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In re Application of :
MAUGER, Stefan Jozef :
Application No. 17/269,025 :
Filed: 17 Feb 2021 : **DECISION ON PETITION**
For: IMPLANTABLE COMPONENTS :
AND EXTERNAL DEVICES :
COMMUNICATING WITH SAME :

This is a decision on the petition filed November 18, 2024, pursuant to 37 CFR 1.181, requesting supervisory review and reconsideration of the decision issued on September 17, 2024, by the Director of Technology Center 3700 (hereinafter “Technology Center Director”), which Technology Center Director’s decision refused to withdraw the finality of the Office action issued on June 20, 2024.

The petition to overturn the Technology Center Director’s decision of September 17, 2024, and withdraw the finality of the Office action of June 20, 2024, is **DENIED**.

RELEVANT BACKGROUND

The instant application was filed on February 17, 2021, under 35 U.S.C. § 371 as a U.S. National Stage entry to PCT/IB2019/057749, filed September 13, 2019.

Prosecution of the above-named application led to a non-final Office action being issued on January 17, 2024. The non-final Office action of January 17, 2024, (hereinafter “non-final Office action”), included, *inter alia*: (1) a rejection of claims 24 through 27, 29, and 34 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement; (2) a rejection of claims 24 through 27, 29, and 34 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention; (3) a rejection of claims 24 through 27, 29, and 34 under 35 U.S.C. § 102(a)(1) as being anticipated by Darley et al. (U.S. Pat. Publ’n No. 2007/0106344; hereinafter “Darley”); (4) a rejection of claims 26, 27, 29, and 34 under 35 U.S.C. § 103 as unpatentable over Darley; and (5) a rejection of claims 24 through 27, 29, and 34 under 35 U.S.C. § 103 as being unpatentable over Parker et al. (U.S. Pat. Publ’n No. 2012/0053657; hereinafter “Parker”) in view of Kolz et al. (U.S. Pat. Publ’n No. 2008/0111677; hereinafter “Kolz”).

A response to the non-final Office action of January 17, 2024, was filed on April 17, 2024, which included, *inter alia*: an amendment to the claims, amending claim 24 and adding new

claims 35 through 44, and arguments traversing the rejections presented in the non-final Office action.

A final Office action was issued on June 20, 2024, (hereinafter “final Office action”), which included, *inter alia*: (1) a response to arguments section; (2) a withdrawal of claims 37 and 38 from further consideration under 37 CFR 1.142(b); (3) a rejection of claims 24 through 27, 29, 34 through 36, and 39 through 44 under 35 U.S.C. § 112(a) as failing to comply with the written description requirement; (4) a rejection of claims 24 through 27, 29, 34 through 36, and 39 through 44 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention; (5) a rejection of claims 24 through 27, 29, 34, 35, 39 through 42, and 44 under 35 U.S.C. § 102(a)(1) as being anticipated by Darley; (6) a rejection of claims 26, 27, 29, and 34 under 35 U.S.C. § 103 as unpatentable over Darley; (7) a rejection of claims 36 and 43 under 35 U.S.C. § 103 as being unpatentable over Darley in view of Daly (U.S. Pat. Publ’n No. 2010/0016922; hereinafter “Daly”); and (8) a rejection of claims 24 through 27, 29, 34 through 36, and 39 through 44 under 35 U.S.C. § 103 as being unpatentable over Parker in view of Kolz.

A petition under 37 CFR 1.181 to the Technology Center Director was filed on August 20, 2024, requesting withdrawal of the finality of the Office action of June 20, 2024.

The petition of August 20, 2024, was dismissed by the Technology Center Director in a decision issued on September 17, 2024.

A response to the final Office action of June 20, 2024, was filed on September 18, 2024, which included, *inter alia*: arguments traversing the rejections presented in the final Office action.

An advisory action was issued on September 20, 2024, which included a response to the arguments presented in the response filed September 18, 2024.

A notice of appeal and a pre-appeal brief review request were filed on October 21, 2024.

The instant petition under 37 CFR 1.181 was filed on November 18, 2024, requesting review of the Technology Center Director’s decision issued on September 17, 2024.

A decision on the pre-appeal brief review request of October 21, 2024, was issued on November 27, 2024, which decision indicated the appeal would proceed to the Patent Trial and Appeal Board.

An appeal brief was filed on December 27, 2024.

STATUTES AND REGULATIONS

35 U.S.C. § 131 provides that:

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 U.S.C. 132(a) states:

Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Director shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

35 U.S.C. 134(a) states:

Patent applicant. An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Patent Appeals and Interferences, having once paid the fee for such appeal.

37 CFR 1.104 provides, in part, that:

(a) *Examiner's action.*

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution.

(b) *Completeness of examiner's action.* The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of

invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

(c) *Rejection of claims.*

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

(3) In rejecting claims the examiner may rely upon admissions by the applicant, or the patent owner in a reexamination proceeding, as to any matter affecting patentability and, insofar as rejections in applications are concerned, may also rely upon facts within his or her knowledge pursuant to paragraph (d)(2) of this section.

37 CFR 1.113 provides that:

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 CFR 1.181 provides, in part, that:

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter*

partes prosecution of a reexamination proceeding which is not subject to appeal to the Patent Trial and Appeal Board or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Patent Trial and Appeal Board, see § 41.3 of this title.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Director to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

OPINION

Petitioner argues that the response to arguments in the final Office action contains new grounds of rejection, which were not necessitated by an amendment or the filing of an Information Disclosure Statement (IDS), because the examiner asserts new facts and new rationales that were not present in the rejection of claims 25 and 26 in non-final Office action; and therefore, the finality of the Office action of June 20, 2024, must be withdrawn.

Whether there is a new ground of rejection depends upon whether the basic thrust of a rejection has remained the same. *See In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised to the applicant. *See In re Biedermann*, 733 F.3d 329, 337 (Fed. Cir. 2013) (quoting *In re Leithem*, 661 F.3d 1316, 1319). The prior rejection, however, need not be repeated in *haec verba* to avoid being considered a new ground of rejection. *See id.* In addition, further explanation and elaboration upon a rejection, and thoroughness in responding to an applicant's arguments, are not considered a new ground of rejection. *See In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2011). MPEP § 1207.03, subsection III specifically provides that:

A position or rationale that changes the “basic thrust of the rejection” will also give rise to a new ground of rejection. *In re Kronig*, 539 F.2d 1300, 1303 (CCPA 1976).

However, the examiner need not use identical language in both the examiner's answer and the Office action from which the appeal is taken to avoid triggering a new ground of rejection. It is not a new ground of rejection, for example, if the examiner's answer responds to appellant's arguments using different language, or restates the reasoning of the rejection in a different way, so long as the "basic thrust of the rejection" is the same. *In re Kronig*, 539 F.2d at 1303; see also *In re Jung*, 637 F.3d 1356, 1364-65 (Fed. Cir. 2001) (additional explanation responding to arguments offered for the first time "did not change the rejection" and appellant had fair opportunity to respond); *In re Noznick*, 391 F.2d 946, 949 (CCPA 1968) (no new ground of rejection made when "explaining to appellants why their arguments were ineffective to overcome the rejection made by the examiner"); *In re Krammes*, 314 F.2d 813, 817 (CCPA 1963) ("It is well established that mere difference in form of expression of the reasons for finding claims unpatentable or unobvious over the references does not amount to reliance on a different ground of rejection." (citations omitted)); *In re Cowles*, 156 F.2d 551, 1241 (CCPA 1946) (holding that the use of "different language" does not necessarily trigger a new ground of rejection).

Regarding claim 25, petitioner argues that the examiner's response, "As emphasized in the office action, what a user is doing (being active) while using the implantable device and for how long (at least 6 hours) is intended use. For example, it is well understood that a person is generally active and/or works for at least 6 hours a day,"¹ is a new ground of rejection because there was no reference to "at least 6 hours" nor was it asserted that "it is well understood that a person is generally active and/or works for at least 6 hours a day" in the claim rejection in the non-final Office action.² Petitioner's argument is not persuasive. The rejection of claim 25 under 35 U.S.C. § 103 as unpatentable over Parker in view of Kolz is identical in both the non-final Office action and the final Office action. In response to petitioner's traversal of claim 25 that, "FIGs. 3, 5 and 6 do not teach or suggest the recitations of our claim that have been disregarded"³ the examiner's response is explaining how the language in the claim rejection (i.e., "what the user is doing during [the time the device is in the second mode] or how long they are doing it for is intended use, as long as the device is capable of performing the function should the situation occur, the claim language is met") is consistent with the term "at least 6 hours" as recited in the claim. Likewise, the examiner's statement that "a person is generally active and/or works for at least 6 hours a day" is an explanation directed to the cited figures depicting activity or working, in response to petitioner's argument. The explanation in the examiner's response was provided in direct response to petitioner's argument and did not change the basic thrust of the rejection.

Petitioner also argues that the examiner's response, "While Kolz uses sleeping as a primary example, Par 0005 (as cited in the office action) makes it clear that there are many reasons why a person doesn't wear or removes their externally worn portion ('However, most persons with cochlear implants or similar devices remove the externally worn portion at least part of the time... It is also typically removed while bathing, and sometimes may be removed purely for relaxation, to shut out externally distracting noise')"⁴ is a new ground of rejection because the examiner presents new facts and rationales. Petitioner's argument is not persuasive. In response

¹ Petition filed on November 18, 2024, p. 12.

² See Petition filed on November 18, 2024, p. 12.

³ Remarks filed on April 17, 2024, p. 36.

⁴ Petition filed on November 18, 2024, p. 13.

to the petitioner's traversal of the rejection of claim 25 that, "Kolz is for when the person is sleeping. It is a device that is positioned by a bed"⁵ the examiner's response cites excerpts from paragraph 5 of Kolz, identifying that the externally worn device can also be removed when not sleeping, in direct response to the petitioner's argument. In the rejection of claim 24 under 35 U.S.C. § 103 as unpatentable over Parker in view of Kolz in the non-final Office action, the examiner cites to the Abstract and paragraphs 5 through 7 and 16 through 18 of Kolz. The citation of paragraph 5 in the examiner's response in the final Office action did not change the basic thrust of the rejection because the examiner explicitly cited to paragraph 5 in the rejection of claim 24, from which claim 25 depends, in the non-final and final Office actions.

Lastly, regarding claim 25, petitioner argues that the examiner's response, "The examiner would disagree, as a POSITA when reading Parker as a whole, would understand that while these figures do not specifically show a cochlear implant, they encompass such an implant (See Pars 0006-8 and 0055)"⁶ is a new ground of rejection because the "bit about what one of skill would understand as a whole, even though the examiner concedes it is not shown in the cited figures, is new."⁷ Petitioner's argument is not persuasive. In response to petitioner's traversal of the rejection of claim 25 that, "the FIGs. cited in Parker are not for the cochlear implant embodiments of Parker, and thus cannot give any warning to the recipient that would be heard by the recipient,"⁸ the examiner's response refers to paragraphs 6 through 8 and 55 of Parker to provide additional explanation in response to petitioner's argument. In the rejection of claim 24 in the non-final and final Office actions, the examiner cites to paragraphs 4 through 7 and Figure 1 of Parker, that disclose a system architecture that include an implantable component used for a spinal cord stimulation system and further disclose that similar system architectures are used for cochlear implants. Paragraphs 8 and 55 of Parker cited in the examiner's response also disclose "cochlear implants." Therefore, the additional explanation is in direct response to petitioner's arguments and did not change the basic thrust of the rejection.

Regarding claim 26, petitioner asserts that the examiner's response, "as pointed out in Par 0047 and Fig. 7 of Parker, the data is streamed/transferred when the user is not wearing the externally worn/attached device. Specifically, the tuned coil 702 is equivalent to the tuned coils 202, 302, 402, 502 and 602 in the embodiments shown in Figs. 2-6, which are explicitly not worn/attached to the user"⁹ is a new ground of rejection. Petitioner's assertion is not well taken. In response to petitioner's traversal of the rejection of claim 26 that, "the rejection asserts that Kolz corresponds to the first mode... Claim 26 is directed to the second mode. This is not addressed in the office action"¹⁰ the examiner's response refers to figure 7 and elements 302 and 502 of Parker to provide additional explanation in response to petitioner's arguments. The additional citation to figure 7 and elements 302 and 502 in the examiner's response did not change the basic thrust of the rejection because the examiner cited to paragraph 47 and figures 3 and 5, which describe figure 7 and disclose elements 302 and 502, respectively, in the rejection of claims 24 and 25, from which claim 26 depends, in the non-final and final Office actions.

⁵ Remarks filed on April 17, 2024, p. 37.

⁶ Petition filed on November 18, 2024, p. 14.

⁷ *Id.*

⁸ Remarks filed on April 17, 2024, p. 37.

⁹ Petition filed on November 18, 2024, p. 16.

¹⁰ Remarks filed on April 17, 2024, p. 38.

As discussed above, the response to petitioner's arguments in the final Office action did not change the basic thrust of the rejection of claims 25 and 26. Accordingly, the final Office action did not contain a new ground of rejection warranting the withdraw of the finality of the Office action of June 20, 2024.

Additionally, petitioner argues that the rejection of claim 26 is not sufficient because "the USPTO cited an entire reference, without explaining where exactly the alleged teachings were present."¹¹

Petitioner's argument with regard to the sufficiency of the final Office action is not persuasive. As explained in *Pfizer v. Lee*, 811 F.3d 466, 469 (Fed. Cir. 2016):

Section 132 in turn provides that if a patent examiner finds that a patent application does not comply with the standards of patentability, the examiner will issue an office action with respect to the application, 'stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application.'

With respect to sufficiency of an Office action under 35 U.S.C. § 132:

Section 132 merely ensures that an applicant "at least be informed of the broad statutory basis for [the rejection of] his claims, so that he may determine what the issues are on which he can or should produce evidence." Section 132 is violated when a rejection is so uninformative that it prevents the applicant from recognizing and seeking to counter the grounds for rejection.

See Chester v. Miller, 906 F.2d 1574, 1578 (Fed. Cir. 1990) (citations omitted).

Any Office action (final or non-final) may be noncompliant with 35 U.S.C. § 132(a). *See Pfizer*, 811 F.3d at 472-75 (determining whether a non-final restriction requirement complies with 35 U.S.C. § 132(a)). However, here, the record indicates that the petitioner was informed of the broad statutory basis for the rejection of claim 26, which is dependent from claims 24 and 25. Specifically, the final Office action stated that claims 24 through 27, 29, 34 through 36, and 39 through 44 are "rejected under 35 U.S.C. § 103 as being unpatentable over US2012/0053657 to Parker et al. and in view of US 2008/0111677 to Kolz et al."¹² and with regard to the rejection of claim 24 that, "Kolz discloses during a first mode, i.e. when a user is sleeping and has taken off the wearable external device, an alarm is applicable to the recipient via an internal alarm system of the implantable component (Abstract, Pars 0005-7 and 0016-18)."¹³ Therefore, the statement in the rejection of claim 26 that, "Kolz only discloses/discusses an internal alarm, and therefore

¹¹ Petition filed on November 18, 2024, p. 15.

¹² Final Office action issued on June 20, 2024, p. 33.

¹³ *Id.*

the examiner interprets this as an ‘only’ an internal alarm. However, if applicant disagrees, there are only two options, internally or externally applied alarm, it would obvious to choose an internal alarm only, especially when a user is not wearing their body-worn external device, as explicitly taught by Kolz”¹⁴ in combination with the citation in the rejection of claim 24 is sufficient information to place the petitioner on notice of the basis of the rejection. That is, the information provided in the final Office action, stating the statutory basis for rejection in combination with the prior art reference to Kolz and the detailed explanation as to claim 26 and the claims upon which it depends, provides sufficient information to place petitioner on notice of the bases for the rejection of claim 26 and did not prevent the petitioner from recognizing and seeking to counter the grounds for rejection.

Petitioner should note that review of the propriety of a rejection per se (and its underlying reasoning), is by way of an appeal as provided by 35 U.S.C. § 134 and 37 CFR 41.31, and not by way of petition under 37 CFR 1.181, even if a petitioner frames the issues as concerning procedure versus the merits. *See Boundy v. U.S. Patent & Trademark Office*, 73 USPQ2d 1468, 1472 (E.D. Va. 2004).

In conclusion, the record reflects that the examiner did not introduce a new ground of rejection in the rejections of claims 25 and 26 or in the response to petitioner’s arguments in the final Office action of June 20, 2024. In addition, a review of the final Office action of June 20, 2024, reveals that it contains sufficient information to place petitioner on notice as to the basis for the rejection of the claims 24 through 27, 29, 34 through 36, and 39 through 44, and that the examiner clearly took note of and responded to petitioner’s arguments in detail. The Office action of June 20, 2024, was properly made final.

DECISION

For the reasons stated above, the petition to withdraw the finality of the Office action issued on June 20, 2024, is **DENIED**. As such, neither the Technology Center Director’s decision of September 17, 2024, nor the final Office action of June 20, 2024, will be disturbed.

This constitutes a final decision on this petition. No further requests for reconsideration will be entertained. Judicial review of this petition decision may be available upon entry of a final Agency action adverse to the petitioner in the instant application (*e.g.*, a final decision by the Patent Trial and Appeal Board). *See* MPEP § 1002.02.

/Charles Kim/
Deputy Commissioner
for Patents

¹⁴ *Id.*, at p. 34.