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EXAMINER
ZILBERING, ASSAF

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BEREND JAN ARENDS,
CHRISTIAAN MICHAEL BEINDORFF,
ALBERT JAN BEZEMER, and TEUNIS DE MAN

Appeal 2018-007784
Application 14/359,133
Technology Center 1700

Before BEVERLY A. FRANKLIN, CHRISTOPHER C. KENNEDY, and MICHAEL G. MCMANUS, *Administrative Patent Judges*.

KENNEDY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

The Appellant[1] filed a Request for Rehearing ("Request" or "Req.") under 37 C.F.R. § 41.52 seeking reconsideration of our Decision dated September 17, 2019 ("Decision" or "Dec."), in which we affirmed the Examiner's rejections of claims 1–3, 5–11, and 13.

We DENY the Request.

[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42(a).

ANALYSIS

In the Decision, we declined to consider the Appellant's arguments concerning the Examiner's rejection of dependent claim 5 because the Appellant's arguments were raised for the first time in the Reply Brief. Dec. 4. In the Rehearing Request, the Appellant does not contend that the Reply arguments had been sufficiently raised in the Appeal Brief. *See* Req. 2–3. Nor does the Appellant argue that the Appellant had "good cause" for presenting new arguments in the Reply. *See id.*; *see also* 37 C.F.R. § 41.41(b)(2). Instead, the Appellant argues that the Board was obligated to consider the Reply arguments because those arguments allegedly were "responsive to an argument raised in the examiner's answer," as contemplated by 37 C.F.R. § 41.41(b)(2). *See* Req. 2–3.

That argument is not persuasive. In the Examiner's Answer, the Examiner's discussion of claim 5 was essentially identical to the Examiner's discussion of claim 5 in the Final Action. *Compare* Ans. 5–6, *with* Final Act. 5–6. The Appellant does not contend otherwise. Although 37 C.F.R. § 41.41(b)(2) refers to "arguments raised in the examiner's answer," the Federal Circuit has interpreted that as encompassing only "arguments raised *for the first time*" in the answer:

> Since the examiner's answer is deemed to incorporate all grounds in the Final Office Action, *an applicant's reply may not respond to grounds or arguments raised in the examiner's answer if they were part of the Final Office Action and the applicant did not address them in the initial appeal brief.* If an examiner's answer includes arguments raised for the first time, i.e., not in the Final Office Action, an applicant may address those arguments in the reply. 37 C.F.R. §§ 41.39, 41.41.

In re Durance, 891 F.3d 991, 1001 (Fed. Cir. 2018) (emphasis added). That holding is consistent with longstanding Board practice. *See, e.g.*, *In re Borden*, No. 2008-004312 (BPAI Jan. 7, 2010) (informative) ("The reply brief is not an opportunity to make arguments that could have been made during prosecution, but were not. *Nor is the reply brief an opportunity to make arguments that could have been made in the principal brief on appeal to rebut the Examiner's rejections, but were not.*" (emphasis added)).

Accordingly, we maintain our determination that the Appellant's arguments addressing claim 5 for the first time in the Reply Brief were untimely. *See* Dec. 5. We decline to consider those arguments because the Examiner has not had an opportunity to consider them in the first instance.

CONCLUSION

The Decision has been reconsidered, but, for the reasons set forth above, the request is DENIED with regard to modifying the result of the Decision.

Outcome of Decision on Rehearing:

Claims	**35 U.S.C §**	**Reference(s)/Basis**	**Denied**	**Granted**
1–3, 6–11, 13	103(a)	Barendse	1–3, 6–11, 13	
5	103(a)	Barendse, Münüklü	5	
Overall Outcome			1–3, 5–11, 13	

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–3, 6–11, 13	103(a)	Barendse	1–3, 6–11, 13	
5	103(a)	Barendse, Münüklü	5	
Overall Outcome			1–3, 5–11, 13	

DENIED