



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
12/308,340 04/12/2010 Dirk Otte BOSC.P5673US/11602894 5840

24972 7590 12/05/2016
NORTON ROSE FULBRIGHT US LLP
1301 Avenue of the Americas
NEW YORK, NY 10019-6022

Table with 1 column: EXAMINER

YANG, JAMES J

Table with 2 columns: ART UNIT, PAPER NUMBER

2683

Table with 2 columns: NOTIFICATION DATE, DELIVERY MODE

12/05/2016

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

nyipdocket@nortonrosefulbright.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* DIRK OTTE

---

Appeal 2015-006833  
Application 12/308,340  
Technology Center 2600

---

Before ALLEN R. MacDONALD, JOHN P. PINKERTON, and  
GARTH D. BAER, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to Appellant’s Request for Rehearing (“Request”) under 37 C.F.R. § 41.52<sup>1</sup>, Appellant requests a rehearing of our Decision of Sep. 21, 2016 (“Decision”), in which we affirmed the Examiner’s rejection of claims 6–16 under 35 U.S.C. § 102(b).

---

<sup>1</sup> Although Appellant’s Request is entitled “Request for Rehearing Under 37 C.F.R. § 41.50(b)(2)” (Request 1, emphasis added), we treat the Request as a request for rehearing under 37 C.F.R. § 41.52. *See* 37 C.F.R. § 41.52(a)(1) (“Appellant may file a single request for rehearing within two months of the date of the original decision of the Board.”).

## INTRODUCTION

Appellant argues, “[i]n affirming the Examiner’s rejection of the claims, *the Board applies two **new interpretations*** of how the disclosure of Ashby is considered to disclose the features of the claims, *neither of which the Examiner has previously noted.*” Request 1–2 (emphasis in original). Specifically, as argued by Appellant, “under a first new interpretation . . . Ashby’s POI data as a whole can be considered to disclose the claims’ ‘each of at least one single stored map datum’ being associated with a plurality of tiles,” and “[u]nder a second interpretation . . . since the POI data as whole is associated with a plurality of tiles . . . any part of the POI data is similarly considered to be associated with a plurality of tiles.” *Id.* at 2. Appellant also argues “[h]ad the Examiner applied those interpretations of Ashby . . . claims 11 and 15 would have been separately argued, because those new interpretations are untenable in consideration of the additional features required by claims 11 and 15.” *Id.* According to Appellant, “it is clear that Ashby, if considered in light of the two new interpretations suggested by the Board, cannot be considered to disclose the features of either of claims 11 and 15.” *Id.* Appellant subsequently argues the Board should consider whether the features of claims 11 and 15 can be considered to be disclosed by Ashby under either of the “new” interpretations, and further presents arguments for patentability of claims 11 and 15 in light of the “new” interpretations. *Id.* at 2–3.

## 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). “Arguments not raised, and Evidence not previously relied upon . . . are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4).” *Id.* Permitted new arguments are limited to: (a) new arguments based upon a recent relevant decision of either the Board or a Federal Court; (b) new arguments responding to a new ground of rejection designated pursuant to § 41.50(b); or (c) new arguments that the Board’s decision contains an undesignated new ground of rejection. *See* 37 C.F.R. § 41.52(a)(2)–(4).

Although Appellant does not explicitly state that the Board’s decision contains an undesignated new ground of rejection, we construe Appellant’s argument that the Board applied two new interpretations of how the disclosure of Ashby is considered to teach the features of the claims as arguing the Decision contains an undesignated new ground of rejection. We disagree, however, with Appellant’s characterization of the Board’s conclusions as “new interpretations” that were not “previously noted” by the Examiner. Request 1–2. The finding that Ashby’s collection of POI data teaches “at least one single stored map datum [associated] with a respective plurality of planar tiles,” is a finding that was made by the Examiner in the Answer. *See* Ans. 3 (“The collection of POI’s . . . is thus interpretable as being associated with a respective plurality of planar tiles. . . . Therefore, the collection of POI data 54 . . . represents POI’s, [i.e.,] map datum, with a respective plurality of areas, [i.e.,] planar tiles.”); *see also* Decision 4–5 (indicating agreement with the Examiner’s finding). Because we agreed with and adopted the Examiner’s findings, even though the Decision restates the Examiner’s findings in a different way, the “basic thrust of the rejection” is the same, and thus, the Decision does not contain an undesignated new

ground of rejection. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976); *see also In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when “explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner”). Further, the finding that Ashby’s POI parcel also teaches “at least one single stored map datum [associated] with a respective plurality of planar tiles,” is an alternate finding that assumes *arguendo* Appellant’s argued interpretation of “map datum” (*see* App. Br. 5). Since it was not necessary for the Board to rely on the alternate finding to support the rejection, the alternate finding also did not change the basic thrust of the rejection. Thus, we do not agree with Appellant that the Decision contained an undesignated new ground of rejection.

Further, Appellant’s arguments that claims 11 and 15 are separately patentable were not raised in Appellant’s Briefs. Because we do not agree that the Decision contained an undesignated new ground of rejection, Appellant’s arguments regarding claims 11 and 15 do not fall under paragraphs (a)(2) through (a)(4) of 37 C.F.R. § 41.52, and thus are not permitted. Thus, we decline to reconsider the rejection of claims 11 and 15.

#### DECISION

Accordingly, upon granting the Request to the extent we have reconsidered the Decision in view of the arguments presented in Request, we deny the Request and make no changes to the Decision.

#### REHEARING DENIED