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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/141,567	04/28/2016	John Nicholas Gross	JONK 2015-2CIP2	7332
23694	7590	09/25/2019	EXAMINER	
Law Office of J. Nicholas Gross, Prof. Corp. PO BOX 9489 BERKELEY, CA 94709			KING, DOUGLAS	
			ART UNIT	PAPER NUMBER
			2824	
			NOTIFICATION DATE	DELIVERY MODE
			09/25/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JOHN NICHOLAS GROSS and DAVID K.Y. LIU

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Appeal 2018-006248  
Application 15/141,567  
Technology Center 2800

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Before KAREN M. HASTINGS, JENNIFER R. GUPTA, and  
LILAN REN, *Administrative Patent Judges*.

HASTINGS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is in response to a Request for Rehearing (“Request”), dated July 22, 2019, of our Decision, mailed May 21, 2019 (“Decision”), wherein we affirmed the Examiner’s § 103 rejections of claims 1–20, as well as the Examiner’s § 112 rejection for lack of written description of claim 5, and § 112 rejection for indefiniteness of claims 4–13. Appellant’s<sup>1</sup> request of reconsideration is limited to the § 112 rejection for lack of written description and the § 103 rejections (Request 3, footnote 1).

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<sup>1</sup> Appellant is the Applicant, Jonker LLC, which is also stated to be the real party in interest (Appeal Br. 2).

We have reconsidered our Decision of May 21, 2019, in light of Appellant's comments in the Request for Rehearing, and we find no error in the disposition of the disputed §§ 103 and 112 rejections.

We have reviewed the arguments set forth by Appellant in the Request. However, we remain of the opinion that the subject matter of claims 1–20 is properly rejected and unpatentable under 35 U.S.C. § 103(a), and that claim 5 is properly rejected under 35 U.S.C. § 112 as lacking written description.

*The § 112 Rejection for Lack of Written Description Rejection*

Appellant argues that the written description rejection did not address the actual claim language because the “Board was led astray by the Examiner’s incomplete recitation of the claim language” (Request 3) and that the “exact make up” of the isolated element of any “intermediary processing system” is not material to the function or goal of the claim (Request 4). Appellant further contends that the rejection is in error because the present disclosure is not directed to an unpredictable chemical or biological art (Request 6). These arguments are not persuasive.

First, “the intermediary processing system” may be viewed as inextricably intertwined with the end-to-end ephemeral channel such that the exact make up of such intermediary system is not immaterial as urged by Appellant. Thus, contrary to Appellant’s position, the Examiner’s rejection is not impermissibly directed to an isolated element.

Second, Appellant’s contentions that the Examiner did not suggest there would be “undue experimentation,” that the Board’s reliance on *LizardTech* is misplaced (Request 5), and that because the present disclosure does not relate to an unpredictable chemical or biological art, there is no

written description problem with claiming any intermediary processing system to process the ephemeral data (Request 6), are unpersuasive. It is well established that the written description requirement is a separate requirement from the enablement requirement. Although these requirements may be closely related in a situation where a generic claim limitation is at issue (as here), the Examiner's failure to provide a specific "argument or suggestion" (Request 5) that undue experimentation would be required is not fatal for a lack of written description requirement for the entire scope of the disputed claim limitation. Whether this is predictable art or not (and we do not concede that it is a predictable art), we have already determined that the scope of what is considered ephemeral memory, data, and parameters is not limited (Decision 8, 9). Compliance with the written description requirement is a question of fact and is determined on a case-by-case basis. *Centocor Ortho Biotech, Inc. v. Abbott Labs.*, 636 F.3d 1341, 1347 (Fed. Cir. 2011); *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991); *In re Alton*, 76 F.3d 1168, 1171–72 (Fed. Cir. 1996). We see no error in the Examiner's determination that the Specification fails to sufficiently describe the scope of the entire claim limitation by generically reciting ephemeral data treatment by any intermediary processing system:

wherein said set of ephemeral parameters further operate to effectuate an end-to-end ephemeral channel, by specifying and controlling data treatment by any intermediary processing systems between the first wireless communications device and said second communications device such that such intermediary processing systems store such ephemeral data in an ephemeral non-volatile memory or an ephemeral storage.

(Claim 5, Claims Appendix).

Accordingly, we decline to modify our decision to affirm the Examiner's § 112 rejection for lack of written description of claim 5.

*The § 103 Rejections*

Appellant argues that the decision reached by the merits panel includes a new ground of rejection because it relies upon an admission of prior art that is inaccurate and was never relied upon by the Examiner (Request 7).

We disagree.

“[T]he ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976). The mere fact that the Examiner did not rely upon Appellant's admission of prior art is not a basis for calling our affirmance a new ground of rejection. The Examiner's rejection relies upon modifying a conventional flash drive with an automatic deleting feature (e.g., Ans. 3, 4, summarizing the Final Action obviousness rejection). Appellant's Specification admission merely bolsters the reasonableness of such a rejection. One of ordinary skill in the art would have inferred that “from the perspective of mobile device 400, device 410 preferably appears as a conventional flash drive” (Spec. 14) means that the device 400 could interface with a conventional flash drive. Thus, contrary to Appellant's position, this Board did not change the basic thrust of the Examiner's rejection and introduce a new ground of rejection.

Appellant's rehash of arguments previously presented in the Appeal and Reply Briefs are unpersuasive for reasons detailed in the Decision and

the Examiner's Answer. This is because the arguments fail to consider what the applied prior art would have suggested to an artisan with ordinary creativity and skill. Contrary to Appellant's assertion, the Board did not overlook the claim limitation "such that said data cannot be read again after any first read access is made to such data within the ephemeral non-volatile memory device" (claims 1 and 5; Request 9). One of ordinary skill would have reasonably inferred that erasing the data may occur "after a first read access" as recited in each of claims 1 and 5 based on the applied prior art.<sup>2</sup>

Appellant's failure to raise an argument for patentability in the principal Brief on Appeal cannot be corrected in a Request for Rehearing. *See Cooper v. Goldfarb*, 154 F.3d 1321, 1331 (Fed. Cir. 1998) (citing *Moller v. Harding*, 214 USPQ 730, 731 (BPAI 1982), *aff'd*, 714 F.2d 160 (Fed. Cir. 1983) (table) ("A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.")); 37 C.F.R. § 41.52 (indicating that presentation of a new argument in a request for Rehearing is untimely and inappropriate).

Accordingly, to the extent that some of Appellant's arguments in the Request are new, and/or based on new arguments raised in the Reply Brief (e.g., Request 12–14 arguments regarding Banerjee), they are untimely.

As our precedents make clear, the analysis of obviousness under § 103 "need not seek out precise teachings directed to the specific subject matter of

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<sup>2</sup> It is noted that each of independent claims 1 and 5 states that the automatic erasing data from the second communications device is "based on" a response to any one of a read access, a time expiration, or any predetermined event, then each claim states "wherein said automatically erasing effectuates [a treatment] such that said data cannot be read again after any first read access is made to such data within the ephemeral non-volatile memory device."

the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417–18 (2007). Accordingly, no persuasive merit is present in Appellant’s arguments with respect to the obviousness rejections.

Appellant’s argument that we adopted an unreasonable claim construction by the Examiner for claim 3 (Request 14) is not persuasive for reasons set out in the Decision (Decision 12). Appellant’s argument that we overlooked Appellant’s arguments for claims 9, 11, 12, and 18 (Request 15) is not persuasive. The merits panel stated that “[w]e sustain the rejections for the reasons expressed by the Examiner” (Decision 3). We also point out that, in our view, Appellant has not presented any further substantive arguments for the remaining dependent claims (Decision 13). Appellant’s statements with respect to claims 9, 11, 12, and 13 are conclusory (Appeal Br. 16) and are considered to be not much more than general allegations of patentability that are not considered substantive separate patentability arguments. *Cf.* 37 C.F.R. § 41.37(c)(1)(vii) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”).

Thus, we also decline to reconsider our decision to affirm the Examiner’s § 103 rejections of the appealed claims.

This Decision on the Request for Rehearing incorporates our Decision, mailed May 21, 2019, and is final for the purposes of judicial review. *See* 37 C.F.R. § 41.52 (a)(1).

### CONCLUSION

In conclusion, based on the foregoing, Appellant's Request is denied with respect to making changes to the final disposition of the rejections therein.

#### Outcome of Decision on Rehearing:

Claims	Basis	Granted	Denied
5	§ 112(a)		5
1-3 and 14-20	§ 103 Logan, Starek		1-3 and 14-20
4-13	§ 103 Logan, Starek, Banerjee		4-13
<b>Overall Outcome</b>			1-20

#### Final Outcome of Appeal after Rehearing:

Claims	Basis	Affirmed	Reversed
5	§ 112(a)	5	
4-13	§ 112(b) <sup>3</sup>	4-13	
1-3 and 14-20	§ 103 Logan, Starek	1-3 and 14-20	
4-13	§ 103 Logan, Starek, Banerjee	4-13	
<b>Overall Outcome</b>		1-20	

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)(v)(2010).

DENIED

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<sup>3</sup> Appellant did not request reconsideration of this rejection.