 P.O. Box 1450, Alexandria, VA 22313-1450
 Sir:

This is a petition to withdraw the 37 CFR 1.105 Requirement For Information under 37 CFR 1.181(A)(3). The instant application (and the instant claims) has been finally rejected, appealed, briefed, answered, decided by the Board, and reheard by the Board. Thus, this is an inappropriate time to make such a Requirement. Further, this Requirement For Information is part of an inappropriate pattern of such requirements. Hence, this 37 CFR 1.105 Requirement For Information should be withdrawn.

IT IS AN INAPPROPRIATE TIME FOR A 37 CFR 1.105 REQUIREMENT FOR INFORMATION WHEN THE APPLICATION AND THE CLAIMS HAVE BEEN FINALLY REJECTED, APPEALED, BRIEFED, ANSWERED, DECIDED BY THE BOARD, AND REHEARD BY THE BOARD

The instant application has been finally rejected, appealed, briefed, answered, decided by the Board, and reheard by the Board; which is an inappropriate time to make such a Requirement – “Ordinarily, a request for information should not be made with or after a final rejection”. For example, all of the rejections of the claims have already been decided by the Board. Thus, this Requirement will place an unnecessary “burden on both the applicant and the Office” (discussed below), which is discouraged by the PTO.

The instant Requirement For Information violates MPEP 704.11(b):

704.11(b) When May a Requirement for Information Be Made [R-2]

* * *

Ordinarily, a request for information should not be made with or after a final rejection.

* * *

III. < AFTER THE FIRST ACTION ON THE MERITS ...

A requirement for information is not proper when no further action would be taken by the examiner. The reasonable necessity criteria for a requirement for information implies further action by the examiner. This means that actions in which requirements for information necessary for examination are made should generally be a non-final action because the applicant's reply must be considered and applied as appropriate.

In particular; the instant Requirement For Information violates “[t]he reasonable necessity criteria” because the information required from the Applicant is not “necessary for examination” as the instant application has already been finally rejected, appealed, briefed, answered, decided by the Board, and reheard by the Board. Further, the examination “should generally be [at] a non-final action [stage] because the applicant's reply must be considered and applied as appropriate.” However, the instant application is well past the “non-final action” stage.

THIS REQUIREMENT FOR INFORMATION IS PART OF A PATTERN OF SUCH REQUIREMENTS, WHICH IS INAPPROPRIATE

This Requirement For Information is part of a pattern of such requirements, which is inappropriate. This Requirement For Information is being misused (Federal Register Vol. 69, No. 182, page 56513, col. 1):

Requirements for information are not routinely made. They are to be used only where there is an absence of necessary information within the record. Any such requirement should be tailored to treat specific issues on a case-by-case basis.

However, this and other Requirements For Information are being “routinely made” in various ones of the Applicant’s copending applications, the requirements are not being made “on a case-by-case basis”. For example, such Requirements For Information have been made in [REDACTED] of the Applicant’s applications within the same art group (Group [REDACTED]) within a six week period. This violates the fundamental basis of 37 CFR 1.105 and the PTO’s commitments to the public.

THE EXAMINER DOES NOT HAVE “A REASONABLE BASIS FOR REQUIRING [THE] INFORMATION” IN VIEW OF THE FINALITY OF THE INSTANT ACTION.

The instant Requirement For Information violates MPEP 704.11 because the Examiner does not have “a reasonable basis for requiring [the] information” and thus, “[I]t is a significant burden on both the applicant and the Office”. See MPEP 704.11:

704.11 What Information May Be Required ...

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A Requirement For Information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

The statement then goes on to give two examples where “the claimed subject matter cannot be adequately searched” or where there is a “lack of relevant prior art found in the

examiner's search"; neither of which are the situation in the instant case. Here, the instant application (and the instant claims) has been finally rejected, appealed, briefed, answered, decided by the Board, and reheard by the Board.

CONCLUSION

The Applicant requests that the Commissioner invoke his supervisory authority and withdraw the 37 CFR 1.105 Requirement For Information under 37 CFR 1.181(A)(3) for the good and sufficient reasons set forth above.

No fee should be required for the instant filing, which is filed under 37 CFR 1.181(A)(3). However, an authorization to charge the Applicant's Deposit Account is provided out of an abundance of caution. Please charge any fees associated with the papers transmitted herewith to Deposit Account No. [REDACTED]

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number [REDACTED] on May 4, 2006.

Dated: May 4, 2006

Respectfully submitted,
[REDACTED]

REDACTED

EXHIBIT B

REDACTED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

[REDACTED])

Serial No.: [REDACTED])

Filed: [REDACTED])

Docket No.: [REDACTED])

**For: A MOVING MAP DISPLAY IMPLEMENTED)
WITH AN IMAGE PROCESSOR SCANNING)
OUT MOVING MAP INFORMATION)**

Group Art Unit: [REDACTED]

Examiner: [REDACTED]

PETITION UNDER 37 CFR 1.144/1.181
FOR WITHDRAWAL OF AN IMPROPER RESTRICTION REQUIREMENT

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Sir:

The Applicant respectfully petitions for intervention of the Commissioner to withdraw an improper restriction requirement and to direct the Examiner to generate an action directed to all of the claims presented for examination under 37 CFR 1.111.

6 RELIEF REQUESTED

The Applicant respectfully petitions for withdrawal of the improper restriction requirement and for an action directed to all of the claims presented for examination.

No fee should be required for the instant filing, which is filed under 37 CFR 1.181(A)(3). However, an authorization to charge the Applicant's Deposit Account is provided out of an abundance of caution. Please charge any fees associated with the papers transmitted herewith to Deposit Account No [REDACTED]

CERTIFICATION OF MAILING: I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 21, 2006.

Dated: June 21, 2006

Respectfully submitted,

[REDACTED]

REDACTED

EXHIBIT C

REDACTED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

[REDACTED]

Serial No.: [REDACTED]

Filed: [REDACTED]

Docket No. [REDACTED]

For: [REDACTED]

Group Art Unit: [REDACTED]

Examiner: [REDACTED]

PETITION UNDER 37 CFR 1.181(A)(3)
CONCERNING A REQUIREMENT FOR INFORMATION
UNDER 37 C.F.R. § 1.105

Hon. Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450

This is a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director. The Applicant respectfully petitions for intervention of the Director regarding a Requirement For Information under 37 CFR 1.105.

RELIEF REQUESTED

The Applicant requests the following relief:

A determination that the Requirement For Information Under 37 CFR § 1.105 dated March 21, 2006 is not proper requirements for information under 37 CFR § 1.105 and that it be withdrawn.

IV. THIS REQUIREMENT FOR INFORMATION IS PART OF A PATTERN OF SUCH IMPROPER REQUIREMENTS, WHICH IS INAPPROPRIATE AND SHOULD BE ENDED

This Requirement For Information is part of a pattern of such requirements, which is inappropriate. This Requirement For Information is being misused (Federal Register Vol. 69, No. 182, page 56513, col. 1 (emphasis added)):

Requirements for information are not routinely made. They are to be used only where there is an absence of necessary information within the record. Any such requirement should be tailored to treat specific issues on a case-by-case basis.

However, this and other Requirements For Information are being “routinely made” in various ones of the Applicant’s copending applications, the requirements are not being made “on a case-by-case basis”. For example, such Requirements For Information were made in [REDACTED] of the Applicant’s applications within the same art group (Group [REDACTED] within a six week period. This violates the fundamental basis of 37 CFR 1.105 and the PTO’s commitments to the public.

This is even more troubling because [REDACTED] of these applications including the instant application have been finally rejected, briefed, answered, replied to, heard by the Board, decided by the Board, and Reheard by the Board. Then, early in 2005, the Examiner reopened prosecution and generated 105 Requirements similar to the 105 Requirement addressed herein in all [REDACTED] of these Board-decided cases. Even more significant is the fact that the rejections of most of the claims at issue in these four Board-decided cases, effectively all of the claims at-issue in the Board-decided cases, have been reversed by the Board but are now under 105 Requirements for the second time since the Board rendered its decisions. Furthermore, the Board specifically addressed the issues of (1) priority and (2) § 112-1 rejections which are now at issue in (1) Stipulation 1 and (2) Stipulation 2, respectively. Essentially, the Examiner appears to be seeking a method for reversing the Board’s decisions.

There appears to be no reason for this 105 Requirement. The terminology that is at issue here has been in the prior art for more than 25 years and is admitted known to the Examiner. It is not obscure terminology in an abstract art, it is very well known terminology in a very well know art.

During the “rulemaking” in the Federal Register, the PTO promised the profession that it had petition relief was available regarding improper 105 Requirements. However, the Examiner herein informed the Applicant that he would not stay the two month time period if the Applicant filed petitions. Even more troubling, the Applicant did file petitions to withdraw the 105 Requirements in the four Board-decided applications including the instant application yet the six month maximum extension period has run without the Applicant receiving a response to these petitions. This seems to indicate that the PTO’s promise to the profession about petition relief for improper 105 Requirements is to no effect.

These 105 Requirements are so poorly worded and ambiguous that they are virtually impossible to respond to. They impose an extreme burden on the Applicant while producing very little useful information for the examination process.

This burden does not end with a single ambiguous, unintelligible 105 Requirement. A 105 Requirement had previously been generated in all four of the Board-decided applications including the instant application early in 2005.

Thus, for these reasons alone, this 105 Requirement should be withdrawn to put an end to this burdensome and apparently never-ending process regarding this Applicant.

REDACTED

EXHIBIT D

REDACTED

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLUMBIA

GILBERT P. HYATT,

Plaintiff,

v.

JON W. DUDAS,

Defendant.

Civil Action 04-1802 (HHK)

Civil Action 04-1138 (HHK)

Civil Action 04-1139 (HHK)

Civil Action 05-0310 (HHK)

MEMORANDUM OPINION

Gilbert P. Hyatt brings these four civil actions against Jon Dudas, in his official capacity as Director of the United States Patent and Trademark Office (“PTO”), seeking review of decisions by the Board of Patent Appeals and Interferences (“Board”) that affirmed the rejection of twelve patent applications. Before the court are the parties’ submissions on a threshold question—whether the Board erred by reviewing twenty-one representative claims instead of reviewing all of Hyatt’s approximately 2400 claims. Upon consideration of the parties’ respective positions and the record of the case, the court concludes that, while the Board did not err by grouping claims, it improperly selected the representative claims for review.

I. BACKGROUND

A. Patent Application Requirements

An inventor seeking to obtain a patent must file a written application with the PTO. That application must include a specification of the purported invention, consisting of, *inter alia*, both a written description of the claimed invention and an enablement for that invention. 35 U.S.C. § 112, para. 1. To fulfill the written description requirement, a patent applicant must “convey

with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563–64 (Fed. Cir. 1991). That is, a description need not describe exactly what the applicant claims as her invention, but it must convey to one with “ordinary skill in the art” that the applicant invented what is claimed. *Union Oil Co. v. Atlantic Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000). The application must also explain the “manner and process of making and using [the invention] in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . to make and use the same.” 35 U.S.C. § 112 para. 1; *see also* 37 C.F.R. § 1.71(a). To meet this enablement requirement, “a patent application must adequately disclose the claimed invention so as to enable a person skilled in the art to practice the invention at the time the application was filed without undue experimentation.” *In re Swartz*, 232 F.3d 862, 863 (Fed. Cir. 2000). “[A] ‘reasonable’ amount of routine experimentation,” is allowed but “such experimentation must not be ‘undue.’” *Enzo Biochem, Inc. v. Calgene, Inc.*, 188 F.3d 1362, 1371 (Fed. Cir. 1999). Additionally, “[w]hether claims are sufficiently enabled by a disclosure in a specification is determined as of the date that the patent application was first filed.” *Id.*

At the end of the written description and enablement section of a patent application, a proper specification should conclude with a list of “claims,” which identify the specific “subject matter” of the invention that the applicant regards as hers. 35 U.S.C. § 112 para. 2. A claim is a single-sentence description, usually divided into several paragraphs, of what an applicant believes to be her invention, setting the boundaries of the invention the applicant wishes the PTO to examine. Specifically, a single claim can be composed of multiple elements and/or limitations. Elements are the previously known physical components that make up the claimed

invention. Limitations, on the other hand, usually describe the claim's restrictions, or the interaction between or features of the claim's elements. An application may contain several claims, and each claim usually contains several limitations. In addition, several claims in a single application may share some of the same limitations. As a result, the PTO may reject several claims at once by rejecting a single, shared limitation.

An applicant may, if she wishes, add additional claims to an invention disclosed in an earlier application, provided that the earlier, or parent, application has not yet been issued or abandoned. These "continuation applications" rely on the same specification in the pending parent application and are entitled to the parent application's filing date.

B. Patent Examination

After an inventor files her application, the PTO assigns the application to an Examiner who has the necessary technical competence. HERBERT F. SCHWARTZ, *PATENT LAW & PRACTICE* 10, 18 (3d ed. 2001). After examining the application, the Examiner sends the applicant an "Office action" which may grant or reject the claims. *Id.* at 18-24; *see also* 37 C.F.R. § 1.104(a)(2). The applicant may respond by submitting, in writing, a reply that "distinctly and specifically points out the supposed errors in the Examiner's action and must reply to every ground of objection and rejection in the prior Office action." 37 C.F.R. § 1.111(b). "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section." *Id.* If the Examiner and applicant cannot agree on the disposition of certain claims, the Examiner issues a Final Office action. *Id.* § 1.113. If the Final Office action rejects the claims in the application, the applicant may then appeal to the Board, 35

U.S.C. § 134(a), which is made up of a panel of three administrative patent judges, who will either sustain or reverse the Examiner's rejections. *Id.* § 6.

On appeal, the Board is entitled to group the applicant's claims by common ground of rejection, in accordance with PTO regulations, and review one representative claim from each group, unless the applicant meets her burden of assuring separate review of all claims. To assure the separate review of all of her claims, the applicant's brief to the Board must (1) contain a statement that her claims do not stand or fall together; and (2) explain why her claims are separately patentable. *See* 37 C.F.R. § 1.192(d)(7). If the Board sustains the Examiner's rejections, the applicant may appeal to the Federal Circuit under 35 U.S.C. § 141, or she may bring a civil action to overturn the Board's decision in this court under 35 U.S.C. § 145.

C. Factual Background

Hyatt is an electrical engineer who holds more than sixty patents on inventions in subject areas including microcomputers, computer memories and displays, and global-positioning systems. Between April and June 1995, Hyatt filed the twelve patent applications at issue in these four cases, which, combined, included approximately 2400 claims. Each of these applications was part of a series of continuation applications based on ancestor patents dating back to the early 1980s or before, and each was later amended to add hundreds of claims that were not claimed in the ancestor applications or in the application as filed in 1995. The Examiner ultimately rejected all of the claims in Hyatt's applications. The most common basis for rejection was that the amended claims were not adequately described in the earlier-filed application. According to the PTO, this requirement—the written description requirement—is particularly important where, as here, “the patent claims are written years after the original patent

application was filed, as the written support must be in the application as originally filed.” Pl.’s Br. at 5. The PTO also rejected some of Hyatt’s claims for lack of enablement and for obviousness.¹ Hyatt appealed these rejections to the Board.

For each rejected application, Hyatt filed an appeal brief and the Examiner thereafter filed a responsive brief. For two of the twelve applications, the Examiner provided Notices of Non-Compliance indicating that Hyatt had failed to meet the requirements of the PTO regulation governing the grouping of claims on appeal. The Notices also provided Hyatt a chance to cure these deficiencies by submitting supplemental arguments, which Hyatt did.

Following appellate briefing, the Board issued an opinion in each case, rejecting Hyatt’s patent applications. Rather than review the hundreds of claims independently, the Board determined that it was “free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim.” *See, e.g.*, Pl.’s Mot., Ex. 16 (Decision on Appeal for the ‘728 application), at 6; *id.*, Ex. 17 (Decision on Appeal for the ‘072 application), at 4–7; *id.*, Ex. 18 (Decision on Appeal for the ‘361 application), at 4–7. Focusing solely on twenty-one representative claims, the Board sustained the Examiner’s rejections and, accordingly, denied Hyatt’s applications. Hyatt thereafter filed four § 145 actions in this court that encompass all twelve patent applications at issue.

¹ The rejections for obviousness were based on 35 U.S.C. § 103(a), which provides that “[a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

II. ANALYSIS

The issue before the court involves the propriety of the Board's grouping of Hyatt's claims. Hyatt first argues that he met the necessary requirements to prevent the grouping of his claims on appeal and that the Board erred by failing to consider all his claims. Alternatively, assuming the court were to disagree, Hyatt contends that the court should nonetheless consider all his claims for two reasons: (1) because the PTO assertedly waived its right to challenge Hyatt's compliance with the regulations in ten of the twelve applications at issue; and (2) because equity compels such a result. Finally, Hyatt argues that, assuming that grouping of claims was appropriate, the Board failed to group his claims properly. The court addresses each of these four arguments in turn.

A. Compliance with 37 C.F.R. § 192(c)(7)

PTO regulations govern the propriety of grouping claims on appeal. The former version of the relevant regulation—and the one that governs this litigation²—provides:

Grouping of Claims. For each ground of rejection which appellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, appellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

37 C.F.R. § 1.192(c)(7) (“Rule 192(c)(7)”).

² 37 C.F.R. § 1.192(c)(7) was replaced by 37 C.F.R. § 41.37(c)(1)(vii), effective September 2004. However, the former rule was applicable when Hyatt filed his appellate briefs in 2000–2001 and accordingly will be the focus of this discussion.

In *In re McDaniel*, the Federal Circuit discussed Rule 192(c)(7) in detail and explained that the grouping of claims “operates to relieve the Board from having to review—and an applicant from having to argue—the myriad of distinctions that might exist among claims, where those distinctions are, in and of themselves, of no patentable consequence to a contested rejection.” 293 F.3d 1379, 1383 (Fed. Cir. 2002). The rationale underlying the grouping of claims as permitted by Rule 192(c)(7) is that “[i]f the applicant’s commonly applicable reasons for patentability have merit, the rejection of both claims will be overcome, quite apart from any patentable distinctions that exist between the claims.” *Id.* Therefore, according to the Federal Circuit, Rule 192(c)(7) “acts as the default that permits the Board to designate one claim to serve as a representative of others in a commonly rejected group and to focus its attention on only those matters that are dispositive of the appeal.” *Id.*

Under the regulation, the Board will group claims “unless applicant overcomes the default to assure separate review of individual claims.” *Id.* Thus, the Federal Circuit has interpreted Rule 192(c)(7) to create a presumption that claims will be grouped together on appeal based on a common ground of rejection and that this presumption can only be overcome if the appellant meets her burden of demonstrating that each claim should be addressed separately. According to the text of Rule 192(c)(7), that burden requires the appellant’s brief to meet two conditions: (1) it must contain a statement that the claims do not stand or fall together; and (2) it must explain why claims are separately patentable. *Id.* (citing U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1206 (8th ed. 2001)); *see also Hyatt v. Dudas*, 399 F. Supp. 2d 1, 7–8 (D.D.C. 2005).

The PTO concedes that the first requirement has been met, Def.'s Br. at 12, but disagrees with Hyatt regarding whether Hyatt sufficiently argued for the separate patentability of his claims, thus assertedly failing to meet the second requirement. Notably, the parties disagree as to what is required to meet the second requirement contained in Rule 192(c)(7). The PTO reads the regulation to require that the applicant "explain why *each individual claim* is separately patentable." Def.'s Br. at 6 (emphasis added). An applicant can do this, according to the PTO, by presenting "substantive argument about why each claim overcomes the rejection(s) made against it and is separately patentable." *Id.* at 7. At its core then, the PTO's interpretation of Rule 192(c)(7) requires that, if the applicant wants the Board to review each claim separately, the applicant must argue each claim separately.

Hyatt disagrees, insisting that the language of Rule 192(c)(7) does not require "a claim-by-claim analysis in order to pass muster under the Rule." Pl.'s Opp'n at 9–10. Rather, Hyatt asserts that he satisfied the requirements for arguing separate patentability by "analyzing each disputed claim limitation and then identifying which claims recited that claim limitation." *Id.* at 16. He suggests that the claim limitation listings could have been combined with the subject matter arguments made throughout his appellate briefs to "provide a conceptual matrix" that "*in effect* provides a separate argument for the claim elements in each claim, but without repeating the same argument over and over again for each claim having a common claim limitation." *Id.* at 20 (emphasis added). Hyatt insists that this was a "logical, practical and reasonable means of satisfying the requirements of Rule 12(c)(7)." Pl.'s Surreply at 6.³

³ It should be noted that Hyatt's method of creating this "conceptual matrix" is far from straightforward and requires a substantial amount of effort to determine which subject matter arguments apply to which claims. Using the '521 application as an example, in his "Summary of

Ultimately, the court disagrees with the PTO that a claim-by-claim argument is necessarily required under the plain language of the rule. Rule 192(c)(7) requires that the “appellant explain[] why the claims of the group are believed to be separately patentable.” Nowhere in this language is there a requirement that such explanation be done on a claim-by-claim basis, and the court declines to manufacture such language now. Nonetheless, by explicitly providing that “[m]erely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable,” the rule certainly anticipates that not just any argument will suffice to require the Board to review an applicant’s claims separately. Rather, the appellant is expected to make an argument that adequately addresses the reasons for separate patentability, thereby rebutting the presumption in favor of grouping. For the following reasons, Hyatt failed to do so and, accordingly, the Board did not err by reviewing only representative claims.

First, although Hyatt argues that a claim-by-claim argument for separate patentability would be redundant and inefficient, his solution—the “conceptual matrix” approach linking subject matter arguments with corresponding claims—fails to show that grouping claims was inappropriate and, moreover, inadvertently gives greater support for such grouping. It is well established that patentability of a claim requires reading the claim in its entirety. *See In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983) (“The claim must be read as a whole.”); *Ricoh Co. v. Katun Corp.*, 380 F. Supp. 2d 418, 423 (D.N.J. 2005) (“A claim must be read as a whole,

Separate Claims Argument” Hyatt disputes the written description rejection of the “filter” limitation. *See* Pl.’s Opp’n, Ex. 13, at 3. To determine the claims in which this limitation appears, however, a reader of Hyatt’s brief would have to consult the “Different Claim Limitations in the Instant Application” exhibit and go through 311 claims one by one to check if that limitation appears therein. *See* Pl.’s Mot., Ex. 24, at Tab 6.

rather than element by element.”). By arguing separate patentability of each claim by simply inserting various generically argued limitations into each claim, Hyatt does not address claim limitations within the context of each separate claim and therefore does not address why each claim as a whole is separately patentable. *Cf. In re Hiniker*, 150 F.3d 1362, 1368 (Fed. Cir. 1998) (“Although [appellant’s] submissions are extensive and its arguments are otherwise persuasive, neither is connected to the broad claims [he] seeks to secure.”).

Moreover, by admitting that a subject matter-based approach adequately addresses the rejections at issue, Hyatt implicitly concedes the appropriateness of grouping his claims. If each limitation may be addressed on a general basis without contextualization in specific claims, rejected claims having such limitations must therefore be conceded as having been validly rejected for reasons generally applicable across all claims, despite the differences as to the remaining limitations. *Cf. In re Battiston*, 2005 U.S. App. LEXIS 14303, at *8 (Fed. Cir. July 15, 2005) (finding Board’s grouping of claims proper where appellant argued “each of the original four rejections, not the claims, separately”). These commonly applicable grounds for rejection of Hyatt’s claims thus justify the Board’s corresponding grouping of claims and strongly undermines Hyatt’s argument for separate patentability. *See In re McDaniel*, 293 F.3d at 1383 (“For example, if two commonly rejected but patentably distinct claims are considered by an applicant to be patentably distinguishable over the cited art for reasons applicable to both claims, there is no reason why the Board, or an applicant for that matter, should have to be concerned with the distinctions between the claims themselves in the rejected group.”).

Finally, for the two applications for which Hyatt did argue separate patentability on a claim-by-claim basis,⁴ Hyatt's arguments, although extensive, do little more than list differences in what each claim covers and make unsupported conclusory arguments for wrongful rejection. For example, Hyatt cites to the following argument in his '072 Supplemental Brief as representative:

Claim 98 recites the following novel combination of contested limitations that distinguishes the reference and that is separately patentable over the combinations recited in the other claims: a first memory storing input image information, a spatial filter circuit generating output spatially filtered image information, a second memory, a second memory input circuit inputting spatially filtered image information, an undersampling circuit, a spatial interpolation circuit, a temporal interpolation circuit, a communication link communicating output image information, a display circuit, and a display device displaying an image. Neither the art rejections nor the double patenting rejection establish motivation for the combination of the references, nor obviousness of the recited cooperation between the limitations in this claim. Further the § 112-1 rejections do not establish why the express disclosure of the limitations in this claim does not satisfy § 112-1. Still further, neither the art rejections nor the double patenting rejection establish what in the reference is relied on to establish obviousness of each of the recited limitations in this claim: e.g., filter, interpolation, spatial, temporal, temporal interpolation, and undersampling type limitations. Further, the rejections fail to establish the required *prima facie* case and fail to provide the required "substantial evidence" to support the rejections of this claim.

Pl.'s Mot., Ex. 12, at 33 (internal citations omitted).

The first part of the argument merely states what the limitations of that claim are. As expressly indicated by Rule 192(c)(7), this is not sufficient to preclude grouping of claims. *See* 37 C.F.R. § 1.192(c)(7) ("Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.").

⁴ Hyatt submitted these claim-by-claim arguments in response to a Notice of Non-compliance issued by the Examiner.

While the second part of Hyatt's claim-specific argument does acknowledge the particular grounds for rejection, it only does so through broad denials of the propriety of these rejections and does not state *why* they are improper. Although Hyatt argues that the threshold for sufficiently arguing separate patentability is quite low, his reliance upon *In re Watts*, 354 F.3d 1362 (Fed. Cir. 2004), for this proposition is misplaced. In *Watts*, appellant's claims 17–21 and 23 were rejected as obvious over a combination of three prior patents. Because the appellant argued that this combination did not disclose the “critical I/O limitations” present in claims 21 and 23 but not in claims 17–20, the court found the Board's grouping of all five claims improper. *Id.* at 1368–69. Although the arguments for separate patentability in *Watts* were not extensive, they nevertheless provided a specific reason why the claims should not be grouped together, namely that the patentability of two claims involved a limitation not addressed by the prior art over which it was rejected. By contrast, Hyatt provides no specific reason why any claim should be considered apart from other claims with a common ground of rejection.

For these reasons, Hyatt failed to meet his burden of establishing the second requirement of Rule 192(c)(7), for he did not present adequate *argument* as to why the claims were separately patentable. Consequently, the Board did not err when it chose to group Hyatt's claims.

B. Waiver

As noted above, the Examiner issued Notices of Non-compliance in two of Hyatt's twelve appeals, informing him that, although he had stated that his claims did not stand or fall together, he had failed to include “any separate discussion of the separate patentability of ANY individual claim.” Pl.'s Mot., Ex. 11, at 3 (capitalization in original). Hyatt argues that, by failing to issue such notices for the remaining ten appeals, the Examiner implicitly conceded that

Hyatt had included adequate discussion of the separate patentability of his claims in those appeals. Accordingly, Hyatt insists that the PTO waived any right to group his claims in ten of his twelve appeals. For the following reasons, the court disagrees.

Under 37 C.F.R. § 1.192(d), the Examiner was required to notify Hyatt if his brief did “not comply with all the requirements of paragraph (c)” of that Rule—the paragraph dealing with grouping of claims by the Board on appeal—and permit him to file an amended brief. While Hyatt cites a number of cases for the proposition that an Examiner’s failure to issue a Notice of Non-compliance can bind the Board and preclude it from grouping claims under Rule 192(c)(7), Pl.’s Br. at 11 (citing *Ex parte Schier*, 21 U.S.P.Q.2d 1016 (Bd. Pat. App. & Inter. 1991) and *Ex parte Ohsumi*, 21 U.S.P.Q.2d 1020 (Bd. Pat. App. & Interf. 1991)), these cases are inapposite for they all involve situations wherein the applicant failed to make *any* argument for separate patentability. Here, however, Hyatt made such an argument, albeit an unconvincing one. The PTO’s Manual of Patent Examining Procedure specifically distinguishes these two scenarios, stating:

[In reviewing the contents of an appellate brief] a distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case, notification of a defective appeal brief [by the Examiner] is in order, while in the latter case, the application or reexamination is forwarded to the Board for a decision on the merits.

U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 1206 (8th ed. 2001, rev. May 2004). Accordingly, where an appellant’s brief is facially consistent with Rule 192(c)(7)—i.e., there is a statement that claims do not stand or fall together and *an* argument for separate patentability—the Examiner need not issue a Notice of Non-compliance and, accordingly, does not bind the scope of the Board’s review by failing to do so. Here, because

Hyatt included some argument for the separate patentability of his claims, his brief was not non-compliant with the rules and the Examiner was not required to provide him the opportunity to amend his briefs.

Moreover, the PTO regulation in effect at the time of Hyatt's appeal, as well as relevant case law decided after *Schier* and *Ohsumi*, make clear that the authority to substantively evaluate an appellant's arguments for separate patentability lies with the Board, not the Examiner. First, the language of the regulation governing this case states that "*the Board* shall select a single claim from the group and shall decide the appeal as to the ground of rejection," 37 C.F.R. § 1.192(c)(7) (emphasis added), whereas the rule in effect at the time *Schier* and *Ohsumi* were decided did not explicitly place this determination with the Board. *See id.* § 1.192(c)(5) ("For each ground of rejection which appellant contests and which applies to more than one claim, it will be presumed that the rejected claims stand or fall together."). The insertion of "the Board" into the regulation clarifies any ambiguous division of responsibilities that may have remained under the former "it will be presumed" language.

Furthermore, the Federal Circuit, in *In re McDaniel*, accorded the Board unqualified authority to group claims in accordance with Rule 192(c)(7) without mention of any limitations stemming from the Examiner's finding of compliance or non-compliance with that rule. *In re McDaniel*, 293 F.3d at 1383 ("The rule acts as the default that permits *the Board* to designate one claim to serve as representative . . .") (emphasis added); *Id.* ("If the brief fails to meet either requirement, *the Board* is free to select a single claim . . .") (emphasis added).

Given these, the court cannot agree with Hyatt that the Examiner's failure to issue a Notice of Non-compliance in ten of the twelve appeals had any binding effect upon the Board's

ability to select representative claims, for the ultimate authority on the merits of Hyatt's brief lay with the Board. Although it is admittedly surprising that the Examiner chose to issue Notices of Non-compliance in two appeals but not in other similar ones, the Examiner's inconsistency cannot constrain the Board's discretion.

C. Equitable Principles

Noting that § 145 actions are rooted in a bill of equity, Hyatt urges the court to consider all of his claims for two "equitable" reasons: (1) because the Examiner's issuance of Notices of Non-compliance for only two of the twelve applications denied him adequate notice of deficiency; and (2) because the PTO's elimination of former Rule 192(c)(7) due to confusion in its application requires leniency towards Hyatt's good faith attempt at compliance. Pl.'s Br. at 24-27.

First, Hyatt insists that the Examiner's failure to provide a Notice of Non-compliance in ten of the twelve applications "served to create added confusion regarding the PTO's interpretation and implementation of the Rule." *Id.* at 27. The inconsistent use of the Notice of Non-compliance for Hyatt's applications is, according to Hyatt, "nothing short of unconscionable." *Id.* Ultimately though, as discussed above, when given the chance to amend his appeal briefs in the two matters in which the Examiner *did* issue Notices of Non-compliance, Hyatt still failed to meet his burden of arguing for the separate patentability of his claims. Accordingly, the court does not agree that any unfairness resulted from Hyatt's not being given the opportunity to amend his briefs in the other ten appeals.

With regard to his second equitable argument, Hyatt comments that Rule 192(c)(7) is "not a model of clarity," *id.* at 26, an assertion with which the PTO has agreed in the past. *See* 69

Fed. Reg. 49960, 49962–63 (Aug. 12, 2004) (noting that Rule 192(c)(7) has “led to many problems” for appellants and Examiners).⁵ Given the “admitted problems with former Rule 192,” Hyatt insists that “it would be unfair to penalize [him] where he at least made a good-faith effort to comply with the PTO’s confusing requirement.” Pl.’s Br. at 26–27. Many litigants, however, are bound by laws and regulations that they believe are ambiguous. Such ambiguity does not, in this court’s opinion, merit the equitable relief that Hyatt seeks.⁶

D. Proper Grouping of Claims by the Board

Lastly, Hyatt contends that, even if the Board was entitled to group together his claims under Rule 192(c)(7), its selection of representative claims was improper. Specifically, Hyatt argues that the Board erred by selecting as representative only those claims that were discussed in the “Summary of the Invention” section of his appeal brief. Instead, he insists that the Board was required to group claims according to the common ground of rejection relied on by the Examiner and to select a representative claim for each grouping. The court agrees.

Rule 192(c)(7) requires that claims be grouped on appeal by common ground of rejection. *See* 37 C.F.R. § 1.129(c)(7) (“For each ground of rejection which appellant contests and which applies to a group of two or more claims . . .”). The PTO does not disagree that it was required

⁵ For this reason, the PTO replaced Rule 192(c)(7) and supplanted it with 37 C.F.R. § 41.37(c)(1)(vii) (“Rule 41.37(c)(1)(vii)”), a regulation that clarifies the burden on an appellant who wishes to avoid the grouping of claims. Specifically, Rule 41.37(c)(1)(vii), unlike Rule 192(c)(7), explicitly requires an appellant to argue separate patentability on a claim-by-claim basis in order to avoid grouping by the Board. *See* 37 C.F.R. § 41.37(c)(1)(vii) (“Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.”).

⁶ The PTO also argues that Hyatt does not deserve equitable relief because he has “abus[ed] the spirit of the rules of patent prosecution.” Def.’s Opp’n at 33. The court takes no position on these allegations.

to group claims by common ground of rejection, but instead argues that a common ground of rejection is “defined not by claim limitations, as Mr. Hyatt argues, but rather by the statutory basis for rejection.” Def.’s Reply at 6.⁷ This argument is contradicted by Federal Circuit precedent. In *In re McDaniel*, the Federal Circuit clarified that, when selecting representative claims, the Board may not “ignore the distinctions between separate grounds of rejection and select the broadest claim rejected on one ground as a representative of a separate group of claims subject to a different ground of rejection.” *In re McDaniel*, 293 F.3d at 1384. Rather, the Board is required to group claims together such that the distinctions between the claims are “of no patentable consequence to a contested rejection.” *Id.* at 1383–84.⁸

Applying these principles, the Federal Circuit noted that certain of the claims at issue in *In re McDaniel* shared a common ground of rejection when they “were rejected over some of the same references *and* under the same statutory provision.” *Id.* at 1384 (emphasis added). Given

⁷ The PTO also argues that Hyatt waived any right to have other representative claims reviewed by the Board by failing to argue those claims in his appeal briefs. This argument is inconsistent with *In re McDaniel*, where the applicant was held to have “waived” the separate argument of his claims, yet nonetheless had the right to have “each grounds of rejection relied on by the Examiner reviewed independently by the Board.” *In re McDaniel*, 293 F.3d at 1384.

⁸ The court recognizes that *In re McDaniel* is not a perfect parallel to this case in that the rejections at issue in *In re McDaniel* were due to the presence of prior art, whereas here the rejections were primarily for lack of written description. As Hyatt notes, “a written description rejection is the converse of a prior art rejection.” Pl.’s Surreply at 10. Specifically, in the case of a prior art rejection, the elements of the claims *are* disclosed by the cited reference. However, a written description rejection involves a very different showing that the elements *are not* disclosed by the specification. This distinction has very real consequences when it comes to grouping under Rule 192(c)(7), consequences that the PTO fails to appreciate.

The court agrees with Hyatt that the question of adequate disclosure of one claim limitation, such as an input circuit, has a “different patentable consequence” than the disclosure of a different limitation, such as a processor. Given this difference, the Board should not have grouped claims that have been rejected for lack of a written description unless those claims share a limitation that has been found to have not been disclosed by the specification.

this explicit recognition that proper grouping requires more than that the claims share the same statutory basis for rejection, the court cannot agree with the PTO's argument to the contrary.⁹

To demonstrate how the Board erred, the court will focus on one exemplar application—the '549 application. There, the Examiner's rejection provided thirteen separate claim groupings, each relating to a separate and distinct claim limitation that allegedly was not supported by the written description in the application. *See* Pl.'s Opp'n, Ex. 27, at 20. On appeal, the Board failed to focus on these claim groupings, instead selecting one claim from the Summary of the Invention section of the appeal brief to serve as the sole representative claim. *See* Pl.'s Opp'n, Ex. 12, at 3–5. Doing so was improper because that representative claim failed to share a common ground of rejection with many of the claims it purported to represent. Instead, as the Federal Circuit has made clear, the Board was required to group claims together such that the distinctions between the claims were “of no patentable consequence.” *Id.* at 1383–84.¹⁰ In sum, the Board's use of one claim as representative of a large number of claims whose sole similarity is that they were rejected under the same statutory provision is contrary to binding case law.

⁹ As Hyatt correctly notes, this conclusion is strengthened by the internal PTO guidelines, which provide that the “ground of rejection” for an applicant's patent claim must include both “the statutory basis for any ground of rejection,” as well as “the reason” for the rejection. *See* U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 707.07(d) (8th ed. 2001, rev. May 2005)

¹⁰ However, contrary to Hyatt's argument, *In re McDaniel* does not require the Board to choose a representative claim for each claim group rejected by the Examiner. In *In re McDaniel*, the Federal Circuit affirmed the Board's use of claim 53 as representative of claims 61–63, even though claim 53 has not been rejected together with claims 61–63. *In re McDaniel*, 293 F.3d at 1384.

The Board's failure to evaluate a number of representative claims that it should have has "left this court without an adequate record" to review. *Hyatt*, 393 F. Supp. 2d at 13. The appropriate remedy therefore is to remand the case to the PTO for further proceedings consistent with this opinion, and to allow them to determine, in the first instance, the proper grouping of claims. Remand is a common remedy in patent cases where the Board errs. *See In re Beaver*, 893 F.2d 329, 330 (Fed. Cir. 1989) (remanding to the PTO after determining that the Board erred in grouping claims); *Hyatt*, 393 F. Supp. 2d at 13 (remanding to the PTO after concluding that the Board erred in determining that the Examiner's rejections established a *prima facie* case). Moreover, the "application of Patent Office expertise in the first instance may either obviate the need for judicial consideration, or illuminate the issues and facilitate the court's disposition." *DeSeversky v. Brenner*, 424 F.2d at 857, 859 (D.C. Cir. 1970).

III. CONCLUSION

Accordingly, this matter is remanded to the PTO. An appropriate order accompanies this memorandum opinion.

Henry H. Kennedy, Jr.
United States District Judge

Dated: August 30, 2006

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EXHIBIT E

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[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]	[REDACTED]
GILBERT P HYATT PO BOX 81230 LAS VEGAS, NV 89180			EXAMINER [REDACTED]	
			ART UNIT	PAPER NUMBER
			[REDACTED]	
DATE MAILED: 08/10/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

- The written description requirement of 35 U.S.C. 112 has several policy objectives including the conveyance of information that an applicant "has invented the subject matter which is claimed", and to put the public in possession of what the applicant claims as the invention.
- The written description requirement is satisfied when a patent "specification" describes the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.
- To show possession, the specification must describe the claimed invention with all of its limitations using words, structures, figures, diagrams and formulas that full set forth the claimed invention.
- The written description requirement prevents an applicant from claiming subject matter that was not adequately described in the specification as filed.

The original disclosure, comprising the originally filed specification, claims and drawings, is the sole basis for the written description support of claimed subject matter. Possession of a claimed invention, and particularly a claimed invention added after the original filing date (such as the applicant's pending claims), is satisfied when the specification describes the claimed invention with all of its limitations using words, structures, figures, diagrams and formulas. It is not enough for a specification to individually mention the claim elements in disparate sections without having a disclosed relationship with each other. There must be at least one self-contained embodiment in the original disclosure that describes the claimed invention, including all of its elements and the interrelations between the elements.

The Applicant's Claim Invention(s) Lacks Written Description Support

Each of the pending claims recites a combination of individual claimed elements, where the elements are modified by their interrelations (e.g., the "in response to"

Each image unit "In" is multiplied by a weight "Wn" from a table 520C, and then the products are summed. That sum-of-the-products configuration is typical of a spatial filter. It corresponds to the filter shown in Figure 2 of Reitmeier et al., for example. (Patent No. 4,432,009).

On the other hand, a "transform processor" is quite different, as evidenced by Widergren et al. (Patent No. 4,394,774). By the way, Appellant cited both these patents in an IDS (Paper No. [REDACTED]). Widergren describes a typical transform processor at Column 12, line 10 through Column 14, line 20, in connection with Figures 5, 6 and 7. In Widergren's system, the transform is the Discrete Cosine Transform, which is a species of Fourier transform. Transform processing involves considerably more than the mere sum-of-the-products, as evidenced in Widergren.

Whether or not the excerpts quoted above are read in isolation or in context, they simply don't support the features called for in Appellant's claims. [REDACTED] Appellant's disclosure fails to provide an adequate written description of Appellant's claimed invention. The terms are exemplary in nature, and are merely mentioned as examples of elements or information that "can be" used, rather than as part of description of self-contained working embodiment. However, a mere mention that one "can" use certain elements or information (for some undisclosed purpose) is not enough written description to provide evidence of possession of the example claim. There is certainly no mention in the specification of a nexus between the elements and information and the remaining individual elements of the example claim, let alone their claimed interrelations. There is no explicit, implicit, or inherent teaching in the original



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			EXAMINER	
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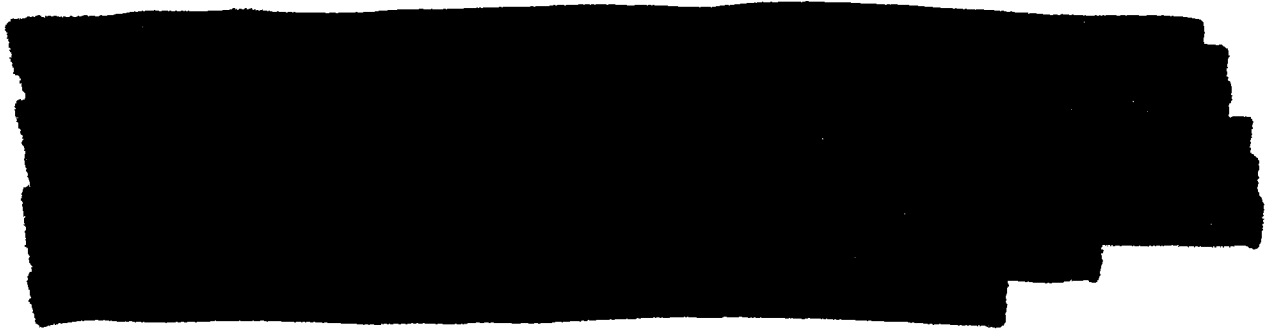
description rejection below, the examiner provides a clear explanation of the guiding criteria. In determining whether the claims have a corresponding written description, the specification was read for coherent embodiments, partial embodiments, or some cohesive suggestion or guide that would tie together the disparately disclosed elements of the specification in the manner claimed. Hindsight, or relying upon the claim itself as a guide, is improper.

One additional element to this criteria is noteworthy. That is, written description is analogous to anticipation, not obviousness. The claimed inventions must be anticipated by the original disclosure, not obvious in view of the original disclosure. Given many of the currently pending claims as guides, an argument that one skilled in the art would have found the written description to be obvious is erroneous. *The main question is whether the applicant actually invented what is now claimed; not whether the applicant invented a system from which the now claimed invention would have been obvious.* It is “not a question of whether one skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure Rather, it is a question whether the application necessarily discloses that particular device.” (*Jepson v. Coleman*, 314 F. 2d 533, 536, 136 USPO 647, 649-50 (CCPA 1963)). “The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, a prior art application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought” *Lockwood v. American Airlines Inc.* 41 USPO2d 1961 at 1966 (Fed. Cir. 1997).

Applicant's Disclosed Invention

The disclosed invention appears to be several generalized image processing architectures having numerous optional capabilities. The specification is a description of several optional architectures (e.g., Figures [REDACTED]), each architecture having numerous optional inputs, supervisory functions, geometric processing capabilities, spatial processing capabilities, multiplexing capabilities, and outputs (e.g., the tables at specification pages 24-30 describe many of these options), with miscellaneous descriptions of image processing operations scattered throughout (and not seemingly related to each other). *The specification lacks coherent embodiments and cohesive descriptions that tie the architecture, hardware options and/or miscellaneous processing descriptions together in a manner that describes the claimed inventions.* This is the primary basis for the written description rejections advanced herein. Examples of the architecture, hardware options and miscellaneous processing descriptions are provided immediately below.

Some of the optional architectures include (see specification page 5):



A brief review of these figures reveals that the architectures are all different, having different functional blocks and different interconnections. This fact per se is not the issue. Again, the issue is the lack of coherent embodiments and cohesive descriptions that tie one or

Art Unit: 2621

“can be” stored. The [REDACTED] descriptions above are not described in connection with one another. However, the claims tie such disparately disclosed [REDACTED] operations together (an example is provided below). For example, there is no description storing a [REDACTED]

[REDACTED]. The reason this example is used here will become evident later.

However, the point of this example is that linking disparate, suggested capabilities of the specification (such as the [REDACTED] suggestions cited from the specification above) in the absence of any suggestions, or guides for doing so does not bespeak of possession. Furthermore, few if any of the miscellaneous [REDACTED] operations or capabilities described in the specification are linked to any of the specific architectures, or any particular set of hardware/processing options within the architectures.

Again, the specification is a mixing bowl of architectures, options, and miscellaneous [REDACTED] functions that lacks coherent embodiments and cohesive descriptions that tie them together; especially in a manner that describes the claimed inventions. It is the examiner’s contention that such a collection of possibilities and capabilities does not necessarily put the applicant in possession of a very specific claim that tie these “capabilities” together as a complete system.

The Claimed Inventions

The claims recite combinations of structural elements and functions, whereby the structural and functional elements are interrelated (i.e., using “in response to” language” and/or interconnected (i.e., using “coupled to” language) to form very specific systems. However, upon

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			ART UNIT	PAPER NUMBER
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Application/Control Number: [REDACTED]

Art Unit: [REDACTED]

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [REDACTED] can be reached on [REDACTED]. The fax phone number for the organization where this application or proceeding is assigned is [REDACTED].

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

[REDACTED]
Primary Examiner
Art Unit [REDACTED]
January 14, 2005

[REDACTED]
PRIMARY EXAMINER



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[REDACTED]

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

EXAMINER

[REDACTED]

ART UNIT	PAPER NUMBER
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Commissioner of Patents and Trademarks

Serial Number: [REDACTED]

Page 63

Art Unit: [REDACTED]

advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to [REDACTED] whose telephone number is [REDACTED]. The examiner can normally be reached on Monday-Friday from 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, [REDACTED] can be reached on [REDACTED]. The fax phone number for this Group is [REDACTED]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is [REDACTED]

[REDACTED]
August 26, 1999



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. [REDACTED]

Application Number: [REDACTED]

Filing Date: [REDACTED]

Appellant(s): [REDACTED]

MAILED

AUG 21 2001

Technology Center [REDACTED]

[REDACTED]
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed August 28, 2000. To assist the reader in navigating this lengthy Answer, the Examiner has provided the following Table of Contents.

REDACTED

EXHIBIT G

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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[REDACTED] [REDACTED] [REDACTED] [REDACTED]

[REDACTED] LM31/0817 [REDACTED] EXAMINER

[REDACTED] [REDACTED] ART UNIT PAPER NUMBER

DATE MAILED: 08/17/99

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Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
Examiner	Group Art Unit

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on 9/16/98
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 111; 453 O.G. 213.

Disposition of Claims

- Claim(s) [REDACTED] is/are pending in the application.
- Of the above claim(s) [REDACTED] is/are withdrawn from consideration.
- Claim(s) [REDACTED] is/are allowed.
- Claim(s) [REDACTED] is/are rejected.
- Claim(s) [REDACTED] is/are objected to.
- Claim(s) [REDACTED] are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - All Some* None of the CERTIFIED copies of the priority documents have been received.
 - received in Application No. (Series Code/Serial Number) _____
 - received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s) [REDACTED]
- Interview Summary, PTO-413
- Notice of Reference(s) Cited, PTO-892
- Notice of Informal Patent Application, PTO-52
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Other _____

Office Action Summary

Application/Control Number: [REDACTED]

Page 135

Art Unit: [REDACTED]

42. Any inquiry concerning this communication or earlier communications from the examiner should be directed to [REDACTED] whose telephone number is [REDACTED]. The examiner can normally be reached on Monday through Thursday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor [REDACTED] can be reached on [REDACTED]. The fax phone number for this Group is [REDACTED].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is [REDACTED]

[REDACTED]
August 10, 1999

[REDACTED]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)

[REDACTED])

Serial No. [REDACTED])

Docket No. [REDACTED])

Filed: [REDACTED])

For: [REDACTED])

Group Art Unit [REDACTED]

Examiner: [REDACTED]

PETITION FOR AN EXAMINER'S ANSWER
UNDER 37 CFR 1.181(A)(3)

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

The Applicant respectfully petitions the Commissioner for his intervention to direct the Examiner to expeditiously provide the Applicant with an Examiner's Answer in response to the Applicant's Appeal Brief.

Examination in the instant application proceeded to the taking of an appeal and the timely filing of an Appeal Brief on July 17, 2000. An Examiner's Answer was due within two months.

The examiner should furnish the appellant with a written statement in answer to the appellant's brief within 2 months after the receipt of the brief by the examiner.

See MPEP 1208 (emphasis added). The importance of an examiner expeditiously furnishing an Examiner's Answer is even more compellingly illustrated by the fact that an Examiner's Answer takes "precedence" and "priority" over special applications.

Certain procedures by the examiners [examiner's answers] take precedence over actions even on special cases....

Applications in which practice requires that the examiner act within a set period, such as 2 months after


appellants brief to furnish the examiner's answers (MPEP § 1208) necessarily takes priority over special cases without specific time limits.

See MPEP 708.01 (emphasis added). Nevertheless, it has been over six (6) months and the Applicant has not received an Examiner's Answer. This is a blatant violation of the plain requirements of the PTO and of the right's of the Applicant.

Even the United States Congress discourages delays by the PTO. The United States Congress, in the term extension provision of the American Inventors Protection Act of 1999, sent the clear message that undue delay by the PTO is unacceptable.

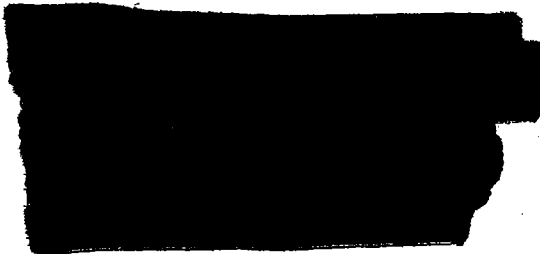
In view of the above, the Commissioner is hereby petitioned to direct the Examiner to immediately prepare an Examiner's Answer in the instant application or, alternatively, to pass the instant application to issue.

Because this petition seeks to invoke the Supervisory Authority of the Commissioner, a petition fee is not required.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No.  including any fees that may be required but are not set forth above.

Respectfully submitted,

Dated: January 19, 2001





UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. [REDACTED]

Application Number: [REDACTED]

Filing Date: [REDACTED]

Appellant(s): [REDACTED]

MAILED

OCT 31 2001

Technology Center [REDACTED]

[REDACTED]
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed July 17, 2000.

Application/Control Number: [REDACTED]
Art Unit: [REDACTED]

Respectfully submitted,

[REDACTED]

Primary Examiner

[REDACTED]

PRIMARY EXAMINER

Appeal Conference Conferees:

[REDACTED]

Primary Examiner

[REDACTED]

SPE, Art Unit

[REDACTED]

Primary Examiner

October 17, 2001

[REDACTED]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of)
)

Serial No.)

Docket No.)

Filed:)

For:)

Group Art Unit:)

Examiner:)

TRANSMITTAL LETTER

Hon. Assistant Commissioner
For Patents
Washington, D.C. 20231

Sir:

Transmitted herewith is:

1. REPLY BRIEF UNDER 37 CFR 1.193(B) in triplicate.
2. REQUEST FOR AN ORAL HEARING.

The fees are calculated below.

CLAIMS AS AMENDED

Claims Remaining After Amendment	Highest No. Prev. Paid For	Present Extra	Rate	Additional Fee
Total Claims	Minus	= 0	X \$18.00 =	\$ 0.00
Indep Claims	Minus	= 0	X \$84.00 =	\$ 0.00
Oral Hearing				\$ 140.00
Total Fee				<u>\$ 140.00</u>

Charge \$ 140.00 to Deposit Account No. 08-3626.

Please charge any fees associated with the papers transmitted herewith to Deposit Account No. [REDACTED] including any fees that may be required but are not set forth above.

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 with the express mail label number [REDACTED] on December 31, 2001.

Respectfully submitted,

Dated: December 31, 2001

[REDACTED]

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte [REDACTED]

Appeal [REDACTED]
Application [REDACTED]
Technology Center [REDACTED]

Decided: July 20, 2007

Before [REDACTED]
[REDACTED] Administrative Patent Judges.

[REDACTED] Administrative Patent Judge.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the final rejection of
claims [REDACTED] We have jurisdiction under 35
U.S.C. § 6(b).

FINDINGS OF FACT

(1) WRITTEN DESCRIPTION

(1) The Examiner informed Appellant that “[t]he written description requires support for the claimed subject matter in disclosure as discussed in MPEP § 2163.01” (Final Rejection 12);

(2) The Examiner informed Appellant that “[t]he burden on the examiner with regard to the written description requirement is set forth in MPEP § 2163.04” (Final Rejection 13);

(3) The Examiner informed Appellant that “after reviewing the claims and the description of the invention, that applicant fails to present claims that define an invention which would have been clearly conveyed to persons of ordinary skill in the art at the time the application was filed” (Final Rejection 13);

(4) The Examiner informed Appellant of specific limitations that are not found in the originally filed disclosure (Final Rejection 14 to 40);

(5) In response to the Examiner’s position, the Appellant pointed to elements in the figures of the originally filed application that allegedly provide support for the system limitations of claim 111 (Br. 9 and 10);

(6) Appellant’s response also included an extensive listing of elements found in the claims on appeal, and the number of occurrences that each element is mentioned in the originally filed disclosure (Br. 32 to 36);

- (7) Appellant listed pages in the originally filed disclosure that contained “off-the-shelf” components (Br. 37 and 38);
- (8) Appellant incorporated by reference material to supplement the originally filed disclosure;
- (9) The Examiner noted that “the only claim argued in detail is independent claim [REDACTED]” (Answer 5);
- (10) Using claim [REDACTED] as a representative claim selected by Appellant, the Examiner stated that “the critical components and features called for in the claims are nowhere to be found either in the specification or in the drawing figures” (Answer 13);
- (11) The Examiner discussed at length excerpts from Appellant’s disclosure (Answer 13 to 21), and found that “they simply don’t support the features called for in Appellant’s claims” (Answer 21);
- (12) The Examiner notified Appellant that “accompanying details as to how the various possibilities and permutations would actually be implemented” in the claims is not described in the originally filed disclosure (Answer 22);
- (13) The Examiner listed features in claim [REDACTED] that do not appear either singly or in combination in the originally filed disclosure (Answer 27 to 29);
- (14) The Examiner notified Appellant that “it is not simply that the individual elements are not described but also the combination of elements including the claimed interconnections that are not described explicitly, implicitly or inherently” (Answer 29 and 30);

- (15) The Examiner listed features in claim [REDACTED] that do not appear either singly or in combination in the originally filed disclosure (Answer 31 to 33);
- (16) The Examiner listed other features in the claims that are not found in the originally filed disclosure (Answer 33 and 34);
- (17) The Examiner found that the disclosure as originally filed lacks written description support for the myriad of products set forth in the claims on appeal (Answer 34 to 36); and
- (18) Appellant did not specifically respond to the request for a showing of the interconnections between the claimed elements.

PRINCIPLES OF LAW

(1) WRITTEN DESCRIPTION

If the Examiner had a reasonable basis for questioning the written description for the claims on appeal, then the burden of proof thereafter shifted to Appellant to make a showing. *In re Wertheim*, 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976).

In the recently decided *Hyatt*¹ case, the court stated, in pertinent part, that:

Here, we hold the examiner's initial rejection complied with § 2163.04(1)(B), followed Alton, and accomplished the aims

¹ *Hyatt v. Dudas*, No. 2006-1171, 2007 WL 1839700, at * 4 (Fed. Cir. Jun. 28, 2007)

of the prima facie case. For example, in rejecting application claim 163, the examiner explained that the written description did not support the particular claimed combination of elements, even listing each and every element of the allegedly unsupported combination. And the examiner was explicit that while each element may be individually described in the specification, the deficiency was the lack of adequate description of their combination—he stated. “While each element may individually be discussed neither the specification nor drawings clearly support the claimed embodiment as a whole.” *Id.* (emphasis added). He further indicated what Hyatt needed to address his concern: “[I]t is not enough that applicant show where each claimed element resides in the earliest filed application but [he] must also provide support for the linkage of the claimed elements creating the embodiment.” *Id.* (emphasis added).

Hyatt was clearly notified of what exactly the examiner felt was missing by way of written description. The burden was then properly shifted to Hyatt to cite to the examiner where adequate written description could be found, or to make an amendment to address the deficiency. Hyatt cannot avoid addressing the PTO’s concerns by instead challenging the PTO’s view that the burden was properly shifted. See Star Fruits, 393

F.3d at 1284 (“So long as the request from the examiner for information is not arbitrary or capricious, the applicant cannot impede the examiner’s performance of his duty by refusing to comply with an information requirement which proceeds from the examiner’s view of the scope of the law to be applied to the application at hand.”). Here, the examiner’s position was not arbitrary or capricious. Thus, it was incumbent upon Hyatt to comply with his responsibilities as a patent applicant so that the PTO could discharge its duty and finally resolve the allowability of the claims of Hyatt’s applications at issue. Because he refused to do so at the appropriate time, these claims were properly rejected.

ANALYSIS

(1) WRITTEN DESCRIPTION

In our review of Appellant’s Specification, we found a lack of critical components and features as well as “interconnections” between such claimed features and critical components. Based upon such deficiencies in the written description, we find that the Examiner had a reasonable basis for questioning the written description for each of the rejected claims on appeal, and the burden of proof thereafter properly shifted to Appellant.

As indicated *supra*, claim [REDACTED] is the only claim on appeal that Appellant has read on the disclosure for a showing of written description

support. We have reviewed the portions of the drawing and the disclosure suggested by the Appellant, and we agree with the findings made by the Examiner with respect to claim [REDACTED]. The referenced portions of the drawings and Specification do not provide written description support for the functions performed by the noted system elements.

The mere fact that individual words or elements in the claims appear throughout the disclosure is not helpful to an understanding of how all of those words or elements are tied together in each of the claims on appeal. If the claimed system elements are not tied together in the manner set forth in the claims on appeal, then it does not matter how many times the individual elements of the claimed system are mentioned in the disclosure.

Appellant's numerous arguments throughout the Briefs, particularly the discussion of the Specification in general and the case law surrounding written description, were not helpful in our quest to assess the written description support for the claimed subject elements.

Appellant has never read the claim limitations on specific portions of that massive body of material incorporated into the disclosure, and arguments in general about incorporation-by-reference cannot take the place of such a demonstration by Appellant.

In summary, we find that the Examiner met the initial burden of presenting to the Appellant a showing of what was lacking in the disclosure

to provide written description support for the claimed invention², and that the burden of making a proper showing of written description support properly shifted to the Appellant. In keeping with the recent *Hyatt* decision, we find that the Appellant did not properly comply with the Examiner's request for additional information that would prove that the claims have written description support in the originally filed disclosure.

FINDINGS OF FACT

(2) ENABLEMENT

- (1) A substantial portion of the deficiencies listed in connection with the lack of written description rejection was used to support the Examiner's position that Appellant has presented a non-enabling disclosure for the claims on appeal (Final Rejection 46 to 73);
- (2) As indicated in finding of fact (7) *supra*, Appellant contends that a substantial portion of the claimed elements are "off-the-shelf" components;
- (3) The Examiner contends that many elements in the claims on appeal were

² The Examiner informed Appellant that "[t]he claims on appeal are all newly added claims with new limitations. There are no original claims remaining in the application" (Answer 6). If the Appellant had shown support in his original disclosure for each of the newly added claims when the amendments were filed, then he might have avoided a written description rejection of the claims. When the claims are unusually lengthy or complex, an [a]pplicant should . . . specifically point out the support for any amendments made to the disclosure. *M.P.E.P.* § 2163.06 (6th ed., Rev. 2, July 1996).

not commonplace when Appellant's original Application was filed (Answer 38 to 40); and

(4) The Examiner references prior art (i.e., the Widergren U.S. Patent No. 4,394,774), the Reitmeier U.S. Patent No. 4,432,009, and the Sternberg U.S. Patent No. 4,322,716) that explains the state of the art prior to Appellant's original application filing date (Answer 39 and 40).

PRINCIPLES OF LAW

(2) ENABLEMENT

The test for enablement under 35 U.S.C. § 112 is whether one reasonably skilled in the art could make or use the claimed invention from the disclosed subject matter with information in the art without undue experimentation. *United States v. Telectronics*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1222-23 (Fed. Cir. 1988).

If the PTO meets its initial burden of presenting a reasonable explanation as to why the claimed subject matter is not enabled by the description of the invention provided in the specification of the application, then the burden shifts to the Applicant to provide suitable proofs indicating that the specification is indeed enabling. *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). *See In re Wright*, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

ANALYSIS

(2) ENABLEMENT

Simply stated, the Examiner's position that elements of the claimed invention are not commonplace is directly contradicted by the citation of references that purportedly show that the elements are well known in the art. In view of such contradictory positions, and Appellant's arguments throughout the Briefs concerning the use of commercially available products and components, and the level of skill in the art, we are of the opinion that the Examiner has not established a prima facie case of lack of enablement, and that the burden of rebuttal did not shift to Appellant.

CONCLUSIONS OF LAW

The lack of written description rejection is affirmed because the Examiner met his initial burden, and the Appellant did not properly rebut the positions outlined in the rejection.

The lack of enablement rejection is reversed because the Examiner did not meet the initial burden of establishing that the skilled artisan would have to resort to undue experimentation to arrive at the claimed subject matter.

DECISION

The lack of written description rejection of all of the claims on appeal is affirmed, and the lack of enablement rejection of all of the claims on appeal is reversed.

Appeal
Application

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
[REDACTED])	Group Art Unit: [REDACTED]
Serial No.: [REDACTED])	Examiner: [REDACTED]
Filed: [REDACTED])	
Docket No.: [REDACTED])	
Appeal No. [REDACTED])	
For: [REDACTED])	
[REDACTED])	

REQUEST FOR REHEARING

Mail Stop Appeal Brief – Patents
Commissioner For Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

ATTENTION: Board of Patent Appeals and Interferences

May It Please The Honorable Board:

This is a Request for Rehearing from the Decision of the Board affirming the rejection of claims [REDACTED] under 35 U.S.C. § 112-1 for lack of written description. This Request for Rehearing involves points of law and fact which the Appellant believes were misapprehended or overlooked in rendering the Decision. In accordance with 37 C.F.R. § 41.52(a)(1),¹ other points which the Appellant believes were misapprehended or overlooked and new grounds raised in rendering the Decision will become apparent in the discussion which follows. Furthermore, the Appellant relies on the arguments of record in the Appeal Brief and the Reply Brief.

Formerly 37 C.F.R. § 1.197(b).

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**1.2 THE WRITTEN DESCRIPTION REJECTION SHOULD BE REVERSED
BECAUSE THE EXAMINER FAILED TO ESTABLISH A PRIMA FACIE
CASE REGARDING MOST OF THE CLAIMS REJECTED UNDER § 112-1**

The Board misapprehended or overlooked important points:

- 1) by using the wrong standard for establishing a *prima facie* case with respect to written description,
- 2) by looking at the Examiner's Answer rather than the Final Office Action to determine whether the Examiner had established a *prima facie* case for written description, and
- 3) by determining that the Examiner had made a request for information.

See Appeal Brief, p. [REDACTED]; Reply Brief pp. [REDACTED]:

FACTS

The Final Office Action purportedly establishes a *prima facie* case with respect to written description by stating the following rejection,

With regard to the claims, applicant does not describe anywhere in the specification limitations which are recited in the claim. The following elements are all recited in the claim but are nowhere to be found, much less described, in the descriptive portion of the specification: "act of making a product" in claims [REDACTED]

[REDACTED], all of the above mentioned claims recite making various product products, (sic) for example [REDACTED]

[REDACTED], etc.

Final Office Action, p. 14.

On pages 36-40 of the Final Rejection the Examiner makes statements to the effect that certain quoted language would involve undue experimentation to implement a particular embodiment. These statements are related to the enablement rejection (which has been reversed) not to the written description rejection. However, the Appellant finds no identification of any specific claim limitations that are asserted to have inadequate written description.

The section on written description concludes with the general allegation that:

These claim limitations are not described in the application as filed. Therefore, the requirement for an adequate written description has not been met.

Final Office Acton, p. 40. However, this statement does not identify any particular claim limitations and the Appellant has been unable to find any identified claim limitations that are alleged to have inadequate written description other than the "making a product" claim limitations discussed above.

Claims [REDACTED]

[REDACTED] do not recite the above discussed "product" claim limitations and thus do not recite any claim elements that were listed in the Final Rejection as having inadequate written description.

The Board decision makes four findings of fact that are allegedly supported by the Final Office Action as follows:

- (1) The Examiner informed Appellant that "[t]he written description requires support for the claimed subject matter in disclosure as discussed in MPEP § 2163.01" (Final Rejection at 12);

- (2) The Examiner informed Appellant that "[t]he burden on the examiner with regard to the written description requirement is set forth in MPEP § 2163.04" (Final Rejection at 13);

- (3) The Examiner informed Appellant that "after reviewing the claims and the description of the invention, that applicant fails to present claims that define an invention which would have

been clearly conveyed to persons of ordinary skill in the art at the time the application was filed" (Final Rejection at 13);

Board Decision, p. 4. The full quotation from the Final Rejection further states, "The reasons are stated below." However, except for dependent claims which recite "making a product" claim limitations, no specific reasons were stated "below". Final Office Action, p. 13:26 and pp. 14:1 - 40:25:

(4) The Examiner informed Appellant of specific limitations that are not found in the originally filed disclosure (Final Rejection 14 to 40);

Board Decision, p. 4.

The Board also made the following Finding Of Fact (18), but Finding Of Fact (18) did not indicate where support for the finding could purportedly be found.

(18) Appellant did not specifically respond to the request for a showing of the interconnections between the claimed elements.

Board Decision, p.6. Finding OF Fact (18) contains no indication of where support can be found for the Finding and it is not supported by the Final Office Action, which made no Rule 1.105(a) request for a showing of the interconnections between the claimed elements.

With respect to establishing a *prima facie* case, the Board Decision stated:

If the Examiner had a reasonable basis for questioning the written description for the claims on appeal, then the burden of proof thereafter shifted to Appellant to make a showing. *In re Wertheim*, 541 F.2d 257, 263-64, 191 USPQ 90, 97 (CCPA 1976).

Board Decision, p. 6.

In our review of Appellant's Specification, we found a lack of critical components and features as well as "interconnections" between such claimed features and critical components. Based upon such deficiencies in the written description, we find that the Examiner had a reasonable basis for questioning the written description for each of the rejected claims on appeal, and the burden of proof thereafter properly shifted to Appellant.

Board Decision, p. 8.

In summary, we find that the Examiner met the initial burden of presenting to the Appellant a showing of what was lacking in the disclosure to provide written description support for the claimed invention* and that the burden of making a proper showing of written description support properly shifted to the Appellant. In keeping with the recent *Hyatt* decision, we find that the Appellant did not properly comply with the Examiner's request for additional information that would prove that the claims have written description support in the originally filed disclosure.

* The Examiner informed Appellant that "[t]he claims on appeal are all newly added claims with new limitations. There are no original claims remaining in the application" (Answer 6). If the Appellant had shown support in his original disclosure for each of the newly added claims when the amendments were filed, then he might have avoided a written description rejection of the claims. When the claims are unusually lengthy or complex, an [a]pplicant should . . . specifically point out the support for any amendments made to the disclosure. *M.P.E.P*

Board Decision, pp. 9-10.

ARGUMENT

The Board recognized that the Examiner was required to establish a *prima facie* case in his rejection for lack of written description. However, it misapprehended or overlooked important points when it found that the Examiner had established a *prima facie* case. The Board's erroneous determination that the Examiner had established a *prima facie* case was based upon an improper legal standard, impermissible use of the Examiner's Answer in addition to the Final Office Action and use of unsupported Findings Of Fact.

In determining whether or not the Examiner had established a *prima facie* case, the Board determined that the Examiner had established a *prima facie* case because he "had a reasonable basis for questioning the written description for each of the rejected claims on appeal". However it is not sufficient for the Examiner to "have a reasonable basis", he must give the Appellant fair notice of the specific grounds of rejection in the

initial office action so that the Applicant can appropriately respond with evidence of patentability, amendment of the claims where appropriate, and argument.

The term "*prima facie* case" refers only to the initial examination step. [citations omitted.] As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1991).

The examiner cannot sit mum, leaving the applicant to shoot arrows into the dark hoping to somehow hit a secret objection harbored by the examiner. The 'prima facie case' notion, the exact origin of which appears obscure, (see *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984)), seemingly was intended to leave no doubt among examiners that they must state clearly and specifically any objections (the prima facie case) to patentability, and give the applicant fair opportunity to meet those objections with evidence and argument.

Id. at 1449 (Plager, C.J., concurring).

As recognized by the Examiner in the Final Office Action, p. 13, the MPEP sets forth the minimum requirements for establishing a *prima facie* case. At the time the Final Office Action was issued the MPEP required:

(a) Statement of rejection requirements

Any time an examiner bases a rejection of a claim or the denial of the effects of a filing date of a previously filed application on the lack of a written description, the examiner should:

(1) identify the claim limitation not described; and

(2) provide reasons why persons skilled in the art at the time the application was filed would not have recognized the description of this limitation in the disclosure of the application as filed. A typical reason points out the differences between what is disclosed and what is claimed. A simple statement that "There does not appear to be a written description of the claim limitation '_____' in the application as filed" may be sufficient where the support is

not apparent and the applicant has not pointed out where the limitation is supported.

MPEP § 2163.04. Thus, at a minimum, the Examiner must identify each claim element for which the Examiner asserts inadequate written description. This requirement was approved by the Federal Circuit, which approved an updated version of the provision. Both the prior version and the updated version require, as a minimum, that the Examiner list the claim elements for which a lack of written description is being asserted:

In the context of the written description requirement, an adequate *prima facie* case must therefore sufficiently explain to the applicant what, in the examiner's view, is missing from the written description. The PTO expressed this requirement in MPEP § 2163.04(I)(B). [Footnote omitted.] We hold that 2163.04(I)(B) as written is a lawful formulation of the *prima facie* standard for lack of written description.

Hyatt v. Dudas, 2006-1171, p. 6 (Fed. Cir. 6-28-2007).

It is thus clear that the Examiner must put the Appellant on notice as to "what is missing from the written description." At a minimum, the rejection must identify the elements that are asserted to lack written description. The Board's standard that the "Examiner had a reasonable basis for questioning the written description" is not sufficient to establish a *prima facie* case is not sufficient. The Examiner must not only have a "reasonable basis" for questioning written description, he must give the Appellant adequate notice of that reasonable basis in the Office Action.

Here, the Examiner identified some dependent claims as having an inadequate description with respect to "making a product" limitations. While the Appellant does not agree with the determination that those dependent claims are not supported by an adequate written description, those "making a product" claims are not now in issue regarding the Examiner's failure to establish a *prima facie* case of written description. With respect to many other claims, the Examiner simply asserted that "applicant does not describe anywhere in the specification limitations which are recited in the claim." Neither specific claims nor specific claim limitations were identified. This was not sufficient to give the Appellant fair notice of the reasons for the rejection. The Final Office Action did not notify the Appellant of any claim limitations that lacked written

description support in claims [REDACTED]
[REDACTED]

These claims do not recite "making a product" claim limitations and thus do not recite any claim elements that were listed in the Final Rejection as having inadequate written description. Thus, the Examiner did not establish a *prima facie* case for these claims in the Final Rejection.

The Board erred when it used argument found in the Examiner's Answer to determine that the Examiner had established a *prima facie* case. Findings Of Fact (9) through (17) are all allegedly supported by the Examiner's Answer and relate to general assertions by the Examiner with respect to a *prima facie* case issue rather than arguments on the merits that discuss written description support for any particular claim elements. However, the Appellant must be given fair notice of the grounds of rejection at the initial stage of examination. After the Appeal Brief has been filed it is too late to inform the Appellant of the reasons for rejecting his claims.

The record here reveals that the application was fully prosecuted. References were cited and applied by the examiner, the applicant responded with argument, and the examiner then issued a final rejection, stating why he was not persuaded by the applicant's argument. ... We discern no irregularity in the procedure.

Oetiker at pp. 1445-6 (emphasis added). While approving this procedure, the Court emphasized the importance of establishing a *prima facie* case at the time of the initial examination of the patent application when the non-final office action is issued:

The term "*prima facie* case" refers only to the initial examination step. [citations omitted.] As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.

In re Oetiker, 977 F.2d 1443, 1445 (emphasis added):

We think that the PTO is correct in treating the concept of the *prima facie* case as of broad applicability, for it places the initial burden on the examiner, the appropriate procedure whatever the technological class of invention.

Id. at 1446 (emphasis added):

The Board's usage of the term *prima facie* was imprecise for, as discussed *supra*, the term "*prima facie* obvious" relates to the burden on the examiner at the initial stage of the examination.

Id. at 1446 (emphasis added).

This is further confirmed in *Hyatt v. Dudas* (2006-1175) where the Federal Circuit addressed "the examiner's initial rejection" (CAFC decision at page 8 (emphasis added)).

In finding that a *prima facie* case had been established the Board stated:

In summary, we find that the Examiner met the initial burden of presenting to the Applicant a showing of what was lacking in the disclosure to provide written description support for the claimed invention* and that the burden of making a proper showing of written description support properly shifted to the Applicant.

* The Examiner informed Appellant that "[t]he claims on appeal are all newly added claims with new limitations. There are no original claims remaining in the application" (Answer 6). If the Appellant had shown support in his original disclosure for each of the newly added claims when the amendments were filed, then he might have avoided a written description rejection of the claims. When the claims are unusually lengthy or complex, an [a]pplicant should . . . specifically point out the support for any amendments made to the disclosure. *M.P.E.P.* § 2163.06 (6th ed., Rev. 2, July 1996).

Board Decision, pp. 9-10. The Board thus cited directly to the Examiner's Answer to support its assertion that the Examiner had established a *prima facie* case. Even this citation did not identify particular claim limitations that allegedly lacked written description support.

The Board further erred by relying on Findings of Fact (4) and (18). Finding of Fact (4) states:

(4) The Examiner informed Appellant of specific limitations that are not found in the originally filed disclosure (Final Rejection 14 to 40);

Board Decision, p.4. While this finding cites to the Final Rejection, it is not supported by the record. As discussed previously herein, the Final Rejection discussed “making a product” claim limitations that appear in some dependent claims. However, for many claims no limitation was identified as allegedly lacking written description support.

The Board erred when it found that a request for information had been made by the Examiner. Finding of Fact (18) states:

(18) Appellant did not specifically respond to the request for a showing of the interconnections between the claimed elements.

Board Decision, p. 6. This finding does not indicate where support can be found in the record. Further, the Appellant carefully reviewed the Final Office Action and found no support for this finding therein.

The Board’s concluding statement asserted that:

In keeping with the recent *Hyatt* decision, we find that the Appellant did not properly comply with the Examiner’s request for additional information that would prove that the claims have written description support in the originally filed disclosure.

Board Decision, p. 10. As discussed above, the Examiner must establish a *prima facie* case in an Office Action prior to appeal so as to give fair notice to the Appellant. The Appellant was not given such fair notice and any reliance by Board on the alleged request was in error.

1.3 THE BOARD DECISION STATES A NEW GROUND OF REJECTION UNDER 37 CFR 41.50(B)²

Applicant requests that the Board Decision relating to written description be designated a new ground of rejection. The Board Decision erred by treating argument made by the Examiner in the Examiner's Answer as a rejection (Section 1.2). When the Final Rejection is properly treated as the only source of the Examiner's rejection, as it must be, the grounds on which the Board sustained the written description rejection are significantly different from the ground stated by the Examiner and thus constitute new grounds of rejection.

FACTS

Aside from general statements with respect to the law of written description and references to the Examiner's Answer, the Board made only two Findings Of Fact, (4) and (18), which purportedly relate to the Final Office Action. The Final Office Action is where the Examiner's rejections representing the Examiner's decision must be made. Furthermore, neither of these findings is supported by the facts in the record. The two findings state:

(4) The Examiner informed Appellant of specific limitations that are not found in the originally filed disclosure (Final Rejection 14 to 40);

(18) Appellant did not specifically respond to the request for a showing of the interconnections between the claimed elements.

Board Decision, pp. 4-6.

The Final Rejection states:

With regard to the claims, applicant does not describe anywhere in the specification limitations which are recited in the claim. The following elements are all recited in the claim but are nowhere to be found, much less described, in

² Formerly 37 C.F.R. § 1.196(b).

the descriptive portion of the specification: "act of making a product" in claims [REDACTED]
[REDACTED] all of the above mentioned claims recite making various product products, (sic) for example [REDACTED], etc.

Final Office Action, p. 14. On pages 36-40 of the Final Rejection the Examiner makes statements to the effect that certain quoted language would involve undue experimentation to implement a particular embodiment. However, the Appellant finds no identification of claim elements, other than "making a product" claim limitations occurring in dependent claims, that are asserted to have inadequate written description.

The section on written description concludes with the general allegation that:

These claim limitations are not described in the application as filed. Therefore, the requirement for an adequate written description has not been met.

Final Office Acton, p. 40. This statement does not identify any claim limitations and the Appellant has been unable to find any listed claim limitations that are alleged to have inadequate written description other than the "making a product" claim limitations discussed above.

ARGUMENT

Claims [REDACTED] do not recite "making a product" claim limitations and thus do not recite any claim elements that were listed in the Final Rejection as having inadequate written description.

The Board identified the grounds on which it was purportedly affirming the rejection of the Examiner as follows:

As indicated *supra*, claim [REDACTED] is the only claim on appeal that Appellant has read on the disclosure for a showing of written description support. We have reviewed the portions

of the drawings and the disclosure suggested by the Appellant, and we agree with the findings made by the Examiner with respect to claim [REDACTED]. The referenced portions of the drawings and Specification do not provide written description support for the functions performed by the noted system elements.

The mere fact that individual words or elements in the claims appear throughout the disclosure is not helpful to an understanding of how all of those words or elements are tied together in each of the claims on appeal. If the claimed system elements are not tied together in the manner set forth in the claims on appeal, then it does not matter how many times the individual elements of the claimed system are mentioned in the disclosure.

In summary, we find that the Examiner met the initial burden of presenting to the Appellant a showing of what was lacking in the disclosure to provide written description support for the claimed invention * and that the burden of making a proper showing of written description support properly shifted to the Appellant. In keeping with the recent *Hyatt* decision, we find that the Appellant did not properly comply with the Examiner's request for additional information that would prove that the claims have written description support in the originally filed disclosure.

* The Examiner informed Appellant that "[t]he claims on appeal are all newly added claims with new limitations. There are no original claims remaining in the application" (Answer 6). If the Appellant had shown support in his original disclosure for each of the newly added claims when the amendments were filed, then he might have avoided a written description rejection of the claims. When the claims are unusually lengthy or complex, an [a]pplicant should . . . specifically point out the support for any amendments made to the disclosure. *M.P.E.P.* § 2163.06 (6th ed., Rev. 2, July 1996).

Board Decision, pp.8-10.

It is clear that the Examiner must state a *prima facie* case for any rejection in an office action so that the Applicant can have an opportunity to respond by arguing against the rejection, presenting evidence of patentability and amending the claims if appropriate:

The *prima facie* case is a procedural tool of patent examination, allocating the burdens of going forward as between examiner and applicant. *In re Spada*, 911 F.2d 707, 707 n. 3, 15 USPQ2d 1655, 1657 n. 3 (Fed. Cir. 1990). The term “prima facie case” refers only to the initial examination step. *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. If that burden is met, the burden of coming forward with evidence or argument shifts to the applicant.

In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). The Board decision must be compared against this initial rejection by the Examiner when determining whether or not the Board has stated a new ground of rejections. This has been mandated by Congress (The Board “shall review adverse decisions of examiners”, 35 U.S.C. § 6(b).) Any other result, such as comparing the Board decision to argument made in the Examiner’s Answer during appeal would unfairly deprive the applicant of an opportunity to amend the claims or oppose the rejection with evidence of patentability.

As stated in the PTO Rules:

(a)(1) The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner.

37 C.F.R. § 41.50. The Rules thus make it clear that it is the “decision” of the examiner that must be affirmed or reversed. Argument made in the Examiner’s Answer does not constitute the “decision” of the examiner. This requirement is followed by the decisions of the Federal Circuit:

This affirmance of a nonexistent rejection violated the statutory mandate that the Board review “adverse decisions of the examiners upon applications for patents,” 35 U.S.C. § 6(b) (2000) (emphasis added) as well as the strictures of 37 C.F.R. § 1.196(a) (now 41.50(a)), which specifies that with respect to the grounds of rejection before it, the Board, in deciding the appeal, must either “affirm or reverse the *decision of the examiner . . . on the grounds and on the claims specified by the examiner*, or remand the application

to the examiner for further consideration” (emphasis in original).

In re McDaniel, 293 F.2d 1379, 1385, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002). Applicant notes that 37 C.F.R. § 41.50(b) now specifies the procedures to be followed when a new ground of rejection is raised by the Board.

When the Board decision is compared to the “decision of the examiner”, as opposed to argument made in the Examiner’s Answer, it is clear that the Board decision states new grounds of rejection.

The Board decision states at least three new grounds of rejection. The Board decision states, “We have reviewed the portions of the drawing and the disclosure suggested by the Appellant, and we agree with the findings made by the Examiner with respect to claim [REDACTED]. The referenced portions of the drawing and Specification do not provide written description support for the functions performed by the noted system elements.” The thrust and rationale of the decision contrasts sharply with the “decision” of the Examiner, which states in pertinent part:

[A]pplicant does not describe anywhere in the specification limitations which are recited in the claim.

Final Office Action, p. 14. The Examiner’s decision does not deal specifically with claim [REDACTED] and does not “note” the claim elements that were incorrectly referenced in the Board decision..

It is clear that the Board is reviewing argument made by the Examiner in the Examiner’s Answer and not the “decision” of the Final Office Action in its decision. The Board states that it agrees “with the findings made by the Examiner with respect to claim [REDACTED].” However, the “decision” in the Final Office Action made no findings with respect to claim [REDACTED]. A decision based upon findings that do not appear in the Examiner’s “decision” is clearly a new ground of rejection.

Further, the Board appears to accept that there is disclosure of the claimed elements, stating that “The mere fact that individual words and elements in the claims appear throughout the disclosure is not helpful” However, the Board does find a lack of support for the interconnections between these elements. The Board states, “[T]he

disclosure is not helpful to an understanding of how all of the words or elements are tied together in each of the claims on appeal. If the claimed system elements are not tied together in the manner set forth in the claims on appeal, then it does not matter how many times the individual elements of the claimed system are mentioned in the disclosure.” However, this determination that the interconnections between elements is not adequately disclosed is a new ground of rejection that clearly based on argument in the Examiner’s Answer, not the “decision” in the Final Office Action. See, e.g., Fact Of Fact 14 on page 5 of the Board decision which questions the interconnections, but is based upon the argument in the Examiner’s Answer, not the “decision” in the Final Office Action.

This portion of the decision appears to be based at least in part on Finding Of Fact (4) which asserts that “The Examiner informed Appellant of specific limitations that are not found in the originally filed disclosure (Final Rejection 14 to 40).” However, as discussed above, the Final Office Action asserted that certain claim limitations related to making a product did not have adequate support, but mentioned no other limitations. No limitations in the following claims were identified: [REDACTED]

[REDACTED]

[REDACTED] The Board decision clearly states a new ground of rejection with respect to these claims.

In addition, the Board decision appears to be based at least in part on the summary portion of its decision which states:

In keeping with the recent *Hyatt* decision, we find that the Appellant did not properly comply with the Examiner’s request for additional information that would prove that the claims have written description support in the originally filed disclosure.

Board Decision, p. 10. This portion of the Board decision is apparently responsive to Findings Of Fact (18) stating that “Appellant did not specifically respond to the request for a showing of the interconnections between the claimed elements.” The purported source of Finding (18) is not identified, but the source of the request is presumably the Examiner’s Answer, not the “decision” provided by the Final Office Action. Neither a request for information nor a determination that a request for information had not been complied with were included in the “decision” of the Final Office Action that was under

review by the Board. This determination that a request for information was not complied with is clearly a new ground of rejection.

The Board decision states new grounds of rejection with respect to all claims and particularly with respect to the claims that do not recite the "making a product" claim limitations discussed above. The Appellant requests that these rejections be properly designated new grounds of rejection so that the Appellant will have a fair opportunity to respond with argument, evidence or claim amendments as appropriate.

1.3.1 The Board Should Be Consistent With Its Established Position In Denominating Rejections

The Decision relies on new grounds of rejection (discussed in detail herein). Hence, the Board should afford the Appellant his rights under 37 CFR 41.50(b) by denominating the rejections as new grounds of rejection. This is not only an equitable issue, but the Board has denominated rejections in many other cases for **much lesser reasons** which necessitates denominating the rejections here for consistency as well as equity.

The MPEP characterizes a first request for rehearing as an entitlement (MPEP 1214.03) (emphasis added):

The term 'rehearing' is used in 37 CFR 1.197(b) for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that **an appellant is entitled** to an oral hearing on the request for rehearing, but **only to a rehearing** on the written record.

In *Hanson*,³ the Board's reasons only differed "somewhat" from the examiner's reasons:

While we are affirming under § 112, second paragraph, the reasons for which we do so **differ somewhat** from those of the examiner. Accordingly, we denominate our affirmance as a new ground of rejection under 37 CFR § 1.196 (b).

(emphasis added). In *Rodgers*,⁴ the former-Chief Judge Stoner denominated an affirmed written description rejection because it was "different in thrust":

³ *Ex parte Hanson*, Appeal No. 94-3255 (Bd. Pat. App. & Int. 1998) (unpublished).

Recognizing that our basis for sustaining the rejection of claim 21 is different in thrust than that stated by the examiner, we shall denominate the same a new ground of rejection pursuant to the provisions of 37 CFR 1.196(b)."

(emphasis added). In *Tytgat*,⁵ the Board denominated the rejection because it "may have been" a different rationale:

Since we have developed what we think may have been a rationale different from the examiner, we choose to designate our affirmance as a new ground of rejection under 37 CFR § 1.196(b).

(emphasis added). In *Deuel*,⁶ the Board denominated the rejection because it "may have changed the basic thrust of the examiner's rejection":

Although we have affirmed the examiner's rejection, our reasoning may have changed the basic thrust of the examiner's rejection. Accordingly, we designate this affirmance a new ground of rejection pursuant to 37 CFR 1.196 (b) –

(emphasis added). In *Rohrer*,⁷ the Board denominated the rejection because new reasons were applied to the rejection:

... Appellants further request that we designate our position with respect to claim 36 to be a new ground of rejection, thereby affording appellants the right to amend the claim pursuant to 37 CFR 1.196.

We shall grant appellants' request to the extent that we shall designate our affirmance of the rejection of claim 36 to be a new ground of rejection subject to the provisions of 37 CFR 1.196(b) Inasmuch as our affirmance of the rejection was based upon the reasons specifically applied previously only to claims 33-35, we grant appellants' request to the extent indicated.

In *Stern*,⁸ the Board denominated the rejection new ground and construed the submission of new evidence by the appellant as an election to proceed before the examiner:

⁴ *Ex parte Rodgers*, 27 USPQ2d 1738 at 1743-44 (Bd. Pat. App. & Int. 1992).

⁵ *Ex parte Tytgat*, 225 USPQ 907 (Bd. Pat. App. & Int. 1985).

⁶ *Ex parte Deuel*, 27 USPQ2d 1360 (Bd. Pat. App. & Int. 1993).

⁷ *Ex parte Rohrer*, 20 USPQ2d 1460 (Bd. Pat. App. & Int. 1990).

⁸ *Ex parte Stern*, 13 USPQ2d 1379 (Bd. Pat. App. & Int. 1989).

We hereby designate our affirmance of the examiner's rejection under 35 U.S.C. 103 as a new ground of rejection pursuant to the provisions of 37 CFR 1.196(b) so that appellant may be afforded the procedural safeguards of that rule which include the option of submitting additional evidence and have the new rejection considered by the examiner or having the new rejection reconsidered by the Board of Patent Appeals and Interferences on the existing record. Inasmuch as appellant has submitted new objective evidence in the form of a declaration, we construe appellant's response as an election to proceed before the examiner. Accordingly, this case is forwarded to the examiner.

1.3.2 The Law Of The Federal Circuit And The CCPA Necessitates Denominating The Instant Written Description Rejection As A New Ground Of Rejection

The Federal Circuit indicates that a Decision that does more than just affirming or reversing the examiner requires a remand to the examiner:

[W]ith respect to the grounds of rejection before it, the Board, in deciding the appeal, must either affirm or reverse the decision of the examiner ... on the grounds and on the claims specified by the examiner, or remand the application to the examiner for further consideration.

In re McDaniel, 293 F.2d 1379, 1385, 63 USPQ2d 1462, 1466 (Fed. Cir. 2002).

The Federal Circuit and the CCPA confirm that an appellant, as here, is entitled to respond to a new position or rationale:

Where the board makes a decision advancing a position or rationale new to the proceedings, an applicant must be afforded an opportunity to respond to that position or rationale by submission of contradicting evidence. In re Eynde, 480 F.2d 1364, 178 USPQ 470 (CCPA 1973). Accordingly, if the board or the examiner in this case had stated that there was no objective evidence, appellants would have been **entitled** to respond by filing such evidence.

In re De Blauwe, 222 USPQ 191, 197 n.9 (Fed. Cir. 1984) (emphasis added):

We do agree with appellants that where the board advances a position or rationale new to the proceedings, as it is empowered to do and quite capable of doing, the appellant

must be afforded an opportunity to respond to that position or rationale by the submission of contradicting evidence. This court so held in In re Moore, *supra*, and we expressly reaffirm that view. The board's refusal to consider evidence which responds to such a new rationale is error.

In re Eynde, 178 USPQ 470, 475 (CCPA 1973) (emphasis added):

Again we are confronted with a set of circumstances which occurs too frequently in Patent Office appeals. In its review of the examiner's decision in this case, as noted above, the board made a ruling based not upon the facts of record which it had before it, but rather on a finding of a new fact. We recognize the right of the board, under the statute and rules, to make additional findings. We also acknowledge the technical expertise of the individual members of the board in making findings of technical fact based upon their own knowledge and experience. We have consistently sought to give weight to such findings where they do not appear unreasonable on their face and are not challenged by the applicant.

A finding such as was made here, however, supporting as it does an alternative ground for sustaining the examiner's rejection, and apparently based on nothing more than a bare allegation of scientific fact, does everything but cry out for an opportunity to respond. Appellant here did respond, and challenged the board's assertion with an allegation of his own to the contrary. He supported his assertion with the affidavit opinion of an acknowledged expert in the art. Encouraged and misled, perhaps, by some language in earlier opinions of this court, the board gave little consideration to appellant's assertion. This we feel was wrong. Appellant's response here was more than mere 'argument'. It was a direct challenge to a finding of fact made for the first time by the board and included with it some evidence in the nature of rebuttal. Under the circumstances, it was entitled to more serious consideration. We shall so treat it.

In re Moore, 170 USPQ 260, 263 (CCPA 1971).

1.3.3 Denominating The Instant Written Description Rejection As A New Ground Of Rejection Is Necessary For The Additional Reason That, As In Raychem, "The Patent Owner's Ability To Refile Is Non-Existent"

In Raychem,⁹ the Board denominated the rejection "since the patent owner's ability to refile is non-existent" (emphasis added):

Inasmuch as we have placed substantial reliance upon Richart and Smith-Johannsen in addition to the Bedard, Griff and Gale references relied upon by the examiner, and **since the patent owner's ability to refile is non-existent** in a reexamination proceeding, we denominate our affirmance of the examiner's rejection as a new ground of rejection under 37 CFR 1.196(b) in order to provide the patent owner with a full and fair opportunity to respond.

Similarly, in the instant application, the Appellant's "ability to refile is non-existent".

This is because [REDACTED]

[REDACTED] Thus, the instant decision should be denominated as a new ground of rejection.

⁹ *Ex parte Raychem*, 1990 Pat. App. Lexis 12 at *36 (Bd. App. & Int.; July 20, 1990; as corrected by Erratum Aug. 22, 1990).

¹⁰ The General Agreement On Tariffs and Trade (GATT).

1.4 THE WRITTEN DESCRIPTION REJECTION SHOULD BE REVERSED BECAUSE NEITHER THE FINAL OFFICE ACTION NOR THE BOARD DECISION PROPERLY GROUPED THE CLAIMS

Both the Final Office Action and the Board erred by improperly grouping the claims because they failed to consider the claims in proper groupings that have “no patentable consequence” among the claims in a group. *In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002). See Appeal Brief, p. [REDACTED]. In the context of a written description rejection this means that each claim limitation that is challenged must form a different claim group, *Hyatt v. Dudas*, pp. 17-18, CA 04-1802, 04-1138, 04-1139, 05-0310 (HHK) (D.C. 8-30-2006).

1.4.1 The Final Office Action Failed to Properly Group the Claims

Paragraphs 7, 9, 10 and 12 of the Final Office Action related to a rejection for lack of written description. Paragraphs 7, 9 and 10 rejected a group of dependent claims for lack of written description support for “making a product” claim limitations. Paragraph 12 rejected all claims for lack of written description (p. 9), but separately identified and rejected groups of claims that recite “making a product” or recite making one of several specifically defined products, with [REDACTED] being specifically identified, p. 14. The “making a product” claims are listed, but the claims reciting specific products are not separately identified. With respect to the other claims the only guidance given for the alleged lack of written description is that “applicant does not describe nor disclose anywhere in the specification limitations which are recited in the claims”.

The Final Office Action thus effectively divides the claims into multiple groups for the written description rejection, with the groups including the claims that recite “making a product” claim limitations, the claims that recite making a specific product, and the claims that do not recited “making a product”. No claim element is identified as insufficiently disclosed among the claims that do not recite “making a product” or making a specific product. This failure to identify claim elements that are alleged to be

inadequately described fails to comply with MPEP § 2163.04, which requires at a minimum that each challenged claim limitation be specifically identified. Had the Final Office Action followed the normal practice of the PTO and complied with this requirement to identify specific claim limitations, the claims could have been grouped on a limitation by limitation basis and, as a consequence, the *McDaniel* requirement that the distinctions among the claims in a group be of “no patentable consequence” would have been satisfied. However, by failing to comply with MPEP § 2163.04, the Final Office Action also failed to comply with the “no patentable consequence” *McDaniel* requirement. Because the claims were not properly grouped by the Final Office Action in groups of claims having “no patentable consequence,” the written description rejections should be reversed.

1.4.2 The Board Decision Failed to Properly Group the Claims

The Board Decision erred by failing to properly group the claims. The Board decision failed to even adhere to the partial grouping provided in the Final Office Action. The Final Office Action separately discussed and identified the claims reciting a “making a product” limitation. However, the Board decision on written description did not separately consider these “making a product” claims.

Without discussing the disclosure or giving any reason why the disclosure was deficient, the Board stated, upon review of the specification “we found a lack of critical components and features as well as “interconnections” between such claimed features and critical components. This general statement appears to apply to all claims grouped together regardless of the particular claim limitations that are recited in each different claim. Neither the critical components and features nor the interconnections are identified by the Final Office Action or by the Board.

The Board Decision did separately discuss claim [REDACTED] in very general terms, stating,

We have reviewed the portions of the drawings and the disclosure suggested by the Appellant, and we agree with the findings made by the Examiner with respect to claim

111. The referenced portions of the drawings and Specification do not provide written description support for the functions performed by the noted system elements.

Board Decision, p. 9. However, the Final Office Action did not even discuss the different limitations of claim [REDACTED] let alone make findings with respect to claims [REDACTED] or note any system elements of claim [REDACTED]. Since the Board Decision does not mention other claims, it has apparently grouped all of the claims together with claim [REDACTED] even though other claims have different limitations than the limitations in claim [REDACTED]. This grouping together of claims with different limitations that have different patentable consequences is improper. See *In re McDaniel*, 293 F.3d 1379, 1383 (Fed. Cir. 2002). The Board should reconsider its decision in view of *In re McDaniel* and *Hyatt v. Dudas* and separately evaluate each different claim limitation with the claims being grouped on a claim limitation basis such that the differences in claim recitations within a group have no patentable consequence.

1.4.3 The Board Failed To Review The Adverse Decision Of The Examiner As Required By 35 U.S.C. § 6(B)

By changing the limited claim groupings employed by the Examiner, the Board Decision misapprehended or overlooked the requirement to review adverse decisions of examiners, 35 U.S.C. § 6(b). The Final Office Action separately discussed and identified the claims reciting a “making a product” limitation as well as limitations reciting making specific products. However, the Board Decision on written description did not separately consider these “making a product” or specific product claims. Instead, the Board Decision singled out claim [REDACTED] which had not been separately considered by the Examiner, stating:

We have reviewed the portions of the drawings and the disclosure suggested by the Appellant, and we agree with the findings made by the Examiner with respect to claim [REDACTED]. The referenced portions of the drawings and Specification do not provide written description support for the functions performed by the noted system elements.

Board Decision at 9.

As stated by the Federal Circuit:

37 C.F.R. § 1.192(c)(7) does not give the Board carte blanche to ignore the distinctions between separate grounds of rejection and to select the broadest claim rejected on one ground as a representative of a separate group of claims subject to a different ground of rejection. The applicant has the right to have each of the grounds of rejection relied on by the Examiner reviewed independently by the Board under 35 U.S.C. § 6(b) (providing that “[t]he Board of Patent Appeals and Interferences shall . . . review *adverse decisions of examiners* upon applications for patents”) (emphasis added). Simplification and expedition of appeals cannot justify the Board’s conflating separately stated grounds of rejection by selecting, for the purpose of deciding an appeal as to one ground of rejection, a representative claim which is not itself subject to that ground of rejection.

In re McDaniel, 293 F.3d 1379, 1384 (Fed. Cir. 2002) (emphasis in original). By basing its decision upon claim [REDACTED] and the “noted system elements”, which had not been considered by the Examiner in the Final Office Action where the *prima facie* case is required to be made, the Board rendered a new decision rather than review the decision of the examiner. Further by grouping claim [REDACTED] with the “making a product” claims and “specific” product claim that were separately considered by the Examiner, the Board Decision failed to review the adverse decision of the Examiner.

**1.5 THE WRITTEN DESCRIPTION REJECTION SHOULD BE REVERSED
BECAUSE THE CLAIMS HAVE ADEQUATE WRITTEN DESCRIPTION
SUPPORT**

The Board misapprehended or overlooked the extensive showing of written description support provided in the Appeal Brief and Reply Brief. For example, see Appeal Brief pp. [REDACTED] and Reply Brief pp. [REDACTED]. The Board apparently overlooked this extensive discussion of the disclosure as it concluded,

The mere fact that individual words or elements in the claim appear throughout the disclosure is not helpful to an understanding of how all of those words or elements are tied together in each of the claims on appeal. If the claimed system elements are not tied together in the manner set forth in the claims on appeal, then it does not matter how many times the individual elements are mentioned in the disclosure.

Board Decision, p. 9 (emphasis in original).

However, the Appellant went beyond showing how many times a claim element appears in the specification. He provided a reading of claim [REDACTED] on the disclosure at pages 9-10 of the Appeal Brief. The Reply Brief responded to the new arguments in the Examiner's Answer by providing discussions of individual claim terms with a complete section for each claim term. For example, sections are devoted to [REDACTED] as well as many additional terms that are used in the claims. These separate sections discussing important terms used in the claims are provided at pages [REDACTED]. Reconsideration of the determination that the claims do not have written description support in the specification is respectfully requested.

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see pp. 28:1-2, 29:1, 3, 11, 14 and 17 and 32:10-13). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for filtering (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see pp. 15:15-22:1). The Reply Brief responded with an entire

Section [REDACTED] explaining how the specification provides written description for data compression (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see pp. 27:22-28:1). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for correlation (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see p. 61:6-9). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for displaying (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see pp. 15:3-10 and 31:21-22). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for communication, including transmitting and receiving (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see p. 27:17-18 and 31:21-22). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for radio frequency (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see p. 46:6-20). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for signature modulating and signature demodulating (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see pp. 46:6-20). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for telephone (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] operations in the Examiner's Answer (see pp. 27:17-18, 30:4, 46:13-20 and 47:12-15). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for data link operations (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see p. 33:19-22). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for displaying (see pp. [REDACTED]).

For the first time the Examiner questioned the disclosure of [REDACTED] in the Examiner's Answer (see p. 33:19-22). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for time-of-arrival operations (see pp. [REDACTED]).

The Examiner amplified his rejection asserting inadequate written description for making a product in the Examiner's Answer (see p. 34:5-36-10). The Reply Brief responded with an entire Section [REDACTED] explaining how the specification provides written description for product operations (see pp. [REDACTED]).

1.6 PRIOR DECISIONS FINDING WRITTEN DESCRIPTION SUPPORT FOR CERTAIN CLAIM ELEMENTS SHOULD BE GIVEN CONSIDERATION IN THE PRESENT APPEAL

The Board has apparently overlooked the fact that prior Board decisions have found literal written description support for claim elements appearing in the specification and listed in a Table of Terminology Occurrences. See Appeal Brief, pp. [REDACTED]. The Appellant is aware that prior decisions are not dispositive of written description issues in the present appeal. However, consistent application of the law would suggest that prior decisions finding written description support should be given serious consideration by the Board.

One example where the PTO Board of Appeals has found written description support in a related copending application is [REDACTED], where the Board stated,

In response, appellant argued (brief, page 21) that the examiner has ignored "the numerous recitations in the specification regarding the subject terminology (See, e.g., the Table Of Terminology Occurrences; see also (Section 8.1.9)." In Section [REDACTED] (brief, page [REDACTED]), each of the claimed elements is listed along with the number of times the element is recited in the disclosure.

We agree with the appellant's argument (brief, page [REDACTED]) that the listing in Section [REDACTED] of the brief provides literal written description support for each of the individual elements, however, we do not agree with the appellant that such a listing provides written description support for the claimed interconnections between the elements, and the claimed functions performed by the interconnected elements.

Ex parte [REDACTED] Board Decision dated [REDACTED] Docket No. [REDACTED] Serial No. [REDACTED]; Appeal No. [REDACTED] at pages 7-8 (emphasis added).¹¹ Thus, for similar reasons, the disclosure in the instant application "provides literal written description support for each of the individual elements". Although this determination does not include "interconnections between elements," "the examiner's initial rejection" (emphasis

¹¹ See also the Board Decision dated [REDACTED] Docket No. [REDACTED] Serial No. [REDACTED] Appeal No. [REDACTED] at pages [REDACTED] and the Board Decision dated [REDACTED] Docket No. [REDACTED] Serial No. [REDACTED] Appeal No. [REDACTED] at pages [REDACTED].

added) does not establish a *prima facie* case of lack of written description regarding “interconnections between elements.” The requirement for this issue must be presented in the initial rejection is set forth in the decision of the Federal Circuit as quoted by the Board in the instant decision at page 6. *See also* Section 1.2 herein.

Further, the MPEP confirms that “[s]oftware aspects of inventions may be described functionally”:¹²

The claimed invention subject matter need not be described literally, i.e., using the same terms, in order for the disclosure to satisfy the description requirement. Software aspects of inventions may be described functionally. See *Robotic Vision Sys. v. View Eng'g, Inc.*, 112 F.3d 1163, 1166, 42 USPQ2d 1619, 1622-23 (Fed. Cir. 1997); *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997); *In re Hayes Microcomputer Prods., Inc.*, 982 F.2d 1527, 1537-38, 25 USPQ2d 1241, 1248-49 (Fed. Cir. 1992).

Hence, the claimed elements and functions that are literally disclosed and that relate to software aspects of the inventions should satisfy the written description requirements for all of the software features of the claims including the interconnections.

It is thus requested that the Board remain consistent with prior decisions and acknowledge literal written description of the claim elements set forth in the Table of Terminology Occurrences, Appeal Brief, pp. [REDACTED].

¹² MPEP 2106, in discussing compliance with the written description requirement at B.1. (pp. 2100-20; Revision 2, May 2004).

Serial No. [REDACTED]

CERTIFICATION OF MAILING BY EXPRESS MAIL: I hereby certify that this correspondence is being deposited with the United States Postal Service with Express Mail post office to addressee service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 with the express mail label number [REDACTED] on September 19, 2007.

Respectfully submitted,

Dated: September 19, 2007

[REDACTED]