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EXAMINER

CUEVAS, PEDRO J

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MATTHEW EARLEY

Appeal 2019-000815
Application 12/925,235
Technology Center 2800

Before ROMULO H. DELMENDO, RAE LYNN P. GUEST, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

DELMENDO, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

The Appellant¹ requests rehearing of our Decision on Appeal entered November 14, 2019 (“original Decision” or “original Dec.”), in which we affirmed the Primary Examiner’s final decision to reject claims 26–29 (Request for Rehearing filed November 27, 2019 (“Request” or “Req. Reh’g”). We have jurisdiction under 35 U.S.C. § 6.

The Appellant’s arguments in the Request do not provide any substantive arguments on the merits to establish that we misapprehended or overlooked any point in our original Decision (Req. Reh’g 1). Rather, the

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Inventor, Matthew Earley, is the Applicant and also the real party in interest (Appeal Brief filed February 8, 2018 (“Appeal Br.”) at 3).

Appellant contends that we changed the ground of rejection to a new rejection under 35 U.S.C. § 102 because we cited to *In re Schreiber*, 128 F.3d 1473, 1477, 1478 (Fed. Cir. 1997) in our original Decision, whereas the Examiner cited to *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951) (Req. Reh’g 1). According to the Appellant, “[i]n the PTAB’s Decision on Appeal[,] the [affirmance of the] rejection of . . . Claim 26 was based on [*Schreiber*,] stating that [the] function found in preamble is also found in prior art of Earley” and “that this is, in fact, an undesignated new ground of rejection” (*id.*). The Appellant states further that, should the Appellant “have an opportunity to respond to the new rejection, the necessary ‘proof’ may already be at hand” (*id.* (referring to arguments made on pages 3–6 in a Reply filed November 23, 2015, which is attached to the Request, and the Examiner’s response in a Non-Final Office Action entered December 9, 2015 (paragraph 8)).

We maintain our affirmance of the Examiner’s rejection for the reasons given in our original Decision. For the reasons discussed below, we also do not agree with the Appellant that we entered an undesignated new ground of rejection in our original Decision. But given the Appellant’s *pro se* status and the complex nature of this prosecution, we hereby grant—out of an abundance of caution—the Appellant’s request to designate our affirmance as a new ground of rejection to afford the Appellant with all the procedural safeguards. *See, e.g.*, 37 C.F.R. § 41.37(c)(1) (“[A] brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i), (c)(1)(ii), (c)(1)(iv), and (c)(1)(v) of this section.”).

For completeness, we explain why our original Decision did not include an undesignated new ground of rejection. Although the Appellant is correct that *Schreiber* decided an anticipation rejection under 35 U.S.C. § 102(b), 128 F.3d at 1475, we cited to it using the signal “*Cf.*”² for the proposition that: (i) “[i]t is well-settled that a prior art reference’s silence with respect to a function recited in a claim does not necessarily defeat a rejection over that prior art reference”; (ii) an applicant is free to recite features of an apparatus either structurally or functionally, but functional claiming carries with it a risk; and (iii) “[w]here the PTO has reason to believe that a functional limitation asserted to be critical for establishing patentability in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require an applicant to prove that the subject matter shown in the prior art does not possess the specified characteristic” (original Dec. 7–8). Furthermore, we cited to *In re Best*, 562 F.2d 1252, 1255 (CCPA 1997), for the proposition that this shifting in the burden of production may, if warranted, be appropriate in either a 35 U.S.C. § 102 or 35 U.S.C. § 103 context (original Dec. 9).

While it is true that the Examiner discussed the *Kropa* case (Ans. 4–5), the Examiner also pointed out that a claim to an apparatus must be distinguished patentably from the prior art in terms of structure rather than function (*id.* at 10). Indeed, the Examiner found that the Appellant failed to prove that the result recited in claim 26’s preamble was sufficient to confer

² “*Cf.*” indicates that the cited authority supports a proposition different from the main proposition but sufficiently analogous to lend support—i.e., to compare. *The Bluebook*[®]: *A Uniform System of Citation* 59 (20th ed.).

novelty or “unexpected results” over the prior art (*id.* at 14). In this regard, the Examiner found that “Earley clearly teaches . . . a centrifugal weight control apparatus (CWC in Figures 1 and 3)” (Final Act. 8) and that “[t]he only additional structural component added by the Appellant is the ‘Centrifugal Weight Control’ system, invented by the Appellant, p[1]aced between the vertical shaft and the input of the rotational speed and torque adjusting mechanism” (Ans. 13). We expounded upon the Examiner’s position, but we did not alter it to the extent that our original Decision included an undesignated new ground of rejection—i.e., we did not change the basic thrust of the Examiner’s rejection. *In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (explaining that limiting the Board’s decision to “verbatim repetition of the examiner's office actions . . . would ill-serve the Board’s purpose as a reviewing body”); *In re Kronig*, 539 F.2d 1300, 1302–03 (CCPA 1976) (no new ground of rejection where an appellant has had an opportunity to react to the thrust of the rejection).

As we stated above, in view of the Appellant’s *pro se* status and the complex nature of this prosecution, it is appropriate to designate our affirmance as 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 that the Appellant, WITHIN TWO MONTHS FROM THE DATE OF THIS 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 proceeding will be remanded to the examiner. . . .

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

IV. CONCLUSION

In summary:

Outcome of Decision on Rehearing

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
26–29	103(a)	Earley, Carter, Simon		26–29 (newly rejected)

Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
26–29	103(a)	Earley, Carter, Simon	26–29		26–29

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

GRANTED/AFFIRMED; 37 C.F.R. § 41.50(b)