

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARTIN T. MOORE, SHILAD W. SEN, WERNER GEYER,
MICHAEL MULLER, and MICHAEL CHI HUNG WU

Appeal 2012-008578
Application 11/617,114
Technology Center 2400

Before CARL W. WHITEHEAD JR., BRUCE R. WINSOR, and
JESSICA C. KAISER, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered December 17, 2014 (“Decision”), which affirmed the Examiner’s rejections for anticipation, obviousness, and non-statutory subject matter. A request for rehearing “must state with particularity the points [of law or fact] believed to have been misapprehended or overlooked by the Board,” and must comply with 37 C.F.R. § 41.52(a)(1).

We have reconsidered the Decision in light of Appellants’ arguments, but we decline to change the Decision.

DISCUSSION

Appellants' request for rehearing is limited to our affirmance of the Examiner's § 101 rejection of claims 12 and 14–19 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. (Req. Reh'g 3.) Specifically, Appellants contend that we misapprehended or overlooked our obligation to review claims 12 and 14–19 as amended to recite a “storage medium.” (*Id.* 3–5.)

This issue was fully addressed in our Decision. (Decision 3.) To reiterate our position, the claims as amended have not been examined or rejected. (*Id.* (citing Ans. 12).) Because in *ex parte* appeals, we review rejections made by patent examiners, *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001), we declined to review the claims as amended in the first instance. (*Id.*)

Appellant contends that 37 C.F.R. § 41.50(a)(1) requires us to address the amended claims. (Req. Reh'g 3.) That provision states:

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. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed. The Board may also remand an application to the examiner.

37 C.F.R. § 41.50(a)(1) (2012) (emphasis added). We disagree with Appellants because nothing in this provision requires us to review claims for which no rejection has yet been made. *See Ex Parte Frye*, 94 USPQ2d 1072, 1077 (BPAI 2010) (precedential) (“[T]he Board’s primary role is to

review adverse decisions of examiners including the findings and conclusions made by the examiner.”).

Appellants next contend that the Examiner necessarily rejected the amended claims by proceeding with an Answer, rather than re-opening prosecution. (Req. Reh’g 4.) We disagree. In the Answer, the Examiner explicitly stated the amended claims “have not to date been examined or rejected as amended and are thus new arguments that are being made for the first time by the Appellant for a non-existent rejection.” (Ans. 12.) The Examiner then addressed the claims as rejected (prior to the amendment), which recited a “computer usable medium,” but did not substantively address the amended claims. (*Id.*) Thus, we conclude that the Examiner’s Answer did not reject the amended claims. We also note that the Examiner’s failure to address the amended claims in the Answer or by re-opening prosecution is a petitionable matter, not appealable to this Board. *See* 37 C.F.R. §§ 1.181-183; *see also* MPEP §§ 1002 (8th Ed., Rev. 8, July 2010).

Finally, Appellants contend that footnote 1 on page 3 of the Decision should be designated as a new ground of rejection. (Req. Reh’g 5.) That footnote, however, explicitly stated “we do not review whether claims 12 and 14–19 as amended on August 29, 2011 are unpatentable under 35 U.S.C. § 101.” (Decision 3 n.1.) Our observation that the *Mewherter* case had been decided after docketing of this appeal (*id.*) was for informative purposes and was not a new ground of rejection. We note, for example, we made no findings and drew no conclusions regarding the construction of “computer usable storage medium” in light of the Appellants’ Specification (*id.*).

SUMMARY

We have *granted* Appellants' request for rehearing to the extent that we have reconsidered our decision entered December 17, 2014. Appellants have not shown that we misapprehended or overlooked any issue of law or fact in declining to review in the first instance whether amended claims 12 and 14–19 recite patent eligible subject matter under § 101. Accordingly, the request is *denied* in that we decline to make any change in our decision.

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

REHEARING DENIED

msc