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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* RODERICK A. HYDE, JORDIN T. KARE,  
ERIC C. LEUTHHARDT, DENNIS J. RIVET,  
LOWELL L. WOOD JR., and EDWARD K.Y. JUNG

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Appeal 2012-004555  
Application 11/906,995<sup>1</sup>  
Technology Center 3600

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Before BRUCE R. WINSOR, JOHN A. EVANS, and  
JASON J. CHUNG, *Administrative Patent Judges*.

CHUNG, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 1 and 33–65.<sup>2</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part and enter a new ground of rejection.

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<sup>1</sup> According to Appellants, the real party in interest is Searete LLC, which is wholly owned by Intellectual Ventures Management LLC (App. Br. 6.)

<sup>2</sup> Claims 2–32 and 66–116 were previously cancelled.

## INVENTION

The invention is directed to reviewing and underwriting a risk for epigenetic information. Spec. 1–3. Claim 1 is illustrative of the invention and reproduced below:

1. A method comprising:  
reviewing epigenetic information for at least one individual; and  
underwriting a risk at least partially based upon said epigenetic information for said at least one individual;  
where each step is performed using a microprocessor.

## REFERENCES

Atkins	US 5,852,811	Dec. 22, 1998
Fey et al.	US 2002/0052761 A1	May 2, 2002
Flagg	US 6,456,979 B1	Sept. 24, 2002
Halle	US 2005/0282213 A1	Dec. 22, 2005
Apfeld et al.	US 2006/0147947 A1	July 6, 2006
Binns et al.	US 7,392,201 B1	Jun. 24, 2008
Kenedy et al.	US 2008/0228765 A1	Sept. 18, 2008
Jacobson	US 7,685,007 B1	Mar. 23, 2010

Patrick L. Brockett, Richard MacMinn, and Maureen Carter, *Genetic Testing, Insurance Economics, and Societal Responsibility*, NORTH AMERICAN ACTUARIAL JOURNAL vol. 3, no. 1, 1–120 (1999) (genetic testing and how it pertains to insurance companies underwriting policies).

## RELATED APPEALS

Appellants did not identify any related appeals. However, we note that there are at least seven related appeals, which are: appeal No. 2012-

Appeal 2012-004555  
Application 11/906,995

002201 (Application No. 11/986,966); appeal No. 2012-004467 (Application No. 12/012,701); appeal No. 2012-004590 (Application No. 11/974,166); appeal No. 2012-009645 (Application No. 11/986,986); appeal No. 2012-011303 (Application No. 11/986,967); appeal No. 2013-004647 (Application No. 12/079,589); and appeal No. 2013-007816 (Application No. 12/004,098).

### REJECTIONS AT ISSUE

Claims 1, 33–42, 45, 60, and 65 are rejected under a provisional non-statutory obviousness-type double patenting rejection over Application 11/974,166.<sup>3</sup> Ans. 5–6.

Claim 1 is rejected under 35 U.S.C. § 102(b) as anticipated by Apfeld. Ans. 6–7.

Claims 33–36, 39–41, 43–50, 53, 55–58, 60, 62–64, and 65 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett and Kenedy.<sup>4</sup> Ans. 7–15.

Claim 37 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett, Kenedy, and Halle. Ans. 15–16.

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<sup>3</sup> Application No. 11/974,166 is pending. Thus, we do not reach the merits of the Examiner’s double patenting rejections because this issue is not ripe for decision by the Board. Panels have the flexibility to reach or not reach provisional double-patenting rejections. *See Ex parte Moncla*, 95 USPQ2d 1884 (BPAI 2010) (precedential).

<sup>4</sup> The Examiner inadvertently left out claims 33 and 65 in the heading of the rejection, but addressed claims 33 and 65 in the body of the rejection. Ans. 7–15. We deem this to be a typographical error and have included it here.

Claims 38, 42, and 52 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett, Kenedy, and Jacobson. Ans. 16–18.

Claim 51 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett, Kenedy, and Atkins. Ans. 18–19.

Claims 54 and 59 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett, Kenedy, and Flagg. Ans. 19–20.

Claim 61 is rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Brockett, Kenedy, and Binns. Ans. 20–21.

#### ISSUES<sup>5</sup>

Did the Examiner err in finding that Apfeld discloses the features of claim 1?

Did the Examiner err in finding that the combination of Brockett and Kenedy teaches the features of claims 33, 36, 43, 58, and 65?

#### CONTENTIONS AND ANALYSIS

##### **Rejection of Claim 1 under 35 U.S.C. § 102(b)**

Claim 1 is recited *supra*. The Examiner made explicit findings regarding the elements taught by the prior art, and explained how the elements are mapped to the respective claim elements of the appealed

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<sup>5</sup> We considered the Appeal Brief filed August 16, 2011; the Examiner's Answer mailed November 28, 2011; the Reply Brief filed January 27, 2012; and the Supplemental Reply Brief filed January 27, 2012. We consider both the Reply Brief and the Supplemental Reply Brief to be a single brief because they were filed on the same date.

claims. Ans. 6–7 and 25–27. Appellants styled their arguments as a challenge to the existence of a prima facie case of unpatentability of the claims at issue (App. Br. 21–44).

However, it is well settled that:

[The USPTO] satisfies its initial burden of production by adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond. In other words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in notify[ing] the applicant . . . [by] stating the reasons for [its] 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 [the] application.

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (internal citations and quotation marks omitted). We agree with the Examiner.

The Examiner found Apfeld discloses evaluating and determining the identity of a gene of a human subject, which discloses reviewing epigenetic information for at least one individual. Ans. 25–26. Also, the Examiner found Apfeld discloses a premium for insurance is evaluated as a function of an indicator parameter; the indicator parameter can be a function of the result of evaluating ATP and AMP that includes epigenetic modification that is used as an underwriting process for life insurance, which discloses underwriting a risk at least partially based upon said epigenetic information for said at least one individual. Ans. 26–27. The Examiner also found Apfeld discloses each step is performed using a microprocessor. Ans. 7.

As explained in *Jung*, 637 F.3d at 1356, the Examiner’s findings and explanations would have put any reasonable Applicants on notice of the Examiner’s rejection, and given them ample information with which to

counter the grounds of rejection, which is all that is required to establish a prima facie case of unpatentability. In short, the Examiner has satisfied the initial burden of production by combining the references to establish a case of obviousness. The burden then shifts to Appellants to rebut the Examiner's case.

In order to rebut a prima facie case of unpatentability, Appellants must distinctly and specifically point out the supposed Examiner errors, and the specific distinctions believed to render the claims patentable over the applied references. *See* 37 C.F.R. § 41.37(c)(vii) (2010) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

Appellants have failed to carry their burden. Appellants generally assert that the claims define a patentable invention because the Examiner has failed to establish a prima facie case of unpatentability, but fail to articulate with any specificity what gaps exist between the cited references and the claims. Appellants' assertion generally includes the following: recite the disputed claim, duplicate the Examiner's statement of the rejection, further duplicate the cited portions of the prior art references, and contend—without

adequate analysis of the cited portions of the prior art—that the duplicated language in the prior art does not meet the disputed claim limitations.

Additionally, Appellants fail to persuade us of error because for each of the claims, although the cited text does not repeat the recited claim limitation verbatim, one skilled in the art would understand the recited claim limitation encompasses the disclosure cited by the Examiner. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (whether a reference teaches a claim limitation “is not an ‘ipsissimis verbis’ test”).

Moreover, because we conclude that the Examiner provided an adequate evidentiary basis for finding anticipation, we are not persuaded that the rejection was improperly based on a hindsight analysis, personal knowledge, or official notice, as Appellants argue. App. Br. 52–53.

Accordingly, for the reasons stated *supra*, we sustain the Examiner’s rejection of claim 1.

**Rejection of Claims 33–35, 37–42, 44–57, and 59–65 under 35 U.S.C.**

**§ 103(a)**

The Examiner’s findings are set forth in the Answer. Ans. 27–29. Appellants styled their arguments as a challenge to the existence of a prima facie case of unpatentability of the claims at issue (App. Br. 54–74).

However, it is well settled that:

[The USPTO] satisfies its initial burden of production by adequately explain[ing] the shortcomings it perceives so that the applicant is properly notified and able to respond. In other words, the PTO carries its procedural burden of establishing a prima facie case when its rejection satisfies 35 U.S.C. § 132, in notify[ing] the applicant . . . [by] stating the reasons for [its] 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 [the] application.

*In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (internal citations and quotation marks omitted).

The Examiner found Brockett teaches genetic screening or testing for abnormality, defects, or deficiencies, which teaches reviewing genetic information for at least one individual. Ans. 28. Additionally, the Examiner found Brockett teaches a premium calculation that is reflective of a known risk based on genetic test results obtained, which teaches underwriting a risk at least partially based upon said genetic information for said at least one individual. *Id.* The Examiner also found that although Brockett fails to teach epigenetic information, Kenedy discloses epigenetic information. *Id.*

The Examiner explained that a person of ordinary skill in the art at the time the invention was made would have been motivated to modify the premium calculation of a known risk of Brockett to include epigenetic information of Kenedy to distinguish among potential insured people and develop improved quantitative assessments of risk and better calculations of the actuarial present value of future lost costs based on new statistically significant information gained from genetic testing. Ans. 28–29. In other words, the motivation to combine the teachings of Brockett and Kenedy is to provide a system that generates more predictable and effective results. Thus, the combination of Brockett and Kenedy teach the features of the claim.

As explained in *Jung*, 637 F.3d at 1356, the Examiner's findings and explanations would have put any reasonable Applicants on notice of the Examiner's rejection, and given them ample information with which to counter the grounds of rejection, which is all that is required to establish a

prima facie case of unpatentability. In short, the Examiner has satisfied the initial burden of production by combining the references to establish a case of obviousness. The burden then shifts to Appellants to rebut the Examiner's case.

In order to rebut a prima facie case of unpatentability, Appellants must distinctly and specifically point out the supposed Examiner errors, and the specific distinctions believed to render the claims patentable over the applied references. *See* 37 C.F.R. § 41.37(c)(vii) (2010) (“A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.”); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”); *cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

Appellants have failed to carry their burden. Appellants generally assert that the claims define a patentable invention because the Examiner has failed to establish a prima facie case of unpatentability, but fail to articulate with any specificity what gaps exist between the cited references and the claims. Appellants' assertion generally includes the following: recite the disputed claim, duplicate the Examiner's statement of the rejection, further duplicate the cited portions of the prior art references, and contend—without adequate analysis of the cited portions of the prior art—that the duplicated language in the prior art does not meet the disputed claim limitations.

Additionally, Appellants fail to persuade us of error because for each of the claims, although the cited text does not repeat the recited claim limitation verbatim, one skilled in the art would understand the recited claim limitation encompasses the disclosure cited by the Examiner. *See In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990) (whether a reference teaches a claim limitation “is not an ‘ipsissimis verbis’ test”).

After considering all the evidence and arguments, we conclude that the record supports, and Appellants have not persuasively rebutted, a conclusion of prima facie obviousness for the reasons discussed by the Examiner and explained *supra*, in the discussion of Brockett and Kenedy. Ans. 6–7.

Additionally, Appellants assert that the Examiner has not articulated reasoning with rational underpinnings to support a motivation to combine the teachings of Brockett and Kenedy. App. Br. 67–74. Specifically, Appellants styled their arguments to state there is no teaching to modify or combine components as a matter of law. *Id.*

We are not persuaded of nonobviousness by Appellants’ assertions that the Examiner did not provide a teaching to combine or modify components. *Id.* As explained *supra*, in the discussion of Brockett and Kenedy, the Examiner identified a teaching to combine or modify components. Thus, we find that the Examiner articulated reasoning with rational underpinnings to support a motivation to combine the teachings of Brockett and Kenedy, *see In re Kahn*, 441 F.3d 977, 989 (Fed. Cir. 2006).

Accordingly, for the reasons stated *supra*, we sustain the Examiner’s rejection of claim 33, and claims 34–35, 37–42, 44–57, and 59–65, which Appellants contend are allowable for the same reasons as claim 33.

**Rejection of Claim 36 under 35 U.S.C. § 103(a)**

Claim 36 recites, “means for counting an occurrence of at least one clinical outcome.” The Examiner found Brockett teaches death or disability, which the Examiner relied on to teach “clinical outcome,” and increased incidence, which the Examiner relied on to teach “counting an occurrence.” Ans. 34–35. Appellants contend the cited portions are in the context of insurance, rather than clinical outcomes. App. Br. 75–76. We agree with Appellants.

Brockett merely teaches insurers can administer tests and use the information to underwrite policies if there is a distinct relation between a particular gene and increased incidence of death or disability, which is describing statistics in the context of insurance, rather than the deaths or disabilities occurring in clinical outcomes. App. Br. 75–76.

Accordingly, for the reasons stated *supra*, we do not sustain the Examiner’s rejection of claim 36.

**Rejection of Claim 43 under 35 U.S.C. § 103(a)**

Claim 43 recites, “means for setting a premium at least partially based upon said epigenetic information for said at least one individual.” The Examiner found that the combination of Brockett and Kenedy teaches the claimed features. Ans. 10. Appellants contend the Examiner has not provided a prima facie case of unpatentability and Brockett’s teaching is in the context of a definitive information set rather than a means for setting a premium at least partially based upon said epigenetic information for said at least one individual. App. Br. 77–78. We agree with the Examiner.

We conclude the Examiner established a prima facie case of unpatentability for at least the reasons stated *supra* in the discussion of claim 33. The Examiner found that Brockett teaches a premium calculation that is reflective of a known risk based on a genetic test and Kenedy teaches epigenetic, which teaches means for setting a premium at least partially based upon said epigenetic information. Ans. 10 and 35.

Accordingly, for the reasons stated *supra*, we sustain the Examiner's rejection of claim 43.

**Rejection of Claim 58 under 35 U.S.C. § 103(a)**

Claim 58 recites, “means for setting a premium at least partially based upon said epigenetic information for said at least one individual for life insurance comprises: means for establishing at least one of guaranteed insurability or guaranteed renewability.” The Examiner found that the combination of Brockett and Kenedy teaches the disputed features. Ans. 14 and 36. In particular, the Examiner found Brockett teaches guaranteed issue, which the Examiner relied upon to teach the disputed feature. *Id.*

Appellants contend the Examiner has not provided a prima facie case of unpatentability and Brockett's teaching is in the context of adverse selection problems rather than means for establishing at least one of guaranteed insurability or guaranteed renewability. App. Br. 79–80. We agree with Appellants.

Although Brockett teaches insurance, Brockett fails to teach life insurance. App. Br. 78–80. Moreover, Brockett teaches guaranteed issue based on law, rather than based upon said epigenetic information for said at least one individual for life insurance. *Id.* Thus, Brockett fails to teach,

“means for setting a premium at least partially based upon said epigenetic information for said at least one individual for life insurance comprises: means for establishing at least one of guaranteed insurability or guaranteed renewability.”

Accordingly, for the reasons stated *supra*, we do not sustain the Examiner’s rejection of claim 58.

#### *NEW GROUNDS OF REJECTION*

Within our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 1 and 33–36, 37–58, and 59–65 under 35 U.S.C. § 101.

Following the decision in *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. 2347 (2014) (citing *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 132 S.Ct. 1289, 1300 (2012)), we analyze claims where the abstract idea judicial exception to the categories of statutory subject matter is at issue using the following two-part analysis set forth in *Mayo*: 1) Determine whether the claim is directed to an abstract idea; and 2) if an abstract idea is present in the claim, determine whether any element, or combination of elements, in the claim is sufficient to ensure that the claim amounts to significantly more than the abstract idea itself. *See Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S.Ct. at 2350.

As to the first part of the analysis, examples of abstract ideas referenced in *Alice Corp.* include: fundamental economic practices;<sup>6</sup> certain

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<sup>6</sup> *Alice Corp.*, at 2350: *e.g.*, intermediated settlement, *i.e.*, the use of a third party intermediary to mitigate settlement risk.

methods of organizing human activities;<sup>7</sup> “an idea of itself;”<sup>8</sup> and, mathematical relationships or formulas.<sup>9</sup> Claims that include abstract ideas like these are examined under the second part of the analysis to determine whether the abstract idea has been applied in an eligible manner.

As to the second part of the analysis, we consider the claim as a whole by considering all claim elements, both individually and in combination. *Id.* at 2355. Limitations referenced in *Alice Corp.* that may be enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: Improvements to another technology or technical fields;<sup>10</sup> improvements to the functioning of the computer itself;<sup>11</sup> and meaningful limitations beyond generally linking the use of an abstract idea to a particular technological environment.<sup>12</sup>

Limitations referenced in *Alice Corp.* that are not enough to qualify as “significantly more” when recited in a claim with an abstract idea include, as non-limiting or non-exclusive examples: adding the words “apply it” (or an

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<sup>7</sup> *Id.*, at 2356: *e.g.*, a series of steps instructing how to hedge risk (citing *Bilski v. Kappos*, 561 U.S. 593, 599 (2010)).

<sup>8</sup> *Id.*, at 2355: *e.g.*, a principle, an original cause, a motive (citing *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) and *Le Roy v. Tatham*, 14 How. 156, 175 (1853)).

<sup>9</sup> *Id.*, at 2350: *e.g.*, a mathematical formula for computing alarm limits in a catalytic conversion process (*Parker v. Flook*, 437 U.S. 584, 594–595 (1978)), or a formula for converting binary-coded decimal numerals into pure binary form (*Benson*, 409 U.S. at 71–72).

<sup>10</sup> *Id.*, at 2358: *e.g.*, a mathematical formula applied in a specific rubber molding process (citing *Diamond v. Diehr*, 450 U.S. 175, 177–178 (1981)).

<sup>11</sup> *Id.* at 2359.

<sup>12</sup> *Id.* at 2360: noting that none of the hardware recited “offers a meaningful limitation beyond generally linking ‘the use of the [method] to a particular technological environment,’ that is, implementation via computers” (citing *Bilski*, 561 U.S. at 610, 611).

equivalent) with an abstract idea;<sup>13</sup> mere instructions to implement an abstract idea on a computer;<sup>14</sup> or requiring no more than a generic computer to perform generic computer functions that are well-understood, routine and conventional activities previously known to the industry.<sup>15</sup>

If there are no meaningful limitations in the claim that transform the abstract idea into a patent eligible application such that the claim amounts to significantly more than the abstract idea itself, the claim is directed to non-statutory subject matter under 35 U.S.C. § 101.

Each of claims 1, 43–70, 72, 75–83, and 85 recites a fundamental economic practice such as “underwriting a risk at least partially based upon said epigenetic information for said at least one individual,”<sup>16</sup> which is an abstract idea under the first step of the analysis. Next, we analyze the claims under the second part of the analysis and we find that the claims require no more than a generic computer to perform generic computer functions.

We also note that The Supreme Court held that “simply appending conventional steps, specified at a high level of generality, to laws of nature, natural phenomena, and abstract ideas cannot make those laws, phenomena, and ideas patentable.” *Mayo*, 132 S.Ct. at 1300.

Accordingly, for the reasons stated *supra*, we enter a new ground of rejection for claims 1, 43–70, 72, 75–83, and 85.

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<sup>13</sup> *Id.* at 2357, 2358.

<sup>14</sup> *Id.* at 2360: *e.g.*, simply implementing a mathematical principle on a physical machine, namely a computer (citing *Mayo* at 1301).

<sup>15</sup> *Id.* at 2359: *e.g.*, using a computer to obtain data, adjust account balances, and issue automated instructions.

<sup>16</sup> We note that the relationship epigenetic information and the risk of an individual developing a disease is a well-known natural phenomenon.

## CONCLUSION

We are persuaded that the Examiner did not err in finding that Apfeld discloses the features of claim 1.

We are persuaded that the Examiner did not err in finding that the combination of Brockett and Kenedy teaches the features of claims 33, 43, and 65.

We are persuaded that the Examiner erred in finding that the combination of Brockett and Kenedy teaches the features of claims 36 and 58.

We find that claims 1, 43–70, 72, 75–83, and 85 are directed to non-statutory subject matter.

## DECISION

The Examiner's decision to reject claims 1 and 33–35, 37–57, and 59–65 under 35 U.S.C. §§ 102(b) and 103(a) is affirmed.

The Examiner's decision to reject claims 36 and 58 under 35 U.S.C. § 103(a) is reversed.

We enter a new ground of rejection for claims 1 and 33–36, 37–58, and 59–65 under 35 U.S.C. § 101.

## *TIME PERIOD*

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).

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides "[a] new ground of rejection

Appeal 2012-004555  
Application 11/906,995

pursuant to this paragraph shall not be considered final for judicial review." 37 CFR § 41.50(b) also provides that the appellant, 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 . . . .

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

ELD