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24504	7590	03/25/2020	EXAMINER	
THOMAS HORSTEMEYER, LLP 3200 WINDY HILL ROAD, SE SUITE 1600E ATLANTA, GA 30339			STULII, VERA	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WOLF PETER LUDWIG

Appeal 2019-002925
Application 12/794,332
Technology Center 1700

Before CATHERINE Q. TIMM, GEORGE C. BEST, and
JANE E. INGLESE, *Administrative Patent Judges*.

INGLESE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of our Decision entered December 26, 2019 (“Decision”) affirming the Examiner’s rejections of claims 1–14, 17, and 19–21 under 35 U.S.C. § 103(a).¹ Request for Rehearing filed February 26, 2020 (“Req. Reh’g”). We grant Appellant’s request for reasons that follow.

¹ In our Decision, we affirmed the Examiner’s rejection of claims 1, 7, 8, 17, 19, and 20 under 35 U.S.C. § 103(a) as unpatentable over Ludwig (Rejection I), rejection of claims 2–6 under 35 U.S.C. § 103(a) as unpatentable over Ludwig in view of Gehring (Rejection II), and rejection of claims 9–14 and 21 under 35 U.S.C. § 103(a) as unpatentable over Ludwig in view of Toledo (Rejection III).

ANALYSIS

An appellant may seek review of an asserted undesignated new ground of rejection in a request for rehearing before the Board:

(c) Review of undesignated new ground of rejection. Any request to seek review of a panel's failure to designate a new ground of rejection in its decision must be raised by filing a request for rehearing as set forth in §41.52.

37 C.F.R. § 41.50(c); *see also* 37 C.F.R. § 41.52(a)(4).

Appellant's Request for Rehearing is limited to asking us to designate our affirmance of the Examiner's rejections under 35 U.S.C. § 103(a) as including new grounds of rejection. Specifically, Appellant argues that our Decision includes undesignated new grounds of rejection for each of Rejections I, II, and III because our "Decision goes beyond the grounds of rejection relied upon by the Examiner" by relying on "new facts . . . that go beyond those relied upon and presented by the Examiner in both the Final Office Action and in the Examiner's Answer," and "rationales not previously raised or presented by the Examiner in support of the rejections." Req. Reh'g 4-5. Appellant argues that although our Decision discusses paragraphs 31 and 35-40, 57, and 58 of Ludwig, these disclosures were not "relied upon the Examiner to support" Rejections I, II, and III. Req. Reh'g 4-5.

We find Appellant's arguments persuasive. The § 103(a) rejections as discussed in our Decision include new grounds of rejection. In the interests of fairness and due process, we, therefore, agree that the § 103(a) rejections should be designated as new grounds of rejection, to afford Appellant a full opportunity to respond. We, accordingly, grant Appellant's request to designate Rejections I, II, and III as new grounds of rejection.

CONCLUSION

Outcome of Decision on Rehearing:

Claims	35 U.S.C. §	Reference(s)/Basis	Denied	Granted
1, 7, 8, 17, 19, 20	103(a)	Ludwig		1, 7, 8, 17, 19, 20
2-6	103(a)	Ludwig, Gehring		2-6
9-14, 21	103(a)	Ludwig, Toledo		9-14, 21
Overall Outcome				1-14, 17, 19-21

Final Outcome of Appeal after Rehearing:

Claims Rejected	35 U.S.C. §	References	Affirmed	Reversed	New Ground
1, 7, 8, 17, 19, 20	103(a)	Ludwig	1, 7, 8, 17, 19, 20		1, 7, 8, 17, 19, 20
2-6	103(a)	Ludwig, Gehring	2-6		2-6
9-14, 21	103(a)	Ludwig, Toledo	9-14, 21		9-14, 21
Overall Outcome			1-14, 17, 19-21		1-14, 17, 19-21

TIME PERIOD FOR RESPONSE

This Decision on Rehearing contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b), which provides that “[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 THE 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 prosecution 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. . . .

As explained in the Manual of Patent Examining Procedure:

The new ground of rejection raised by the Board does not reopen prosecution except as to that subject matter to which the new rejection was applied. If the Board's decision in which the rejection under 37 CFR 41.50(b) was made includes an affirmance of the examiner's rejection, the basis of the affirmed rejection is not open to further prosecution. If the appellant elects to proceed before the examiner with regard to the new rejection, the Board's affirmance of the examiner's rejection will be treated as nonfinal for purposes of seeking judicial review, and no request for reconsideration of the affirmance need be filed at that time.

MPEP § 1214.01 ("Procedure Following New Ground of Rejection by Board").

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv).

GRANTED; 37 C.F.R. § 41.50(b)