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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/164,178	01/25/2014	Vincent S. Darago	5045.2.1G	2587
23484	7590	12/13/2016	EXAMINER	
John Ogilvie 2148 E. 11270 S. Sandy, UT 84092			HOANG, HIEU T	
			ART UNIT	PAPER NUMBER
			2452	
			NOTIFICATION DATE	DELIVERY MODE
			12/13/2016	ELECTRONIC

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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* VINCENT S. DARAGO and  
CHRISTOPHER JENKINS

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Appeal 2015-005867  
Application 14/164,178  
Technology Center 2400

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Before ADAM J. PYONIN, AMBER L. HAGY, and  
SHARON FENICK, *Administrative Patent Judges*.

HAGY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

In papers filed November 21, 2016, Appellants request rehearing (hereinafter “Request”) under 37 C.F.R. § 41.52 from our Decision on Appeal mailed September 29, 2016 (hereinafter “Decision”).<sup>1</sup> In the Decision, we affirmed the Examiner’s rejection of claims 38–53 and 58–61.

We have reconsidered our decision in light of Appellants’ Request for Rehearing, but we decline to change the decision.

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<sup>1</sup> “The 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).

We find Appellants' arguments unpersuasive for the reasons given in our prior Decision. We highlight the following for emphasis.

Appellants contend:

1. Appellants pointed out in their Appeal Brief that "Official Notice may only be taken of **facts**" and the Examiner, at pages 10, 11, and 12 of the Answer, took Official Notice of "legal conclusions (which are not facts)." (Request 1.) The Board must correct the Examiner's "clear and significant misunderstanding," and "[d]oing anything less at this point will make the Board a public apologist for a clear legal error by the Examiner." (Request 2.)

2. In holding that the second, third, and fourth arguments of the Appeal Brief fail because they rely on the premise that the prior art references "cannot be physically combined," the Board overlooked the decision in *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009). (Request 2.)

3. The Board failed to consider Appellants' evidence that combining the Ananda and Lawlor references would "**decrease accuracy** by several orders of magnitude." (Request 3–5.)

4. The Board failed to consider Appellants' evidence that combining the Ananda and Lawlor references would add "complexity" and "drastically complicate[] the system." (Request 5–6.)

5. The Board failed to consider Appellants' evidence that combining the Ananda and Lawlor references "would break Ananda's technology" and create an inoperative result. (Request 6.)

None of Appellants' contentions show any matter that was misapprehended or overlooked by the Board in rendering the Decision.

With regard to Appellants' first contention, we disagree that Appellants have raised an "oversight" on the part of the Examiner with regard to taking Official Notice that requires correction. Most fundamentally, Appellants' stated basis for rehearing does not pertain to issues preserved on appeal. The "Official Notices" referenced in Appellants' closing paragraph on appeal are those stated by the Examiner at "pages 10, 11, and 12 of the Final Office Action" (Request 1 (citing App. Br. 8))—which do not pertain to any claims Appellants argued substantively on appeal. Rather, the Examiner's rejections stated at pages 10–12 of the Final Office Action are of claims 48, 50, and 52. (Final Act. 10–12.) As we noted in the Decision, however, Appellants presented substantive arguments on appeal only with regard to the Examiner's rejection of *claim 38*, and expressly agreed that "the claims are grouped together" for purposes of appeal. (Decision 4, n.4; *see also* App. Br. 4.) And, while the Examiner relied upon a *different* Official Notice in the rejection of claim 38, Appellants did not raise any error by the Examiner with regard to the Examiner's reliance on that Official Notice. (Decision 4, n.5; *see also* Final Act. 7 ("Official notice is taken that distribution of courseware content over a network was known in the art (for example, see Siefert, US 2001/0055749, [0010], distributing lessons to client computers").)

Thus, Appellants did not present arguments on appeal regarding the Examiner's rejection of any claims other than claim 38, or on the taking of Official Notice in the rejection of claim 38. Any arguments not presented on appeal are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(iv). Therefore, Appellants' closing remarks in their Appeal Brief disparaging the Examiner's taking of "Official Notice" in connection with the rejection of

claims not substantively argued on appeal (or identified by Appellants) fail to constitute a separate issue of patentability. *See In re Lovin*, 652 F.3d 1349, 1356 (Fed. Cir. 2011) (“We conclude that the Board has reasonably interpreted Rule 41.37 to require applicants to articulate more substantive arguments if they wish for individual claims to be treated separately.”).

By noting that Appellants have waived a substantive challenge to the Examiner’s taking of Official Notice in connection with the rejection of claims 48, 50, and 52, we do not mean to suggest that, had such a challenge been preserved, Appellants would have been successful in demonstrating Examiner error in the rejection of those claims. By choosing not to address these claims substantively on appeal, Appellants have not placed into context the propriety of the Examiner’s findings or conclusions regarding those claims—including the Examiner’s taking of Official Notice—nor have they provided the Examiner with an opportunity in an Answer to respond to such contentions. We cannot opine on rehearing, in a vacuum, as to whether the Examiner’s taking of Official Notice in connection with claims not argued on appeal was reversible error.

With regard to Appellants’ second contention, we disagree that we overlooked relevant precedent. As we noted in our Decision, Appellants’ arguments that combining Lawlor with Ananda would result in an inferior and/or unworkable system are premised on the notion that the Examiner’s combination requires bodily incorporation of Lawlor with Ananda, and that such combination is unworkable. (Decision 6–7.) As we further noted in our Decision, however, whether parts of one reference may be bodily incorporated into another is not the proper standard for evaluating obviousness. (*Id.* (citing, e.g., *In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir.

1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference . . .”). *See also In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012) (“It is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.”). The Federal Circuit’s decision in *DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314 (Fed. Cir. 2009), is not to the contrary, nor do Appellants explain their reasoning behind suggesting that it is.

With regard to Appellants’ third, fourth, and fifth contentions, Appellants’ arguments are a reiteration of the arguments referenced in Appellants’ Appeal Brief<sup>2</sup> as to alleged errors in the Examiner’s fact finding. (Request 4–6.) Appellants argue that adding Lawlor’s clock synchronization to Ananda would make the system more complex and would decrease accuracy, and could even “break” Ananda’s system. (*Id.*) As we noted in our Decision, we found these arguments unpersuasive because, *inter alia*, they rely on the flawed premise that the systems taught in the cited references would have to be bodily incorporated together, without the exercise of independent judgment or creativity by the ordinary skilled artisan. (Decision 6–8.) In reiterating those arguments in their Request,

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<sup>2</sup> As we noted in our Decision, the substance of Appellants’ arguments on these grounds was contained primarily in a document that was incorporated by reference, improperly, into Appellants’ Appeal Brief. (Decision 4.) Appellants perpetuate this error in their Request by again relying on material that is not in Appellants’ Appeal Brief. (*E.g.*, Request 3 (citing “8/22/2014 submission”).)

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Appellants have not persuaded us that we have overlooked or misapprehended any matter in rendering our Decision.

#### CONCLUSION

In view of the foregoing discussion, we grant Appellants' Request for Rehearing to the extent of reconsidering our Decision, but we deny Appellants' request with respect to making any change thereto.

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).

DENIED