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ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024			FOUD, HICHAM B	
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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 ROGIER NOLDUS

Appeal 2014-006343
Application 13/128,722
Technology Center 2400

Before DAVID M. KOHUT, LINZY T. McCARTNEY, and
MONICA S. ULLAGADDI, *Administrative Patent Judges*.

McCARTNEY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our July 27, 2016 decision (“Decision”) affirming the Examiner’s rejection of claims 1–12 and 14–21. We grant Appellant’s request and modify the Decision in the manner discussed below.

ANALYSIS

Appellant contends the Decision does not address arguments for claims 15, 17, 19, and 21 that Appellant raised in the Reply Brief. Req. for Reh'g 2–3. *See also* Reply Br. 7–8. Appellant asserts these arguments were submitted in the Reply Brief as the Examiner acknowledged in his Answer that the primary reference (Qian) fails to disclose “wherein the serviced request comprises IMEI besides the IMSI and wherein said another identifier is the IMEI”; he relied on further references as teaching[] those limitations.

Id. at 2.

We agree with Appellant that the Decision does not explicitly address arguments for claims 15, 17, 19, and 21 that Appellant raised in the Reply Brief. However, we find Appellant waived these arguments. “[A] reply brief [is not] an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner’s rejections, but were not.” *Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative); *see also* 37 C.F.R. § 41.41(b)(2). “When new issues have been raised by the Appellant [in a reply brief] . . . the Board, unless good cause is shown, will not consider those new issues.” *Borden*, 93 USPQ2d 1473, 1476; *see also* 37 C.F.R. § 41.41(b)(2).

Here, Appellant first presented arguments for claims 15, 17, 19, and 21 in the Reply Brief. *Compare* App. Br. 3–13, *with* Reply Br. 7–8; *see also* Req. for Reh'g 2. Although Appellant suggests Appellant raised these arguments in response to the Examiner changing the rejection in the Answer, *see* Req. for Reh'g 2, the record reflects otherwise. Contrary to Appellant’s assertion, the Examiner found in the *Final Rejection* that Qian does not disclose “wherein the service request comprises IMEI besides the IMSI and

wherein said another identifier is the IMEI.” Final Act. 3. That the Examiner reiterated this point in the Answer, *see* Ans. 10, does not amount to a change in the rejection. Similarly, to the extent Appellant argues the Examiner relied on new references in the Answer to address this limitation, *see* Req. for Reh’g 2, this argument is not supported by the record before us. With respect to the limitation quoted by Appellant, the Examiner found Bleckert teaches or suggests this limitation in both the Final Rejection and the Answer. *Compare* Final Act. 3, *with* Ans. 10.

In sum, Appellant could have challenged the Examiner’s rejections of claims 15, 17, 19, and 21 in the Appeal Brief, but chose not to. Appellant’s belated arguments for claims 15, 17, 19, and 21 are not responsive to a change in the Examiner’s position in the Answer, and Appellant has not explained why good cause exists for the untimely presentation of these arguments. Accordingly, Appellant has waived these arguments and we will not consider the arguments as part of this appeal.

DECISION

We grant Appellant’s request and modify the Decision in the manner discussed above. We maintain our affirmance of the Examiner’s rejections of claims 1–12 and 14–21.

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).

REQUEST GRANTED