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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VLADIMIR GAMALEY, GILI NACHUM,
ANDREW L. SCHIRMER, and EITAN SHAPIRO¹

Appeal 2018-002341
Application 14/074,896
Technology Center 2100

Before JASON V. MORGAN, JEREMY J. CURCURI, and
JON M. JURGOVAN, *Administrative Patent Judges*.

MORGAN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is a decision on Appellant's Request for Rehearing, filed under 37 C.F.R. §§ 41.52(a)(1), (4), requesting that we designate our Decision of June 19, 2019—wherein we affirmed the Examiner's rejection of claims 21–40—as containing a new ground of rejection. We have reconsidered our Decision in light of Appellant's request, and we have found no basis for entering a new ground of rejection designation. We, therefore, decline to change the Decision.

Appellant's request is denied.

¹ Appellant is the applicant and real party in interest, International Business Machines Corporation (IBM Corp). Appeal Br. 1.

DISCUSSION

In the Answer, the Examiner entered a new ground of rejection, explicitly designated as such, of claims 21–40 under 35 U.S.C. § 112(b) as being indefinite because “[t]he term ‘recent’ . . . is a relative term which renders the claim[s] indefinite.” Ans. 4; *see also id.* at 2 (providing the heading “NEW GROUNDS OF REJECTION”). The Examiner found “[t]he term ‘recent’ is not defined by the claim[s], the [S]pecification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.” *Id.* at 4–5. Appellant disagreed, arguing that “recent” meant “some predetermined time period.” Reply Br. 7. We found Appellant’s arguments unpersuasive “[b]ecause the Specification fail[ed] to define what the term *recent* means, because Appellant fail[ed] to provide persuasive evidence to support Appellant’s proffered interpretation of the *recent* recitation, and because the evidence of record provide[d] evidence of at least one meaning for *recent* that differs from what Appellant proffer[ed].” Dec. 5. Therefore, we affirmed the Examiner’s rejection under 35 U.S.C. § 112(b). *Id.*

In arguing that we entered an undesignated new ground of rejection as part of our affirmance, Appellant argues that the Examiner relied solely on the finding that the Specification fails to define the term *recent* in setting forth the 35 U.S.C. § 112(b) rejection. Req. Reh’g 6–7. Appellant argues we inappropriately further relied on Appellant’s failure to provide persuasive evidence to support Appellant’s proffered interpretation of the *recent* recitation and on additional evidence in the record not cited by the Examiner in affirming the Examiner’s rejection. *Id.*

Appellant’s arguments are unpersuasive because the disputed facts and analyses that Appellant argues “represent multiple new thrusts of the rejection to which Appellants have not had a fair opportunity to respond” (*id.* at 7) were directed to the merits of Appellant’s arguments as set forth in the Reply Brief. Specifically, Appellant argued (1) that the Specification’s disclosed “example of recentcy [sic]” and (2) the use of the term *recent*, as found in over 11,000 previously issued patents, were pertinent to the meaning of the term *recent* and whether it was definite. Reply Br. 6–7. That is, rather than merely asserting the Examiner’s findings and conclusions were erroneous, Appellant proffered affirmative bases for reversing the Examiner. As such, we properly reviewed each of these affirmative bases for reversal.

With respect to the Specification’s “example of recentcy” (*id.* at 6), we identified the specific disclosure in the Specification Appellant referred to and properly ascertained that it failed to disclose “what it means for an event to be *recent* for purposes of including its topic or posts among those that are ranked.” Dec. 4 (citing Spec. ¶ 30). With respect to Appellant’s broad invitation to consider the pertinence of “[t]he term ‘recent’ [as] found in a great multitude [(over 11,000)] of issued U.S. Patents” (Reply Br. 7), we reasonably ascertained that it was unnecessary to go any further than a search through the prior art already of record, which included a patent with a disclosure relevant to whether the Appellant’s proffered meaning for the term *recent* was correct (Dec. 4–5 (citing Parnaby ¶ 113 (cited in Final Act. 3))).

In both cases, we did not rely on new facts and rationales not previously raised to the Appellant by the Examiner in a manner depriving

Appellant of the “fair opportunity to react to the thrust of the rejection.” *Rambus Inc. v. Rea*, 731 F.3d 1248, 1255 (Fed. Cir. 2013) (quoting *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011)) (cited in Req. Reh’g 2). In *Rambus*, the Examiner’s finding in support of the combination of prior art references was itself erroneous—the Board supplied its own reasons, thus *supplanting* the Examiner’s findings rather than *elaborating* on them with more detail. *Rambus*, 731 F.3d at 1256 (citing, e.g., *In re Adler*, 723 F.3d 1322, 1328 (Fed. Cir. 2013)).

In contrast, we did not find the Examiner’s findings erroneous; we properly responded to Appellant’s arguments, which included affirmative bases going beyond the Examiner’s rejection as to why the Examiner’s rejection should be reversed rather than merely identifying weaknesses in the Examiner’s findings and analysis. We neither ignored Appellant’s proffered affirmative bases nor mistook them as unassailable simply because they had been set forth in the Reply Brief and thus had not been rebutted by the Examiner. Instead, we analyzed the merit of Appellant’s affirmative bases for reversal and, having found them unpersuasive, cited to evidence of record and provided explanations showing why the affirmative bases were unpersuasive. Therefore, rather than changing the thrust of the Examiner’s rejection, we properly elaborated on the Examiner’s findings without providing Appellant inadequate opportunity to react to the thrust of the rejection. *Rambus*, 731 F.3d at 1255–56.

Similarly, Appellant’s contentions that it was incumbent on us to designate portions of decision as containing new grounds of rejection based on *In re Stepan Co.*, 660 F.3d 1341 (Fed. Cir. 2011), *In re Leithem*, 661 F.3d 1316 (Fed. Cir. 2011), *In re DeBlauwe*, 736 F.2d 699 (Fed. Cir. 1984), and

In re Kronig, 539 F.2d 1300 (CCPA 1976) are unsupported by the cited authorities. See Req. Reh’g 2–3. In *Stepan*, the Board changed the statutory basis under which claims were rejected. 660 F.3d at 1343. We did not change the statutory basis of the rejection. In *Leithem*, the Board found that, contrary to the Examiner’s finding, cited prior art failed to disclose fluffed pulp, and the Board instead found that the prior art pulp *could be* fluffed (i.e., that it would have been obvious to fluff). 661 F.3d at 1318. We did not find error in the Examiner’s findings or supplant them with our own. In *DeBlauwe*, the Board failed to point out that there was no objective evidence of unexpected results, as the Solicitor argued on appeal, thus warranting remand to afford the Appellants the opportunity to submit such results. 736 F.2d at 704, 706. We pointed out the shortcomings in Appellant’s arguments rather than leave them unaddressed until appeal before the Court of Appeals for the Federal Circuit. And in *Kronig*, the Board’s reliance on fewer references than the Examiner relied on in rejecting claims as obvious was *not* deemed to set forth a new ground of rejection. 539 F.2d at 1303. Although the facts differ, the case here is similar to *Kronig* to the extent that “[t]he basic thrust of the rejection at the [E]xaminer and [B]oard level was the same, and . . . [A]ppellant[] . . . had fair opportunity to react to that rejection.” *Id.* Accordingly, Appellant fails to show why any of these cases demonstrate that we erred by not designating our Decision as containing a new ground of rejection.

Appellant further argues we erroneously cited *Ex parte McAward*, No. 2015-006416, 2017 WL 3669566 (PTAB Aug. 25, 2017) (precedential), as legal support. Req. Reh’g 3. Appellant argues that, had this case been cited previously, Appellant would have been able to make an argument with

respect thereto. *Id.* at 4. The precedential *Ex parte McAward* decision, however, merely represented an interpretation of the law relied on by the Examiner, 35 U.S.C. § 112(b), to reject the claims. Ans. 4. Being set forth in a precedential opinion, this interpretation of the law was binding on us at the time of the Decision. It was, in fact, issued and made precedential before Appellant filed the Reply Brief. *See* 2017 Annual Report, Patent Public Advisory Committee, USPTO, 22, available at <https://www.uspto.gov/web/offices/com/sol/og/2017/week48/2017PPACAnnualReport.pdf>.

Appellant does not provide persuasive support for the apparent contention that it is the duty of the Board to apprise Appellant of relevant binding authorities for correctly *interpreting* the law and setting forth the most effective arguments in light thereof. The requirement to provide notice under 5 U.S.C. § 554(b)(3) of the matters of fact and law asserted “has been applied to mean that ‘an agency may not change theories in midstream without giving respondents reasonable notice of the change’ and ‘the opportunity to present argument under the new theory.’” *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1080 (Fed. Cir. 2015) (quoting *Rodale Press, Inc. v. FTC*, 407 F.2d 1252, 1256–57 (D.C. Cir. 1968)). Appellant does not, however, show how citing to a relevant authority, *Ex parte McAward*, to set forth the proper interpretation of the law changed the theory of the case.

In summary, Appellant’s arguments as to why we erred in not designating the Decision as containing new grounds of rejection relate either to: (1) our analysis in response to Appellant’s proffered affirmative arguments and evidence or (2) our citation of binding precedent, available to Appellant before the filing of the Reply Brief, interpreting the law at issue.

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Appellant does not show that either such analysis or such citation must be designated as setting forth a new ground of rejection.

Accordingly, we have reviewed the Decision in light of Appellant's Request for Rehearing, but we do not make any modifications to the Decision. Appellant's Request for Rehearing is DENIED.

DENIED