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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/992,740	05/30/2018	Brian Michael Coyle		1058

7590 09/15/2020  
Brian Michael Coyle  
Box 176  
CANYON, CA 94516

EXAMINER
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LARSEN, JEFFREY R

ART UNIT	PAPER NUMBER
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3643

MAIL DATE	DELIVERY MODE
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09/15/2020

PAPER

**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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BRIAN MICHAEL COYLE

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Appeal 2020-004797  
Application 15/992,740  
Technology Center 3600

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Before JOHN C. KERINS, DANIEL S. SONG, and  
CHARLES N. GREENHUT, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

ORDER REQUESTING BRIEFING OR INFORMATION

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the  
Examiner’s decision to reject claims 1–2, 4, 7–16, and 18–23. *See* Final Act.

1. We have jurisdiction under 35 U.S.C. § 6(b).

We REQUEST ADDITIONAL BRIEFING OR INFORMATION.

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<sup>1</sup> We use the term “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Brian Michael Coyle. Appeal Br. 3.

## REFERENCES

The prior art relied upon by the Examiner is:

<b>Name</b>	<b>Reference</b>	<b>Date</b>
Goodman	US 5,968,036	Oct. 19, 1999
Benedict	US 2005/0004631 A1	Jan. 6, 2005
Soukos '251	US 2005/0221251 A1	Oct. 6, 2005
Mannino	US 2009/0191504 A1	July 30, 2009
Soukos '383	US 2017/0326383 A1	Nov. 16, 2017

## REJECTIONS

Claims 1, 2, 4, 7–16, and 18–23 are rejected under 35 U.S.C. § 112(b) as being indefinite. Final Act. 2 as modified by Ans. 3.

Claims 1, 2, and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukos '383 and Benedict. Final Act. 11.

Claims 7–10, 18, and 19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukos '383, Mannino, and Benedict. Final Act. 12.

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukos '383, Mannino, Benedict, and Soukos '251. Final Act. 19.

Claim 20 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Soukos '383, Goodman, and Benedict. Final Act. 22.

## REQUEST FOR BRIEFING AND INFORMATION

### *Summary*

New or additional briefing is seen as potentially benefiting Appellant for the following reasons:

(A) The Appeal Brief dated March 30, 2020, and the Reply Brief filed June 9, 2020, appear to erroneously be directed to the claims as proposed to be amended at pages 5–21 of the “AFCP 2.0: AMENDMENT AND RESPONSE TO OFFICE ACTION MAILED 08/01/2019,” filed October 3, 2019. Those amendments were refused entry by the Examiner in an Advisory Action dated November 27, 2019, and are therefore not properly on appeal. The claims pending for the purposes of appeal are the claims in their form *prior to* the proposed amendments, and which were the subject of [or “rejected in”] the Final Action dated August 1, 2019. Any arguments made in the Appeal Brief and Reply Brief as submitted that are based solely on changes that were proposed, but not entered, **WILL NOT** be considered by the Board on appeal.

(B) The Appeal Brief and Reply Brief are not organized in a manner that clearly indicates what specific positions taken by the Examiner are believed to be in error, and do not then identify with any particularity why any such positions are erroneous based upon the evidence in the record.

(C) The Appeal Brief and Reply Brief include personal attacks against the Examiner in violation of 37 C.F.R. § 41.1(c).

Detailed reasons as to why Appellant is being afforded the opportunity to provide new or additional briefing, or to take other action consistent with this Order, are discussed below.

*Pro se Resources*

The Patent Trial and Appeal Board, and the Patent and Trademark Office (“PTO”) in general, are mindful of the difficulties pro se applicants face in the complex area of patent law and practice. What may look like a “wall of words” (Appeal Br. 11) to some, may read as a reasonable explanation as to why an application fails to comply with the requirements of Title 35 to others. Here, the Examiner has indicated the presence of allowable subject matter within this application. Final Act. 25. This indicates that the Examiner would pass the application to issuance so that a patent may be granted to Appellant if Appellant overcomes the Examiner’s rejections by making the revisions suggested by the Examiner. If Appellant wishes to do so, Appellant is free to choose whether to attempt to overcome the Examiner’s rejections by amending the claims, demonstrating errors in the Examiner’s rejections, or some combination of both. Where, as is the case here, the Examiner acknowledges patentable subject matter in an application and believes difficulties passing the application to issue are due to a pro se applicant’s lack of familiarity with patent prosecution, the Manual of Patent Examining Procedure “MPEP” § 401 recommends advising an applicant as follows:

An examination of this application reveals that applicant is unfamiliar with patent prosecution procedure. While an applicant may prosecute the application (except that a juristic entity must be represented by a patent practitioner, 37 [C.F.R. § ]1.31), lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed. Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and

prosecution. The Office cannot aid in selecting an attorney or agent.

A listing of registered patent attorneys and agents is available at <https://oedci.uspto.gov/OEDCI/>. Applicants may also obtain a list of registered patent attorneys and agents located in their area by writing to the Mail Stop OED, Director of the U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450

Appellant is certainly free to disregard this advice. Indeed, the Office provides a number of resources to assist pro se applicants in prosecuting their own applications. A compilation of those resources can be found at: <https://www.uspto.gov/patents-getting-started/using-legal-services/pro-se-assistance-program>.

Although normally we might proceed with reaching a decision on the merits of this case on the record presented, in light of Appellant's pro se status and the posture of this case we feel that doing so at this time may disservice Appellant. Accordingly, in an "abundance of fairness,"<sup>2</sup> we discuss certain issues with regard to Appellant's briefing that Appellant may wish to correct or address before we render a final decision, and we provide Appellant several options for responding to this Order.

### *The Claims on Appeal*

Rule 37 C.F.R. § 41.37(c)(1) specifies what "the [appeal] brief shall contain." Subparagraph (v) of rule 41.37(c)(1) requires "[a]n appendix containing a copy of the claims involved in the appeal." Here, the Examiner correctly points out:

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<sup>2</sup> *C.f. Ex parte Letts*, 88 USPQ2d 1854, 1859 (BPAI 2008) (precedential) (the Board, at its discretion, may follow an "abundance of fairness policy.").

the after final amended claims submitted 10/03/2019 have not been entered into the record per the Advisory Action of 11/27/2019. The claims Appellant indicates as presently pending and presented in the appendix of the Appeal Brief are not the claims currently under rejection.

Ans. 3.

37 C.F.R. § 41.37(d) states:

If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief.

However, there is an exception in § 41.37(c)(1) that states:

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.

The exception above, in addition to affording extra latitude to pro se applicants, is one way the PTO has endeavored to “reduce the number of notices of noncompliant appeal brief and non-substantive returns from the [Board] that require appellants to file corrected appeal briefs.”<sup>3</sup> It is with that goal in mind that MPEP § 1205.03 states:

Once an appeal brief is accepted by the Board as in compliance with 37 [C.F.R. § ]41.37, the appeal brief will not later be held as defective by the Patent Appeal Center or the examiner. The Board will not return or remand the application to the examiner for issues related to a non-compliant appeal brief. Furthermore,

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<sup>3</sup> See, e.g., Fed. Reg. Vol. 75, No. 60 (Mar. 30, 2010) available at <https://www.govinfo.gov/content/pkg/FR-2010-03-30/pdf/2010-7034.pdf> and, along with other information, at <https://www.uspto.gov/patents-application-process/appealing-patent-decisions/procedures/guidance-reduce-non-compliant>

examiners are not required to review appeal briefs for the purposes of determining whether the appeal briefs comply with 37 [C.F.R. § ]41.37. Accordingly, the Notification of Non-Compliant Appeal Brief (PTOL-462) and form paragraphs for holding an appeal brief defective are no longer available for the examiner to use.

Here, however, were we to proceed with reaching a decision on the merits of this case, Appellant could, in effect, be negatively impacted by the PTO's decision *not* to hold Appellant's Appeal Brief non-compliant for containing an incorrect set of claims and not requiring Appellant to file an amended brief. This is because many of Appellant's arguments could be dismissed as moot due to the fact that they are based on claims that are not presently before us for review.

Appellant asserts that the amendments to the claims putting them in the form of those supplied in Appellant's Claims Appendix were improperly denied entry by the Examiner. Reply Br. 2. We cannot comment as to that matter because it is well-settled that the Examiner's refusal to enter an amendment is a subject that is outside the scope of the Board's jurisdiction. In that regard, 37 C.F.R. § 41.37(c)(2) expressly states, with emphasis added:

A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence. See § 1.116 of this title for treatment of amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for treatment of amendments, affidavits or other Evidence filed after the date of filing the appeal. **Review of an examiner's refusal to admit an amendment or Evidence is by petition to the Director.** See § 1.181 of this title.



Thus, if an applicant believes an amendment is improperly refused entry by the Examiner, the proper course of action would be to petition the Examiner's decision not to enter the amendment *prior* to taking an appeal to the Board. This Board lacks the jurisdiction to provide any remedy for Appellant's failure to file such a petition. Appellant is therefore advised that the claims that we would consider pending for purposes of our review are those that were entered on June 18, 2019, prior to the Examiner's Final Action on August 1, 2019, from which the appeal was taken under 37 C.F.R. § 41.31. *See* Ans. 3 (citing Adv. Act. November 27, 2019)

### *Appellant's Briefing*

#### *Brief Organization*

As mentioned above, 37 C.F.R. § 41.37(c)(1) requires only *substantial* compliance with 37 C.F.R. § 41.37(c)(1)(iv) for a pro se applicant-appellant. *See* MPEP § 1205.02. Nevertheless, it is in Appellant's best interest to follow the provisions of 37 C.F.R. § 41.37(c)(1)(iv) regarding briefing as closely as possible so as to make it clear what aspects of the Examiner's Action Appellant wishes to contest. Section 41.37(c)(1)(iv) instructs:

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). For each ground of rejection applying to two or more claims, the claims may be argued separately (claims are considered by appellant as separately patentable), as a group (all claims subject to the ground of rejection stand or fall together), or as a subgroup (a subset of the claims subject to the ground of rejection stand or fall together).

To comply with this provision one would expect the arguments section of the brief to include headings that match, or sufficiently identify, each ground of rejection in the appealed action that Appellant wishes to contest. Within each of those sections there should appear subheadings identifying the claim, or group of claims, for which Appellant intends to raise issues. Appellant has not organized the brief in this manner and has, for some reason, provided some arguments as an Appendix to the brief as opposed to under the Argument section. *See* 37 C.F.R. § 41.37(c)(1) (“the brief shall contain the following items under appropriate headings and in the order indicated”). Although we will strive to do our best in understanding what Appellant intended to argue so long as there is substantial compliance with rule 41.37(c)(1)(iv), Appellant would be better served by providing briefing that is organized in a way that is more consistent with 37 C.F.R. § 41.37(c)(1)(iv). This is because our review is limited to the issues raised by Appellant and we will not scour the record in an effort to find fault with the Examiner’s rejection on Appellant’s behalf. The Board depends on appellants to apprise us of the issues for which they seek review in a clear and concise manner, as discussed in more detail below.

### *Brief Content*

“Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection.”<sup>4</sup> “[T]he Board will not, as a general matter, unilaterally review those uncontested aspects of the

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<sup>4</sup> *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (citations omitted).

rejection.”<sup>5</sup> Those matters that are contested, must be within the scope of our jurisdiction. There is no sense in raising issues of examination procedure<sup>6</sup> and examiner discretion<sup>7</sup> because we generally lack the jurisdiction to, and therefore will not, address such matters.<sup>8</sup>

With regard to matters that *do* fall within our jurisdiction, perhaps the most important requirement of 37 C.F.R. § 41.37(c)(1)(iv) is that the arguments must address the Examiner’s Action. 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”). Appellant reproduces a number of tidbits of case law and portions of the MPEP, but in general, fails to correctly apply them. For example, Appellant undertakes a detailed comparison of the claims of the present application with the claims and prosecution history of Soukos. Appeal Br. 16–17. We do not see how this claim comparison is relevant to a prior-art rejection predicated on Soukos’s disclosure where, regarding the term in question, “resilient,” the Examiner relies on paragraph 169 of Soukos’s disclosure and not Soukos’s claims. Final Act. 11. The pertinent question in this context is whether the subject matter within cited paragraph 169, read in the context of Soukos as a whole, satisfies the aspects of Appellant’s claim for which the Examiner relied upon it. Despite what appears like an effort to contest this aspect of the Examiner’s rejection, we do not find this issue addressed anywhere within Appellant’s briefing. Naked assertions of Examiner legal or factual error that do not address the

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<sup>5</sup> *Id.* at 1075–76 (citations omitted)

<sup>6</sup> For example the refusal to enter an amendment. *See* Appeal Br. 12.

<sup>7</sup> For example the amount of time given by the Examiner to respond to the Examiner’s emails. *See* Appeal Br. 11.

<sup>8</sup> *In re Searles*, 422 F.2d 431, 434–435 (CCPA 1970).

substance of the Examiner's position do not comply with the requirements of 37 C.F.R. § 41.37(c)(1)(iv).<sup>9</sup>

The Examiner recognizes that Appellant's arguments with regard to the prior-art rejections are generally misguided and the Examiner did not see the need to provide any substantive responses to Appellant's arguments. *See* Ans. 4–9. Ultimately, if Appellant wishes to rebrief this case, it would be in Appellant's best interest to provide a briefing that points to the supposed errors in the Examiner's Action with more particularity. Typically, arguments concerning a § 103(a) rejection will focus on whether the Examiner used an unreasonably broad claim construction, whether the Examiner misinterpreted a teaching or disclosure in a reference, whether references should be considered relevant and combinable in the manner proposed by the Examiner, and any so-called "secondary considerations."<sup>10</sup> In addition to identifying the specific issues for which Appellant seeks review, it is vital to provide an explanation as to precisely why the Examiner erred. On the record presently before us it is difficult to discern within Appellant's briefing any cogent analysis in this regard.

With regard to the rejections under 35 U.S.C. § 112(b), the Examiner withdrew all bases for such rejection save one: the recitation of a range within a range. Ans. 3–4 (citing MPEP § 2173.05(c)). There is nothing

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<sup>9</sup> *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

<sup>10</sup> "Secondary considerations" is a phrase in patent law that is used in an obviousness analysis to refer to a specific class of rebuttal evidence. *See* MPEP § 2145; *Graham v. John Deere Co.*, 383 U.S. 1 (1966); *see* Appeal Br. 13 (misinterpreting the phrase "secondary considerations"). Secondary considerations must be established with evidence (*Id.*), but such evidence must have been made of record prior to appeal to the Board. *See* MPEP § 1205.02.

unusual about this Board conducting an appellate review of indefiniteness rejections. *See* Appeal Br. 8. Numerous examples can be found by searching prior Board decisions.<sup>11</sup> If Appellant wishes to contest the Examiner’s rejection under 35 U.S.C. § 112(b) Appellant must provide arguments which point out the supposed errors in the Examiner’s position. Where Appellant does not contest the merits of an Examiner’s rejection, it is generally considered a waiver of the right to do so.<sup>12</sup> Appellant is reminded that, under 37 C.F.R. § 41.50(a)(1), “the affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.” Thus, claims that stand rejected on *any* ground after an appeal will ultimately stand rejected.

*Requirement for courtesy and decorum*

Finally, we remind Appellant that 37 C.F.R. § 41.1(c) states that “[e]ach party must act with courtesy and decorum in all proceedings before the Board.” 37 C.F.R. § 41.1(c) serves as an additional reminder to the more general rule of 37 C.F.R. § 1.3:

Applicants and their attorneys or agents are required to conduct their business with the United States Patent and Trademark Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Director and will not be entered. A notice of the non-entry of the paper will be

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<sup>11</sup> <https://e-foia.uspto.gov/Foia/PTABReadingRoom.jsp>

<sup>12</sup> *In re Berger*, 279 F.3d 975 (Fed. Cir. 2002) (Affirming the Board’s affirmance of an uncontested rejection, holding that the appellant had waived the right to contest the rejection by not presenting arguments on appeal to the Board); *Hyatt v. Dudas*, 551 F.3d 1307, 1314 (Fed. Cir. 2008) (“the applicant can waive appeal of a ground of rejection”).

provided. Complaints against examiners and other employees must be made in correspondence separate from other papers.

Personal attacks against office personnel and the use of language or tone that may be considered accusatory, condescending, or inflammatory is considered to be in violation of these rules. Where an applicant believes the Examiner has made incorrect determinations involving matters of fact or law, failed to follow proper procedure, acted arbitrarily, or abused the Examiner's discretion, remedy may be found by simply indicating how the Examiner has done so *in the appropriate forum for review*. Personal attacks against the Examiner are not in Appellant's best interests. Statements containing such remarks may be ignored by Office personnel or may cause papers submitted to the Office to be refused entry. *See* MPEP § 714.25. Moreover, such statements are not helpful in aiding the Board in properly resolving the issues necessary to render a decision on the merits of a case.

#### ORDER REQUESTING BRIEFING OR INFORMATION

Pursuant to 37 C.F.R. § 41.50(d) we request that Appellant respond to this order by exercising only one of the following options:

- 1) Indicate that, despite the issues and considerations raised hereinabove, Appellant wishes for us to render a final decision in this appeal based on the briefing presently before us and the claims entered June 18, 2019; or
- 2) File a substitute Appeal Brief arguing the claims entered June 18, 2019 and, if Appellant desires, taking into account the issues and

- considerations discussed above with regard to the briefing presently before us.<sup>13</sup>
- 3) File a Request for Continued Examination (RCE) and fee set forth in 37 C.F.R. § 1.17(e) to enter any desired amendments to the presently pending claims entered June 18, 2019 and continue prosecution before the Examiner. This will serve to withdraw this appeal.<sup>14</sup> 37 C.F.R. § 1.114(d); MPEP § 1215.01.
  - 4) Coordinate with the Examiner or the Examiner's supervisor (*see* Final Act. 26) to determine if an amendment can be made to the claims that overcomes the Examiner's rejections without significantly affecting the scope of the presently pending (June 18, 2019) claims. Appellant may then request that we remand the case for the Examiner to make (*see, e.g.*, MPEP § 1302.04), or enter, such an amendment pursuant to MPEP § 1211.02 (citing MPEP § 1206).<sup>15</sup>

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<sup>13</sup> Should Appellant elect option (2) we may, at our discretion, remand the case to the Examiner to provide a substitute Examiner's Answer. See MPEP § 1212 ("after an appellant has replied to a requirement under 37 [C.F.R. §] 41.50(d), a remand by the Board to the examiner may be appropriate to permit the examiner to respond to the appellant's response to the Board's order."). Should a substitute Answer be provided by the Examiner, Appellant will be provided an opportunity to file a substitute Reply Brief in response to that substitute Answer.

<sup>14</sup> "A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including [] an appeal, [] will not entitle a party to a refund of such fee." 37 C.F.R. § 1.26; MPEP § 607.02.

<sup>15</sup> *See* note 14.

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Application 15/992,740

TIME PERIOD FOR RESPONSE

Appellant is given **two months** from the mailing date of this order within which to respond. **Extensions of time are only available under 37 C.F.R. § 1.136(b). Failure to respond within the time period set by the Board may result in dismissal of the appeal.**

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

SO ORDERED; 37 C.F.R. § 41.50(d)