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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DANIELE PIANEZZE

Appeal 2018-000567
Application 13/510,688
Technology Center 3700

Before EDWARD A. BROWN, JAMES P. CALVE, and
JILL D. HILL, *Administrative Patent Judges*.

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–13 and 17–27, which are the pending claims. Appellant's representative presented oral argument on January 7, 2020. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART and enter a NEW GROUND OF REJECTION.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Illinois Tool Works Inc. Appeal Br. (filed Dec. 27, 2016) 2.

CLAIMED SUBJECT MATTER

Appellant's disclosure "relates to a control switch harness for the lighting of burners of a cooking range, couplable in use to the gas taps feeding the burners and provided with an optical light indication when the gas tap is open." Spec. 1, ll. 6–10.

Claims 1, 11, and 27 are independent claims. Claim 1 illustrates the subject matter on appeal.

1. A lighting control switch harness for burners of a cooking range comprising a plurality of elements connected to one another and each comprising: a body couplable in use to a respective gas tap and closed by a cover at least partially pervious to light; a printed circuit underneath the cover and carrying one or more light sources, a first switch accommodated within the body and comprising at least one fixed contact connected to the printed circuit, a mobile contact and first means carried by the body so as to be operatively couplable in use to a mobile stem of the gas tap for integrally rotating therewith and then taking the mobile contact towards the at least one fixed contact; and a second switch accommodated within the body and comprising a fixed contact, a mobile contact and second means carried by the body so as to be in use operatively couplable to the mobile stem of the gas tap for translating parallelly thereto and then taking the mobile contact towards the fixed contact; said elements being mechanically and electrically connected to one another only by means of three wires passing through the body of the various elements, a first wire being connected to a first contact of the second switch of each element, a second wire being connected to the mobile contact of the first switch of each element, and a third wire being connected to a second contact of the second switch of each element.

Appeal Br. 93 (Claims App.).

REJECTIONS

Claims 1–5, 8, 9, 11–13, 18, 19, and 21–27 are rejected under 35 U.S.C. § 103(a) as unpatentable over Böttcher² and Claprod³.

Claims 6, 10, and 20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Böttcher, Claprod, and Rada⁴.

Claims 7 and 17 are rejected under 35 U.S.C. § 103(a) as unpatentable over Böttcher, Claprod, and Painter⁵.

ANALYSIS

Claims 1–5, 8, 9, 11–13, 18, 19, and 21–27 over Böttcher and Claprod

Claims 1–5, 8, 9, 21, 23, and 25

As to claim 1, the Examiner finds that Böttcher discloses a lighting control switch harness for burners of a cooking range, the harness comprising a plurality of elements (switches 19) connected to each other, and each element comprising all claimed limitations except for “the cover being at least partially pervious to light,” “a printed circuit underneath the cover and carrying one or more light sources,” and “the fixed contact connected to the printed circuit.” Final Act. 6–7. The Examiner relies on Claprod as teaching these missing limitations and reasons that it would have been obvious to one of ordinary skill in the art to modify Böttcher in view of Claprod to include them. *Id.* at 8.

² Böttcher et al., DE 198 23 120 A1, published Nov. 25, 1999 (“Böttcher”). Both the Examiner and Appellant refer to Böttcher as “Boettcher.”

³ Claprod, US 7,926,964 B2, issued Apr. 19, 2011.

⁴ Rada et al., US 5,180,050, issued Jan. 19, 1993 (“Rada”).

⁵ Painter, US 665,459, issued Jan. 8, 1901.

Appellant and the Examiner disagree about the proper construction of the following language recited in claim 1:

*said elements being mechanically and electrically connected to one another only by means of three wires passing through the body of the various elements*⁶, a first wire being connected to a first contact of the second switch of each element, a second wire being connected to the mobile contact of the first switch of each element, and a third wire being connected to a second contact of the second switch of each element.

Appeal Br. 93 (Claims App.) (emphasis added). The Examiner interprets the connection limitation to mean that “the elements must be electrically connected by only three wires and that the elements must be mechanically connected by only three wires.” Ans. 27. The Examiner states, however, “this limitation does *not* require that the wires mechanically connecting the elements be *the same wires* that electrically connect the elements” (*id.* at 2 (emphasis added)), and “‘a wire being connected to . . . each element’ does *not* require that each element be connected by *the same wire*” (*id.* at 15).

The Examiner finds that Böttcher’s elements 19 are electrically connected by only three wires (i.e., stranded wires 12, 13, and 14) and are also mechanically connected by only three wires (i.e., stranded wires 13, 14, and anti-twist protection element 15). Final Act. 7. The Examiner further finds that wires 13, 12, and 14 correspond to the recited “first wire,” “second wire,” and “third wire,” respectively. *Id.* The Examiner appears to concede that wire 12 does *not* mechanically connect the elements together, stating that wire 12 in Böttcher “was relied upon as an electrical connection.” Ans.

⁶ We also refer to this italicized language herein as the “connection limitation.”

7. Instead, the Examiner relies on anti-protection element 15 as providing the third mechanical connection. Final Act. 7.

Appellant contests the Examiner's findings because the rejection relies on wires 12, 13, and 14, and also on "wires" 13, 14, and 15, that is, a total of four wires, and not *only three wires* as claimed. Appeal Br. 19. Appellant also contends that Böttcher's element 15 is not a wire, but an anti-rotation device. *Id.* Appellant disagrees that Böttcher's wire 12 is "a second wire being connected to the mobile contact of the first switch of each element," as claimed. *Id.* at 20 (boldface omitted). Instead, Appellant contends, a wire 12 "exists for each separate element, and does not extend to each element." *Id.* That is, Appellant's position is that Böttcher discloses multiple wires 12, each of which is for only one element, and none of the wires 12 extends to each element (i.e., every element).

Because the Examiner and Appellant disagree about the proper meaning of the connection limitation, namely, "said elements being mechanically and electrically connected to one another only by means of three wires passing through the body of the various elements," we address this construction. During examination of a patent application, claims are to be given their broadest reasonable interpretation consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). "The correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is . . . an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is 'consistent with the specification.'" *In re Smith International, Inc.*, 871 F.3d 1375, 1382–83

(Fed. Cir. 2017) (citing *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted)).

In addition to the connection limitation, claim 1 recites “*a first wire being connected to a first contact of the second switch of each element, a second wire being connected to the mobile contact of the first switch of each element, and a third wire being connected to a second contact of the second switch of each element.*” Appeal Br. 93 (Claims App.) (emphasis added). Claim 1 thus requires each one of a first wire, a second wire, and a third wire to be connected to *each* element of the plurality of elements.

As for the meaning of the connection limitation, Appellant’s Specification provides guidance. The Specification describes, “*by using only three connection wires, two microswitches acting on two different circuits can be incorporated in a single switch harness element.*” Spec. 3, ll. 22–25 (emphasis added). This indicates an advantage. The Specification further describes, “[t]he switch harness 1 comprises a plurality of elements 3 connected to one another mechanically in series and electrically in parallel, according to a feature of the invention, *by only three electric conductor wires, indicated by numerals 4, 5, and 6, respectively.*” *Id.* at 4, ll. 23–28 (emphasis added). Figure 3 depicts a lighting control switch harness 1 including three elements 3 connected to each other by wires 4, 5, and 6. Figures 1 and 4, for example, depict wires 4, 5, and 6 passing through the body 10 of an element 3. The Specification also describes:

According to the invention, *the elements 3 are mechanically and electrically connected to one another only by means of the three wires 4, 5 and 6, passing through the body 10 of the various elements 3.* In particular, the wire 4 is connected to a first contact 28 of the switch 21 of each element

3, in the non-limitative case in point to the mobile contact 28, while wire 5 is connected to the mobile contact 23 of the switch 20 of each element 3, and wire 6 is connected to the fixed contact 27 of the switch 21 of each element 3. Furthermore, the wire 4 is also electrically connected in permanent manner to the printed circuit 14 of each element 3 by means of a metallic contact terminal 30 (figure 6) carried by the body 10.

Id. at 6, ll. 5–18 (emphasis added). Figure 2 shows an element 3 that includes contacts between wire 4 and mobile contact 28 of second switch 21, wire 5 and mobile contact 23 of first switch 20, and wire 6 and fixed contact 27 of second switch 21.

Construing the language of claim 1 consistent with the supporting disclosure, we agree with Appellant that the claim language requires the plurality of elements to be *both* electrically *and* mechanically connected by *only* three wires. In other words, the *same* three wires provide *both* the recited electrical and mechanical connections of each of the elements. We further construe claim 1 consistent with the disclosure to require that the three wires that provide both electrical and mechanical connections to each of the elements *are* the recited first wire, second wire, and third wire. The Examiner’s construction of the disputed language is inconsistent with the plain language of claim 1 interpreted in light of Appellant’s disclosure.

Böttcher describes “single stranded wires 12, 13, and 14” as shown in Figure 5. Böttcher ⁷, Fig. 5. Böttcher also describes anti-twist protection element 15 shown in Figure 5, as being “configured as a linear mounting element and consist[ing] of wires.” *Id.* at 14, Fig. 5. We agree with

⁷ Herein, all citations to Böttcher refer to the English-language translation by Schreiber Translations, Inc. (dated March 2016), of record in the present application.

Appellant that the Examiner has not established by a preponderance of the evidence that Böttcher discloses the connection limitation *and* the first, second, *and* third wires, as recited in claim 1. Even if each one of wires 13 and 14 provides both electrical and mechanical connections between each of the switches 19 shown in Figure 5 of Böttcher, and wires 13 and 14 can also be considered to correspond to the recited first wire and third wire, respectively, we agree with Appellant that the Examiner still has not established that Böttcher discloses (i) *only* three wires that provide *both* electrical and mechanical connections between *each* of the multiple switches 19 and (ii) the second wire, as claimed. Böttcher describes that “[t]he single stranded *wires* 12 for the signaling contact are integrated in the circuit for the signal display, which is not depicted in detail.” *Id.* at 15 (boldface omitted, emphasis added). Figure 5 of Böttcher shows a separate wire 12 connected to each individual switch 19, that is, multiple wires 12. As such, Figure 5 does not disclose a single wire 12 that is both electrically *and* mechanically connected to *each* switch 19 (i.e. to every switch 19), or that is “connected to the mobile contact of the first switch *of each element*,” as required by claim 1. To the contrary, no single disclosed wire 12 is either electrically *or* mechanically connected to *each* switch 19, and further, a plurality of wires 12 considered in combination provide only an electrical connection to the multiple switches 19 in Figure 5 as the Examiner finds. *See* Final Act. 7.

In the Examiner’s Answer, the Examiner states the following about claim 23:

[A]ppellant’s claim 23 states “wherein the first wire, the second wire and the third wire make up the three wires passing through

the body of the various element that mechanically and electrically connect the elements.” *This limitation further demands that wire 12 of [Böttcher] be a mechanical connection to the elements. When viewing [Böttcher] alone, this is clearly not the case.* However, claim 23 is rejected over [Böttcher], in view of Claprod. The modification of Claprod places the lights in the catenary elements of [Böttcher]. *Wire 12 of [Böttcher] will therefore not extend to an alternate location on the stove as seen in figure 5, but to each subsequent element like wires 13 and 14.* Therefore, by the modification of Claprod, wire 12 of [Böttcher] will also mechanically connect the catenary elements. Furthermore, since wire 15 of [Böttcher] is a purely mechanical connection for the elements, its inclusion in the catenary of [Böttcher] *is obviated by the presence of element 12 which now mechanically connects each element.*

Ans. 28–29 (emphasis added).

Claim 23 depends from claim 1 and recites the limitation “wherein the first wire, the second wire and the third wire *make up* the three wires passing through the body of the various elements that mechanically and electrically connect the elements.” Appeal Br. 97 (Claims App.) (emphasis added). As discussed above, however, we construe the limitation “three wires passing through the body of the various elements” in claim 1 as corresponding to the first wire, second wire, and third wire. In claim 23, we construe the term “make up” as meaning “are” or “correspond to.” Consequently, we construe claim 23 as not further limiting claim 1.

The Examiner’s erroneous claim construction for claim 1 led to the erroneous findings that Böttcher discloses the connection limitation and the recited first, second, *and* third wires. Having made these findings, the Examiner does not propose any modification of Böttcher in view of Claprod to meet these limitations of claim 1 as required by their proper

construction. Consequently, the Examiner's proposed combination does not support the rejection of claim 1 because it fails to account for and cure the missing limitations of Böttcher. Because the Examiner's conclusion that it would have been obvious to modify Böttcher in view of Claprod to result in the claimed lighting control switch harness of claim 1 is not supported by an adequate factual basis, the legal conclusion is in error. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (holding that "[t]he legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.")

It is unclear whether the Examiner may be implying that the teachings of Claprod may be applicable to cure any deficiencies of Böttcher as to the limitations of claim 1. However, the Examiner has not provided such additional findings or articulated reasoning with a rational underpinning. *See* Final Act. 6–8. For example, the Examiner's comments regarding claim 23 fail to explain adequately how Böttcher would be modified by replacing the multiple individual wires 12 with only a single wire 12 that passes through the body of each switch 19 and electrically and mechanically connects the switches, and where the single wire 12 is also "connected to the mobile contact of the first switch of each element," as required for the second wire in claim 1. Nor has the Examiner provided an adequate reason with a rational underpinning why one of ordinary skill in the art would have made such modification. Accordingly, the Examiner has not established a *prima facie* case of obviousness for claim 1.

Moreover, claim 1 recites "*first means* carried by the body so as to be operatively couplable in use to a mobile stem of the gas tap for integrally rotating therewith and then taking the mobile contact towards the at least one

fixed contact.” Appeal Br. 93 (Claims App.) (emphasis added). Appellant indicates that the “first means” corresponds to reference number 24 shown in Figure 5. *Id.* at 4. The Specification describes means 24, as follows:

The means 24 consist of a ring idly guided into the first hole 33 and equipped radially on the inside thereof with (known) angular fastening means 35 to the mobile stem 25 and on the radially outside thereof with an overhanging radial appendix 36 which extends into the body 10 and cooperates with the mobile contact 23.

Spec. 7, ll. 4–9 (emphasis added).

The Examiner construes the claimed first means as corresponding to “element 36 of figure 5 which is disclosed in the specification as ‘radial appendix.’ This limitation will therefore be interpreted as a radial appendix or a structural equivalent thereof.” Final Act. 5. The Examiner finds that, in Böttcher, “[t]he first means carried by the body is the radial appendix 7c.” *Id.* at 26.

Claim 1 further recites “*second means* carried by the body so as to be in use operatively couplable to the mobile stem of the gas tap for translating parallelly thereto and then taking the mobile contact towards the fixed contact.” Appeal Br. 93 (Claims App.) (emphasis added). Appellant indicates that the recited “second means” corresponds to reference number 29 shown in Figure 4. *Id.* at 4. The Specification describes “means 29,” as follows:

The means 29 consist of a cup-shaped bush mounted coaxially with the ring 24, with the interposition of a helical spring 37 (visible in figure 5 where the bush 29 is removed), which bush 29 is thoroughly and slidingly guided into the second hole 34 and designed to be thoroughly crossed, in use, by the mobile stem 25.

Spec. 7, ll. 14–19 (emphasis added). Bush 29 is provided with a radial arm 38. *Id.* at 7, ll. 20–22, Figs. 4, 6.

The Examiner construes the second means as corresponding to “element 38 of figure 4 which is disclosed in the specification as ‘radial arm.’ This limitation will therefore be interpreted as a radial arm or a structural equivalent thereof.” Final Act. 5. The Examiner finds that, in Böttcher, “[t]he bottom face or lip of element 7 is the second means.” *Id.* at 26.

The use of the claim term “means” in “first means” and “second means” creates a presumption that § 112, ¶ 6 applies. *Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1349 (Fed. Cir. 2015) (citation omitted). This presumption is overcome when the limitation also includes the structure necessary to perform the recited function. *TriMed, Inc. v. Stryker Corp.*, 514 F.3d 1256, 1259–60 (Fed. Cir. 2008). If a claim term is determined to invoke § 112, sixth paragraph, then the term is construed “by identifying the ‘corresponding structure, material, or acts described in the specification’ to which the claim term will be limited.” *Robert Bosch, LLC v. Snap-On Inc.*, 769 F.3d 1094, 1097 (Fed. Cir. 2014) (citation omitted). Claim 1 does not recite any structure for performing the recited function of either the first means or second means.

Although the Examiner referred to Appellant’s Specification to identify the corresponding structure of the first means and second means, according to § 112, sixth paragraph analysis, we agree that the Examiner has not construed these terms consistent with Appellant’s disclosure. As for the claimed first means, the Specification describes the corresponding structure as ring 24 having an angular fastening means 35 and an overhanging radial

appendix 36. Spec. 7, ll. 4–9. The Specification does not appear to describe the first means as being only the radial appendix, as the Examiner appears to find. Further, we agree with Appellant that switch curve 7c disclosed in Böttcher does not have a structure that is the same as or equivalent to the structure disclosed in Appellant’s Specification as corresponding to the claimed first means.

As for the claimed second means, the Specification describes the corresponding structure as a cup-shaped bush 29 provided with a radial arm 38. *Id.* at 7, ll. 14–22. The Specification does not describe the second means as being only the radial arm 38, as the Examiner appears to find. Further, we agree with Appellant that the bottom face of actuating element 7 in Böttcher does not have a structure that is the same as or equivalent to the structure disclosed in Appellant’s Specification corresponding to the claimed second means.

For the foregoing reasons, we do not sustain the rejection of claim 1, or dependent claims 2–5, 8, 9, 21, 23, and 25, as unpatentable over Böttcher and Claprod.

Claims 11–13, 18, 19, 22, 24, and 26

Claim 11 recites a lighting control switch harness comprising a plurality of elements connected to each other and that

the elements are mechanically and electrically connected to one another only by three wires passing through the body of the various elements, a first wire being connected to a first contact of the second switch of each element, a second wire being connected to the mobile contact of the first switch of each element, and a third wire being connected to a second contact of the second switch of each element.

Appeal Br. 95–96 (Claims App.) (emphasis added).

The Examiner finds that Böttcher discloses these limitations of claim 11 for reasons similar to those stated for claim 1. Final Act. 12. As discussed above, however, the Examiner’s finding that Böttcher’s multiple individual *wires* 12 meet the limitation of “a second wire being connected to the mobile contact of the first switch of *each element*” is incorrect as being premised on an erroneous claim construction. Even if Böttcher’s wires 13 and 14 provide both electrical and mechanical connections between each of the switches 19 shown in Figure 5, and wires 13 and 14 can be considered to correspond to the recited first wire and third wire, the Examiner fails to establish that Böttcher discloses *only* three wires that provide both electrical and mechanical connections between each of the switches 19, as required by claim 11. The Examiner’s reliance on Claprod in rejecting claim 11 does not cure these deficiencies of Böttcher.

Accordingly, we do not sustain the rejection of claim 11, or dependent claims 12, 13, 18, 19, 22, 24, and 26, as unpatentable over Böttcher and Claprod.

Claim 27

Appellant indicates that “[c]laims 1 and 11 are the rejected independent claims that Appellant[] appeals.” Appeal Br. 4. Consistent with this statement, Appellant presents argument for patentability for claims 1 and 11, but not for claim 27. *Id.* at 7–91. Because Appellant does not challenge the rejection of claim 27, Appellant has waived any argument of error, and we summarily sustain the rejection of claim 27 as unpatentable over Böttcher and Claprod. *See In re Berger*, 279 F.3d 975, 984, 985 (Fed.

Cir. 2002) (holding that the Board did not err in sustaining a rejection under 35 U.S.C. § 112, second paragraph, when the applicant failed to contest the rejection on appeal).

Claims 6, 10, and 20 over Böttcher, Claprood, and Rada

Claims 7 and 17 over Böttcher, Claprood, and Painter

Claims 6, 7, 10, and 17 depend from parent claim 1, and claim 20 depends from claim 11. The Examiner's reliance on Rada and Painter fails to cure the deficiency in the rejection of claim 1 or 11. Final Act. 19–25. Accordingly, we do not sustain the rejection of claims 6, 10, and 20 as unpatentable over Böttcher, Claprood, and Rada, or the rejection of claims 7 and 17 as unpatentable over Böttcher, Claprood, and Painter, for the same reasons as for claims 1 and 11.

New ground of rejection of claims 23 and 24

We construe claim 23 as not further limiting the subject matter of claim 1. Claim 24, which depends from claim 11, recites the same limitation as claim 23. Appeal Br. 97 (Claims App.). Likewise as for claim 23, we also construe claim 24 as not further limiting claim 11. Thus, we conclude that claims 23 and 24 fail to comply with the requirements of 35 U.S.C. § 112, fourth paragraph.⁸ Therefore, pursuant to 37 C.F.R. § 41.50(b), we

⁸ According to 35 U.S.C. § 112, fourth paragraph, “[s]ubject to the following paragraph [i.e., 35 U.S.C. § 112, fifth paragraph], a claim in dependent form shall contain a reference to a claim previously set forth *and then specify a further limitation of the subject matter claimed*. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.” (Emphasis added).

enter a new ground of rejection of claims 23 and 24 under 35 U.S.C. § 112, fourth paragraph.

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/ Basis	Affirmed	Reversed	New Ground
1–5, 8, 9, 11–13, 18, 19, 21–27	§ 103(a)	Böttcher, Claprod	27	1–5, 8, 9, 11–13, 18, 19, 21–26	
6, 10, 20	§ 103(a)	Böttcher, Claprod, Rada		6, 10, 20	
7, 17	§ 103(a)	Böttcher, Claprod, Painter		7, 17	
23, 24	§ 112, fourth paragraph				23, 24
Overall Outcome			27	1–13, 17– 26	23, 24

FINALITY OF DECISION AND RESPONSE

This Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, [Appellant], within two months from the date of the decision, must exercise one of the following two options with respect to

the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the Examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection designated in the decision. Should the examiner reject the claims, [Appellant] may again appeal to the Board pursuant to this subpart.
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in MPEP § 1214.01.

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).

AFFIRMED IN PART; 37 C.F.R. § 41.50(b)