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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IGOR MILICEVIC,
MATTHEUS JACOBUS NICOLAAS VAN STRALEN,
JOHANNES ANTOON HARTSUIKER, and
ROLAND HEUVELMANS

Appeal 2017-010094
Application 12/689,394
Technology Center 1700

Before MARK NAGUMO, JAMES C. HOUSEL, and
DEBRA L. DENNETT, *Administrative Patent Judges*.

HOUSEL, *Administrative Patent Judge*.

DECISION ON REHEARING

Appellants request rehearing of a Decision on Appeal mailed August 19, 2019, affirming the Examiner’s decision rejecting claims 1–5, 7–11, and 13–19 as unpatentable under 35 U.S.C. § 103(a), but reversing the Examiner’s decision rejecting claims 1–5, 7–11, and 13–19 as indefinite under 35 U.S.C. § 112, second paragraph.¹

A Request for Rehearing,² must state with particularity the points believed to have been misapprehended or overlooked by the Board.

¹ Hereinafter, “Decision.”

² Hereinafter, “Request.”

Arguments not raised and evidence not previously relied upon in the Briefs before the Board are not permitted in a Request for Rehearing except as permitted by 37 C.F.R. §§ 41.52(a)(2) and (a)(3). *See* 37 C.F.R. § 41.52(a)(1) (2018).

We have reconsidered the Decision in light of Appellants' comments in the Request for Rehearing filed August 19, 2019, and find no error in the disposition of the affirmed rejection. We remain of the opinion that the subject matter of the claims listed in the affirmed rejection is unpatentable.

I.

The Board's Decision affirmed the Examiner's rejection of claims 1–5, 7–11, and 13–19 under 35 U.S.C. § 103(a) as unpatentable over Han in view of Chludzinski and Thonnellier. Decision 8–14. However, the Decision reversed rejection of claims 1–5, 7–11, and 13–19 under 35 U.S.C. § 112, second paragraph, as indefinite. *Id.* at 3–8. In reversing the Examiner's indefiniteness rejection, the Decision presented an extensive claim construction for certain language recited in the claims. *Id.*

In the Request, Appellants request clarification of the basis for affirming, or reversal of, the obviousness rejection because, in Appellants' view, a prima facie case of obviousness cannot be established from the combined teachings of the applied references. Request 1. Appellants base this request on the Board's construction of the “conditionally generating” operation which Appellants contend “[incorporates] a *test and corresponding operation in response to the test result* that is carried out *during each iteration* of the collapsing process.” *Id.* at 2, 4–5. Appellants argue that the conditionally generating step cannot be met by operation of a

system that is incapable of generating an alarm and that such a system would be properly characterized as “unconditionally not-generating an alarm signal.” *Id.* at 4–5.

In addition, Appellants urge that the Board misapprehended their argument at oral hearing with regard to “collapsing” and “consolidation.” Request 2, 5. Appellants reiterate the argument that Chludzinski’s “consolidation” process is not the same as Han’s “collapsing” process, wherein the volume of gas exhausted during “collapsing” is insignificant compared to the volume of gas exhausted during “consolidation.” *Id.* at 5. Appellants urge that the purpose of this argument was to ensure that the Board was aware of a fact that bears upon the reasonableness of the Examiner’s conclusion that the ordinary artisan would have modified Han’s system to test a relatively miniscule volume of helium that flows from the space of the collapsing tube. *Id.* On this basis, Appellants request reconsideration of applying Chludzinski’s teaching regarding testing exhaust gas generated during a “consolidation” process to Appellants’ “collapsing” process. *Id.*

The Decision construed “conditionally generating” as used in claim 1 to mean that the generating step—generating an alarm signal in response to a detecting a deviation by the concentration from an expected concentration—is subject to one or more conditions or requirements, i.e., subject to the detection of a deviation by the sensed concentration from an expected concentration. Decision 5–6. The Decision further states that “this conditional step leads to two possible outcomes—one in which an alarm signal is generated because the condition is met and one in which an alarm signal is not generated because the condition is not met.” *Id.* at 6.

Moreover, the Decision relied on this construction in affirming the obviousness rejection, expressly considering and finding unpersuasive Appellants' view that the conditionally generating step is always performed such that an alarm signal is generated when the triggering condition is detected and is not generated when the triggering condition is not present. *Id.* at 9–10.

We note Appellants do not discuss the caselaw cited in the Decision in support of the Board's construction of the "conditionally generating" step. Decision 10–11. The Decision indicated that the legal principle recited in these cases—that, in method claims, a step reciting a condition precedent, as here, does not need to be performed if the condition precedent is not met—supports the Board's construction. *Id.* Therefore, Appellants have not given us any basis upon which we might rely to alter our construction of the step in question.

Turning to the new argument Appellants raised for the first time at oral hearing, we are sympathetic to Appellants attempt to ensure that relevant facts are presented on the record for consideration by the Board in rendering its decisions on appeals. We are mindful of the potential merits of an argument such as raised here by Appellants that the processes of the prior art are so different, i.e., non-analogous, that the ordinary artisan would not have applied the teachings from one prior art process to another prior art process. However, Appellants do not dispute that the argument regarding a distinction between Chludzinski's "consolidation" and Han's "collapsing" was raised for the first time at oral hearing. Nor do Appellants attempt to explain why this argument was not raised in Appellants' Appeal Brief. One purpose of ensuring arguments are raised in the Appeal Brief is to ensure

that the Board has the benefit of a response to the argument from the Examiner before rendering a decision thereon. In addition, Appellants do not address the Examiner's finding that Chludzinski and Thonnellier both disclose recovery of helium from any process step that utilizes helium in the making of optical fibers. *See* Decision 12.

Accordingly, as discussed above, Appellants have not persuasively shown that the Board misapprehended or overlooked any of the arguments raised in the Briefs in construing the claims or that the Decision to affirm the 35 U.S.C. § 103(a) rejection of claims 1–5, 7–11, and 13–19 should otherwise be modified or reversed.

III.

Appellants' Request for Rehearing has been granted to the extent that the Decision has been reconsidered in light of Appellants' arguments. However, the Request is otherwise denied, and the Decision is not modified in any respect.

This Decision on the Request for Rehearing incorporates our Decision, mailed June 18, 2019, and is final for the purposes of judicial review. *See* 37 C.F.R. § 41.52(a)(1).

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).

REHEARING DENIED