



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
**United States Patent and Trademark Office**  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/666,262	12/22/2009	Heather Phillips	25277.26	7963
122269	7590	06/23/2020	EXAMINER	
Brian Tucker Kirton McConkie 36 South State Street, Suite 1900 Salt Lake City, UT 84111			SCRUGGS, ROBERT J	
			ART UNIT	PAPER NUMBER
			3723	
			NOTIFICATION DATE	DELIVERY MODE
			06/23/2020	ELECTRONIC

**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.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

btucker@kmclaw.com  
ipdocket@kmclaw.com  
klyon@kmclaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

*Ex parte* HEATHER PHILLIPS

---

Appeal 2019-003639  
Application 12/666,262  
Technology Center 3700

---

Before CHARLES N. GREENHUT, MICHELLE R. OSINSKI, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant<sup>1</sup> filed a request for rehearing under 37 C.F.R. § 41.52, dated April 28, 2020, of our Decision mailed April 22, 2020 (hereinafter “Decision”). In the Decision, we reversed the Examiner’s rejection under 35 U.S.C. § 112, as well as, the Rohrig grounds (see “REJECTIONS” below) under 35 U.S.C. § 103(a). Decision 9. Appellant seeks rehearing as to the

---

<sup>1</sup> We use the word Appellant to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Live-Right, LLC. Appeal Br. 4.

portion of our Decision affirming the rejections of claims 19–21 and 23–38 under 35 U.S.C. § 103(a) based on the Kayser grounds (see “REJECTIONS” below). Req. Reh’g 1.

## REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Amodeo	US 3,120,670	Feb. 11, 1964
Halm	US 5,813,079	Sept. 29, 1998
Rohrig ’583	US 6,546,583 B1	Apr. 15, 2003
Stvartak	US 6,601,272 B2	Aug. 5, 2003
Rohrig	US 2003/0014825 A1	Jan. 23, 2003
Davis	US 2003/0046780 A1	Mar. 13, 2003
Kemp	US 2004/0187889 A1	Sept. 30, 2004
Kayser	US 2006/0037160 A1	Feb. 23, 2006
Foster	US 2007/0006411 A1	Jan. 11, 2007
Wong	US 2007/0163064 A1	July 19, 2007
Hohlbein	US 2009/0178219 A1	July 16, 2009
Schneider	US D358,938	June 6, 1995
Moskovich	US D514,321	Feb. 7, 2006

## REJECTIONS

Claims 19–21, 25, and 37 were rejected under 35 U.S.C. § 112, Second Paragraph as being indefinite.

Claims 19–21 and 23–38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the following references:

### I. Rohrig Grounds

- a) Claims 19–21, 23–26, 31, 33, 34, 37, and 38 – Rohrig, Halm, Kayser, Davis, and Foster.
- b) Claims 27 and 28 – Rohrig, Halm, Kayser, Davis, Foster, and Moskovich.

- c) Claims 29 and 30 – Rohrig, Halm, Kayser, Davis, Foster, Moskovich, Stvartak, and Schneider.
- d) Claims 31 and 32 – Rohrig, Halm, Kayser, Davis, Foster, and Rohrig '583.
- e) Claim 35 – Rohrig, Halm, Kayser, Davis, Foster, Hohlbein, and Kemp.
- f) Claim 36 – Rohrig, Halm, Kayser, Davis, Foster, Wong, and Amodeo.

## II. Kayser Grounds

- a) Claims 19–21, 23,<sup>2</sup> 24, 31, 33, 34, and 37 – Kayser, Davis, and Foster.
- b) Claims 25, 26, and 38 – Kayser, Davis, Foster, and Rohrig.
- c) Claims 27 and 28 – Kayser, Davis, Foster, and Moskovich.
- d) Claims 29 and 30 – Kayser, Davis, Foster, Moskovich, Stvartak, and Schneider.
- e) Claims 31 and 32 – Kayser, Davis, Foster, and Rohrig '583.
- f) Claim 35 – Kayser, Davis, Foster, Hohlbein, and Kemp.
- g) Claim 36 – Kayser, Davis, Foster, Wong, and Amodeo.

---

<sup>2</sup> Claim 23 is not included in the listing of the rejection, but is addressed in the body thereof.

## DISCUSSION

A request for rehearing is limited to matters overlooked or misapprehended by the Panel in rendering the original decision. *See* 37 C.F.R. § 41.52; *see also Ex parte Quist*, 95 USPQ2d 1140, 1141 (BPAI 2010) (precedential) (quoting Manual of Patent Examining Procedure (MPEP) § 1214.03). Appellant presents two different issues that it asserts the Board overlooked in the Decision and that it asserts are reasons why the Kayser grounds should be overturned: 1) that “the Office had ‘re-opened prosecution as a sham’” in response to its previous appeal brief; and 2) that we did not fully consider its arguments with respect to “objective indicia of nonobviousness” because, although the only references mentioned in the objective indicia section of the appeal brief were Rohrig and Halm (Appeal Br. 42), Appellant intended those arguments to apply to “all prior art rejections.” Req. Reh’g 3–4. We address each argument in turn.

### *Re-opening Prosecution*

MPEP § 1207.04 provides guidance to examiners as to when they can reopen prosecution after the filing of an appeal brief. In particular, as was the case here, “[t]he examiner may . . . reopen prosecution to enter a new ground of rejection in response to appellant’s brief.” *Id.* In this case, after the Examiner reopened prosecution, the Kayser grounds were added as new grounds of rejection. *See generally*, 2018-11-09 Non-Final Act.

Appellant argues that re-opening prosecution to enter the Kayser grounds was a sham because these were “rejections that the Office had already admitted were overcome.” Req. Reh’g 3; *see also id.* at 2 (“Office admits that new claims 19-38 overcome Kayser grounds” “Office also adds rejections based on Kayser grounds even though the Office admitted on

Appeal 2019-003639  
Application 12/666,262

5/10/2017 that much broader claims overcame the Kayser grounds”(emphasis omitted)). This misstates the file history.

In the April 12, 2017 Non-Final Office Action, Kayser was used as a secondary reference in rejecting the claims. 2017-04-12 Non-Final Action 2–7. In the Examiner’s Interview Summary of May 10, 2017, “the examiner did agree that the . . . proposed amendment would overcome the prior rejection.” However, copies of the proposed amendments were not included (thus we do not know how they compare to the current claims) and there is no discussion of Kayser.

The current Kayser grounds (2018-11-09 Non-Final Act.) are completely different from the grounds that included Kayser in the April 12, 2017 Non-Final Office Action. Kayser is now used as a primary reference in combination with a different set of other references. Thus, Appellant’s assertion that “the Office Action still presents the same rejections that have been at issue for years” lacks support. Req. Reh’g 3 (citing Appeal Br. 4).<sup>3</sup> Our review of the file history does not reveal that the Kayser grounds, as included in the outstanding 2018-11-09 Non-Final Office Action, were added as anything other than as a response to Appellant’s arguments in the previous appeal brief.

Appellant also states that we did not address their argument “that ‘the Office [i.e. the Examiner] continues to present baseless rejections without rebutting any of Applicant’s arguments.’” Req. Reh’g 3 (citing Appeal Brief 5). Of course this argument is not relevant to new grounds, such as the Kayser grounds, because Appellant would not have had an opportunity to

---

<sup>3</sup> We note that the rejections included in the 2017-4-12 Non-Final Action largely repeat the rejections affirmed in a previous Decision (not at issue here) issued January 10, 2017.

address these grounds. Further, as a general proposition it is also false. The outstanding 2018-11-09 Non-Final Office Action includes a section entitled “Response to Arguments” that includes six pages addressing Appellant’s arguments. Though we ultimately did not agree with the Examiner as to some points (*see* Decision 5–7), that does not mean that the Examiner’s positions were baseless or unreasonable. We render decisions as to whether the Office, by way of the examiner, satisfied its burden of demonstrating unpatentability on the totality of the record. *In re Oetiker*, 977 F. 2d 1443, 1445 (Fed. Cir. 1992) (citations omitted). In making this determination we take into account, among other things, the analysis and response to appellant’s arguments provided by the examiner. *Id.* A preponderance of evidence, coupled with correct reasoning and legal conclusions, may be sufficiently dispositive to establish unpatentability based on the totality of the record even where the examiner does not respond to a specific argument. This is particularly true where arguments pertain to matters outside the scope of our jurisdiction or are not pertinent to the rejection for which appellants seek our review. *See* 37 C.F.R. § 41.37(c)(1)(iv) (“The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant”).

We recognize that the Examiner re-opened prosecution in response to Appellant’s previous appeal brief. For the reasons discussed above this does not appear to have been done as a “sham” as asserted by Appellant. Regardless, Appellant is ultimately without remedy for this action before this board. *In re Voss*, 557 F.2d 812, 815–816, n.6 (CCPA 1977) (“It does not appear from the record that appellant ever petitioned the [Director] with respect to the decision to reopen prosecution.”; “The examiner's decision to reopen prosecution constituted neither the rejection of a claim nor a decision

adverse to the ultimate patentability of a claim. Accordingly, we hold that the board properly found that it had no jurisdiction to review the decision to reopen prosecution.”)

*Objective evidence*

In our Decision, we determined that Appellant’s Appeal Brief did not address the Kayser grounds. *See* Decision 7. Upon a second review, we confirm that Appellant’s Appeal Brief does not address, or even acknowledge the Kayser grounds. *See generally* Appeal Brief. Appellant presents arguments concerning secondary considerations only with respect to the Rohrig grounds. *See id.* at 42 (referring back to prior arguments made with respect to Rohrig and Halm in the Rohrig grounds). Our reproduction of a portion of the Examiner’s analysis (Decision 8) served only to point out that the matter was left unaddressed by Appellant’s briefing; it was not intended to serve as an indication that we reviewed the merits of issues not raised by Appellant in contravention of 37 C.F.R. § 41.37(c)(1)(iv) which states:

The arguments shall explain why the examiner erred as to each ground of rejection contested by appellant. Except as provided for in §§ 41.41, 41.47 and 41.52, any arguments or authorities not included in the appeal brief will be refused consideration by the Board for purposes of the present appeal. Each ground of rejection contested by appellant must be argued under a separate heading, and each heading shall reasonably identify the ground of rejection being contested (e.g., by claim number, statutory basis, and applied reference, if any).

Thus, on rehearing and for the first time, “Applicant requests that the Board determine whether the examiner, in rejecting each of the claims under the Kayser grounds, properly analyzed whether the weight of the objective



Appeal 2019-003639  
Application 12/666,262

evidence rebuts his rationales for combining the references to reject every claim as being obvious or whether the examiner simply ignored the objective evidence.” Req. Reh’g 11.

We decline Appellant’s request as improper. A request for rehearing is limited to “points believed to have been misapprehended or overlooked by the Board” (37 C.F.R. § 41.52(a)(1)), and may not raise new arguments except as permitted by 37 C.F.R. § 41.52 paragraphs (a)(2) through (a)(4). We determine that none of the exceptions in 37 C.F.R. § 41.52 (new case law, new grounds of rejection) apply. We further determine that Appellant’s Request does not identify any matter overlooked or misapprehended by the Panel in rendering the original Decision.

#### CONCLUSION

For the foregoing reasons, we are not informed of any matters misapprehended or overlooked in our prior Decision and deny Appellant’s request to make any changes thereto.

DECISION SUMMARY

Outcome of Decision on Rehearing:

Claims	35 U.S.C §	References	Denied	Granted
19–21, 23, 24, 31, 33, 34, 37	103	Kayser, Davis, Foster	19–21, 23, 24, 31, 33, 34, 37	
25, 26, 38	103	Kayser, Davis, Foster, Rohrig	25, 26, 38	
27, 28	103	Kayser, Davis, Foster, Moskovich	27, 28	
29, 30	103	Kayser, Davis, Foster, Moskovich, Stvartak, Schneider	29, 30	
31, 32	103	Kayser, Davis, Foster, Rohrig '583	31, 32	
35	103	Kayser, Davis, Foster, Hohlbein, Kemp	35	
36	103	Kayser, Davis, Foster, Wong, Amodeo	36	
<b>Overall Outcome</b>			<b>19–21, 23–38</b>	

Final Outcome of Appeal after Rehearing:

Claims	35 U.S.C. §	References/Basis	Affirmed	Reversed
19–21, 25, 37	112, ¶ 2	Indefiniteness		19–21, 25, 37
19–21, 23–26, 31, 33, 34, 37, 38	103	Rohrig, Halm, Kayser, Davis, Foster		19–21, 23– 26, 31, 33, 34, 37, 38
27, 28	103	Rohrig, Halm, Kayser, Davis, Foster, Moskovich		27, 28
29, 30	103	Rohrig, Halm, Kayser, Davis, Foster, Moskovich, Stvartak, Schneider		29, 30
31, 32	103	Rohrig, Halm, Kayser, Davis, Foster, Rohrig '583		31, 32
35	103	Rohrig, Halm, Kayser, Davis, Foster, Hohlbein, Kemp		35

<b>Claims</b>	<b>35 U.S.C. §</b>	<b>References/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
36	103	Rohrig, Halm, Kayser, Davis, Foster, Wong, Amodeo		36
19–21, 23, 24, 31, 33, 34, 37	103	Kayser, Davis, Foster	19–21, 23, 24, 31, 33, 34, 37	
25, 26, 38	103	Kayser, Davis, Foster, Rohrig	25, 26, 38	
27, 28	103	Kayser, Davis, Foster, Moskovich	27, 28	
29, 30	103	Kayser, Davis, Foster, Moskovich, Stvartak, Schneider	29, 30	
31, 32	103	Kayser, Davis, Foster, Rohrig '583	31, 32	
35	103	Kayser, Davis, Foster, Hohlbein, Kemp	35	
36	103	Kayser, Davis, Foster, Wong, Amodeo	36	
<b>Overall Outcome</b>			<b>19–21, 23–38</b>	

**TIME PERIOD FOR RESPONSE**

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).

**DENIED**