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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* STEFAN KREILING,  
RAINER SCHOENFELD, ANDREAS TADEN, MICHAEL KUX,  
HARALDI KUSTER, and STANELY L. LEHMANN

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Appeal 2014-005850  
Application 12/765,973  
Technology Center 1700

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Before CHUNG K. PAK, GEORGE C. BEST, and  
CHRISTOPHER C. KENNEDY, *Administrative Patent Judges*.

BEST, *Administrative Patent Judge*.

Appellants<sup>1</sup> request rehearing of their appeal and reconsideration of our Opinion of January 30, 2017. *See Ex parte Kreiling*, Appeal No. 2014-005850, slip op. (PTAB Jan. 30, 2017) (available at <http://bit.ly/2qvAyF6>). In that Opinion, we sustained the Examiner's obviousness rejections of claims 1–7, 9, 10, and 14 of the '973 Application.

For the reasons set forth below, we grant Appellants' Request in that we have reconsidered the issues addressed in the Opinion. After reconsideration, however, we continue to affirm the Examiner's rejection of

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<sup>1</sup> Henkel AG & Co. KGaA is identified as the real party in interest. Appeal Br. 3.

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claims 1–7, 9, 10, and 14 of the '973 Application. Substantively, therefore, we *deny* Appellants' request.

#### REQUEST FOR EXPANDED PANEL

We begin by addressing a preliminary matter. Appellants seek to have their Request considered by an expanded panel of the Board. Req. 1. Appellants argue that an expanded panel is desirable because the Request raises an issue of first impression. *Id.*

Appellants' request for an expanded panel was referred to the Chief Judge for his consideration. The Chief Judge has *denied* Appellants' request.

#### DECISION ON REQUEST FOR REHEARING

On July 17, 2013, the Examiner issued the Final Action in the '973 Application. In the Final Action, the Examiner rejected claims 1–7, 9, 10, and 14 as anticipated by Li or Lehmann. Final Act. 3, 6. In the alternative, the Examiner concluded that these claims were unpatentably obvious over either Li or Lehmann. *Id.* at 3–6.

Appellants filed their Appeal Brief. In their Appeal Brief, Appellants argued that the Examiner had not set forth the required reasoning with a rational underpinning to support the Examiner's alternative conclusion that claims 1–7, and 9, 10, and 14 were unpatentably obvious over Li or Lehmann. *See* Appeal Br. 8 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

The Examiner responded to Appellants' arguments by, *inter alia*, providing the sort of a reasoned basis for the obviousness rejection that Appellants had argued was missing from the Final Action. Answer at 12.

Appellants filed their Reply Brief. In the Reply Brief, Appellants argued that the Examiner's new explanation of the obviousness rejections was an improper undesignated new ground of rejection and should be disregarded by the Board as untimely. Reply Br. 1–4 (citing *Ex parte Yudoovsky*, Appeal No. 2011-006238, slip op. at 5 n.3 (BPAI Feb. 16, 2012) (available at <http://bit.ly/2j6diIL>); *Ex parte Haalck*, Appeal No. 2010-002620 slip op. at 3–4 (BPAI July 14, 2010) (available at <http://bit.ly/2iWHvPe>)). Appellants also argued that the Examiner's inclusion of a new ground of rejection in the Examiner's Answer was an admission that the obviousness rejections set forth in the Final Action were fatally flawed and should be reversed. *Id.* at 4. Appellants, therefore, argued for a *per se* rule: When a panel determines that an examiner has included an undesignated new ground of rejection in the Answer, the new ground of rejection should be disregarded as untimely and the appealed rejection set forth in the office action should be reversed.

On January 30, 2017, we issued our Opinion. In the Opinion, we reversed the Examiner's rejection of claims 1–7, 9, 10, and 14 as anticipated by either Li or Lehmann. Op. 5, 8. We also denied Appellants' request that we determine that the Examiner had included an undesignated new ground of rejection by concluding that these claims were obvious over Li and Lehmann. *Id.* at 7, 8. In so doing, we declined Appellants' invitation to create a *per se* rule that including such new grounds is an admission that the rejection is set forth in the Final Action is reversibly inadequate. *Id.* at 6–7. Finally we affirmed the Examiner's rejection of claims 1–7, 9, 10, and 14 as unpatentably obvious over either Li or Lehmann. *Id.* at 7, 8.

Appellants now seek reconsideration of the Opinion. In a request for rehearing, an Appellant is charged with stating the points believed to have been misapprehended or overlooked by the Board. 37 C.F.R. § 41.52. We review the points of the Opinion contested by Appellants and determine whether we, in fact, made an error in fact finding or applying the law, and further determine whether any error changes the outcome of the Opinion when viewing all the evidence and arguments anew in light of the preponderance of the evidence standard. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (“patentability is determined on the totality of the record, by a preponderance of evidence with due consideration to persuasiveness of argument”); *cf. Gardner v. TEC Sys., Inc.*, 725 F. 2d 1338, 1344 (Fed. Cir. 1984) (any error concerning nonessential facts is harmless and not a basis for reversal).

Appellants argue that our Opinion should be reconsidered because (1) we misapplied 37 C.F.R. § 41.40(a) and, in doing so, violated the policy set forth in 37 C.F.R. § 41.1(b), Req. 4–7; (2) our Opinion results in consideration of issues not joined by the Examiner and Appellants *id.* at 7; and (3) our Opinion misapprehended or overlooked Appellants’ arguments on the merits, *id.* at 8–12.

## I

Appellants’ first argument for reconsideration is that we applied 37 C.F.R. § 41.40(a) in a manner inconsistent with the policy set forth in 37 C.F.R. § 41.1(b). Req. 4–6. Req. 2–4. In particular, Appellants argue that

The Board’s interpretation of Rule 41.40(a) on the present facts does not provide for the “just, speedy, and inexpensive resolution” of this appeal as required by

Rule 41.1(b). The Board's requirement of the filing of a petition under Rule 1.181 is not only meaningless under the present circumstances, but contrary to the plain language of the rule. Had Appellants proceeded down the path suggested by the Board, they would have run the risk of being criticized for not following the rules['] dictates, [which] would have resulted in Appellants spending its resources to prepare and file the petition, and would have suffered the attendant delay of decision of the petition. The Office would also have needlessly spent its resources to consider and decide the petition. Such needless expense of resources and time on the part both of Appellants and the Office is not in accordance with the just, speedy, and inexpensive resolution of this appeal and certainly not what the rule states or contemplates.

Req. 5.

Appellants' argument is based upon a misunderstanding of the Opinion. As provided in the Board's rules, when an examiner's answer includes new arguments and/or new findings of fact sufficient to amount to an undesignated new ground of rejection, an appellant has two options. First, if the appellant wants to submit either a claim amendment and/or new evidence, the appellant must petition under 37 C.F.R. § 1.181 to have the answer designated as containing a new ground of rejection. Once the answer is so designated, the appellant may reopen prosecution in order to submit the claim amendments and/or new evidence. Second, if the appellant does not wish to submit claim amendments or new evidence, the appellant should address the examiner's new arguments and/or findings of fact in the Reply Brief. *See* 37 CFR 41.39(b)(2). Nothing in our opinion contradicts or is otherwise inconsistent with the procedures set forth in the Board's rules.

Appellants appear to misapprehend the portion of the Opinion addressing the principle argument in their Reply Brief. In their Reply Brief, Appellants argue for the application of a new legal rule: when an

examiner's answer contains a new ground of rejection, the Board should ignore the examiner's new arguments and/or new findings of fact as untimely for purposes of determining patentability and consider the inclusion of the new grounds of rejection as a tacit admission that the rejections in the final office action are fatally flawed. *See* Reply Br. 2–4.

For the following reasons, we decline Appellants' invitation to announce and apply a new legal rule.

First, Appellants' proposed rule is inconsistent with 37 C.F.R. § 41.40(a). As discussed in the Opinion, § 41.40 expressly states that “[a]ny request to seek review of the primary examiner’s failure to designate a rejection as a new ground of rejection in an examiner’s answer must be by way of a petition to the Director.”<sup>2</sup> Notwithstanding this clear language, Appellants' proposed rule would direct us to proceed in a specific manner if we determine that the examiner's answer has an undesignated new ground of

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<sup>2</sup> Section 41.40(a) reflects the statutory limits of our appellate jurisdiction, which is defined by statute and is limited to the review of adverse decisions by examiners which at least indirectly relate to matters involving the rejection of claims. *In re Hengehold*, 440 F.2d 1395, 1404, (CCPA 1971); *see also* 35 U.S.C. § 6(b) (defining the PTAB's duties); 35 U.S.C. § 134 (granting applicant the right to appeal once any of the claims have been twice rejected). Rejections of claims involve examination for compliance with the statutory provisions of Title 35, United States Code, as set forth in §§ 100, 101, 102, 103, and 112. *In re Harnisch*, 631 F.2d 716, 721 (CCPA 1980). Decisions an examiner makes during examination of a discretionary, procedural, or nonsubstantive nature not directly connected with the merits of issues involving rejections are reviewable by petition under 37 CFR § 1.181 to the Director, not by appeal. *In re Berger*, 279 F.3d 975, 984–85 (Fed. Cir. 2002). An examiner's decision not to designate an answer as containing a new ground of rejection is a procedural matter that the Board does not have jurisdiction to review.

rejection. Such a course of action is foreclosed by the plain language of § 41.40(a).

Second, the prior Board decisions upon which Appellants ask us to rely—*Yudoovsky* and *Haalck*—are not binding and were decided under a different set of rules than those governing the '973 Application.

Third, Appellants' proposed rule represents poor policymaking. Were we to adopt the proposed rule, an applicant would be able to avoid addressing the merits of an undesignated new ground of rejection—whether by presenting evidence, amending claims, or presenting argument—merely by asking the Board to recognize the examiner's undesignated new ground of rejection as such. The public interest is not served by allowing an applicant to avoid addressing the merits of a new ground of rejection—whether or not it is so designated—presented for the first time in the examiner's answer. Nor is treating the inclusion of a new ground of rejection in an examiner's answer as a tacit admission by the examiner that the rejections in the final office action are fatally flawed consistent with the law. As our reviewing court stated, “[p]atent examiners are quasi-judicial officials” and therefore do not make admissions, but rather make findings of fact and conclusions based on their factual findings. *Western Elec. Co. v. Piezo Tech., Inc.*, 860 F.2d 428, 431 (Fed. Cir. 1988).

## II

Appellants argue that the Opinion should be reconsidered because the Examiner's actions during the prosecution of the '973 Application have deprived Appellants of due process. Req. 6–7. In particular, Appellants argue that “the Board is rewarding the Examiner for piecemeal prosecution

and punishing Appellants for being pro-active in trying to advance prosecution. If the Board's ruling was not overturned future appellants would be discouraged from identifying incomplete obviousness rejections so as not to provoke a belated response from the examiner." *Id.*

We disagree. The Board's rules, as interpreted in the Opinion, provide appellants a full and fair opportunity to present any or all arguments they may have with regard to the undesignated new ground of rejection in an examiner's answer. As discussed above, appellants who want either to present new arguments or to amend their claims, may seek to do so by way of petition to the Director. If appellants want to respond to the merits of the new ground of rejection simply by way of argument, they may do so in their reply brief.

Because the Board's rules provide appellants with a full and fair opportunity to be heard regarding the merits of any designated or undesignated new ground of rejection contained in an examiner's answer, there is no due process problem. Furthermore, contrary to Appellants' argument, *see* Req. 8, the Board has no obligation to act in any particular manner to preserve whatever Patent Term Adjustment to which Appellants may have been entitled.

### III

Finally, Appellants argue that the Opinion should be reconsidered because we either misapprehended or overlooked Appellants' arguments regarding the merits of the new ground of rejection. Req. 8–12. This argument is unpersuasive.

We review the appealed rejections for error based upon the issues identified by Appellants and in light of the arguments and evidence produced thereon. *Cf. Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (cited with approval in *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“it has long been the Board’s practice to require an applicant to identify the alleged error in the examiner’s rejections”)).

In this case, Appellants have failed to identify the alleged error in the obviousness rejections. For the reasons set forth above, we must consider the basis for these rejections set forth in the Examiner’s Answer.<sup>3</sup> As we stated in the Opinion, Appellants did not include any substantive argument for reversal of the § 103(a) rejections in their Reply Brief. *See Op.* 7.

Appellants contend that the arguments made in their Reply Brief demonstrate their intention that we consider the arguments made in the Appeal Brief with respect to a hypothetical explanation of the obviousness rejections. We decline to do so. Appellants cannot meet their burden of identifying error in the rejection the Examiner *actually made* by pointing to their discussion of hypothetical rejection an examiner *might have made*.

We, therefore, are constrained to affirm the rejection of claims 1–7, 9, 10, and 14 as unpatentable over either Li or Lehmann.

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<sup>3</sup> For example, in rejecting the claims as unpatentable over Li, the Examiner found that Li identifies 2,4-diisocyanatotoluene as a compound that could be used in place of the symmetrical diisocyanates used in Li’s examples with a reasonable expectation of success. Answer 4–5. As the Federal Circuit has explained, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Appellants do not direct our attention to any alleged unexpected results.

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### CONCLUSION

The subject Request has been granted to the extent that the Opinion has been reconsidered, but is denied with respect to making any changes therein.

DENIED