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THE INVENTION SCIENCE FUND CLARENCE T. TEGREENE 11235 SE 6TH STREET SUITE 200 BELLEVUE, WA 98004			RAJ, RAJIV J	
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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte EDWARD K.Y. JUNG, ROYCE A. LEVIEN,
ROBERT W. LORD, MARK A. MALAMUD, JOHN D. RINALDO, JR.,
and LOWELL L. WOOD, JR.

Appeal 2011-004103
Application 11/478,341
Technology Center 3600

Before JOSEPH A. FISCHETTI, MICHAEL W. KIM, and
NINA L. MEDLOCK, *Administrative Patent Judges*.

MEDLOCK, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellants filed a Request for Rehearing/Reconsideration (“Request”) dated December 5, 2012, of our Decision, mailed October 5, 2012, (“Decision”), in which we affirmed the Examiner’s rejections of claims 1,4, 6-8, 10, 12-16, 19-22, 24-25, 27, 28, 33-34, 38, 40, 86, and 87 under 35 U.S.C. § 103(a). Appellants request that the Board read Appellants’ Appeal Brief as consistent with the notice theory announced in *In re Jung*, 637 F.3d 1356 (Fed. Cir. 2011) or that the Board, alternatively, grant Appellants leave to file a revised Appeal Brief (Request 3). We have jurisdiction over the Request under 35 U.S.C. § 6(b).

DISCUSSION

Requests for rehearing must comply with 37 C.F.R. § 41.52(a)(1), and “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” In this regard, requests must specifically recite the points of law or fact which the appellant believes were overlooked or misapprehended. A new argument also may be presented “based upon a recent relevant decision of either the Board or a Federal Court.” 37 C.F.R. §§ 41.52(a)(2).

Appellants assert in the Request that, under the “newly-announced notice-theory of the *prima facie* case of *In re Jung*,” the Appeal Brief may be read “as an demonstration that [Appellants have] affirmatively carried the burden of demonstrating that the claims are patentable over the examiner-cited art” such that the Board should hold that all pending claims are allowable (Request 3-4). However, Appellants do not identify with particularity any matter that allegedly was misapprehended or overlooked by

the Board in rendering the Decision. Instead, the Request merely sets forth Appellants' general disagreement with the Decision, including whether the Examiner established a prima facie case of obviousness, and, if so, whether the prima facie case has been rebutted.

In *In re Jung*, the Federal Circuit held that, during prosecution, an examiner is governed by 35 U.S.C. § 132, which requires notification to an applicant of the reasons for a rejection with "such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application." *In re Jung*, 637 F.3d at 1362 (quoting *Chester v. Miller*, 906 F.2d 1574, 1578 (1990)). However, the court made clear that section 132 does not mandate that in order to make a prima facie case, an examiner must make an on-the-record claim construction of every term in every rejected claim or explain every possible difference between the prior art and the claimed invention. *Id.* at 1363. Instead, that statute only requires that "an applicant at least be informed of the broad statutory basis for the rejection of his claims, so that he may determine what the issues are on which he can or should produce evidence." *Id.*

Here, the Examiner provided a detailed description of the findings and rationales that were the bases for the rejections, including pinpoint citations for each claim limitation and rationale for modifying references, as set forth on pages 4-19 of the Examiner's Answer. We found that the Examiner established a prima facie case of obviousness (*see, e.g.*, Decision 4-6), which also is fully consistent with the Federal Circuit's reaffirmation in *Jung* that the procedural burden of establishing a prima facie case of obviousness is met by stating the reasons for a rejection together with information and references that will be useful to the applicant in judging the propriety of

continued prosecution. *See In re Jung*, 637 F.3d at 1362. Therefore, the burden properly shifted to Appellants to rebut the prima facie case. *See, e.g., In re Dillon*, 919 F.2d 688, 692 (Fed. Cir. 1990).

Appellants argue in the Request that the Examiner failed to provide “objectively verifiable” evidence to support the Examiner’s assertions regarding what the combination of references teaches or suggests (*see, e.g.*, Request 13-17 and Decision 8 and 9). In fact, the Answer fully informed Appellants regarding the reasoning underlying the obviousness conclusion, and identified “objectively-verifiable evidence” for support, i.e., the cited portions of the Abrams, Edelson, and Goetz references themselves. For example, page 21 of the Answer reads:

Abrams [0002] states “packaging of pharmaceuticals and drugs” which is an example of disclosing “*packaging the two or more . . . agents . . .*” Further Claim 24 [of Abrams] lists nutraceutical agents (i.e. potassium, calcium, ACE inhibitor, etc.) that are packaged prescribed pharmaceuticals (*pharmaceutical are prescriptions that are issued to individuals in response to the individuals parameters) thus disclosing the following claim language: “*nutraceutical agents in response to at least one of the one more parameters associated with the individual.*”

Here, not only has the Examiner provided pinpoint citations to Abrams, but the Examiner also has shown how quotations from those pinpoint citations correspond to specific claim language. Based on this and other detailed analysis by the Examiner, the Decision agreed with the Examiner’s findings and rationales, and agreed that Appellants did not meet the burden of persuasion to overcome the prima facie case.

Appellants may well disagree with how the Examiner interpreted and applied the references, but Appellants offer no substantive argument in the

Request nor identify with particularity any findings by the Examiner that were unreasonable or unsupported or any matter that was misapprehended or overlooked by the Board.

Appellants request that the Board read Appellants' Appeal Brief as consistent with the notice theory announced in *In re Jung*. However, we find nothing in *Jung* that gives applicants the right to procedurally challenge a prima facie showing without substantively responding to the merits of the rejection. In fact, just the opposite is true. *See Jung*, 627 F.3d at 1363 (characterizing such a procedure as "manifestly inefficient and entirely unnecessary"). The Federal Circuit in *Jung* also noted, with approval, the Board's long-standing practice of requiring an applicant to identify the alleged error in an examiner's rejections. *See Jung*, 627 F.3d at 1365.

Appellants' Request fails to "state with particularity the points believed to have been misapprehended or overlooked by the Board," as required by 37 C.F.R. § 41.52(a)(1). Therefore, we decline to modify our original Decision.

DECISION

Appellants' Request has been granted to the extent that we have reconsidered our Decision in light of Appellants' Request, but is denied in all other respects.

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

DENIED

Appeal 2011-004103
Application 11/478,341

JRG