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ABB - Whitmyer IP Group LLC 600 Summer Street Stamford, CT 06901			HINSON, RONALD	
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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 ADAM MICHALIK, PATRICIA RICKETTS,
MASSIMO CARMIGNOTO, JAYRAM YADAVA, ROBERTO ZANNOL,
MILJENKO HRKAC, ALESSANDRO MATTOZZI, CLAIRE PITOIS,
EMMANOUIL LOGAKIS, HARALD MARTINI, ILARIO SCIAN,
ORLANDO GIRLANDA, RUDI VELTHUIS, and SPIROS TZAVVALAS

Appeal 2018-004280
Application 14/652,716
Technology Center 2800

Before ST. JOHN COURTENAY III, THU A. DANG, and
JOHN A. EVANS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant¹ filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.52(a)(1) for reconsideration of our Decision on Appeal, mailed July 30, 2019 (“Decision”). Our Decision affirmed the Examiner’s decision rejecting all the claims 1–20 under 35 U.S.C § 103.

¹ We use the word “Appellant” to refer to “Applicants” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as “ABB Schweiz AG, CH-5400 Baden, Switzerland.” App. Br. 2.

We have reconsidered our Decision, in light of Appellant's arguments in the Request, and are not persuaded that we misapprehended or overlooked any points in rendering our Decision.

In the Request, Appellant does not substantively traverse the analysis set forth in our Decision. Rather, Appellant seeks acknowledgment that our analysis of the Examiner's obviousness rejection in the Decision qualifies as an undesignated new grounds of rejection under our procedural rules:

The relief sought in this paper is acknowledgment that one or more rejections in the Decision qualify as undesignated new ground(s) of rejection pursuant to Rules 41.50(c) and 41.52(a)(4). Acknowledgement of new grounds is appropriate because there are numerous instances in which the Decision implicitly acknowledges deficiencies in the Examiner's Rejection, offers new alternative grounds of rejection, makes new claim interpretations, and cites evidence not relied on by the Examiner. Appellants recount these instances in the following subsections.

Appellants desire to go back to the Examiner without filing a Request for Continued Examination following designation of the Decision as including new grounds. Appellants refrain from arguing error in the Decision and merely request that it be designated as including new grounds pursuant to Rules 41.50(c) and 41.52(a)(4).

Moreover, because the Appellants argued only the independent claims to achieve allowability of all remaining claims, acknowledgement of new grounds of rejection would therefore apply to all remaining claims.

Request 1.

Appellant enumerates several reasons why it is believed that our Decision presents a new grounds of rejection in conflict with the Examiner's rejection. *See* Request 1–3.

For example, Appellant argues:

Indeed, this is shown in how the Decision further conflicts with the Examiner's Answer and Final Office Action in relation to the teaches of Rolling. As described above, the Examiner cited Rolling as disclosing a non-porous composite material that does not allow a liquid to penetrate into or through the insulator. (See Examiner's Answer at 7; *cf* Final Office Action dated May 2, 2017 at 2.) In stark contrast, the Board found that Rolling disclosed an insulator that is *impregnated* with oil. (Decision at 14.) This is *precisely what the Appellants argued* showed that Rolling does not disclose a non-porous composite material that does not allow a liquid to penetrate into or through the insulator. (See, e.g., Appellants' Brief (Exhibit D hereto) at 7-10.) Thus, the Board in fact agreed with Appellants regarding the teachings of Rolling and instead found the claimed composite material was disclosed in Gainer.

The Board also notably agreed with Appellants that the claim language "the composite material does not allow for a liquid to penetrate into or through the insulator" describes "a property of the composite material." (Decision at 8.) In the Examiner's Answer, the Examiner referred to the claim language as "functional limitations . . . which are narrative in form," which the Examiner gave "little patentable weight." (Examiner's Answer at 3.)

Additionally, the foregoing constitutes a new rejection despite the fact that the Examiner relied on Gainer as disclosing the elements of dependent claim 2, which is directed to an embodiment of the claimed "resin matrix." A new rejection exists because the "resin matrix" is a comprised element of the claimed non-porous composite material. Accordingly, even if the Examiner was correct to rely on Golner as disclosing the claimed "resin matrix," this disclosure does not equate with a rejection of independent claim 1 as the claimed "resin matrix" is only one element of independent claim 1.

For at least these reasons, the Board's conclusions in the Decision do not constitute an affirmance of the Examiner. Rather, the Decision issues new grounds of rejection as the Decision directly conflicts with the Examiner, who explicitly did not rely upon Golner as disclosing a non-porous composite.

Request 3.

We have reviewed Appellant's arguments in the Request, our Decision, and have again reviewed the Examiner's obviousness rejection, and the Examiner's responses to Appellant's arguments as set forth in the Answer. As correctly noted by Appellant (Request 1), the new argument that the Board's Decision purportedly contains an undesignated new ground of rejection is expressly permitted under 37 C.F.R. § 41.52(a)(4).

For essentially the same reasons argued by Appellant in the Request, and to accord Appellant procedural due process on appeal, we agree to modify our Decision only to the extent that we designate our Decision as a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

DECISION

We grant Appellant's Request for Rehearing only to the extent that we have reconsidered our Decision and have modified it to be a new ground of rejection under 37 C.F.R. § 41.50(b).

Section 41.50(b) provides that "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review." Thus, WITHIN TWO MONTHS FROM THE DATE OF THIS REHEARING DECISION, Appellant 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 newly 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 proceeding will be remanded to the Examiner;² **or**

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record.

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). *See* 37 C.F.R. § 41.50(f).

REHEARING GRANTED

² Regarding option (1), “*Reopen prosecution,*” and particularly regarding the requirement to submit *an amendment and/or new evidence*, please note MPEP 1214.01(I): “If the appellant submits an argument without either an appropriate amendment or new evidence as to any of the claims rejected by the Board, *it will be treated as a request for rehearing* under 37 C.F.R. 41.50(b)(2).” If for any reason Appellant desires to reopen prosecution before the Examiner *without submitting an amendment and/or new evidence*, a Request for Continued Examination (RCE) that complies with 37 C.F.R. § 114 will remove the application from the jurisdiction of the Board under 37 C.F.R. §41.35, and will reopen prosecution before the Examiner.