The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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*Ex parte* KAZUHIRO NODA and RYOUJI YAMAZAKI

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Appeal 2007-0756
Application 10/652,853
Technology Center 3600

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Decided: June 21, 2007

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Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and JENNIFER D. BAHR, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Kazuhiro Noda and Ryouji Yamazaki (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1-12. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

Appellants' claimed invention is directed to a braking apparatus capable of performing skidding control and traction control of a vehicle (Specification 1). Claim 1 is illustrative of the claimed subject matter and reads as follows:

> 1. A braking apparatus for a vehicle comprising:
>
> a hydraulic braking pressure control apparatus disposed on a metallic base, the hydraulic braking pressure control apparatus including:
>
> control valve units for switching among a state where hydraulic passages to access a master cylinder are communicated with wheel brakes while the wheel brakes are interrupted from reservoirs, a state where the hydraulic passages are interrupted from the wheel brakes while the wheel brakes are communicated with the reservoirs, and a state where the wheel brakes are interrupted from the hydraulic passages and the reservoirs;
>
> pumps for discharging a brake fluid reserved in the reservoirs to the hydraulic passages;
>
> suction valves provided between the master cylinder and suction ports of the pumps; and
>
> regulators normally communicating the master cylinder with the hydraulic passages, interrupting the master cylinder from the hydraulic passages when the suction valves are open and letting the hydraulic pressure of the hydraulic passages escape into the master cylinder as the hydraulic pressure of the hydraulic passages exceeds a predetermined value;
>
> wherein the suction valves are disposed on the base in positions closer to the suction ports of the pumps than the control valve units and the regulators, and the regulators are disposed on the

> base in positions closer to the suction port[1] of the pumps than the control valve units.

The Examiner relies upon the following as evidence of unpatentability:

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|---|---|---|
| Fujita | US 5,449,226 | Sep. 12, 1995 |
| Nohira | US 6,234,199 B1 | May 22, 2001 |
| Brachert | US 6,318,818 B1 | Nov. 20, 2001 |

Appellants seek review of the Examiner's rejection of claims 1, 4, 5, 9, 10, and 12 under 35 U.S.C. § 102(b) as anticipated by Nohira and rejections under 35 U.S.C. § 103(a) of claims 3, 6, and 11 as unpatentable over Nohira, claim 2 as unpatentable over Nohira in view of Brachert, and claims 7 and 8 as unpatentable over Nohira in view of Fujita.

The Examiner provides reasoning in support of the rejections in the Answer (mailed September 18, 2006). Appellants present opposing arguments in the Appeal Brief (filed July 10, 2006) and Reply Brief (filed November 20, 2006). Appellants' counsel presented oral argument in the appeal on June 5, 2007.

## OPINION

We turn our attention first to the rejection of claims 1, 4, 5, 9, 10, and 12 as anticipated by Nohira. The first issue presented to us is whether, in the embodiment of Fig. 9, Nohira's suction valves (SI1 and SI2) are disposed in positions closer to the suction ports of the pumps than the control valve units (PC1 through PC8) and the regulators (valves SC1 and SC2), as required in independent claims 1 and 10. The Examiner determines that the suction valves, regulators, and control valve units read on valves SI1 and SI2, valves

[1] It appears that "port" should be "ports."

SC1 and SC2, and valves PC1 to PC8, respectively, of Nohira (Answer 3-4) and Appellants do not contest this determination (e.g., Appeal Br. 11). Rather, Appellants contend that, because Nohira's suction valves SI1 and SI2 are located above and below the regulators SC1 and SC2, the regulators SCI and SC2, not the suction valves SI1 and SI2, are closer to the suction ports of the pumps (Appeal Br. 11 and 14). We conclude that the Examiner is correct. The findings and reasoning on which we base this conclusion are as follows:

1. Though not labelled in Fig. 9, Nohira's pumps are illustrated as dashed-line squares directly to the left of and slightly overlapping suction valves SI1 and SI2 (note labelling of analogous structure in Fig. 1 as pressure pumps HP1 and HP2 – Nohira, col. 4, ll. 26-43).
2. The suction ports of Nohira's pumps are not labelled in any of the drawings. In the annotated Fig. 9 on page 10 of the Answer, the Examiner labels the "suction port" with a lead line pointing generally to the dashed lines between the pump and the motor, at a height closer to the pump than to the motor. The Examiner asserts, however, that the suction ports of the pump cannot be located anywhere else but on the perimeters of the pumps, as the suction ports of the pump are where the hydraulic fluid is coming into the pump (Answer 9). Appellants do not provide any evidence or explanation to rebut the Examiner's assertion, which seems reasonable on its face. Appellants' contention that the Examiner "simply cannot properly argue that the dashed-line squares adjacent SI1 and SI2 are the recited pumps and <u>at the same time</u> assert that these are also the recited suction ports of the pumps" (Reply Br. 4; Appeal Br. 13) is not well

taken. The Examiner does not assert that the dashed-line squares are both the pumps and the suction ports of the pump. Rather, we understand the Examiner's position to be that the suction ports are disposed someplace along the periphery of the dashed-line squares, as this is the place where the hydraulic fluid enters the pumps, which are represented by the dashed-line squares.

3. Nohira's valves SI1 and SI2, identified by the Examiner without challenge from Appellants as the suction valves, are illustrated in Fig. 9 closer to the peripheries of the dashed-line squares representing the pumps than the valves SC1 and SC2, identified by the Examiner without challenge from Appellants as the regulators. Moreover, the valves PC1 through PC8, identified by the Examiner without challenge from Appellants as control valve units, are further from the suction ports of the pumps than are the regulators SC1 and SC2.
4. Nohira's Fig. 3 is a perspective view of the hydraulic pressure unit shown in plan view in Fig. 1 and in schematic block diagram form in Fig. 4. The spatial relationships illustrated in Fig. 1 are consistent with those indicated in the perspective view of Fig. 3. Figs. 7 and 8 are a schematic block diagram and plan view, respectively, of a conventional system with a traction control system (Nohira, col. 1, ll. 30-31 and 43-50). Nohira's Fig. 9 is a plan view of a hydraulic pressure control system of the type illustrated in Figs. 7 and 8 that additionally performs a steering control by braking operation. Such a system requires control of the brake fluid at relatively high pressure and therefore utilizes electromagnetic valves SC1, SC2, SI1, and SI2 having solenoid coil portions of relatively large outer diameters.

> (Nohira, col. 1, ll. 58-67.) Accordingly, the only difference between the system of Figs. 7 and 8 and the system of Fig. 9 is in the diameters of the electromagnetic valves. The relative positions of the components are the same for the system of Fig. 9 as for the system of Figs. 7 and 8. Nohira does not illustrate a perspective view of the systems of Figs 7 and 8 and Fig. 9, but the consistency between the spatial relationships shown in Fig. 1 and Fig. 3 indicates that a perspective view of the Fig. 9 system would convey spatial relationships between the components consistent with that shown in Fig. 9.

Based on the above, we conclude that the Examiner did not err in determining that Nohira's suction valves SI1 and SI2 are closer to the suction ports of the pumps than are the regulators SC1 and SC2. While this does not appear to be in dispute, we also conclude that the Examiner properly found that Nohira's regulators SC1 and SC2 are closer to the suction ports of the pumps than are the control valve units PC1 through PC8. Appellants thus have not demonstrated error in the Examiner's rejection of claims 1 and 10. The rejection is sustained.

Turning next to the rejection of claim 4 as anticipated by Nohira, for reasons stated below in our new rejection under the second paragraph of 35 U.S.C. § 112 entered under the provisions of 37 C.F.R. § 41.50(b), no reasonably definite meaning can be ascribed to certain language appearing in the claims. "All words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious -- the claim becomes indefinite." *In re Wilson*,

424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions (*see In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962)), we are constrained to reverse, pro forma, the Examiner's rejection of claim 4 under 35 U.S.C. § 102(b) as anticipated by Nohira. We hasten to add that this is a procedural reversal rather than one based upon the merits of the anticipation rejection.

We turn next to the rejection of claim 5 as anticipated by Nohira. Appellants contend that the Examiner has failed to identify any disclosure in Nohira that the regulators SC1 and SC2 of Fig. 9 are normally open solenoid valves incorporating one-way valves and relief valves alone or in combination with the regulators being on the same side of the base as the suction valves with respect to the control valve units (Appeal Br. 17). According to Appellants, the language of Nohira discussing Fig. 9 is silent with regard to these features (Appeal Br. 17-18). Appellants' argument is not well taken.

As discussed above, the only difference between Nohira's Fig. 9 hydraulic system and that of Figs. 7 and 8 is the diameter of the electromechanical solenoid valves (Nohira, col. 1, ll. 29-67). The schematic block diagram of Fig. 7 applies to Fig. 9 as well, with the exception that, in the Fig. 9 system, larger diameter valves SC1, SC2, SI1, and SI2 replace the valves TC1, TC2, TI1, and TI2 illustrated in Fig. 7.

Nohira's Fig. 7 illustrates regulators TC1 and TC2, which correspond to regulators SC1 and SC2 in Fig. 9, including normally open solenoid

valves in parallel with, and thus "incorporating," one-way valves and relief valves (not labelled in Fig. 7 but analogous to check valves AV1 and AV2 and relief valves RV1 and RV2 of Fig. 4 – Nohira, col. 5, l. 21). Further, as illustrated in Fig. 9, the regulators SC1 and SC2 and suction valves SI1 and SI2 are both on the left of the housing HL, while the control valve units PC1 through PC8 are on the right side of housing HL. We thus conclude that the features asserted by Appellants to be lacking in Nohira are in fact disclosed by Nohira. Appellants have not demonstrated error in the Examiner's rejection of claim 5 as anticipated by Nohira. The rejection is sustained.

We turn our attention next to the rejection of claims 9 and 12, which recite that placement of the suction valves improves suction efficiency of the pumps when the pumps are operated with the suction valves to perform skidding control and traction control. Appellants (Specification 18:6-14) explain this feature as follows:

> The suction valves 12A, 12B are disposed on the base 22 in positions closer to the suction port 42 of each of the pumps 10A, 10B than the control valve unit VA through VD and the regulators 21A, 21B. It is possible to arrange the suction valves 12A, 12B in close proximity the suction port 42 of each of the pumps 10A, 10B. Thus it is possible to improve the negative pressure transport factor from the suction port 42 of each of the pumps 10A, 10B to the suction valves 12A, 12B, thereby improving the suction efficiency of the pumps 10A, 10B, when the pumps 10A, 10B are operated with the suction valves 12A, 12B are opened in order to perform skidding control and traction control of a vehicle.

It is apparent from this explanation that Appellants attribute improved suction efficiency of the pumps when operated with the suction valves to the

placement of the suction valves in close proximity to the pumps and, in particular, in positions closer to the suction port 42 of each of the pumps than the control valve units and regulators. As discussed above, the Examiner correctly determined that Nohira's suction valves SI1 and SI2 in Fig. 9 are closer to the suction ports of the pumps than the regulators SC1 and SC2 and the control valve units PC1 through PC8 and, in so doing, provided sufficient basis in fact and/or technical reasoning to reasonably support the determination that the placement of Nohira's suction valves SI1 and SI2 inherently improves suction efficiency of the pumps when the pumps are operated with the suction valves, as called for in claims 9 and 12, so as to shift the burden to Appellants to prove otherwise. Once the USPTO establishes a prima facie case of anticipation based on inherency, the burden shifts to appellant to prove that the prior art does not possess the characteristic at issue. *See In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986). Appellants have not come forth with any evidence or explanation as to why the placement of Nohira's suction valves SI1 and SI2 would not improve suction efficiency and thus has not met that burden. Appellants thus have failed to demonstrate error in the Examiner's rejection of claims 9 and 12. The rejection is sustained.

We move now to the rejection of claims 3, 6, and 11 as unpatentable over Nohira. With respect to claim 3, the Examiner determines that Nohira meets all of the recited limitations with the exception of the relief valve and one-way valve being on opposite sides of the normally open solenoid valve (Answer 5-6). With respect to claim 6, the Examiner determines that Nohira meets all of the recited limitations except the pressure sensor being on the base below the regulators (Answer 6). With respect to claim 11, the

Examiner determines that Nohira meets all of the recited limitations with the exception of the pressure sensor being positioned below the third row and above the reservoir (Answer 6). Appellants take issue with the Examiner's determinations, alleging that Nohira is silent with respect to these features (Appeal Br. 21-25). Accordingly, the first issue before us in deciding the appeal of the rejection of claims 3, 6, and 11 is whether the Examiner erred in determining which claimed features are met by Nohira.

Turning first to claim 3, Nohira's Fig. 7 illustrates normally open solenoid valves TC1 and TC2, which correspond to regulator solenoid valves SC1 and SC2 in Fig. 9, each connected in parallel with a one-way valve and a relief valve (not labelled in Fig. 7 but analogous to check valves AV1 and AV2 and relief valves RV1 and RV2 of Fig. 4 – Nohira, col. 5, l. 21) between an output hydraulic passage from the master cylinder MC and a hydraulic passage in a flow path with one of the reservoirs RS1 and RS2 via at least one check valve. We thus conclude the Examiner correctly determined Nohira meets all the limitations of claim 3 except that Nohira's one-way valve and relief valve are both disposed on the same side of the normally open regulator solenoid valve SC1 or SC2, rather than on opposing sides of the normally open solenoid valve as called for in claim 3.

As to claims 6 and 11, Nohira illustrates in Fig. 9 a pressure sensor PS, but the pressure sensor PS is disposed above the regulators SC1 and SC2, not below them as called for in claim 6 or below the third row (the row with the suction valves SI1 and SI2 and regulator valves SC1 and SC2) as called for in claim 11. While Nohira does not provide a perspective view for the system of Fig. 9, such systems are structured with the valves and pressure sensor protruding from the inner face of the housing, as illustrated

in Fig. 3. Accordingly, one of ordinary skill in the art would understand Nohira's pressure sensor PS to be protruding from one face of the housing. We thus conclude the Examiner correctly determined Nohira meets all the limitations of claims 6 and 11, with the exception of the placement of the pressure sensor PS relative to the regulators SC1 and SC2 and suction valves SI1 and SI2.

The next issue presented in deciding the appeal of the rejection of claims 3, 6, and 11 as unpatentable over Nohira is whether the differences in the relative placements of components between Nohira and the claims are such as to render the claimed invention nonobvious to one of ordinary skill in the art. The Examiner contends that these differences amount to mere rearrangements of parts involving only routine skill in the art and thus are not patentable distinctions (Answer 6). We agree.

"A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007).

"[T]he mere existence of differences between the prior art and an invention does not establish the invention's nonobviousness." Where the gap between the prior art and Appellants' claimed invention is not so great as to render the claimed invention nonobvious to one reasonably skilled in the art, the claimed invention is not patentable over the prior art. *Dann v. Johnston*, 425 US 219, 229-30, 189 USPQ 257, 261 (1976).

Moreover, when there is a design need and there are a finite number of identified, predictable solutions, a person of ordinary skill in the art has good reason to pursue the known options within his or her technical grasp. "If this leads to the anticipated success, it is likely the product not of

innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103." *KSR Int'l.*, 127 S.Ct. at 1742, 82 USPQ2d at 1397.

Turning first to claim 3, when three valves are connected together in parallel in a hydraulic circuit, as in the case of the normally open solenoid valve SC1 or SC2, the one-way valve and the relief valve of Nohira's regulator, there are only a finite number (6) of arrangements in which the three valves can be placed relative to one another. One of ordinary skill in the art would understand that the valves will operate individually and together in precisely the same manner in any of these six arrangements, each of which is within his or her technical grasp, and thus has good reason to pursue any of the six arrangements, which present only two possibilities with respect to positioning of the one-way valve and relief valve relative to the normally open solenoid valve, namely, the one-way valve and relief valve on the same side of the normally open solenoid valve or on opposite sides of the normally open solenoid valve. We thus conclude that the difference between Appellants' claim 3 and the arrangement of Nohira is not such as to render the subject matter of claim 3 nonobvious to one of ordinary skill in the art. The rejection of claim 3 is sustained.

The design issue of whether to place the pressure sensor above the suction valves and regulator valves, as illustrated in Nohira's Fig. 9, or below the regulators as recited in claim 6 or below the suction valves and regulators as recited in claim 11 likewise presents no operative mechanical distinctions, with each element serving exactly the same function regardless of the placement of the pressure sensor, and either placement is within the technical grasp of one of ordinary skill in the art. The exact placement of

the pressure sensor relative to the suction valves and regulators is simply the result of ordinary creativity, not innovation. We thus conclude that the differences between the subject matter of claims 6 and 11 and the arrangement of Nohira are not such as to render the subject matter of these claims nonobvious to one of ordinary skill in the art. The rejection of claims 6 and 11 is sustained.

We turn next to the rejection of claim 2 as unpatentable over Nohira in view of Brachert. Claim 2 recites that the suction valves are in an uninterrupted flow path with the pumps and a single check valve in fluid communication with the reservoirs and with output hydraulic passages in fluid communication with the master cylinder. As illustrated in Fig. 7 of Nohira, each of valves TI1 and TI2, which correspond to suction valves SC1 and SC2 of Fig. 9, is in an uninterrupted flow path with a first hydraulic passage in fluid communication with the master cylinder MC and with a second hydraulic passage connected between a single check valve in fluid communication with the reservoir RS1 or RS2 and a one-way valve in fluid communication with the pump HP1 or HP2. Inasmuch as the one-way flow valve between the second hydraulic passage and the pump HP1 or HP2 always permits flow from the second hydraulic passage to the pump HP1 or HP2, we find that Nohira's suction valves SC1 and SC2 are in an uninterrupted flow path with the pumps and a single check valve in fluid communication with the reservoirs and with output hydraulic passages in fluid communication with the master cylinder. Accordingly, the rejection of claim 2 as unpatentable over Nohira in view of Brachert is sustainable on the basis of Nohira alone. In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on fewer than all of the references relied

on by the Examiner in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1966). The rejection of claim 2 is sustained.

We turn our attention finally to the rejection of claims 7 and 8, depending from claim 1 and further reciting dampers in a fluid path with the pumps and structural details of the recited dampers, as unpatentable over Nohira in view of Fujita. Nohira illustrates dampers DP1 and DP2 in fluid communication with pumps HP1 and HP2 (Nohira, Fig. 7), with inlets and outlets aligned coaxially so as to open orthogonally to axes of normally open solenoid valves PC1 through PC8. As acknowledged by the Examiner, however, Nohira is silent with respect to the structural details of the dampers as recited in claims 7 and 8 (Answer 7). The Examiner finds that these structural details of dampers were known in the art at the time of Appellants' invention, as evidenced by the damper 32a depicted in Fig. 1 of Fujita (Fujita, col. 3, ll. 42-45). The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time of Appellants' invention to employ an old and well known damper structure as taught by Fujita in a braking apparatus of Nohira since such dampers are widely available and would be cost advantageous to use (Answer 7). Appellants argue that the motivation for such a combination is not found in Nohira and Fujita (Appeal Br. 30).

While there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court or the USPTO can take account of the

inferences and creative steps that a person of ordinary skill in the art would employ. *KSR Int'l.*, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

*Id.* at 1740, 82 USPQ2d at 1396. We must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.*

To merely employ the known damper technology taught by Fujita in the hydraulic braking system of Nohira to fill in the details not specified by Nohira involves only routine skill in the art and common sense and does not require innovation. The use of such known damper technology in the hydraulic braking system of Nohira according to its established function within a hydraulic braking system, as disclosed by Fujita, would yield only predictable results. We conclude that the combined teachings of Nohira and Fujita reasonably support the Examiner's determination that the subject matter of claims 7 and 8 would have been obvious to one of ordinary skill in the art at the time of Appellants' invention. The rejection of claims 7 and 8 is sustained.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter the following new ground of rejection.

Claim 4 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986) (citations omitted). A claim may be invalid for indefiniteness if it is "insolubly ambiguous" and not "amenable to construction." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001).

Claim 4 recites the control valve units including normally *open* solenoid valves and then goes on to recite that the normally *closed* solenoid valves are aligned on the base so as to protrude their solenoid sections from one face of the base. There is no antecedent basis in claim 4 for normally *closed* solenoid valves. Appellants' Specification discloses both normally open valves 6A through 6D and normally closed valves 9A through 9D in the control valve units (Specification 8:14-17 and Fig. 1) and additionally discloses normally open valves 5A and 5B in the regulators and normally closed suction valves 12A and 12B (Specification 11:5-8). All of the disclosed valves appear to be aligned on the base 22 so as to protrude their solenoid sections from one face of the base. Accordingly, one of ordinary skill in the art would not understand what is claimed when claim 4 is read in

light of Appellants' Specification. Specifically, a person of ordinary skill in the art would not be able to determine whether the "normally closed solenoid valves" in claim 4 refer to one of the disclosed normally closed valves, inadvertently lacking antecedent basis in the claim, or to the "normally open solenoid valves" recited in claim 4 as part of the control valve units, with the term "closed" being inserted inadvertently in place of "open." Accordingly, claim 4 is indefinite.

## SUMMARY

The decision of the Examiner to reject claims 1-12 is affirmed as to claims 1-3 and 5-12 and reversed as to claim 4. A new rejection of claim 4 under 35 U.S.C. § 112, second paragraph, is entered pursuant to 37 C.F.R. § 41.50(b).

Regarding the affirmed rejections, 37 C.F.R. § 41.52(a)(1) provides "[a]ppellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejections of one or more claims, this decision contains 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 Appellants, 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 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. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. § 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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) (2006).

AFFIRMED-IN-PART; 37 C.F.R. § 41.50(b)

hh

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