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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/133,282	10/27/2011	Alan Graham Brown	226-002 (21086)	1852
157817	7590	11/04/2019	EXAMINER	
Pilloff & Passino LLP 2000 Duke Street Suite 300 Alexandria, VA 22314			PYON, HAROLD Y	
			ART UNIT	PAPER NUMBER
			1761	
			NOTIFICATION DATE	DELIVERY MODE
			11/04/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL
AND APPEAL BOARD

Ex parte ALAN GRAHAM BROWN, CARLOS ALBERTO MARI,
RODNEY JAMES CONNELL, and MATTHEW CHARLES RYAN¹

Appeal 2017-009508
Application 13/133,282
Technology Center 1700

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and JEFFREY R.
SNAY, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as ITW AUSTRALIA PTY. LTD. Appeal Br. 2.

DECISION ON REQUEST FOR REHEARING²

Appellant requests rehearing of our Decision of May 30, 2019. We have reconsidered our Decision of May 30, 2019 in light of Appellants' comments in the Supplemental Request for Rehearing, and Appellant has not convinced us of error therein for the following reasons.

As a preliminary matter, on page 1 of the Supplemental Request for Rehearing, Appellant requests that the USPTO designate a precedential decision (Precedential Opinion Panel (POP) review) (this request is raised several times in the Supplemental Request for Rehearing). This request for POP review was denied in the Order filed October 21, 2019.

Also, on page 1 of the Supplemental Request for Rehearing, Appellant requests that new grounds of rejection be designated with respect to claim 18 and claims 14 and 15.³ Appellant refers to *In re Imes*, 778 F.3d 1250 (Fed. Cir. 2015) and *In re Leithem*, 661 F.3d 1316, 1319 (Fed. Cir. 2011) in support of a designation

² Appellant filed a first Request for Rehearing (entitled "Rehearing Brief and Request") on August 2, 2019. Appellant filed a second Request for Rehearing (entitled "Supplemental Rehearing Brief and Request") on October 3, 2019 (hereafter referred to as the "Supplemental Request for Rehearing"). On pages 3–4 in the Supplemental Request for Rehearing, Appellant states that the Supplemental Request for Rehearing replaces the document filed on July 30, 2019, and states that the document filed on July 30, 2019 be disregarded as there is nothing in that document that is not in the Supplemental Request for Rehearing. The document that was filed on July 30, 2019 was the PTAB Oral Transcript. Hence, we presume Appellant meant to refer to the first Request for Rehearing filed on August 2, 2019 (and not the document filed on July 30, 2019) because the first Request for Rehearing has nothing that is not in the Supplemental Request for Rehearing, as Appellant states on page 4 of the Supplemental Request for Rehearing. We thus use the Supplemental Request for Rehearing and disregard the first Request for Rehearing filed on August 2, 2019 as requested by Appellant.

³ Review of a request for a new grounds of rejection designation is made by way of 37 CFR 41.50 (c) and 37 CFR 41.52.

of a new grounds, of which we are familiar. Supplemental Request for Rehearing 12 n.5.

With regard to claim 18, beginning on page 26 of the Supplemental Request for Rehearing, Appellant submits that the rationale set forth on page 4 of the Decision of May 30, 2019 that dependency would have been read to modify “comprising” to read “consisting of” was never proffered before. We note that there is no new ground of rejection when the basic thrust of the rejection remains the same such that an appellant has been given a fair opportunity to react to the rejection. *See In re Kronig*, 539 F.2d 1300, 1302-03 (CCPA 1976). While Appellant cites to *In re Imes* and *In re Leithem*, we note that where the statutory basis for the rejection remains the same, and the evidence relied upon in support of the rejection remains the same, a change in the discussion of, or rationale in support of, the rejection does not necessarily constitute a new ground of rejection. *Id.* at 1303. In the instant case (with regard to claim 18), as we pointed on pages 3–4 of the Decision mailed May 30, 2019, the Examiner rejected claim 18 as being indefinite because of the conflicting use of the transitional phrases “comprising” and “consisting of”. Ans. 13. Our comments made on pages 3–4 of the Decision mailed May 30, 2019 reiterate this position of the Examiner and therefore do not amount to new evidence or a new rationale as submitted by Appellant.

With regard to claim 14, beginning on page 49 of the Supplemental Request for Rehearing, Appellant submits that the Board is treating the recitations of claim 14 as “intended use” but the Examiner did not assert this, and requests a new grounds designation. As we stated on page 6 of the Decision mailed May 30, 2019, the Examiner understands claim 14 to encompass a composition comprising a cationic and/or zwitterionic surfactant. Ans. 9–10. It follows that the Examiner’s understanding is that Appellant uses the composition as a coal mining dusting agent

(hence it is referred to as “a coal mining dusting agent” in claim 14), but this does not change the fact that it is a composition comprising a cationic and/or zwitterionic surfactant (see page 6 of the Decision mailed May 30, 2019 and pages 9–10 of the Answer). Hence, our comments made on page 6 of the Decision mailed May 30, 2019 reiterate the position of the Examiner and therefore do not amount to new evidence or a new rationale as submitted by Appellant.

With regard to claim 15, on page 57 of the Supplemental Request for Rehearing, Appellant states that in the rejection of claim 15, the Examiner cites to Examples 5–7 in Adamy, and the Decision cites the disclosure of a slurry in Example 4. We do not agree that our reference to paragraph 36, which discusses the compositions of Adamy’s Example 4, amounts to a new ground of rejection. Our Decision on pages 6–7 agrees with the Examiner’s reliance upon Examples 5–7. More specifically, on page 7 of the Decision mailed May 30, 2019, we stated “. . . the Examiner relies in part on Examples 5–7 of Adamy wherein it is disclosed that “dispersions” (slurries) are made. Adamy, para. 62.” Paragraph 62 states that “[a]ll the formulas were uniform, flowable dispersions”. Appellant argues there is no disclosure of a slurry in Adamy’s Examples 5–7. In so stating, Appellant seems to have overlooked our point, which is that the “dispersions” of Adamy are slurries by definition, and therefore the Examiner’s reliance upon Examples 5–7 adequately supports the rejection over Adamy. Our peripheral referral to paragraph 36 of Adamy was an effort to show that Adamy supports this point and the citation of paragraph 36 does not change the thrust of the rejection. Hence, our comments made on pages 6–7 of the Decision mailed May 30, 2019 reiterate the position of the Examiner and therefore do not amount to new evidence or a new rationale as argued by Appellant.

In view of the above, Appellant's request that a new ground of rejection be designated with respect to claim 14, 15, and 18 is denied.

Beginning on page 1 of the Supplemental Request for Rehearing, Appellant submits that the Decision mailed May 30, 2019 does not address the claim construction issues raised and does not consider certain cited decisions mentioned by Appellants. To the contrary, we thoroughly reviewed the contents of Appellant's briefs in the record in their entirety, including any cited decisions, in making our determinations set forth in our Decision mailed May 30, 2019.

On pages 1–2 of the Supplemental Request for Rehearing, Appellant additionally submits that the Decision mailed May 30, 2019 violates *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) which mandates that the PTAB review be anew, not just for reversible error. Appellant queries why the Examiner is correct on broadest reasonable interpretation standard (“BRI”). *Id.* Appellant submits that *In re Smith Int'l, Inc.* 871 F. 3d 1375 (Fed. Circ. 2017) requires that the claims be construed in light of the Specification. Supplemental Request for Rehearing, 2. Appellant submits that the whole point of the Specification is to suppress or prevent coal dust explosions. *Id.* Appellant submits that certain cases cited in the briefs regarding functional language have import in construing the claims. *Id.* On page 3 of the Supplemental Request for Rehearing. Appellant proffers a Board Amendment.

With the aforementioned introduction, we turn now to the rejection of claim 18 under 35 USC § 112, second paragraph, which is discussed by Appellant, beginning on page 5 of the Supplemental Request for Rehearing. Therein, Appellant explains that claim 18 was put into independent form for no other reason than to give the Examiner a way to allow a claim. On page 6 of the Supplemental Request for Rehearing, Appellant compares claim 8 with claim 18 in an effort to show the

identical nature of the claims in support of the position that to say one is definite and the other is not is error. Beginning on page 7 of the Supplemental Request for Rehearing, Appellant submits that a dependent claim does not modify an independent claim; rather, a dependent claim further narrows the scope of what is claimed in the independent claim, and refers to 35 USC 112, fourth paragraph, in this regard. Appellant argues that the USPTO did not follow the procedures mandated by MPEP 2173 and thus violates the Administrative Procedures Act. Supplemental Request for Rehearing 7. Beginning on page 8 of the Supplemental Request for Rehearing, Appellant reiterates the request for a Precedential Opinion Panel review, but as stated *supra*, this request has been denied.

Beginning on page 9 of the Supplemental Request for Rehearing, Appellant submits that the requirements of *Ex parte Frye* are not met because nowhere was the Specification evaluated, nowhere was the prior art evaluated in view of assessing the scope of the claim, and nowhere was there any interpretation given to claim 18 vis-a-vis the knowledge of one possessing the ordinary level of skill in the pertinent art. Appellant also refers to excerpts from the PTAB Oral Argument transcript on pages 10–12 of the Supplemental Request for Rehearing, apparently for the proposition that the wrong focus is made regarding claim 18, whereas the correct focus should be whether or not it is indefinite, and that a Board Amendment should be considered.

We in fact did focus on the issue as to whether claim 18 is properly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Decision 3–4. Therein, we agreed with the Examiner’s position (the Examiner’s position is set forth on pages 3–4 of the Final Office Action and on page 13 of the Answer). The Examiner states that claim 18 is indefinite because the preamble of the claim uses the transitional phrase “comprising” to describe the claimed liquid formulation, but

later in the claim the transitional phrase “consisting of” is used to describe the formulation. Ans. 13. In making our determination in our Decision mailed May 30, 2019, we fully appreciated that “[t]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (citation omitted); *see also In re Moore*, 439 F.2d 1232, 1235 n.2 (CCPA 1971).⁴ We also fully understood 35 USC 112, fourth paragraph compliance requirements. It is the innate dichotomy of the language of claim 18 as pointed out by the Examiner (use of both “comprising” and “consisting of” in reciting the formulation in claim 18) which brings vagueness to claim scope as understood by the skilled artisan when read in light of the Specification. As such, we are unpersuaded by Appellant’s arguments regarding the 35 U.S.C. § 112, second paragraph, rejection of claim 18.

We agree with Appellant that a dependent claim further narrows the scope of what is claimed in the independent claim from which it depends. Supplemental Request for Rehearing 7. As we stated in our Decision, “we agree with Appellant that claim 18 was not indefinite when it was dependent on claim 8, that was because the dependency would have been read to modify ‘comprising’ to read ‘consisting of.’” Decision 4. But when amending claim 18, Appellant did not modify “comprising” to read “consisting of”, but instead repeated the limitation to the formulation such that the resulting amended claim 18 contained two recitations of the formulation, one introduced with the transitional phrase “comprising” and one introduced by the transitional phrase “consisting of.” This made the claim

⁴ As such, we are unpersuaded of any violation of *Ex parte Frye*, or *In re Smith International Inc.*, or the Administrative Procedures A as submitted by Appellant.

indefinite. The remedy for the indefiniteness of claim 18 is simple. For instance, it could be remedied by changing “comprising” to “consisting of” and deleting the redundant last clause of the claims, i.e., the clause stating “the formulation consisting of a cationic and/or zwitterionic surfactant.”

Appellant refers to a “Board Amendment” as something Appellant would accept. Supplemental Request for Rehearing 12. However, there is nothing presently in our rules that allows for a “Board Amendment.” *See* 37 C.F.R. § 41.50 (limiting our actions to affirmance, reversal, remand, entering a new ground of rejection, and ordering an appellant to additionally brief a matter). When the case is returned to the jurisdiction of the Examiner after our Decision, *see* 37 C.F.R. § 41.54, Appellant may work with the Examiner to remedy the indefiniteness issue.

Appellant argues for a mechanistic application of the law of indefiniteness, but as the MPEP states, “examiners should note that Office policy is not to employ *per se* rules to make technical rejections” and each case must be decided on its own facts. MPEP § 2173.02(II). It is important for examiners to consider the specific facts of each case and demand that applicants amend the claims when they are indefinite. *See Halliburton Energy Servs. v. M-L LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (noting that “the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.”). This is what the Examiner has done here.

Beginning on page 12 of the Supplemental Request for Rehearing, Appellant submits that Appellant’s arguments (that there is no support for the finding that claims 8 and 14 recite intended use) were not addressed, and that *In re Smith* requires the broadest reasonable interpretation (BRI) be developed by doing certain

things, and it must be consistent with the Specification. Supplemental Request for Rehearing, 12–14. Appellant also argues that the language of claim 14 recites structure and that this was not addressed. Supplemental Request for Rehearing 14–16.

Our discussion of the interpretation of claim 8 is set forth on pages 4–5 of the Decision mailed May 30, 2019. Our discussion of the interpretation of claim 14 is set forth on page 6 of the Decision mailed May 30, 2019. In making the determinations therein, we fully understood that “[d]uring examination, “claims . . . are to be given their broadest reasonable interpretation consistent with the specification, and . . . claim language should be read in light of the specification as it would have been interpreted by one of ordinary skill in the art.”” *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). Claim 8, by reciting that the liquid formulation is “adapted for use”, recites the intended use of the formulation.^{5,6} Importantly, Appellants have not adequately explained how such language in claim 8 connotes structure (same applies for claim 14). During examination, statements in the preamble reciting the purpose or intended use of the claimed invention must be

⁵ On page 5 of the PTAB Oral Transcript, the question of the meaning of “adapted for use” as recited in claim 8 was asked. Appellant responded that a charged particle is created that has sufficient charge that will bond to the stone dust particles. The question was also asked if it is the ingredients of the formulation that creates the charges. PTAB Oral Transcript 5. In response, Appellant stated that it is the surfactant. PTAB Oral Transcript 5–6. This supports our determination made in our Decision mailed May 30, 2019 in this regard.

⁶ We note that logic and the plain language of a claim plays a role in proper claim interpretation. *Altiris v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (explaining that to determine whether method steps should be construed to require a particular order of performance “[f]irst, we look to the claim language to determine if, as a matter of logic or grammar, [the method steps] must be performed in the order written.”).

evaluated to determine whether the recited purpose or intended use results in a structural difference between the claimed subject matter and the prior art. If so, the recitation serves to limit the claim. *See, e.g., In re Otto*, 312 F.2d 937, 938, (CCPA 1963) (The claims were directed to a core member for hair curlers and a process of making a core member for hair curlers. The court held that the intended use of hair curling was of no significance to the structure and process of making.); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962) (statement of intended use in an apparatus claim did not distinguish over the prior art apparatus). It is also noted that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)⁷ (anticipation rejection affirmed based on Board’s factual finding that the reference dispenser (a spout disclosed as useful for purposes such as dispensing oil from an oil can) would be capable of dispensing popcorn in the manner set forth in appellant’s claim 1). This similarly holds true for claim 14 as explained on page 6 of the Decision mailed May 30, 2019. Therein, we explained that the Examiner, in a similar manner as with claim 8, understands claim 14 to encompass a composition comprising a cationic and/or zwitterionic surfactant. Appellants use the composition as a coal mining dusting agent (hence it is referred to as “a coal mining dusting agent” in claim 14), but this does not change the fact that it is a composition comprising a cationic and/or zwitterionic surfactant. We therefore are unpersuaded by Appellant’s arguments in this regard.

On page 17 of the Supplemental Request for Rehearing, Appellant reiterates similar arguments already addressed, *supra*, pertaining to the 35 U.S.C. § 112, second paragraph, rejection of claim 18, and pertaining to claim scope of claims 8

⁷ We pointed this out in footnote 3 on page 6 of our Decision mailed May 30, 2019. Importantly, Appellant points to no evidence in the record showing that the prior art products do not necessarily possess the characteristics of the claimed product.

and 14. On pages 18–26, Appellant reiterates similar arguments already addressed, *supra*, with regard to whether claim 18 is properly rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. On pages 29–35, Appellant reiterates similar arguments already addressed, *supra*, pertaining to claim scope and intended use language regarding claims 8 and 14. On pages 31–32, Appellant refer to page 11 of the Reply Brief regarding certain case law in support that functional language connotes structure. As mentioned, *supra*, on pages 4–5 of this Decision on Request for Rehearing, we thoroughly reviewed the contents of Appellant’s briefs in the record in their entirety, including any cited decisions, in making our determinations set forth in our Decision mailed May 30, 2019. The cases cited on page 11 of the Reply Brief are not persuasive as they differ from the facts in the instant case since they do not involve ingredients of a formulation.

On pages 35–42 of the Supplemental Request for Rehearing, Appellant presents similar arguments already addressed, *supra*, pertaining to claim scope and intended use language pertaining to claims 8 and 14.

On page 42 of the Supplemental Request for Rehearing, Appellant discusses the language of claim 18 regarding the phrase “liquid formulation is used to treat stone dust particles applied to coal mine surface”, and submits that arguments involving such were not addressed. In making this point, it appears Appellant has overlooked the fact that because claim 18 is indefinite (the rejection of claim as being indefinite is affirmed), our analysis ended with the 35 U.S. C. 112, second paragraph rejection, as indicated on pages 3–4 of our Decision mailed May 30, 2019.

On pages 43–48 of the Supplemental Request for Rehearing, Appellant presents similar argument pertaining to the intended use language issue involving claim 8, already addressed, *supra*.

On pages 52–55, Appellant traverses the Decision mailed May 30, 2019, stating that the Decision was rendered without the benefits of the transcript. We refer to the Decision on Petition mailed on September 3, 2019 in response thereto. As pointed out on page 5 of the Decision on Petition mailed on September 3, 2019, Appellant does not provide requisite evidence of non-receipt of an Office Communication. As also pointed out on page 6 of the Decision on Petition mailed on September 3, 2019, facts are not provided as to whether Appellant contacted the Board to notify the Board that Appellant did not receive the oral hearing transcript mailed on June 12, 2019, or to point out that the transcript did not appear to be viewable in the Public PAIR system, before filing the petition. The oral hearing transcript was re-mailed on July 30, 2019, and it is viewable in Public PAIR. As also pointed out on page 6 of the Decision on Petition mailed on September 3, 2019, the mailing of an oral hearing transcript does not set the time period for response to a Decision on appeal. Appellant’s request to reset the period for reply from the re-mailing date of the transcript was declined. Decision on Petition mailed on September 3, 2019, p. 6. However, *sua sponte*, Appellant was given an extension of time to file a supplement to the Request for Rehearing. Petition mailed on September 3, 2019, pp. 6–7. We also state that Appellant points to no support for the proposition that a Decision by the same Board panel that heard oral argument should be vacated if issued prior to publication of the hearing transcript.

On page 56 of the Supplemental Request for Rehearing, Appellant submits that the level of skill in the art has not been assessed in violation of MPEP 700 and *Ex parte Frye*. We are unpersuaded by such assertions. As indicated, *supra*, in making the determinations in our Decision mailed May 30 2019, we fully understood that during examination, claims are to be given their broadest reasonable

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interpretation consistent with the specification, and that claim language should be read in light of the specification as it would have been interpreted by one of ordinary skill in the art.

In view of the above, Appellant's Request is granted to the extent that we have reconsidered our Decision, but is denied with respect to making any changes therein.

DENIED