



# 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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/509,131	07/24/2009	Sujeet Kumar	5024.09US01	9349

62274 7590 02/13/2018  
CHRISTENSEN, FONDER, DARDI & HERBERT PLLC  
33 South Sixth Street  
Suite 3950  
Minneapolis, MN 55402

EXAMINER
----------

EGGERDING, ALIX ECHELMEYER

ART UNIT	PAPER NUMBER
----------	--------------

1729

MAIL DATE	DELIVERY MODE
-----------	---------------

02/13/2018

PAPER

**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.

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* SUJEET KUMAR, JAMES P. BUCKLEY, and HANG SHI

---

Appeal 2016-002239  
Application 12/509,131  
Technology Center 1700

---

Before ADRIENE LEPIANE HANLON, N. WHITNEY WILSON, and  
JENNIFER R. GUPTA, *Administrative Patent Judges*.

WILSON, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants<sup>1</sup> timely filed a Request for Rehearing under 37 C.F.R. § 41.52 (“Request”)<sup>2</sup> of our Decision mailed September 13, 2017 in connection with the above-captioned appeal (“Decision”). Requests for Rehearing are limited to matters overlooked or misapprehended by the Panel in rendering the original decision. *See* 37 C.F.R. § 41.52.

In the Decision, we affirmed (1) the rejection of claims 1, 3, 9–12, 14, and 16 under 35 U.S.C. § 103(a) as unpatentable over Wakasugi<sup>3</sup> in view of

---

<sup>1</sup> Appellant identifies the real party in interest as Envia Systems, Inc. (Appeal Br. 3).

<sup>2</sup> Request for Rehearing filed November 10, 2017.

<sup>3</sup> Wakasugi et al., US 8,021,785 B2, issued September 20, 2011.

Amine<sup>4</sup>, (2) the rejection of claims 5 and 15 under 35 U.S.C. § 103(a) as unpatentable over Wakasugi in view of Amine and Sun<sup>5</sup>, (3) the rejection of claims 6–8 under 35 U.S.C. § 103(a) as unpatentable over Wakasugi in view of Amine and Suzuki<sup>6</sup>, and (4) the rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Wakasugi in view of Amine, Suzuki, Radev<sup>7</sup>, and Sun. We reversed the rejection of claims 17–19 under 35 U.S.C. § 103(a) as being unpatentable over Wakasugi in view of Amine, Suzuki, and Radev.

### ISSUES RAISED IN REQUEST

***Claim 21.*** Appellants state that because claim 21 depends from claim 17, its rejection should have been reversed for the same reason as claim 17 (Request 3).<sup>8</sup> We agree, and, upon reconsideration, hereby reverse the rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over Wakasugi in view of Amine, Suzuki, Radev, and Sun.

***Rejections 1 and 3.*** Appellants correctly note that Rejections 1 and 3 were considered together in the Decision, but suggest that the Board incorrectly failed to consider the Suzuki reference at all (Request 4). However, in the Appeal Brief Appellants stated that the claims subject to Rejections 1 and 3 would “stand and fall together” (Appeal Br. 6) and that claims 6 and 7 (the subject of Rejection 3), “are not separately argued with respect to patentability” (Appeal Br. 21). Accordingly, the Decision appropriately did

---

<sup>4</sup> Amine et al., US 2006/0147809 A1, published July 6, 2006.

<sup>5</sup> Sun et al., US 2009/0253042 A1, published October 8, 2009.

<sup>6</sup> Suzuki et al., US 2004/0072072 A1, published April 15, 2004.

<sup>7</sup> Radev, US 7,497,285 B1, issued March 3, 2009.

<sup>8</sup> Appellants acknowledge (Request 4) that the Appeal Brief mistakenly indicated that claim 21 stood or fell with claims 5 and 15.

not separately consider Rejection 3. 37 C.F.R. § 41.37(c)(1)(iv). Moreover, on appeal, Appellants did not dispute the Examiner's factual findings as to Suzuki in setting forth Rejection 3 (*see*, Appeal Br. 21–23) and, therefore, did not persuasively demonstrate reversible error in the portions of Rejection 3 which are not duplicative of Rejection 1.

Appellants argue that “the presence of the missing descriptive matter of the claim is not considered in the context of whether it is inherent in the combination of features pulled from two or more references since this approach is completely inconsistent with a large body of law relating to obviousness” (Request 6). Appellants further suggest that inherency is only relevant in an obviousness context “to fill in an obvious necessary feature from a single reference that are [sic] specifically described in the reference” (*id.*). Appellants contend that it was improper for the Examiner to determine that it would have been obvious to combine the teachings of Wakasugi and Amine and that the properties recited in the claim would have been inherent (*id.*).

However, the Federal Circuit has held that it is appropriate to apply the doctrine of inherency in this situation (i.e. when the combined prior art inherently has the claimed properties), stating that “the limitation at issue necessarily must be present, or the natural result of the combination of elements explicitly disclosed by the prior art.” *PAR Pharm., Inc. v. TWI Pharm., Inc.*, 773 F.3d 1186, 1196 (Fed. Cir. 2014) (emphasis added). We disagree with Appellants' contention that the Federal Circuit in *In re Imes*, 779 F.3d 1250 (Fed. Cir. 2015) barred the use of the doctrine of inherency under the factual situation at issue here.

Appellants also contend that we overlooked an argument that “the references under the initial rejection do not even provide any specifics on the design and construction of their battery.” This argument was not overlooked. As we explained in the Decision, the Examiner found that the battery of Wakasugi in combination with Amine is substantially identical to that of the claims and, therefore, that the properties recited in the claims were presumed to be inherent in that battery (Decision 6). We determined that the Examiner had adequately established that the battery which would have resulted from the obvious combination of Wakasugi and Amine would have been substantially similar to the claimed battery, and that Appellants had not persuasively shown error in that determination (Decision 6–7).

Appellants contend that the Examiner did not adequately set forth a prima facie case of obviousness and that, therefore, even in the absence of any showing by the Appellants, the rejection should have been reversed (Request 8–9). We disagree with Appellants regarding the sufficiency of the prima facie case of obviousness for the reasons set forth above and in the Decision.

Appellants also argue that there would have been no reasonable expectation of success in combining the teachings of Wakasugi and Amine (Request 9–10). Appellants correctly note that in order for a set of references to be combined to render a claimed invention obvious, a person of skill in the art would need motivation to make the necessary combination to achieve the claimed invention, and have a reasonable expectation of success in doing so (Request 9, citing *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007)). However, Appellants assert that this standard requires that a person of skill in the art would have to have reasonably

expected that the combined prior art would have had all of the claimed properties (Request 9–10). However, this standard would vitiate the use of the inherency doctrine, which necessarily involves a situation in which the claimed properties are not specifically mentioned in the art, but which the Examiner has demonstrated would have been inherent in the proposed combination. Thus, we reiterate that the Examiner showed that a person of ordinary skill in the art would have had a reasonable expectation of success in combining the teachings of Wakasugi and Amine, and that the proposed combination would inherently have had the claimed properties. Appellants have not shown reversible error in these findings.

With respect to the objective evidence of patentability presented by Appellants, Appellants contend that the Board misapprehended the significance of the information (Request 11). Appellants correctly state that “[a]n appellant may rebut a *prima facie* case of obviousness by providing a ‘showing of facts supporting the opposite conclusion.’ Such a showing dissipates the *prima facie* holding and requires the examiner to ‘**consider all of the evidence anew**’” (*id.* at 12, citation omitted).

In this instance, the Decision was not perfectly clear that we considered all of the evidence of record in reviewing the objective evidence of patentability and found that the preponderance of that evidence supported the Examiner’s conclusion of unpatentability. That is, as required, we considered the evidence presented by the Examiner and the counter evidence as presented by Appellants together, and concluded that the evidence of unpatentability outweighed the evidence proffered by Appellants, essentially for the reasons set forth in the Decision at pages 8–9, including the fact that the showing was not commensurate in scope with the claims. Moreover, in

the Decision, we noted that Appellants had not disputed the Examiner's finding that "many of the data points of Sun appear to be improved compared to Appellant[s'] data points" (Decision 9). Appellants now appear to be attempting to dispute that finding (Request 14). However, having not been raised earlier, these arguments are untimely, and will not be considered at this time. 37 C.F.R. § 41.52(a)(1).

#### CONCLUSION

The subject Request has been granted to the extent that the Decision has been reconsidered, and we determine that the rejection of claim 21 is REVERSED, but is otherwise denied with respect to making other changes therein.

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).

GRANTED-IN-PART