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In re Application of :
CUMMING, Toby :
Application No. 17/269,605 : DECISION ON PETITION
Filing or 371(c) Date: 19 Feb 2021 :
For: PASSIVE FITTING TECHNIQUES :

This is a decision on the petition filed January 27, 2025, pursuant to 37 CFR 1.181, requesting supervisory review and reconsideration of the decision issued on November 25, 2024, by the Director of Technology Center 2600 (hereinafter “Technology Center Director”), which decision refused to withdraw the finality of the Office action issued September 11, 2024.

The petition to overturn the decision issued on November 25, 2024, by the Technology Center Director and withdraw the finality of the Office action issued September 11, 2024, is **DENIED**.

BACKGROUND

The instant application entered the national stage under 35 U.S.C. § 371 on February 19, 2021.

A nonfinal Office action issued on February 29, 2024, which included, *inter alia*, a rejection of claims 1 through 5, 8, 10, and 25 through 27 under 35 U.S.C. § 102(a)(1) as being anticipated by U.S. Patent No. 8,612,011 to Seligman (hereinafter “Seligman”). Claims 28, 29, 31, 40, 41, 43, 44, and 46 through 48 were objected to as being dependent upon a rejected base claim.

A response to the Office action issued on February 29, 2024, was filed on May 29, 2024, and included an amendment to claim 25 and the addition of claims 50 through 54.

A final Office action issued on September 11, 2024, which included, *inter alia*, a rejection of claims 1 through 5, 8, 10, 25 through 27, and 51 through 54 under 35 U.S.C. § 102(a)(1) as being anticipated by Seligman. Claims 28, 29, 31, 40, 41, 43, 44, 46 through 48, and 50 were objected to as being dependent upon a rejected base claim.

A petition under 37 CFR 1.181 was filed on November 12, 2024, requesting that the finality of the Office action issued on September 11, 2024, be withdrawn. The petition was dismissed by the Technology Center Director in a decision issued on November 25, 2024.

A reply to the final Office action issued on September 11, 2024, was filed on December 5, 2024.

A notice of appeal and pre-appeal brief conference request were filed on January 13, 2024.

The present petition under 37 CFR 1.181 was filed on January 27, 2025, requesting a reconsideration of the decision issued on November 25, 2024, and withdrawal of the finality of the Office action of September 11, 2024.

An advisory action was issued on February 5, 2025, in response to petitioner's reply filed on December 5, 2024.

A notice of panel decision from the pre-appeal brief review was issued on February 7, 2025, the decision indicated that the application would proceed to the Patent and Trial Appeal Board.

An appeal brief was filed on March 13, 2025.

STATUTES AND REGULATIONS

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.

(e) Oral hearing will not be granted except when considered necessary by the Director.

(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.

37 CFR 1.191 provides that:

Appeals to the Patent Trial and Appeal Board under 35 U.S.C. 134(a) and (b) are conducted according to part 41 of this title.

37 CFR 41.31 provides, in part, that:

(a) *Who may appeal and how to file an appeal.* An appeal is taken to the Board by filing a notice of appeal.

(1) Every applicant, any of whose claims has been twice rejected, may appeal from the decision of the examiner to the Board by filing a notice of appeal accompanied by the fee set forth in § 41.20(b)(1) within the time period provided under § 1.134 of this title for reply.

(c) An appeal, when taken, is presumed to be taken from the rejection of all claims under rejection unless cancelled by an amendment filed by the applicant and entered by the Office. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings

OPINION

Petitioner argues that the Office action issued on September 11, 2024, was improperly made final because new grounds of rejection, not necessitated by amendment or the filing of an IDS, were proffered in the response to arguments section of the Office action which asserts a processing strategy that was not asserted in the nonfinal Office action of February 29, 2024.

MPEP § 706.07(a) specifically sets forth the Office's practice on when a second Office action can be properly made final and provides, in part, that:

Second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner.

See MPEP § 609.04(b). Furthermore, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection on newly cited art other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

A review of the records shows that the basis for the rejection of claims 1 through 5, 8, 10, 25 through 27 under 35 U.S.C. § 102(a)(1) as being anticipated by Seligman remained the same in the final Office action issued on September 11, 2024, from the nonfinal Office action issued on February 29, 2024. Specifically, the basis for the rejection of claim 25 in both the Office action of February 29, 2024 and the final Office action of September 11, 2024, is that Seligman teaches a non-transitory computer-readable media having recorded thereon, a computer program for executing at least a portion of a hearing-prosthesis fitting method, the computer program (col. 4 lines 33-52, programming is applied to the system) including: code for enabling a obtaining of first data indicative of a speech environment of the recipient (col. 4 lines 52-67, MAP includes environmental data); code for analyzing the obtained first data; and code for developing fitting data based on the analyzed first data (col 4 line 62 through col. 5 line 14, analysis and development for fitting used in the system). Therefore, the finality of the Office action of September 11, 2024 complies with MPEP § 706.07(a) as a new ground of rejection was not introduced.

Furthermore, in determining whether a ground of rejection is new, MPEP § 1207.03(III) specifically provides:

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, 190 USPQ 425 (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).

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, 190 U.S.P.Q. 425 (C.C.P.A. 1976). A new ground of rejection may be present when a rejection relies upon new facts or a new rationale not previously raised by the applicant. *In re Biedermann*, 733 F.3d, 329, 337 (Fed. Cir. 2013) (quoting *In re Liethem*, 661 F.3d 1316 1319 (Fed. Cir. 2011)). 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 explaining 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).

As discussed above, the rejection of claims 25 remained the same in both the final Office action issued on September 11, 2024, and the nonfinal Office action issued on February 29, 2024. As such, the basic thrust of the rejection did not change.

MPEP § 707.07(f) specifically sets forth the Office’s practice on traversal of any rejection and provides in part, that:

Where the applicant traverses any rejection, the examiner should, if they repeat the rejection, take note of the applicant’s argument and answer the substance of it.

The response to arguments section of the final Office issued September 11, 2024, states that applicant’s arguments have been fully considered but are not persuasive and includes an explanation as to why the examiner disagrees with applicant’s argument regarding claim 25. In the response filed on May 29, 2024, petitioner argues, with regard to claim 25, that Seligman fails to teach a MAP (i.e., one or more electrodes mapped to a certain frequency range, and the output, along with other variables that affect the output delivered to a patient’s hearing prosthesis) including environmental data. The response to arguments section of the final Office action issued on September 11, 2024, explains that Seligman teaches MAP including environmental data, such as a patient’s MAP providing speech processing strategy, and merely elaborates on what was previously presented as a basis for the rejection of claims 1 through 5, 8, 10, 25 through 27 and does not constitute a new ground of rejection. Furthermore, the rejection in the final Office action does not rely on or reference any section of Seligman that was not referenced in the Office action of February 29, 2024, nor has a new theory of anticipation been advanced in the final Office action of September 11, 2024.

A review of the final Office action of September 11, 2024, reveals that it contains sufficient information to place petitioner on notice as to the basis for the rejection of claims 1 through 5, 8, 10, 25 through 27 and newly added claims 51 through 54 and that the examiner clearly took note of and responded to petitioner’s arguments. The examiner’s response to petitioner’s arguments does not rely on new facts and/or new rationales to support the rejections made in the Office action of February 29, 2024, rather, it provides an explanation as to why petitioner’s attempts at traversal of the rejection made in the Office action of February 29, 2024, were not persuasive to

withdraw the rejection. Accordingly, petitioner had a fair opportunity to respond to the thrust of the rejections.

The explanation provided in the response to arguments, along with the basis for the rejection of claim 25 provided at page 4 of the final Office action of September 11, 2024, satisfies the requirements of 35 U.S.C. § 132(a) in that it contains sufficient information to place petitioner on notice of the basis for the rejection of claim 25 under 35 U.S.C. § 102(a)(1) and was in compliance with MPEP 707.07(f).

The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a substantive nature which the applicant may feel deny them the patent protection to which they are entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or other patentability issues, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute (35 U.S.C. § 134).

The line of demarcation between appealable matters and petitionable matters for the Director is carefully observed. The 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; 37 CFR 1.191; and 37 CFR 41.31, and not by way of a 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). As stated by the Court of Customs and Patent Appeals (a predecessor of the U.S. Court of Appeals for the Federal Circuit), the adverse decisions of examiners, which are reviewable by the Board, are those which relate, at least indirectly, to matters involving the rejection of claims. See *In re Hengehold*, 440 F.2d 1395, 1404 (CCPA 1971). That an applicant casts the argument as directed to a procedural requirement (rather than the merits of a rejection) does not untether the review of the prima facie case from the review of the merits of the rejection. See *In re Jung*, 637 F.3d 1356, 1363 (Fed. Cir. 2011) (applicant's procedural arguments concerning the prima facie case requirement are the same arguments that would have been made on the merits). An applicant dissatisfied with an examiner's decision in the second or subsequent rejection may appeal to the Patent Trial and Appeal Board. See 37 CFR 41.31(a)(1). It is well settled that the Director will not, on petition, usurp the functions or impinge upon the jurisdiction of the Patent Trial and Appeal Board. See *In re Dickinson*, 299 F.2d 954, 49 CCPA 951, 133 USPQ 39 (CCPA 1962) (The Board will not ordinarily hear a question that should be decided by the Director on petition, and the Director will not ordinarily entertain a petition where the question presented in a matter appealable to the Board). See also MPEP § 1201. If petitioner believes that the rejection of the claims is without merit, relief may be sought by way of an appeal and not by petition.

DECISION

The present petition is granted to the extent that the Decision by the Technology Center Director has been reviewed. However, for the reasons stated above, the petition to withdraw the finality of the Office action issued on September 11, 2024, is **DENIED**.

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