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EXAMINER

GIDDINS, NELSON S

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SHUBHAM AGARWAL, MANU KUCHHAL and
SHAIENDRA K. SASON

Appeal 2015-000844
Application 13/893,591
Technology Center 2400

Before CAROLYN D. THOMAS, JEFFREY S. SMITH, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

INTRODUCTION

Appellants request rehearing of the Patent Trial and Appeal Board's ("Board") Decision mailed August 9, 2016 ("Decision") in which we affirmed the rejections of claims 17, 25, 32, 36, and 38 under § 103 as being unpatentable over various combinations of Phillips et al. (US 2012/0066610

A1, Mar. 15, 2012), Morris (US 2011/0252356 A1, Oct. 13, 2011), and Maciocci (US 2009/0287646 A1, Nov. 19, 2009) (*see* Final Act. 18, 28).¹

ANALYSIS

In the Request for Rehearing (“Request”), Appellants allege that the Board overlooked arguments “presented by Appellants in the Reply Brief regarding the distinction between the term ‘native application’ and the term ‘web application’” (Req. 1–2, 6).

Specifically, Appellants argue that arguments in the Reply Brief regarding native application and web application terminology were “in response to the new arguments for claim 36 and claim 32 originally raised in the Examiner’s Answer” (Req. 6). We disagree.

As an initial matter, we find that Appellants merely make a conclusory statement regarding the Examiner raising additional issues in the Answer (*see* Reply Br. 1), because Appellants fail to direct our attention to any additional findings made by the Examiner regarding a “native application.” Instead, the Examiner continues to rely on Maciocci, not Phillips, in the Final Action to teach the claimed native application (*see* Final Act. 24, 29, 30–31). Specifically, the Examiner cites to Figures 1, 2, and 3, and Paragraphs 31, 58, 67, and 68, of Maciocci in the Final Rejection (*see id.*) and to Paragraphs 32 and 55 of Maciocci in the Examiner’s Answer

¹ In the record before us, it is unclear whether the Examiner maintains the rejection of claims 25, 32, and 38 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, as the Examiner has neither withdrawn nor repeated the § 101 rejection as currently applicable (*see* Ans. 3). In the event the Examiner has maintained the § 101 rejection of claims 25, 32, and 38, we *summarily affirm* the rejection given the lack of rebuttal from Appellants.

(*see* Ans. 14). Appellants, in the Reply Brief, cite Appellants' Specification to define "native application" and "web application," and contend Phillips' web applications cannot teach both the claimed "web application" and the claimed "native application" (Reply Br. 4–5). The Examiner does not use Phillips to teach or suggest the claimed "native application." Thus, the problem with this argument, as highlighted in our Decision, is that the argument pertaining to the Phillips reference, rather than the cited paragraphs in the Maciocci reference, is not necessitated by the Examiner's response and is instead a belated argument introduced for the first time in the Reply Brief (*see* Decision 8). *See Ex parte Borden*, 93 USPQ2d 1473, 1474 (BPAI 2010) (informative); *see also* 37 C.F.R. § 41.41(b)(2) ("Any argument raised in the reply brief which was not raised in the appeal brief, *or is not responsive to an argument raised in the Examiner's answer*, including any designated new ground of rejection, *will not be considered by the Board for purposes of the present appeal*, unless good cause is shown" (emphasis added)). In other words, Appellants' arguments regarding the claimed native application are not responsive to, and thereby are not necessitated by, the Examiner's findings in the Examiner's Answer.

Furthermore, we note that the Examiner's additional citations to the Maciocci reference in the Answer do not constitute new grounds because the Examiner cites to Figures 1, 2, and 3 in the Final Rejection (*see* Final Act. 24, 29, 30–31) and the paragraphs additionally cited by the Examiner in the Examiner's Answer, Paragraphs 32 and 55, are associated with previously cited Figures 1 and 3, respectively (*see* Ans. 14; *see also* Maciocci ¶¶ 29–32, 49–55). In other words, the Examiner's additional citations to Paragraphs 32

Appeal 2015-000844
Application 13/893,591

and 55 merely elaborate upon what is taught in the previously cited Figures 1 and 3 of Maciocci.

Therefore, for at least the aforementioned reasons, we find unavailing Appellants' contention that the new arguments were necessitated by the Examiner's Answer.

DECISION

Accordingly, we have granted Appellants' Request to the extent that we have reconsidered the original Decision but have DENIED it with respect to making any changes to the 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)(1)(iv).

REHEARING DENIED