

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* THOMAS L. DISTEFANO III

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Appeal 2011-001447  
Application 10/868,312  
Technology Center 2100

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*Before* CARL W. WHITEHEAD JR., ERIC S. FRAHM, and  
ANDREW J. DILLON, *Administrative Patent Judges*.

DILLON, *Administrative Patent Judge*.

DECISION ON REMAND

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's rejections of claims 22–28. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection under 37 C.F.R. § 41.50(b).

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## STATEMENT OF THE CASE

In a Decision on Appeal mailed May 30, 2013, we affirmed the Examiner's rejections of: claims 22 and 23 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,930,777 to Barber; and claims 24–28 under § 102(b) as anticipated by U.S. Patent No. 6,026,433 to D'Arlach.

On July 30, 2013, Appellant filed a Request for Rehearing arguing *inter alia* that the Decision on Appeal presents a new ground of rejection for claim 24.

In a Decision on Request for Rehearing mailed August 20, 2013, we denied Appellant's Request for Rehearing.

On October 18, 2013, Appellant filed a Petition for Review of the present appeal before the United States Court of Appeals for the Federal Circuit (Case No. 2014-1130).

On June 4, 2014, the Court issued an Order remanding the present appeal. The Order states:

The PTO concedes that the Board erred in failing to designate its decision as a new ground of rejection and that DiStefano will be able to request rehearing before the Board or reopen prosecution on remand as to the new ground of rejection.

And, the Order instructs: "This appeal is remanded for further proceedings consistent with this order."

Because the Order states Appellant will be able to consequently request rehearing or reopen prosecution "as to the new ground of rejection," and because Appellant requested us to enter a new ground of rejection for

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only claim 24, we view the Order as solely requiring us to enter a new ground of rejection for claim 24.

In accordance with 37 C.F.R. § 41.50(b) and pursuant to the Order, we enter this Decision on Remand vacating and replacing the prior Decision on Appeal and Decision on Request for Rehearing.

### ILLUSTRATIVE CLAIMS

Independent claim 22 is illustrative:

22. A method, within a development system, of developing an electronic document, comprising:

providing a partial-access user with limited access to web assets accessible through the development system;

providing a greater-access user with both the limited access and additional access to the web assets accessible through the development system;

receiving a web asset authored a third party author; and

compensating the third party author upon the greater-access user accessing, via the additional access, the web asset authored by the third party author.

Independent claim 24 is also illustrative:

24. A method of designing, by a user in a user interface having first and second display regions each capable of displaying a plurality of element, an electronic document, comprising:

selecting a first element from a database including web assets authored by third party authors and web assets provided to the user interface from outside the user interface by the user;

displaying the first element in the second display region;

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interactively displaying the electronic document in the first display region;

modifying the first element displayed in the second display region upon receiving a first command to modify the first element in the second display region; and

displaying the modified first element in the first display region, wherein the modified first element forms at least part of the electronic document.

#### PRIOR ART

The Examiner relies on the following references as evidence of unpatentability:

Barber	US 5,930,777	July 27, 1999
D'Arlach	US 6,026,433	Feb.15, 2000

#### REJECTIONS

The Examiner rejected claims 22 and 23 under 35 U.S.C. § 102(b) as anticipated by Barber. Ans. 3–4.<sup>1</sup>

The Examiner rejected claims 24–28 under § 102(b) as anticipated by D'Arlach. *Id.* at 4–7.

#### CLAIMS 22 AND 23

Independent claim 22 and its sole dependent claim 23 stand rejected as anticipated by Barber. Contrary to Appellant's contention that claims 22 and 23 each "stand alone" (App. Br. 5), Appellant addresses the subject

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<sup>1</sup> Throughout this opinion, we refer to the Appeal Brief filed March 17, 2010 ("App. Br."), the Examiner's Answer mailed June 10, 2010 ("Ans."), and the Reply Brief filed August 10, 2010 ("Reply Br.").

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matter of only claim 22. Claim 23 accordingly stands or falls with claim 22. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 22 (reproduced *supra*) is directed to a method that includes steps by which a development system, partial-access user, greater-access user, and third party author interact with web assets. Appellant argues that the Examiner fails to treat the claimed users and author as distinct from the system. App. Br. 6–9; Reply Br. 2–3. Appellant contends the users and author are implicitly distinct from the system because: the web assets are accessed by the users “through” the system (Reply Br. 3); the web assets are received “within” the system from the author (*id.*); and the author is compensated by the system (App. Br. 8). Appellant further contends that the asserted distinctiveness is required by the Specification’s description of a user 180, author 120, and server 140 as respective entities. Reply Br. 3.

The Examiner construes claim 22 as permitting the claimed users and author to be part of the system. According to the Examiner, the claim language does not limit the system “to a single component/entity/computer” and thus more than one entity can form the system. Ans. 9.

We agree with the Examiner. Claim 22 does not require the users and author to be distinct from the system. Contrary to Appellant’s contentions, the term “through” merely requires the users to access the web assets by way of—, by the instrumentality of—the system. *See e.g., Random House Webster’s Unabridged Dictionary* 1977 (2d ed. 2001). Under this interpretation, the user can be part of the system and access the web assets by way of another part.

Also contrary to Appellant’s contentions, mere performance of the receiving step “within” the system does not require the received web asset to

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originate from a non-system author. Rather, the receiving could be performed by a part of the system and, in turn, the web asset could originate from another part. Furthermore, even assuming *arguendo* that performance of the receiving step “within” the system would instead be understood as requiring the received web asset to originate from a non-system author, the claim language at issue – “within a development system” – is nonetheless non-limiting preamble language. Particularly, it is preamble language that does not state a necessary and defining aspect of the claimed method, but merely confirms the method steps may be ascribed to one or more devices; i.e., are not restricted to performance by a single entity. *See e.g., On Demand Mach. Corp. v. Ingram Indus.*, 442 F.3d 1331, 1343 (Fed. Cir. 2006) (“In considering whether a preamble limits a claim, the preamble is analyzed to ascertain whether it states a necessary and defining aspect of the invention, or is simply an introduction to the general field of the claim.”); *see also Arshal v. United States*, 621 F.2d 421, 430 (Ct. Cl. 1980) (“Where . . . the effect of the words [in the preamble] is at best ambiguous . . . a compelling reason must exist before the language can be given weight.” (citation omitted)).

Further, contrary to Appellant’s contentions, claim 22 does not recite the claimed compensating step as being performed “by” the system. And, even assuming *arguendo* the above-addressed preamble language requires all claim steps to be performed “within” the system, such a requirement would merely in turn require that the step of compensating the author occurs within the system. Under such an interpretation, the author can be part of the system and compensated by another part.

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Finally, contrary to Appellant's contentions, the Specification does not clearly disavow the above interpretations of the claimed method; that is, does not preclude embodiments in which the users and author are part of the system. *See Thorner v. Sony Computer*, 669 F.3d 1362, 1366–67 (Fed. Cir. 2012) (“To constitute disclaimer, there must be a clear and unmistakable disclaimer.”). In fact, the Specification conversely describes a “system in which the method of the present invention can be practiced” (Spec. 4, ll. 20–21) and that includes such a user 180 and author 120.

For the foregoing reasons, the anticipation rejection of claims 22 and 23 over Barber is sustained.

#### CLAIMS 24, 27, AND 28

Claims 24, 27, and 28 stand rejected as anticipated by D'Arlach. Claims 27 and 28 depend from independent claim 24. Appellant addresses the claims collectively. App. Br. 9. Claims 27 and 28 accordingly stand or fall with claim 24. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 24 (reproduced *supra*) is directed to a method that includes a step of “selecting a first element from a database including web assets authored by third party authors and web assets provided to the user interface from outside the user interface by the user.” Addressing these web assets, Appellant argues:

The [claim] phrase “provided to the user interface by the user” includes two prepositions: “to the user interface” and “by the user.” Both of these prepositions modify “web assets provided.” Thus, the web assets are provided to the user interface, and the web assets are provided by the user. The Examiner's alleged construction . . . ignores that the web data . . . are provided by the user.

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Reply Br. 4.

The Examiner construes the asserted claim language – “provided to the user interface from outside the user interface by the user” – as requiring merely that web assets be provided to a user interface as a result of the user, e.g., “by the user’s request.” Ans. 15. We disagree with the Examiner. The claim language at issue plainly states that the database’s included web assets are provided: to the user interface; from outside the user interface; *and by the user*.

For the foregoing reasons, the anticipation rejection of claims 24, 27, and 28 over D’Arlach is not sustained

#### NEW GROUNDS OF REJECTION FOR CLAIM 24

For the reasons stated below, web assets’ origination from third party authors and the user cannot patentably distinguish (i.e., cannot breathe novelty into) the claimed method, particularly because the web assets’ origins have no functional relationship to the claimed method. *See King Pharmaceuticals, Inc. v. Eon Labs, Inc.*, 616 F.3d 1267, 1278–79 (Fed. Cir. 2010) (discussed *infra*). Accordingly, pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claim 24 under § 102(b) as anticipated by D’Arlach. We do so for the reasons presented by the Examiner’s rejection, but replace the Examiner’s above-addressed erred findings with our determination that the web asset’s origins have no functional relationship to the claimed method and therefore cannot patentably distinguish the claimed method over D’Arlach. Though the new grounds of rejection need not address Appellant’s arguments on this issue (presented within the Request for Rehearing), we will further explain our reasoning in light of Appellant’s principal contentions.



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Appellant argues that the web assets' origins are functionally related to the claimed method as follows:

In the context of the enabled invention, the limitations at issue (i.e., "web assets provided to the user interface from outside the user interface by the user") refers to a functional feature – web assets (found within the database) that have been uploaded by the user.

Req. Reh'g 13. Contrary to Appellant's argument, the recitation of the web assets' origins does not implicitly require a step by which the user uploads the web assets to the database. Rather, at best, the recitation implicitly requires that the step of selecting a first element from the database entails doing so from a database storing user-uploaded web assets. There is no apparent difference, however, between: (i) selecting of the first element from a database including user-uploaded web assets; and (ii) selecting of the first element from a database generally. Thus, the web assets' origins are a mere property of the web assets that have no apparent effect upon even a single step of the claimed method. In fact, because the web assets' origins are not even stored (e.g., recorded as a web asset attribute) within the database, there is no conceivable manner by which the web assets' origins could influence performance of a computer-implemented method; that is, could influence performance without being stored for processing. Being devoid of any influence upon the claimed method, the web assets' origins clearly cannot be functionally related to the claimed method and therefore cannot patentably distinguish the claimed method over D'Arlach. *See King Pharmaceuticals*, 616 F.3d at 1278–79.

Note that even assuming *arguendo* the web assets' origins implicitly require a step of uploading the web assets to the database by the user, as

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argued by Appellant (*see* above block quote), the uploading step would also lack a functional relationship to the claimed method. More particularly, the uploading step would have no influence upon the processing of the first element and in turn no influence upon the user's "designing [of] an electronic document" (preamble) via the claimed steps of:

selecting a first element from [the] database . . . ; displaying the first element in the second display region; interactively displaying the electronic document in the first display region; modifying the first element displayed in the second display region upon receiving a first command to modify the first element in the second display region; and displaying the modified first element in the first display region, wherein the modified first element forms at least part of the electronic document.

*King Pharmaceuticals* presents a similar determination. In *King Pharmaceuticals*, a claim at-issue (claim 21) required a step of "informing the patient that administration of a therapeutically effective amount of metaxalone in a pharmaceutical composition with food results in an increase in the maximal plasma concentration (C<sub>max</sub>) and extent of absorption (AUC<sub>(last)</sub>) of metaxalone compared to administration without food." 616 F.3d at 1277. The Federal Circuit determined the informing step was not functionally related to the claimed method, stating:

King contends that there is a functional relationship between the "informing" limitation and the method. Specifically, at oral argument, King's counsel argued that the "informing" limitation increases the likelihood that the patient will take metaxalone with food, thereby increasing the efficiency of the method. . . . This relationship, however, is not functional. Informing a patient about the benefits of a drug in no way transforms the process of taking the drug with food. Irrespective of whether the patient is informed about the benefits, the actual method, taking metaxalone with food, is the

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same. In other words, the “informing” limitation “in no way depends on the [method], and the [method] does not depend on the [‘informing’ limitation].” *In re Ngai*, 367 F.3d [1336,] 1339 [(Fed. Cir. 2004)] (alterations added).

*Id.* at 1279. We likewise find that, in the Federal Circuit’s words, the asserted uploading of web assets to the database by the user in no way transforms the user’s designing of the electronic document via the claimed method’s steps of selecting, displaying, modifying, and re-displaying (as modified) the first element. Irrespective of such uploading, the actual method of designing the electronic document – which entails only processing of the first element – is the same. The uploading in no way depends on the method of designing the electronic document. And, the method of designing the electronic document does not depend on such uploading.<sup>2</sup>

Note also that, in *King Pharmaceutical*, the Federal Circuit found that the informing step merely pronounced an inherent property of the claimed method. *See id.* at 1278 (“The specific question before us is whether an otherwise anticipated method claim becomes patentable because it includes a step of ‘informing’ someone about the existence of an inherent property of that method.”). Namely, the step informed users that administering “a therapeutically effective amount of metaxalone in a pharmaceutical composition with food” (base claim 1) “increase[s] . . . absorption

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<sup>2</sup> Assuming *arguendo* the first element were a web asset, and assuming each web asset’s origin were recorded within the database, and that selecting of the first element were based on the origin thereof, then there would be a clear functional relationship between performance of the claimed method and the web asset’s origins. However, there is simply no such functional relationship between the presently claimed method and web asset’s origins.

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(AUC(last)) of metaxalone compared to administration without food” (dependent claim 21). *See id.* at 1274 (claim 1) and 1277 (claim 21). The inherency finding does not render *King Pharmaceuticals* inapplicable to the facts at hand. The inherency finding was at most a basis – and certainly not a requirement – for the Federal Circuit’s determination that the informing step had no bearing upon the claimed administration of metaxalone. *See id.* at 1279 (“Informing a patient about the benefits of a drug in no way transforms the process of taking the drug with food.”). Furthermore, if such an inherency finding were required to place a fact pattern within the purview of *King Pharmaceuticals*, the Federal Circuit would not have relied upon the reasoning of *Ngai* and *Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), which lack any discussion of inherency. *See King Pharmaceuticals*, 616 F.3d at 1279 (discussing *Ngai* and *Gulack*).

Appellant also argues:

[D]espite the claim limitations at issue being directed to a functional feature, this is a moot point. The printed matter doctrine applies only to printed matter. Moreover, the Federal Circuit has clearly stated that the printed matter doctrine does not apply to computer data structure, and “describ[ing] the origins of the database’s stored web assets” is characteristics of computer data structures (e.g., the web assets).

Req. Reh’g 14. The argument is not persuasive for each of three reasons.

First, the argument is incorrect insofar that the printed matter doctrine is not limited “only to printed matter.” For example, the above-addressed analysis of *King Pharmaceuticals* relies on *Ngai*’s and *Gulack*’s discussion of printed matter in finding that the informing step, though not directed to printed matter, is not functionally related to the claimed method in view of the printed matter doctrine. *See King Pharmaceuticals*, 616 F.3d at 1279

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“Although these ‘printed matter’ cases involved the addition of printed matter, such as written instructions, to a known product, we see no principled reason for limiting their reasoning to that specific factual context. *See In re Ngai*, 367 F.3d at 1338–39; *In re Gulack*, 703 F.2d at 1385–87.”); *cf.*, 616 F.3d at 1279–80 (addressing a printed label notification). And, the Federal Circuit has clarified that “merely underlying data,” as opposed to data dictating operations and/or structure, can also fall within the purview of the printed matter doctrine. *See In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Nor are the data structures analogous to printed matter. *Lowry*’s ADOs do not represent merely underlying data in a database. ADOs contain both information used by application programs and information regarding their physical interrelationships within a memory. *Lowry*’s claims dictate how application programs manage information. Thus, *Lowry*’s claims define functional characteristics of the memory.”).

Second, the argument mischaracterizes the claimed method’s recitation of the web assets’ origins as restricting data structure. As acknowledged by Appellant, *Lowry* presents excellent guidance for determining whether a claim feature constitutes a restriction of data structure. *Req. Reh’g* 13 n.9. “The *Lowry* court . . . concluded that the claimed data structures were ‘physical entities that provide increased efficiency in computer operation[.]’” *Ex parte Nehls*, 88 USPQ2d 1883, 1888 (BPAI 2008) (precedential) (citing *Lowry*, 32 F.3d at 1584). More particularly, *Lowry*’s claimed data structures included data objects having “hierarchical” and “pointing” relationships that formed an “arrangement . . . facilitat[ing] software operations.” 32 F.3d at 1580–81. The web assets’ origins constitute no such restrictions of data structure.

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Third, even assuming *arguendo* the web assets' origins constitute a restriction of data structure, there is no presented evidence that such structure would influence the claimed method. Whereas *Lowry* addressed claims for computer memory data structure including data objects with a restricted relational structure (32 F.3d at 1580), Appellant's claimed method presents the web assets' origins as an incidental property of the database's contents. Thus, *Lowry's* restriction of data structure – and particularly of the data objects' relational structure – directly affected the claimed computer memory data structure including the data objects. *See* 32 F.3d at 1581 (claim 1); *see also id.* at 1580 (“Data structures are the physical implementation of a data model’s organization of the data.”). But here, even assuming the web assets' origins constitute a restriction of data structure, there is no apparent affect upon the claimed method's implementation. *See Nehls*, 88 USPQ2d at 1888 (appellant failed to show that a recited restriction of data, asserted as patentably distinguishing the claimed method over the prior art, “functionally affect[s] the process . . . by changing the efficiency or accuracy or any other characteristic”).

#### *Remaining Dependent Claims 27 and 28*

The Patent Trial and Appeal Board is a review body, rather than a place of initial examination. We have made a new ground of rejection above under 37 C.F.R. § 41.50(b) as to claim 24. However, we have not reviewed remaining claims 27 and 28, which depend from claim 24, to the extent necessary to determine whether these claims are unpatentable under 35 U.S.C. §§ 102 or 103. We leave it to the instant Examiner to determine the appropriateness of any further rejection based thereon.

## CLAIMS 25 AND 26

Claims 25 and 26 stand rejected as anticipated by D’Arlach. Claim 25 depends from claim 24 and recites:

25. The method of claim 24, further comprising, prior to displaying the first element in the second display region:

receiving a search request;

displaying a list of available elements stored in the database in response to the search request;

receiving a selection command to select the first element from the results.

Claim 26 depends from claim 25 and recites:

26. The method of claim 25, wherein

the list of available elements includes a plurality of element categories, and

each element category includes a respective sub-list of available elements within the respective element category.

Claims 25 and 26 are each separately addressed by Appellant. App. Br. 12–17; Reply Br. 9–13. We address both sets of arguments with reference to claim 26, which of course incorporates by reference the subject matter of intervening claim 25.

Before turning to the arguments, we note the claimed “search request” is not described by either claim 25 or 26, e.g., not specified to be a word search. We therefore construe the method of claim 26 as performing, in response to a non-descript search request, acts of determining and displaying a list of selectable elements that includes at least two categorical sub-lists. In accord with an ordinary meaning of “search” within the computer arts and

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consistent with Appellant's Specification, we construe the claimed "search request" as meaning a selective retrieving of data. *See e.g.*, "search." Dictionary.com Unabridged. Random House, Inc. (<http://dictionary.reference.com/browse/search> (last visited August 11, 2013)) ("the act or process of electronically retrieving data, Web pages, database records, or other information from files, databases, etc."); *accord* Spec. 12, l. 8–13, l. 13 (describing "search buttons" that merely retrieve available style options (e.g., retrieve a "color pallet 640" [sic] of Appellant's Figure 6); also describing "search entry fields").

Appellant argues that the Examiner failed to cite a "list of available elements being displaying [sic] or that this list is displayed in response to a search request." Reply Br. 9. Appellant contends that "throughout the Examiner's analysis, the Examiner cites to both Figures 4 and 6 of D'Arlach, which do not describe what is being displayed." *Id.* at 13. Noting that D'Arlach's Figure 10 is "heavily relied upon by the Examiner," Appellant further contends that the Examiner cites Figure 10 as "teach[ing] the limitations associated with the limitations at issue, which occur prior to what is being displayed in Fig. 10." *Id.* at 12.

The Examiner's findings are best described with respect to D'Arlach's Figure 10, which is reproduced below and illustrates a "display screen for changing the text attributes of an exemplary button" (D'Arlach, col. 3, ll. 15–17).



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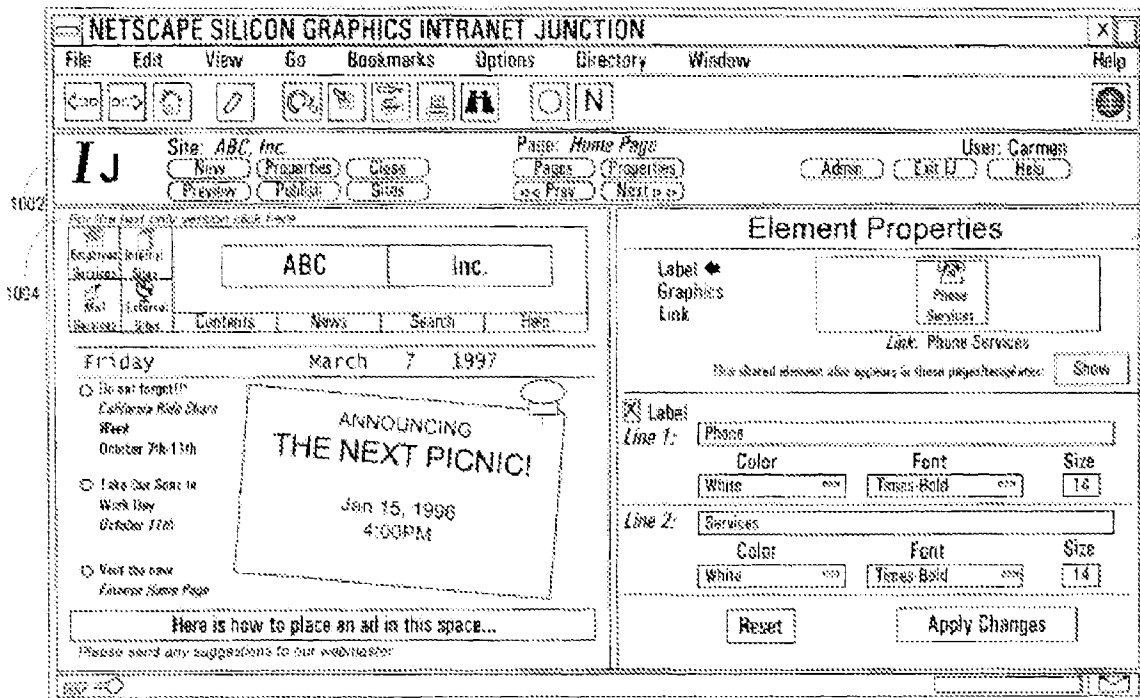


FIGURE 10

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D’Arlach’s Figure 10 illustrates the display screen cited by the Examiner.

The Examiner cites the screen’s left and right frames as respectively corresponding to the claimed first and second display regions. Ans. 5 (addressing base claim 24). The Examiner cites the prior selection of a “particular site” and resulting return of site elements as corresponding to the claimed search request and display of selectable elements. *Id.* at 6.

We agree with the Examiner’s findings. The cited selection of a “particular site” includes the selection of a style template. As explained by D’Arlach:

[S]tyle templates are stored in the server computer as database files and consist of a set of objects or elements stored in the database. To allow creating a new Web site, a CGI program first makes a copy of an existing template in the server computer. The user then customizes or edits the working copy

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of the template, which is the user's site, through a series of forms displayed by a browser in the client computer.

D'Arlach, col. 5, ll. 14–21; *cf.*, Ans. 18 (citing D'Arlach, col. 5, ll. 14–25). In light of the above, Appellant has not shown that the Examiner erred in finding that D'Arlach's cited selection of a "particular site" and resulting return of site elements – which includes menu button selection of a style template and a corresponding return of selectable objects or elements (shown by D'Arlach's Figure 10) – respectively teach the claimed search request and resultant determining and displaying of selectable elements.

As discussed, claim 26 further requires, in response to the search request, determining and displaying a list of selectable elements that includes at least two categorical sub-lists. As shown by the above-quoted passage of D'Arlach, selecting one of D'Arlach's style templates ("search request") yields a determination of the available elements for that style. As shown by D'Arlach's Figure 10, the selection also yields a displayed listing of the available elements by category, e.g., graphics, labels, and links.<sup>3</sup> *See also* D'Arlach, col. 4, ll. 61–64. And as further shown by Figure 10, selection of a categorical subset results in displaying of the corresponding sub-list of selectable elements, e.g., labels "line 1" and "line 2." *See also id.* at Figs. 11 (listing available "graphics elements," i.e., "system images") and 12 (listing available "link" elements). Thus, contrary to Appellant's arguments, D'Arlach's cited teachings do not fail to convey the claimed displaying of available elements or the corresponding prior search request.

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<sup>3</sup> Though D'Arlach's Figure 10 references the graphics, labels, and links as "element properties," they clearly constitute "elements" as disclosed by Appellant's Specification (*see e.g.*, Spec. 12, ll. 11–14).

For the foregoing reasons, the anticipation rejection of claims 25 and 26 over D'Arlach is sustained.

### DECISION

The Examiner's decision rejecting claims 22, 23, 25, and 26 is affirmed.

The Examiner's decision rejecting claims 24, 27, and 28 is reversed.

Pursuant to our authority under 37 C.F.R. § 41.50(b), a new ground of rejection is entered for claim 24 under 35 U.S.C. § 103(a) as unpatentable over D'Arlach.

The new grounds of rejection shall not be considered final for judicial review. *See* 37 C.F.R. § 41.50(b). Appellant must, WITHIN TWO MONTHS FROM THE DATE OF THE PRESENT DECISION, 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. . . .

37 C.F.R. § 41.50(b).

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

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

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