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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SOREN ERIK WESTERMANN

Appeal 2015-002374
Application 12/277,272
Technology Center 2600

Before ELENI MANTIS MERCADER, MIRIAM L. QUINN, and
STEVEN M. AMUNDSON, *Administrative Patent Judges*.

AMUNDSON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Under 37 C.F.R. § 41.52, Appellant requests rehearing of our August 3, 2016 Decision affirming the rejections of claims 1–15 under 35 U.S.C. § 103(a) as unpatentable over Dombrowski¹ alone or combined with other references.

We have reconsidered our Decision in light of Appellant’s arguments. Because Appellant’s arguments do not persuade us that we misapprehended or overlooked any points that would justify a different outcome, we deny Appellant’s request to modify our Decision.

¹ Von Dombrowski et al., US 7,844,065 B2, issued November 30, 2010.

ANALYSIS

A request for rehearing “must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1); *see Ex parte Quist*, 95 USPQ2d 1140, 1141 (BPAI 2010) (precedential). A request for rehearing is not an opportunity to merely express disagreement with a Board decision. *See* 37 C.F.R. § 41.52(a)(1).

Appellant asserts that the Board misapprehended or overlooked several points. We disagree.

Customizing Any Part That Could Cause Discomfort

Appellant quotes the Board’s statement that “[w]e agree with the Examiner that Dombrowski teaches or suggests customizing any hearing-aid part that could cause discomfort, including BTE housings or shells.” Req. Reh’g 1. Appellant then asserts that “[t]he examiner has never stated this.” *Id.* We disagree with Appellant’s contention that we misapprehended the Examiner’s position.

In the Answer, the Examiner found that Dombrowski discusses user comfort “multiple times.” Ans. 14 (citing Dombrowski 3:15–25 as an example). Appellant admits that Dombrowski discusses user comfort in connection with (1) adjusting the length of a tube connecting a BTE unit and an in-canal unit and (2) shaping the in-canal unit to fit a user’s ear geometry. Req. Reh’g 2–3; *see, e.g.*, Dombrowski 3:15–25, 4:53–57, 5:20–22, 5:57–60, 10:31–36, 14:46–50, 26:49–55. Similarly, the Examiner found that Dombrowski’s rapid-prototyping process for making the in-canal unit “provides comfort to the user” based on the user’s anatomy and “consideration of physiological factors.” Ans. 14. The Examiner then reasoned that “for any other part of the hearing aid if the user experiences

discomfort this [rapid-prototyping] method could be extended to that particular part as well.” *Id.* We agreed with that reasoning. Dec. 6 (“Dombrowski’s express teaching of a motivation to customize any part of the hearing aid where comfort is an issue, which is the case with respect to the BTE unit”). Therefore, even if Appellant were correct that the Examiner did not find Dombrowski teaches or suggests customizing any hearing-aid part that could cause discomfort, the Examiner did find, and we agree, that Dombrowski’s teachings of customization are sufficient motivation to customize BTE housings in a hearing aid. Ans. 14–15.

Appellant further argues that the Board wrongly determined that Dombrowski expressly teaches “a motivation to customize any part of the hearing aid where comfort is an issue.” Req. Reh’g 2. We do not agree with Appellant’s argument. The Examiner found that “Dombrowski [] discloses a custom fit ear mold that is fabricated using a rapid prototyping technology, in which the contours of the user’s ear canal are scanned, and the scan data is used either directly or indirectly to replicate the ear canal contours of that user into the custom fit ear mold.” Ans. 3, 8, 12; *see* Final Act. 5, 10, 14; Dombrowski 6:4–8. The Examiner also cites column 3, lines 15–25 as disclosing comfortable fixation of hearing aids, and finds that the same comfort concerns with fixation of an in-ear canal piece, alleviated by customization using rapid prototyping process, could be extended to other parts of the hearing aid where user comfort is needed. Ans. 14. Because comfort is based on the anatomy of a particular user and physiological factors, the Examiner reasons that it would have been obvious to extend Dombrowski’s process of customization to any part of the hearing aid that causes discomfort. *Id.* at 14–15. We find this rationale reasonable and

factually supported by Dombrowski. Appellant's arguments do not persuade us otherwise.

Appellant advances additional arguments regarding Dombrowski. Req. Reh'g 1–3. For instance, Appellant asserts that (1) Dombrowski's teaching of rapid prototyping for an in-canal unit would not have been recognized by a skilled artisan "to have a broader application" and (2) "[t]he examiner never points to anywhere in Dombrowski where Dombrowski itself mentions user comfort and satisfaction as a reason for rapid prototyping" a BTE unit. *Id.* at 2. These are arguments that were considered, found unpersuasive, and addressed in our Decision. Dec. 5–10.

Attorney Argument

Our Decision characterized various assertions as attorney argument unsupported by factual evidence. *See* Dec. 7. Appellant argues that "it is not proper to ignore as attorney argument facts that are immediately apparent from art in the record and from common sense." Req. Reh'g 3. In the Appeal Brief and the Reply Brief, however, Appellant did not cite any "art in the record" to support the assertions characterized as attorney argument. App. Br. 7–10; Reply Br. 6–8. Further, "[a]n assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness." *In re Geisler*, 116 F.3d 1465, 1470 (Fed. Cir. 1997).

Appellant, on rehearing, proffers factual evidence allegedly supporting some assertions characterized as attorney argument, e.g., "Japanese reference 62-023800 submitted with an IDS on December 6, 2011." Req. Reh'g 4. We could not have misapprehended or overlooked evidence that was not presented to us previously. Accordingly, Appellant

fails to identify any factual or legal point that we misapprehended or overlooked regarding attorney argument.

The Passage of Time as Evidence of Nonobviousness

As in the Appeal Brief and the Reply Brief, Appellant argues that “rapid prototyping of hearing aid components has been around for a long time and has never been applied to a BTE unit.” Req. Reh’g 4; *see* App. Br. 9; Reply Br. 6, 8. Appellant then asserts that “while the passage of time is also not a per se indication of non-obviousness, it is also well-accepted that the passage of time is evidence that the invention was not obvious.” Req. Reh’g 5. Appellant, however, cites no support for that assertion. *Id.* Furthermore, the argument was considered and found unpersuasive. Dec. 8.

Finally, Appellant does not contend that the passage of time constitutes a secondary consideration of nonobviousness. Req. Reh’g 5. Notwithstanding Appellant’s failure to argue this point, even if we were to consider the alleged passage of time as part of the obviousness analysis, however, there is no factual support or sufficient evidence to overcome the strong evidence of obviousness presented in the current record.

CONCLUSION

Based on the analysis above, we have granted Appellant’s request to the extent that we have reconsidered our Decision, but we decline to modify it.

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