

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte GARTH JANKE

Appeal 2015-000148
Application 13/135,213
Technology Center 2100

Before HUNG H. BUI, JON M. JURGOVAN, and
JOHN F. HORVATH, *Administrative Patent Judges*.

HORVATH, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Appellant filed a Request for Rehearing on Dec. 29, 2016 (hereafter “Request”) under 37 C.F.R. § 41.52(a)(1), asking us to reconsider our Decision on Appeal mailed Nov. 4, 2016 (hereafter “Decision”). The Decision affirmed (1) the Examiner’s rejection of claims 1 and 14–21 under 35 U.S.C. § 103(a) as obvious over Culliss and Chowdhury, and (2) the Examiner’s rejection of claims 22–33 under 35 U.S.C. § 103(a) as obvious over Culliss, Chowdhury, and Lin. We have considered the questions presented by Appellant in the Request, and are not persuaded the Board has

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misapprehended or overlooked any points in issuing its Decision. Therefore, Appellant's Request is DENIED.

ANALYSIS

A “request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1). Appellant does not state the particular points Appellant believes the Board has misapprehended or overlooked, but rather requests rehearing because, in Appellant's view, “the Decision was non-responsive to the issue Appellant raised” on appeal. Req. Reh'g, 1. Nonetheless, because Appellant appears *pro se*, we consider and address the issues raised in Appellant's Request as follows.

First, Appellant argues the issue raised on Appeal was whether “the combination of Culliss and Chowdhury fails to teach performing the ultimate search *regardless* of whether the user accepts the search term suggestions.” Req. Reh'g, 1. We disagree.

The issue raised on Appeal was whether claim 1 was obvious over Culliss and Chowdhury. *See* Appeal Br. 2–7. We addressed that issue in our Decision, agreeing with the Examiner's conclusion that claim 1 was obvious over Culliss and Chowdhury because, as an open-ended claim, “claim 1 does not prohibit the performance of steps in addition to its positively recited steps, including such additional steps as sending recommended search terms to a user and receiving user acceptance of the recommended search terms (e.g., as taught by Culliss).” Dec. 3–4. Appellant does not disagree with or find error in that analysis, admitting that “[y]es, the claim is open-ended and allows for adding a step of user confirmation.” Req. Reh'g, 1.

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Next, Appellant argues our Decision was non-responsive to the issue raised on Appeal because claim 1 could have been rewritten to require “determining whether the first and second search queries are from the same source and have the same search objective, and if so, **unconditionally** performing an ultimate search defining ultimate search results that are informed by both the first and second search queries and returning the ultimate search results to the source.” Req. Reh’g, 2. Again, we disagree.

The Board “may affirm or reject the decision of the examiner in whole or in part *on the grounds and on the claims specified by the examiner.*” 37 C.F.R. § 41.50(a)(1) (emphasis added). The Decision affirmed the rejection of claim 1 on Appeal, rather than on Appellant’s rewritten claim, which was before neither the Board nor the Examiner. *See* Dec. 2–6; Final Act. 2–4; Appeal Br. 8 (Claims App’x). As noted *supra*, Appellant agrees that claim 1 on Appeal is an open-ended claim that allows additional steps to be performed. *See* Req. Reh’g, 1. Thus, claim 1 literally reads on methods for using a search engine that include suggesting search terms to a user, and determining whether the user has accepted the suggested search terms. It is, therefore, properly rejected as obvious over Culliss and Chowdhury. *See In re Lambert*, 212 F.2d 594, 598 (CCPA 1954) (“[W]hen a claim is fairly readable on prior art it must be rejected for failure to patentably distinguish itself over such prior art.”). Indeed, in its Appeal, Appellant characterized claim 1 as requiring (A + B) (where A is determining whether two queries are from the same source, and B is determining whether the two queries have the same search objective), didn’t dispute the Examiner’s finding that Culliss and Chowdhury teaches (A + B + C) (where C is determining whether a user has accepted search terms suggested by the search engine),

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and admitted that “(A + B) reads on (A + B + C) . . .” *See* Appeal Br. 2, fn. 5.¹

The fact that (A+B) also reads on (A + B + not(C)), which appears to be the point Appellant believes the Board misapprehended or overlooked,² is immaterial to whether claim 1 is patentable over Culliss and Chowdhury. *See Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1346 (Fed. Cir. 1999) (“[I]f granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is [unpatentable], *regardless of whether it also covers subject matter not in the prior art.*”) (emphasis added).

Lastly, Appellant requests that we answer a series of questions, including whether “claim 1 in its current form inherently includes [an] ‘**unconditionally**’ requirement.” Req. Reh’g, 2. Appellant argues “it doesn’t make sense to Appellant to agree that claim 1 is obvious unless the answer to at least one of these questions is ‘Yes.’” *Id.*

¹ We note the logical inconsistency in Appellant’s complete argument, i.e., that although “(A + B) reads on (A + B + C) because (A + B + C) necessarily . . . includes (A + B),” claim 1 is patentable because “‘doing (X) if (a) and (b)’ doesn’t read on ‘doing (X) if (a), (b), and (c)’ because the latter doesn’t necessarily include the former.” Appeal Br., fn. 5. Regardless of the inconsistency, the question addressed in our Decision wasn’t whether the latter (i.e., the prior art) includes the former (i.e., the claim), but whether the former includes the latter, and therefore reads on the prior art.

² *See, e.g.*, Req. Reh’g 1 (“[I]t is a *nonobvious difference* between the claimed invention and the prior art that the prior art will not perform an ultimate search if user confirmation is not received, whereas the claimed invention will.”).

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The Rules do not require the Board to answer Appellant's questions, or to provide Appellant with an advisory opinion on a claim that is not before the Board, and we decline to do so. As noted *supra*, claim 1 on Appeal is an open ended claim that allows additional steps to be performed, including steps that place additional conditions on if and when an "ultimate search" is performed, which are taught in the prior art. *See* Dec. 3-4; Appeal Br. 8 (Claims App'x).

For the reasons discussed above, we do not find our Decision misapprehended or overlooked any points Appellant raised on Appeal. Accordingly, Appellant's request for rehearing is denied.

DECISION

Appellant's Request for Rehearing is denied. This Decision on Request for Rehearing incorporates our Nov. 4, 2016 Decision on Appeal, and is final for the purposes of judicial review. 37 C.F.R. § 41.52(a)(1).

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

REHEARING DENIED