

NOTE: This disposition is nonprecedential.

United States Court of Appeals
for the Federal Circuit

IN RE: DAVID WALTER,
Appellant

2016-2256

Appeal from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
No. 90/013,165.

Decided: August 21, 2017

STEVEN J. MILLER, The Miller Law Offices
PLC, Miami, FL, and MARK TERRY, Office of Mark
Terry, Miami, FL, argued for appellant.

PHILIP J. WARRICK, Office of the Solicitor,
United States Patent and Trademark Office,
Alexandria, VA, argued for appellee Joseph Matal.
Also represented by NATHAN K. KELLEY, THOMAS
W. KRAUSE, JOSEPH GERARD PICCOLO, COKE
MORGAN STEWART.

Before MOORE, SCHALL, and O'MALLEY, *Circuit
Judges*. SCHALL, *Circuit Judge*.

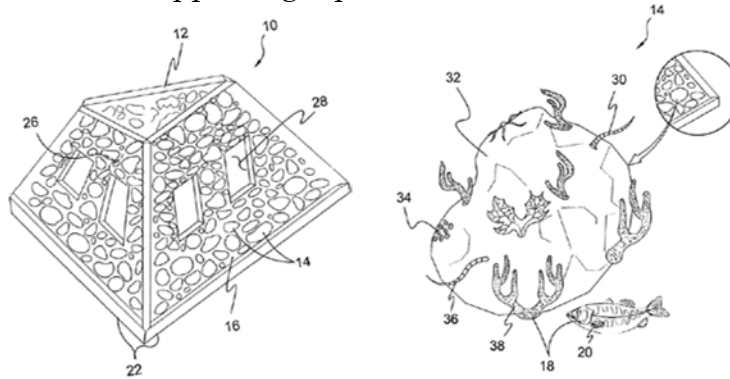
DECISION

David Walter appeals the decision of the Patent Trial and Appeal Board (“Board”) in an *ex parte* reexamination proceeding involving U.S. Patent No. 7,513,711 (“the ’711 patent”). *See Ex parte David Walter*, No. 2015-006121, 2015 WL 5144184 (P.T.A.B. Aug. 31, 2015). In its decision, the Board ruled that all twelve claims of the ’711 patent lack adequate written description and are indefinite under 35 U.S.C. § 112. *Id.* at *2–3. We *affirm*.

DISCUSSION

I. Background

Mr. Walter is the sole inventor of the invention claimed in the ’711 patent. *See* ’711 patent at [76]. The invention relates to artificial reefs for cultivating marine life. *Id.*, col. 1 ll. 8–16. The reefs 10 generally comprise concrete walls 16 joined together to form a hollow interior. *Id.*, Abstract. The walls 16 contain stones 14 for supporting aquatic lifeforms:



Id., Figs. 3, 4. The concrete walls 16 attach to an underlying “support structure” 12 having a base 22 and upwardly-extending “frame members.” *Id.*, col. 1 ll. 36–39, Fig. 2. According to the patent, the reef can take any shape, including pyramidal, prismatic, and cylindrical arrangements. *Id.*, col. 1 ll. 49–51, col. 3 ll. 52–54, Figs. 2, 5, 7. The ’711 patent originally issued with twelve claims one independent claim and eleven dependent claims. *Id.*, col. 4 ll. 26–64. The claims largely embody the foregoing features.

The Patent and Trademark Office began reexamining the ’711 patent in 2014 at Mr. Walter’s request. In those proceedings, the examiner initially rejected the issued claims as obvious over various prior art references. *See* J.A. 124–27. Mr. Walter responded by amending independent claim 1 to recite, *inter alia*, that the reef’s claimed “support structure” was “block-like.” *See* J.A. 154–55. Relying on an expert declaration from Steven J. Miller, *see* J.A. 178, Mr. Walter argued that the plain and ordinary meaning of “block-like” is a “solid support structure made up of discreet [sic] pieces or ‘blocks’ which[,] when joined together in some manner, assemble into a complete structure or apparatus.” J.A. 164. Armed with this construction, Mr. Walter urged that the examiner’s prior art references did not teach a “block-like support structure,” as so construed. *See* J.A. 164–65. The text of amended claim 1 reads in full:

1. An artificial reef comprising:
 - a) a *block-like support structure* made of a plurality of frame members forming a base and frame members extending up from said base;

- b) attachable slab walls fabricated of a concrete material secured to said support structure forming a hollow interior, said walls having recesses to provide access into the hollow interior of said reef; and
- c) a plurality of soft stones embedded into said concrete walls, said soft stones are elevated beyond the face of said concrete walls to provide a greater surface area for marine life to bore and anchor into.

J.A. 24 (emphasis added).

Mr. Walter's amendment did not persuade the examiner. In his ensuing office action, the examiner maintained his obviousness rejections. J.A. 213–16. He also rejected the newly-amended claims as lacking adequate written description support and as indefinite. *Id.* As for the written description rejection, the examiner reasoned that the specification did not disclose a support structure that was “block-like.” *Id.* Turning to indefiniteness, the examiner determined that the term “block-like” lacked reasonable certainty because Mr. Walter's proposed construction conflicted with the dictionary meaning of the term “block.” *Id.* Citing to an internet dictionary, the examiner construed “block” to mean “a solid piece of material . . . *that has flat sides* and is usually square or rectangular in shape.” *Id.* (emphasis added). Because the claimed “support structure” did not contain flat sides, the examiner reasoned, it could not be fairly described as “block-like.” Mr. Walter disagreed with the examiner's findings and appealed the rejections to the Board. J.A. 397.

II. Proceedings Before the Board

Mr. Walter's opening brief to the Board challenged the examiner's rejections. On the issue of indefiniteness, Mr. Walter pointed to places in the specification where he believed one of ordinary skill could have ascertained the meaning of "block-like." J.A. 401–02. Mr. Walter also urged that his amended claims were consistent with the examiner's dictionary definition of "block." In Mr. Walter's view, the claimed "support structure" was "block-like" because the individual frame elements comprising the support structure—not the support structure itself—were "3-dimensional cuboid[s]" with "flat sides." J.A. 402. Mr. Walter did not rely on the construction of "block-like" that he had presented with his initial amendment based on the Miller declaration. Turning to the other rejections, Mr. Walter asserted that the examiner erred in his findings on obviousness and written description.

The examiner responded by reaffirming his construction of "block" and maintaining that a block must contain "flat sides." J.A. 452. Because the claimed support structure comprised wholly open faces without a flat side, the examiner concluded, the "block-like" term was indefinite because the amended claims used the term in a way contrary to its plain meaning. *Id.* The examiner was not persuaded by Mr. Walter's "3-dimensional cuboid" argument because, in the examiner's view, the '711 patent disclosed embodiments with noncuboid frame members. J.A. 458. Finally, the examiner observed that "block-like" is a term of degree, without objective criteria in the patent's intrinsic record for establishing the scope of

the limitation. J.A. 458–59. The examiner also defended his remaining rejections.

In his reply, Mr. Walter continued to allege that the individual “frame elements” of the support structure satisfied the examiner’s construction of “block.” J.A. 482– 83. According to Mr. Walter, the examiner’s construction encompassed noncuboid frame elements because blocks “usually” take cuboid form but need not do so in every case. *Id.* In Mr. Walter’s view, this understanding comported with the specification of the ’711 patent, which depicted reefs taking a variety of shapes. *Id.* Once again, Mr. Walter did not refer to his initial construction of “block-like” submitted with Mr. Miller’s declaration. *Id.*

The Board heard arguments on these issues on August 20, 2015. During the hearing, the Board inquired into the meaning of “block-like.” Mr. Walter responded in a variety of ways. At first, Mr. Walter urged a construction of “block-like” similar to the one he proposed in his initial amendment—namely, that “block-like” meant “discrete pieces that have been put together for the purposes of providing support.” J.A. 509 ll. 18–20. When pressed on this construction, however, Mr. Walter altered his position and advanced the “cuboid” construction he had raised in his briefing. In particular, Mr. Walter urged a construction that “each one of [the individual] frame members is a block-like structure” because they are “cuboid-shaped.” J.A. 511 ll. 12–17. When the Board asked Mr. Walter to clarify this position, he returned to his original stance that “block-like” is synonymous with “discrete.” *See* J.A. 512–13.

Confronted with these arguments, the Board ruled that the term “block-like” is indefinite. *Ex parte Walter*, 2015 WL 5144184, at *2–3. According to the Board, “block-like” lacks reasonable clarity because the specification of the ’711 patent uses the term in a manner “inconsistent with a proper understanding” of the word “block.” *Id.* at *2. The Board also rejected Mr. Walter’s argument that “block-like” referred to the individual “frame members,” rather than the “support structure” as a whole. *Id.* at *3. As the Board reasoned, the claims recited a “*block-like support structure* made of a plurality of frame members,” not a “support structure made of a plurality of *block-like frame members*.” *Id.* (emphases added). The Board also affirmed the examiner’s written description rejection and *pro forma* reversed the obviousness rejection on the grounds that it could not ascertain the meaning of the amended claims. *Id.* at *2–3.

Mr. Walter asked the Board to reconsider its decision, but the Board denied the request. *See* J.A. 4. In addition to reaffirming its prior findings on indefiniteness, the Board held that “block-like” is indefinite for the additional reason that it is a term of degree without sufficient guidance delimiting its scope. J.A. 3–4.

Mr. Walter timely appealed the Board’s decision. We have jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

III. Standard of Review

The Board construes claims of an unexpired patent during reexamination proceedings under the “broadest reasonable construction.” *In re CSB-Sys. Int’l, Inc.*, 832 F.3d 1335, 1340 (Fed. Cir. 2016) (citing

In re NTP, Inc., 654 F.3d 1268, 1274 (Fed. Cir. 2011)). We review the Board’s ultimate claim construction *de novo*. *Id.* (citing *Teva Pharm. USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 840–41 (2015)). When the intrinsic record dictates the proper construction of a term, we review the Board’s construction without deference. *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1278 (Fed. Cir. 2017) (citing *Microsoft Corp. v. Proxyconn, Inc.*, 789 F.3d 1292, 1297 (Fed. Cir. 2015)).

Indefiniteness is a question of law this court reviews *de novo*. *Biosig Instruments, Inc. v. Nautilus, Inc.*, 783 F.3d 1374, 1377 (Fed. Cir. 2015) (citing *Interval Licensing LLC v. AOL, Inc.*, 766 F.3d 1364, 1370 (Fed. Cir. 2014)).

Compliance with the written description requirement is a question of fact we review for substantial evidence. *ULF Bamberg v. Dalvey*, 815 F.3d 793, 797 (Fed. Cir. 2016) (citing *Harari v. Lee*, 656 F.3d 1331, 1341 (Fed. Cir. 2011)). Substantial evidence justifies a finding if a reasonable mind might accept the evidence to support it. *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938).

IV. Analysis

A.

Mr. Walter has advanced several arguments on appeal. In his opening brief, he asserted that he acted as his own lexicographer and defined the term “block-like” during reexamination. *See* Appellant’s Br. 15, 21, 23. Mr. Walter did not raise this argument before the Board, however, and expressly abandoned and disavowed it during oral argument before us. *See* Oral

Argument at 3:24–4:18, 10:03–10:26 (No. 16-2256), <http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2016-2256.mp3>. We therefore deem this argument waived.

Although Mr. Walter no longer relies on the Miller declaration as supporting his lexicography argument, he does contend that the declaration establishes how one of ordinary skill in the art would understand the term “block-like.” Appellant’s Br. 17–18, 23. In Mr. Walter’s view, “block-like” is a term of art in the relevant field, and the Board erred by failing to credit Mr. Miller’s testimony on this point. *Id.*

B.

On the record before us, we agree with the Board that the term “block-like” is indefinite. We therefore affirm the decision of the Board.

At the outset, we decline to adopt the Board’s implicit determination that a patent claim is indefinite because the specification uses a term differently from its dictionary definition. *See Ex parte Walter*, 2015 WL 5144184, at *2. The specification is “always highly relevant to the claim construction analysis. Usually, it is dispositive.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (en banc) (internal quotation marks omitted) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). If there is a conflict between the specification and a general purpose dictionary as to a claim’s proper meaning, the specification controls. *Id.* at 1318–24.

Nevertheless, we agree that the term “block-like” renders Mr. Walter’s claims indefinite in this case. A claim is indefinite under 35 U.S.C. § 112 when the intrinsic record of the patent “fail[s] to inform, with reasonable certainty, those skilled in the art about the scope of the invention.” *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2120, 2124 (2014) (“*Nautilus I*”). If a claim employs a term of degree, the intrinsic record must provide those skilled in the art with “objective boundaries” with which to assess the term’s scope. *Interval Licensing*, 766 F.3d at 1371. If it does not, the claim is indefinite. *Id.*

Here, “block-like” is a term of degree without any accompanying guidance in the intrinsic record for determining its scope. The term ostensibly covers a range of shapes that are sufficiently “like” a “block” and excludes those that are not. But nothing in the intrinsic record offers “objective boundaries” for ascertaining whether a given shape falls into either category. *See Interval Licensing*, 766 F.3d at 1371. And because the “present invention 10 can be fabricated *in any shape* without deviating from the objectives thereof,” *see* ’711 patent, col. 3 ll. 52– 54 (emphasis added), determining whether a particular shape is “block-like” thus strikes us as devolving into a highly subjective inquiry depending “on the unpredictable vagaries of any one person’s opinion.” *Interval Licensing*, 766 F.3d at 1371 (quoting *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005)). When, as here, “nothing in the specification, prosecution history, or proper art provides any indication as to what range of [structures] is covered by the term,” the claim is

indefinite. *Amgen, Inc. v. Chugai Pharm. Co., Ltd.* 927 F.3d 1200, 1218 (Fed. Cir. 1991).

The prosecution history compounds this uncertainty, describing “block-like” in different and often inconsistent ways. During reexamination, for example, Mr. Walter asserted that the term meant having “discreet [sic] pieces conjoined . . . in some manner,” J.A. 164, having “3- dimensional cuboid elements,” J.A. 402, having “solid pieces of material with flat sides,” J.A. 244, and encompassing “curved blocks,” J.A. 482, among other formulations. Mr. Walter also vacillated between applying the “block-like” adjectival phrase to the individual “frame members,” *see* J.A. 511 ll. 12–17, and other times to the “support structure” as a whole, *see* J.A. 164. These shifting positions make pinning down a construction of “block-like” all the more elusive. And even if it were possible to harmonize all of Mr. Walter’s statements, it is not enough “that a court can ascribe *some* meaning to a patent’s claims; the definiteness inquiry trains on the understanding of a skilled artisan at the time of the patent application, not that of a court viewing matters *post hoc*.” *Nautilus I*, 134 S. Ct. at 2130. Here, the term’s ill-defined boundaries coupled with the patentee’s erratic use of the term fails to inform skilled artisans about the scope of the invention with reasonable certainty. *Id.* at 2124. The term is indefinite.

Citing to Mr. Miller’s expert declaration, Mr. Walter urges that “block-like” is a term of art in the structural engineering field. Appellant’s Br. 12, 17–18, 23. We are not persuaded by this argument. *First*, Mr. Miller does not support his opinion with evidence

or analysis, and his testimony is wholly conclusory. *See* J.A. 178 ¶ 6. “[C]onclusory, unsupported assertions by experts as to the definition of a claim term are not useful to a court,” *Phillips*, 415 F.3d at 1318, and thus we give Mr. Miller’s testimony no weight. *See SkinMedica, Inc. v. Histogen Inc.*, 727 F.3d 1187, 1210 (Fed. Cir. 2013) (giving “no weight” to expert testimony in similar circumstances). *Second*, it is difficult to fault the Board for purportedly overlooking Mr. Miller’s declaration when Mr. Walter never relied on it. In both his opening and reply briefs to the Board, Mr. Walter argued that the claims were consistent with the examiner’s construction of “block” and did not urge that the phrase implicated a term of art. *See* J.A. 401–02, 482–83. Nor did Mr. Walter rely on Mr. Miller’s declaration during the oral hearing before the Board. *See* J.A. 509–13. We therefore see no error in the Board’s decision to disregard Mr. Miller’s testimony.

For the foregoing reasons, we hold that amended independent claim 1 of the ’711 patent is indefinite. Mr. Walter does not separately argue the definiteness of dependent claims 2–12, and thus we hold those claims to be indefinite as well. *See Soverain Software LLC v. Newegg Inc.*, 728 F.3d 1332, 1335–36 (Fed. Cir. 2013) (“[P]recedent guides that absent some effort at distinction, the claims rise or fall together.”); *SIBIA Neurosciences, Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1359 (Fed. Cir. 2000). Having determined that claims 1–12 of the ’711 patent, as amended, are indefinite, we do not reach the issue of whether they are also unpatentable for failing to comply with the written description requirement under 35 U.S.C. § 112, first paragraph.

CONCLUSION

For the foregoing reasons, we hold that claims 1–12 of the '711 patent, as amended during reexamination, are indefinite. We therefore affirm the Board's decision finding the claims unpatentable on that ground. In light of this holding, we do not reach the Board's decision on written description.

AFFIRMED

COSTS

Each party shall bear its own costs.

UNITED STATES PATENT AND TRADEMARK
OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

Ex parte DAVID WALTER

Appeal 2015-006121
Reexamination Control 90/013,165
Patent US 7,513,711 B1¹
Technology Center 3900

Before: STEVEN D.A. McCARTHY, DANIEL S.
SONG, and BRETT C. MARTIN, *Administrative
Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Issued to David Walter on April 7, 2009 (the '711 patent).

STATEMENT OF THE CASE

The Patent Owner appeals under 35 U.S.C. §§ 134(b) and 306 from a Final Rejection of claims 1-12. We have jurisdiction under 35 U.S.C. §§ 134(b) and 306. Oral arguments were heard on August 20, 2015, a transcript of which will be entered into the record in due course.

We are informed that the '711 patent is involved in a litigation styled *Walter v. Panhandle Underwater Maintenance & Salvage, LLC* in the U.S. District Court for the Northern District of Florida, Case No. 3:13-cv-00378- MCR-CJK. App. Br. 23.

We AFFIRM.

THE INVENTION

The Patent Owner's invention is directed "generally to oceanic reefs and, more specifically, to the creation, enhancing or expansion of oceanic reefs by the formation and placement of a plurality of differently shaped structures." Spec., col. 1, 11. 8-11. Claim 1, reproduced below, is the only independent claim on appeal:

1. An artificial reef comprising:
 - a) a block-like support structure made of a plurality of frame members forming a base and frame members extending up from said base;
 - b) attachable slab walls fabricated of a concrete material secured

to said support structure forming a hollow interior, said walls having recesses to provide access into the hollow interior of said reef; and

c) a plurality of soft stones embedded into said concrete walls, said soft stones are elevated beyond the face of said concrete walls to provide a greater surface area for marine life to bore and anchor into.

Claim 1 was amended during the reexamination proceeding to add the words "block-like" to limitation "a)".

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Hudson	US 5,215,406	Jun. 1, 1993
Bartkowski	US 6,186,702 B1	Feb. 13, 2001
Huggins	US 7,024,735 B1	Apr. 11, 2006

Suzanne Wentley, Martin Reef Under Watchful Eyes, *The Stuart News* (2004).

THE REJECTIONS ON APPEAL

The Examiner made the following rejections:

1. Claim 1-12 stand rejected under 35 U.S.C. § 112 first paragraph as failing to comply with written description. Ans. 2.

2. Claim 1-12 stand rejected under 35 U.S.C. § 112 second paragraph as being indefinite. Ans. 3.

3. Claim 1-3 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartkowski and Hudson. Ans. 4.

4. Claim 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartkowski, Hudson, and Wentley. Ans. 5.

5. Claim 3-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bartkowski, Hudson, Wentley, and Huggins. Ans. 6.

ANALYSIS

Rejections under 35 U.S.C. § 112

The Examiner rejects claims 1-12 under 35 U.S.C. § 112, first and second paragraphs, as failing to comply with the written description and for indefiniteness, respectively. There are two bases for the rejections that relate to two different claim elements. The first of the rejections relates to the claim element "a block-like support structure" recited in claim 1. According to the Examiner this claim element lacks written description support and is therefore new matter. Ans. 2. The Examiner also asserts that this claim term is indefinite because "the structure of a 'block' is inconsistent with the claimed structure of 'a plurality of frame members', because the frame members would define an open structure without any flat sides." Ans. 3. As the Examiner

points out, this is inconsistent with the dictionary definition of block (no definition is specifically provided in the Specification for "block"), which can be defined as "a solid piece of material (such as rock or wood) that has flat sides and is usually square or rectangular in shape." *Id.*

The Patent Owner argues that, because the Specification recites the term "block-like" several times, there is written description support and this should not be considered new matter. App. Br. 4. Although we agree that the Specification recites the term "block-like" several times, it is not in reference to the support structure alone, as claimed, but is used to describe the overall structure of the artificial reef itself, and not a particular element thereof. We agree that the finished artificial reef, as seen for example in Figure 3, may be properly described as "block-like," but do not agree that the support structure alone, as seen in Figure 2, may likewise be described as such. We further agree with the Examiner that the support structure disclosed in the Specification is an open frame that is inconsistent with a proper understanding of the term "block-like," thus rendering the term indefinite.

The Patent Owner also argues that the term "block-like" does not apply to the support structure as a whole, but that the individual frame members are block-like "3-dimensional cuboid elements" and so the claim language is proper. App. Br. 8. Claim 1, however, recites "a block-like support structure made of a plurality of frame members." It is clear from the claim language at issue that "block-like" modifies the

overall support structure and not the individual frame members. In order to give the claim the meaning set forth by the Patent Owner, the claim language would need to recite "a support structure made of a plurality of block-like frame members," or the like. We conclude that it is clear that the term "block-like" modifies the support structure as a whole and that the Specification fails to support such a claim term. Accordingly, we sustain the Examiner's rejection of claims 1-12 as lacking written description and for indefiniteness with respect to the claim term "block-like support structure."

We decline to reach the second basis for the rejections as they relate to the term "attachable" because the indefiniteness and written description issues relating to "block-like" dispose of all pending claims. Further, because the prior art rejections cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of the claim language, a material issue of claim interpretation is present that must be resolved before the merits of the Examiner's and Appellant's positions can be properly considered. *See In re Steele*, 305 F.2d 859, 862-863 (CCPA 1962). Accordingly, we pro forma reverse the Examiner's rejection of claims 1-12 that stand rejected under 35 U.S.C. § 103(a).

DECISION

For the above reasons, we AFFIRM the Examiner's decision to reject claims 1-12.

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). In the event neither party files a request for rehearing within the time provided in 37 C.F.R. § 41.79, and this decision becomes final and appealable under 37 C.F.R. § 41.81, a party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See*

37 C.F.R. §§ 90.1 and 1.983

AFFIRMED

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UNITED STATES PATENT AND TRADEMARK
OFFICE

BEFORE THE PATENT TRIAL AND APPEAL
BOARD

Ex parte DAVID WALTER

Appeal 2015-006121
Reexamination Control 90/013,165
Patent US 7,513,711 B1¹
Technology Center 3900

Before: STEVEN D.A. McCARTHY, DANIEL S.
SONG, and BRETT C. MARTIN, *Administrative
Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ Issued to David Walter on April 7, 2009 (the '711 patent).

The Patent Owner filed its REQUEST FOR REHEARING on September 30, 2015 (hereinafter "Rehearing Request" or "Rhrq. Req.") under 37 C.F.R. § 41.52,² seeking rehearing of our Decision mailed August 31, 2015 (hereinafter "Decision" or "Dec."), which affirmed various final rejections of the claims made by the Examiner. We grant the Rehearing Request to the extent that we consider the Requester's arguments, but DENY the request to modify the Decision.

A Rehearing Request under 37 C.F.R. § 41.52 has the very specific requirements that the appellant seeking rehearing allege that the Board misapprehended or overlooked something in rendering the original decision. Here, the Patent Owner has done neither, but mostly rehashes arguments already made and rejected. *See* Rhrq. Req. 1-5. We note that a majority of the Rehearing Request merely copies and pastes arguments already made before the Examiner or in the Appeal and which have already been addressed in the Decision.

The Patent Owner states in its main argument, "[t]he Board has misinterpreted the definition of 'block-like' as described in the patent and previously argued by the Appellant." Rhrq. Req. 2. Independent claim 1, however, recites a "support

² The Patent Owner mistakenly references 37 C.F.R. §41.79, which deals with a rehearing in an inter partes reexamination, whereas this appeal is of an ex parte reexamination.

structure." Claim 1 does not call the support structure a "block;" instead, the claim recites that the support structure is "block-like." Ordinarily, the Board does not interpret claims so as to render words within the claim superfluous. This implies that some meaning must be attributed to the word "-like." The implication of the word "-like" is that the support structure shares some feature or features with a block. Neither the claim language, nor the written description of the '117 patent, nor the Patent Owner's arguments, reasonably clarifies what such a feature or features might be.

As such, the Board has not misinterpreted the phrase "block-like support structure" as the Patent Owner contends. (*See* Rhrq. Req. 2). We conclude that the phrase is not definite enough to reasonably interpret, as previously explained in the Decision. (*See* Decision 4-5). Likewise, the Board has not misapprehended any evidence provided by the Patent Owner (*see* Rhrq. Req. 5), which appears to consist primarily of intrinsic evidence in the written description, drawings, and claims of the '711 patent itself (*see* App. Br. 7-9; Rhrq. Req. 2-4); but has considered such evidence and argument related thereto, found it unpersuasive, and provided an interpretation that is fully explained and supported in the original Decision. *See* Dec. 4-5. The Patent Owner simply cannot overcome the fact that the Specification describes a "block-like structure," referring to the overall reef structure, and not a "block-like support structure" or frame as repeatedly

argued and rejected. (*See, e.g.*, '117 patent, col. 1, ll. 37-40 and 49-54).

Pages 4-5 of the Decision address the Patent Owner's arguments invoking the written description of the '117 patent, and, in particular, those arguments invoking either Figure 2 or the object stated generally at lines 44-46 of column 1 (*see* App. Br. 7-8). Even to the extent that the '117 patent, speaks of the base 22 and frame members 24 depicted in Figure 2, the patent describes these structures in terms of their capacity to act as support structure rather than in terms of any "block-like" features. (*See, e.g.*, '117 patent, col. 3, ll. 20-22). As page 5 of the Decision points out, the Patent Owner's argument that the components of the base 22 and the frame members 24 depicted in Figure 2 of the '117 patent themselves comprise "block-like" elements (*see* App. Br. 8; Reply Br. 6-7) merely obscures an already unpersuasive argument. Even were we to agree with the Patent Owner's assertion that the dictionary definition quoted by the Examiner on page 4 of the Final Office Action is not "all-inclusive" (*see* Reply Br. 5-6), the scope and meaning of the phrase "block-like support structure" is not clear enough to satisfy the second paragraph of 35 U.S.C. § 112.

The Patent Owner's arguments amount to nothing more than a disagreement over the interpretation applied by the Board. A Rehearing Request is not an opportunity for the requesting party to reargue its case or to express disagreement with the Decision. Accordingly, we are not persuaded of any basis for granting the Rehearing Request.

DECISION

While we have considered the Decision in light of the Rehearing Request, we decline to modify it in any respect.

Pursuant to 35 U.S.C. §§ 141(b) and 306, this decision is final for the purpose of judicial review. A party seeking judicial review must timely serve notice on the Director of the United States Patent and Trademark Office. *See* 37 C.F.R. §§ 90.1 *et seq.*

DENIED

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NOTE: This order is nonprecedential.

United States Court of Appeals
for the Federal Circuit

IN RE: DAVID WALTER,
Appellant

2016-2256

Appeal from the United States Patent and
Trademark Office, Patent Trial and Appeal Board in
No. 90/013,165.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

Before PROST, *Chief Judge*, NEWMAN, LOURIE,
SCHALL,*
DYK, MOORE, O'MALLEY, REYNA, WALLACH,
TARANTO,
CHEN, HUGHES, and STOLL, *Circuit Judges*.
PER CURIAM.

ORDER

Appellant David Walter filed a combined petition for panel rehearing and rehearing en banc. A response to the petition was invited by the court and filed by appellee Joseph Matal. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was

* Circuit Judge Schall participated only in the decision on the petition for panel rehearing.

referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied. The petition for rehearing en banc is denied.

The mandate of the court will issue on December 5, 2017.

FOR THE COURT

<u>November 28, 2017</u>	<u>/s/ Peter R. Marksteiner</u>
Date	Peter R. Marksteiner Clerk of Court



US007513711B1

(12) **United States Patent**
Walter

(10) **Patent No.:** **US 7,513,711 B1**
(45) **Date of Patent:** **Apr. 7, 2009**

(54) **ARTIFICIAL MARINE REEF INDUCEMENT
STRUCTURE**

(76) Inventor: **David Walter**, P.O. Box 998, Orange
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(*) Notice: Subject to any disclaimer, the term of this
patent is extended or adjusted under 35
U.S.C. 154(b) by 94 days.

(21) Appl. No.: **11/620,000**

(22) Filed: **Jan. 4, 2007**

(51) **Int. CL.**
A01B 61/00 (2006.01)

(52) **U.S. CL.** **405/25**; 119/221

(58) **Field of Classification Search** 45/21,
45/25, 30

See application file for complete search history.

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Primary Examiner—John Kreck

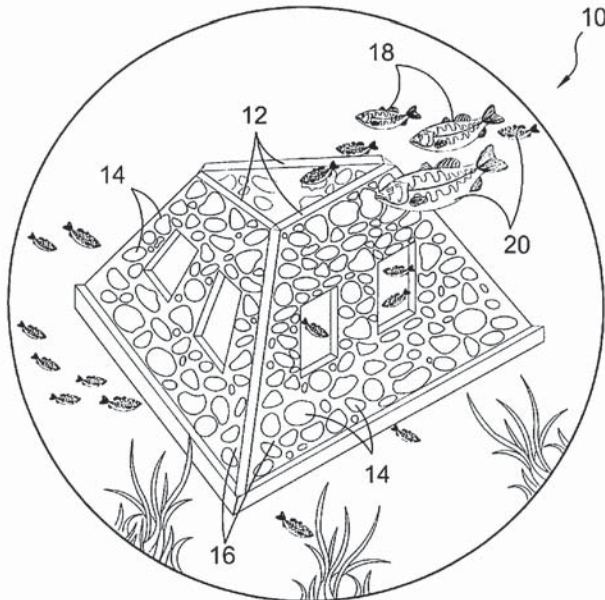
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(57)

ABSTRACT

A structure that can be made in many different shapes composed of primarily soft limestone slabs and formed in a manner to a frame whereby ample surface area is provided for securement thereon of crustaceans, coral and other aquatic life. Additionally the present invention includes a base portion to support the present invention and handles or straps to assist in placement of the device in the ocean.

12 Claims, 7 Drawing Sheets



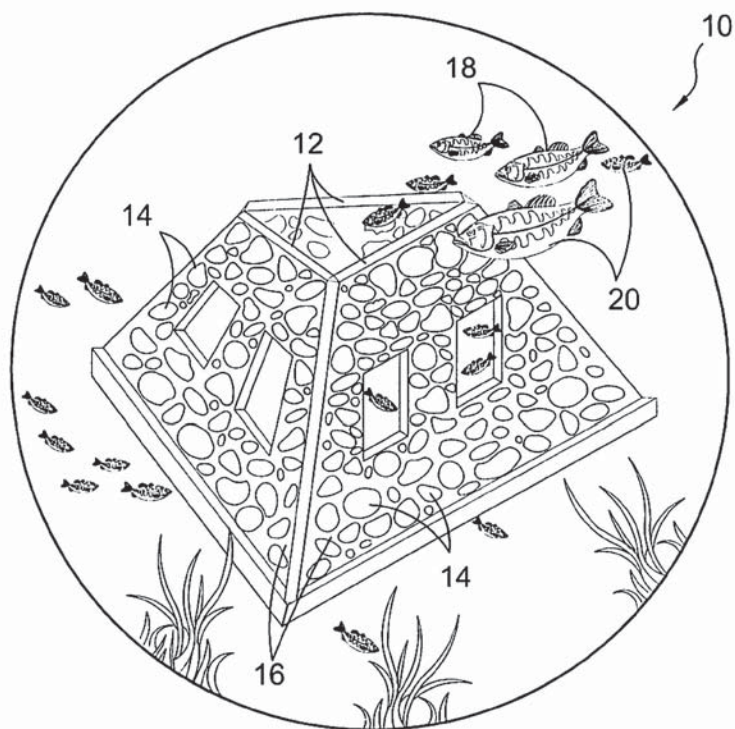


FIG. 1

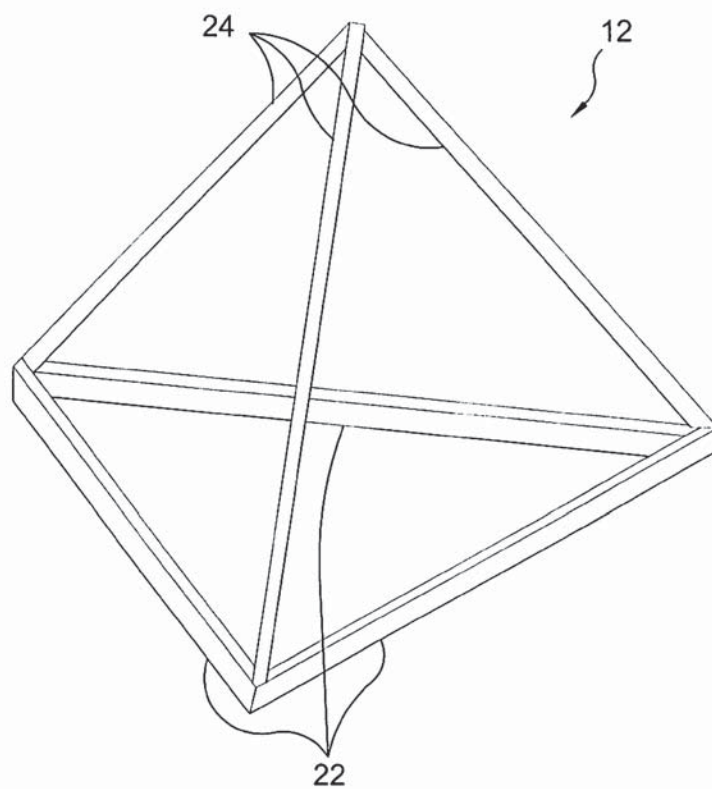


FIG. 2

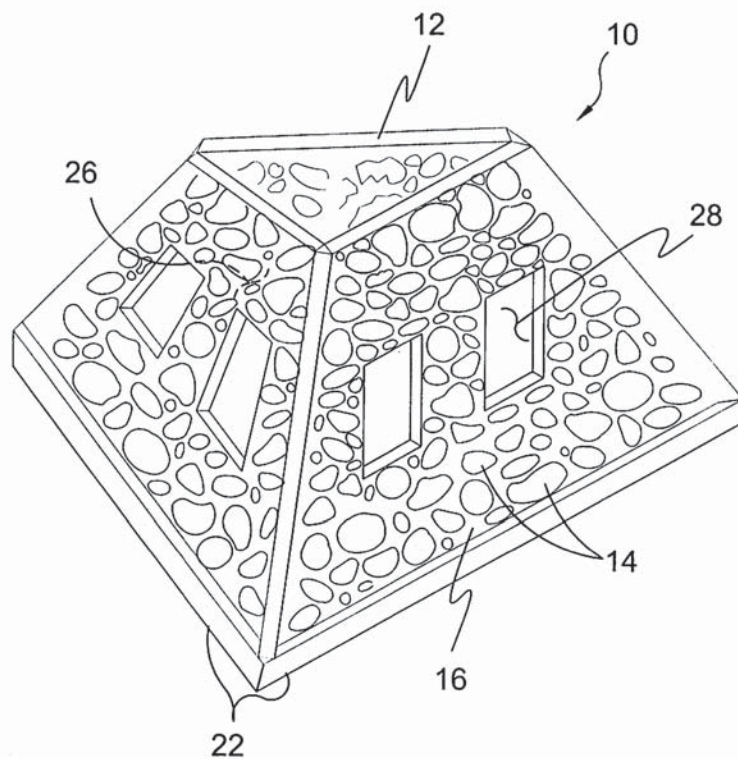
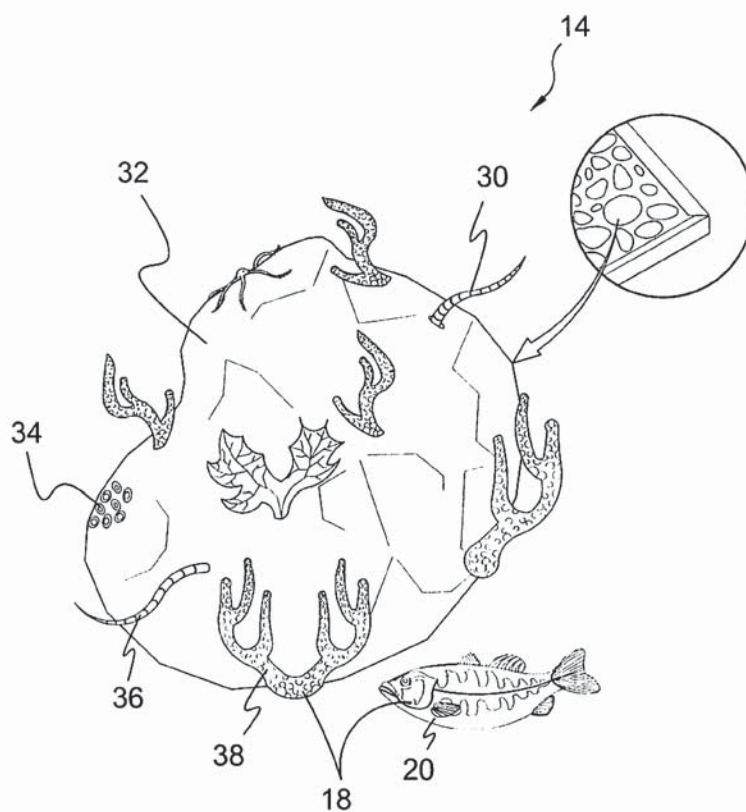
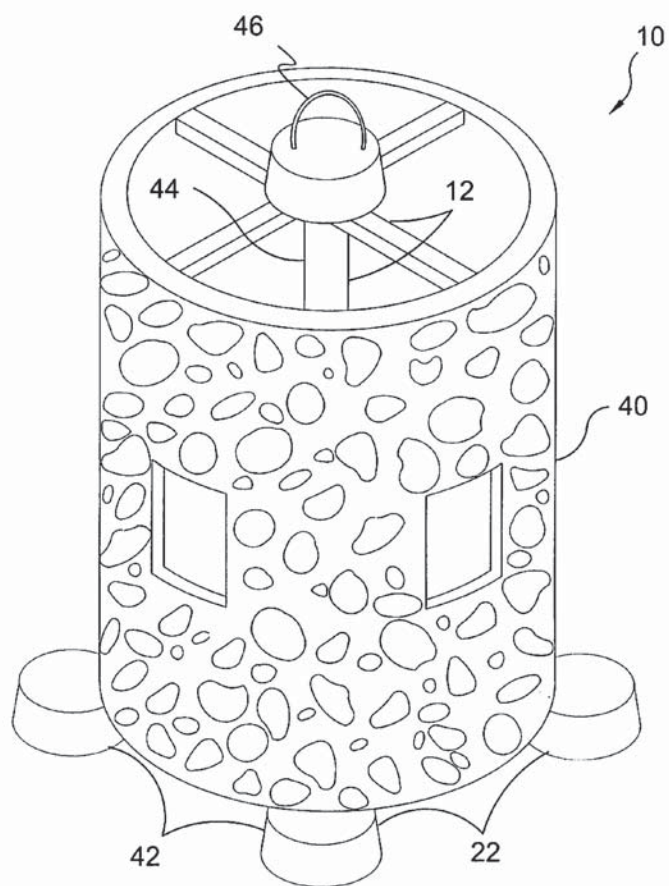
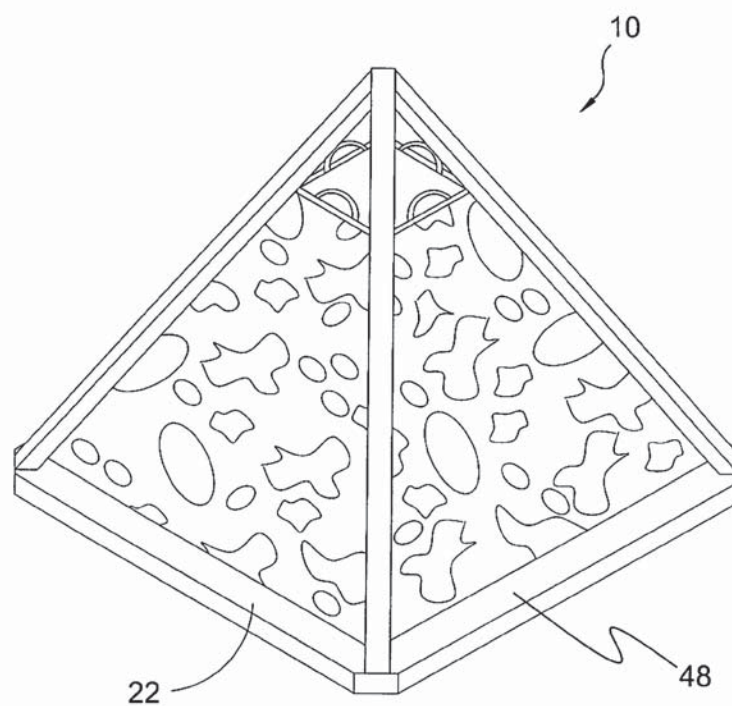


FIG. 3

**FIG. 4**

**FIG. 5**

**FIG. 6**

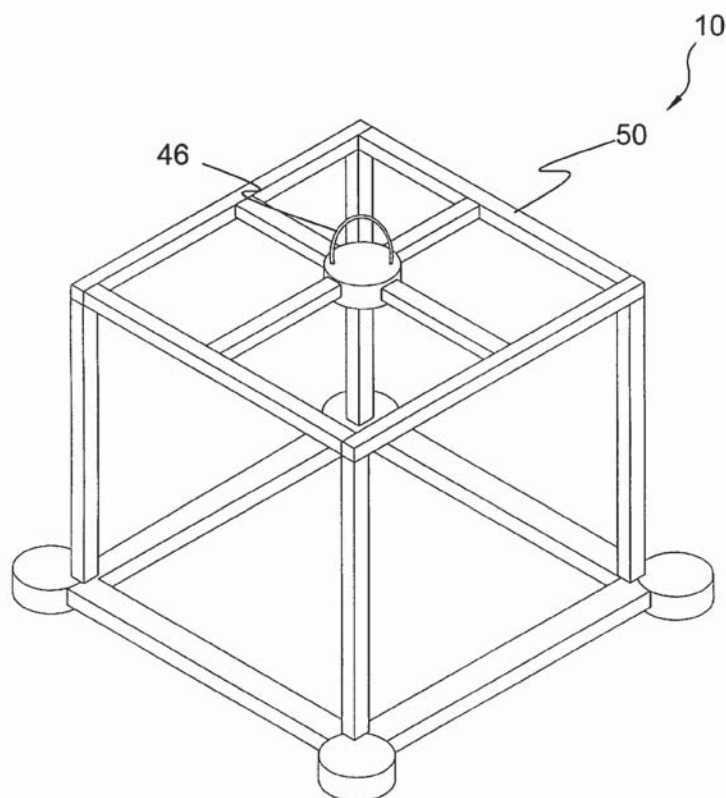


FIG. 7

1 ARTIFICIAL MARINE REEF INDUCEMENT STRUCTURE

BACKGROUND OF THE INVENTION

Field of the Invention

The present invention relates generally to oceanic reefs and, more specifically, to the creation, enhancing or expansion of oceanic reefs by the formation and placement of a plurality of differently shaped structures formed of a frame, typically tetrahedron shaped conjoined with a plurality of slabs forming the majority of the device's surface. The slabs are manufactured of concrete which forms a plate for embedding rocks, such as soft limestone or other indigenous rocks that allow marine animals to burrow.

The present invention functions to promote the formation of an oceanic reef by providing ample surface area formed of soft limestone providing an area for marine wildlife to anchor themselves to enable the start of an oceanic life cycle with an increased fish populace.

While there are other devices for creating an artificial oceanic reef that may be suitable for the purposes for which they were designed, they would not be as suitable for the purposes of the present invention, as hereinafter described.

SUMMARY OF THE PRESENT INVENTION

A primary object of the present invention is to provide a block-like structure composed of primarily soft limestone utilized for the development of artificial oceanic reefs.

Another object of the present invention is to provide a block-like structure having a formed extending surface area ideal for the attachment thereto of crustaceans and other aquatic life forms.

Yet another object of the present invention is to provide a block-like structure having a frame with attachable slabs of soft limestone to provide an easily attachable environment for ocean life.

Still yet another object of the present invention is to provide a block-like structure having loops and attachments to help facilitate in placing of the present invention.

Another object of the present invention is to provide a block-like structure that may be constructed having a base portion to support the device when placed.

Additional objects of the present invention will appear as the description proceeds.

The present invention overcomes the shortcomings of the prior art by providing a block-like structure that can be made in many different shapes composed of primarily soft limestone slabs and formed in a manner to a frame whereby ample surface area is provided for securement thereon of crustaceans, coral and other aquatic life. Additionally the present invention includes a base portion to support the present invention and handles or straps to assist in placement of the device in the ocean.

The foregoing and other objects and advantages will appear from the description to follow. In the description reference is made to the accompanying drawing, which forms a part hereof, and in which is shown by way of illustration specific embodiments in which the invention may be practiced. These embodiments will be described in sufficient detail to enable those skilled in the art to practice the invention, and it is to be understood that other embodiments may be utilized and that structural changes may be made without departing from the scope of the invention. In the accompany-

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ing drawing, like reference characters designate the same or similar parts throughout the several views.

The following detailed description is, therefore, not to be taken in a limiting sense, and the scope of the present invention is best defined by the appended claims.

BRIEF DESCRIPTION OF THE DRAWING FIGURES

In order that the invention may be more fully understood, it will now be described, by way of example, with reference to the accompanying drawing in which:

FIG. 1 is an illustrative view of the present invention in use;
FIG. 2 is a perspective view of a support structure of the present invention;

FIG. 3 is a perspective view of the present invention;

FIG. 4 is a detailed view of the present invention;

FIG. 5 is a perspective view of an alternate shape of the present invention;

FIG. 6 is a perspective view of an alternate shape of the present invention; and

FIG. 7 is a perspective view of an alternate shape of the present invention.

DESCRIPTION OF THE REFERENCED NUMERALS

Turning now descriptively to the drawings, in which similar reference characters denote similar elements throughout the several views, the figures illustrate the Artificial Reef of the present invention. With regard to the reference numerals used, the following numbering is used throughout the various drawing figures.

10 Artificial Reef of the present invention

12 support structure

14 soft stone

16 concrete

18 marine life

20 fish

22 base of 12

24 frame member of 12

26 interior of 12

28 recess of 16

30 boring marine animals

32 coquina (south Florida limestone)

34 crustaceans

36 worms

38 coral

40 cylindrical reef

42 footpads of 40

44 center post of 40

46 hoist bar

48 pyramid-shaped reef with square footprint

50 square reef

DETAILED DESCRIPTION OF THE PREFERRED EMBODIMENT

The following discussion describes in detail one embodiment of the invention (and several variations of that embodiment). This discussion should not be construed, however, as limiting the invention to those particular embodiments, practitioners skilled in the art will recognize numerous other embodiments as well. For definition of the complete scope of the invention, the reader is directed to appended claims.

FIG. 1 is an illustrative view of the present invention 10 in use. The present invention is an artificial reef 10 having a

3 manufactured support structure 12 in a plurality of shapes. Rock, such as Florida or other soft limestone 14, soft limestone 14 is excellent reef material and is embedded into concrete walls 16 assembled about the support structure 12. The added benefit of embedding the stone 14 in the concrete 5 16 reef is to allow vertical relief from the bottom. This exposes more of the stone 14 for marine life 18 to attach itself to. By using small stones 14 instead of one large stone 14, much more surface area is exposed for the marine life 18 to attach to. The stone 14 allows marine boring animals (worms) 10 and other marine life forms 18 such as crustaceans to drill into the stone 14 for easy attachment, attracting fish 20 and other marine life 18 to the artificial reef 10.

FIG. 2 is a perspective view of a support structure 12 of the present invention. Shown is a support structure 12 of the present invention's artificial reef having a manufactured support structure 12 in a plurality of shapes and rock types, such as soft limestone that is an excellent reef material, embedded into concrete walls assembled about the support structure 12. The added benefit of embedding the stone in the concrete is to allow vertical relief from the base 22. Frame members 24 extend from the base 22 to support the concrete walls. This exposes more of the soft stone for marine life to attach itself to. By using small stones instead of one large stone, much more surface area is exposed for the marine life to attach to. 25

FIG. 3 is a perspective view of the present invention 10. Shown is the artificial reef 10 comprising a manufactured support structure 12 in a plurality of shapes and soft rock types 16 that are embedded into concrete walls 16 assembled about the frame members 24 of the support structure 12. The benefit of embedding the soft stone 14 in the concrete walls 16 is to allow vertical relief from the base 22. This exposes more of the soft stone 14 for marine life to attach itself to. By using small stones 14 instead of one large stone 14, much more surface area is exposed for the marine life to attach to. The soft limestone 14 allows marine boring animals (worms) and other marine life forms such as crustaceans to drill into the stone 14 for easy attachment, attracting fish and other marine life to the artificial reef 10. The interior 26 of the reef 10 is substantially hollow and accessible through a plurality of 40 recesses 28 disposed within the walls 16 thereof.

FIG. 4 is a detailed view of the soft rock 14. Shown is one example of the soft rock 14 used in the support structure. As illustrated, soft rock 14 such as coquina (south Florida limestone) 32 or other soft limestone 14 is excellent reef material and is embedded into concrete walls assembled about the support structure. The soft rock 14 allows marine boring animals 30 such as worms 36 and crustaceans 34 to drill into the stone 14 for easy attachment, attracting fish 20, coral 38 and other marine life 18 to the artificial reef.

FIG. 5 is a perspective view of an alternate shape of the present invention 10. The present invention 10 can be fabricated in any shape without deviating from the objectives thereof. Shown is a cylindrical reef 40 having a support structure 12 with foot pads 42 as a base 22 and frame members 24 including a center post 44 with spoke-like members emanating therefrom. A hoist bar 46 is disposed on the top of the center post 44 to assist in the installation thereof.

FIG. 6 is a perspective view of an alternate shape of the present invention 10 having a square base 22 and a pyramid 60 shape 48.

FIG. 7 is a perspective view of an alternate shape of the present invention 10. Shown is the artificial reef 10 fabricated in as a square reef 50 including a hoist bar 46. The benefit of embedding the stone in the concrete is to allow vertical relief from the bottom. This exposes more of the stone for marine 65

4 life to attach itself to. By using small stones instead of one large stone, much more surface area is exposed for the marine life to attach to. The soft limestone allows marine boring animals (worms) and other marine life forms such as crustaceans to drill into the stone for easy attachment, attracting fish and other marine life to the artificial reef 10.

It will be understood that each of the elements described above, or two or more together may also find a useful application in other types of methods differing from the type described above.

While certain novel features of this invention have been shown and described and are pointed out in the annexed claims, it is not intended to be limited to the details above, since it will be understood that various omissions, modifications, substitutions and changes in the forms and details of the device illustrated and in its operation can be made by those skilled in the art without departing in any way from the spirit of the present invention.

Without further analysis, the foregoing will so fully reveal the gist of the present invention that others can, by applying current knowledge, readily adapt it for various applications without omitting features that, from the standpoint of prior art, fairly constitute essential characteristics of the generic or specific aspects of this invention

What is claimed is:

1. An artificial reef comprising:

- a) a support structure made of a plurality of frame members forming a base and frame members extending up from said base;
- b) walls fabricated of a concrete material secured to said support structure forming a hollow interior, said walls having recesses to provide access into the hollow interior of said reef; and
- c) a plurality of soft stones embedded into said concrete walls, said soft stones are elevated beyond the face of said concrete walls to provide a greater surface area for marine life to bore and anchor into.

2. The artificial reef recited in claim 1, wherein said soft stone is sufficiently soft to allow hosting boring marine life.

3. The artificial reef recited in claim 2, wherein said soft stone is limestone.

4. The artificial reef recited in claim 3, wherein said limestone is coquina.

5. The artificial reef recited in claim 4, wherein said base forms a triangulated footprint.

6. The artificial reef recited in claim 5, wherein said frame members extend from said triangulated base to form a pyramidal shape to provide vertical relief.

7. The artificial reef recited in claim 4, wherein said base forms a square footprint.

8. The artificial reef recited in claim 7, wherein said frame members extend from said square base to form a pyramidal shape to provide vertical relief.

9. The artificial reef recited in claim 7, wherein said frame members extend from said square base to form a square shape to provide vertical relief.

10. The artificial reef recited in claim 4, wherein said base forms a substantially circular footprint.

11. The artificial reef recited in claim 10, wherein said frame members extend from said circular base to form a circular shape to provide vertical relief.

12. The artificial reef recited in claim 4, further including a hoist bar for attaching a hook for lifting and lowering said artificial reef during installation.

* * * * *

STATUTES AND REGULATIONS

THE ADMINISTRATIVE PROCEDURE ACT

5 U.S.C. § 701 – 708

§ Section 701. - Application; definitions

This chapter applies, according to the provisions thereof, except to the extent that -

(1) statutes preclude judicial review; or

(2) agency action is committed to agency discretion by law

(b) For the purpose of this chapter -

(1) "agency" means each authority of the Government of the United States, whether or not it is within or subject to review by another agency, but does not include -

(A) the Congress;

(B) the courts of the United States;

(C) the governments of the territories or possessions of the United States;

(D) the government of the District of Columbia;

(E) agencies composed of representatives of the parties or of representatives of organizations of the parties to the disputes determined by them;

(F) courts martial and military commissions;

(G) military authority exercised in the field in time of war or in occupied territory; or

(H) functions conferred by sections 1738, 1739, 1743, and 1744 of title 12; chapter 2 of title 41; subchapter II of chapter 471 of title 49; or sections 1884, 1891-1902, and former section 1641(b)(2), of title 50, appendix; and

(2) "person", "rule", "order", "license", "sanction", "relief", and "agency action" have the meanings given them by section 551 of this title

§ Section 702. - Right of review

A person suffering legal wrong because of agency action, or adversely affected or aggrieved by agency action within the meaning of a relevant statute, is entitled to judicial review thereof. An action in a court of the United States seeking relief other than money damages and stating a claim that an agency or an officer or employee thereof acted or failed to act in an official capacity or under color of legal authority shall not be dismissed nor relief therein be denied on the ground that it is against the United States or that the United States is an indispensable party. The United States may be named as a defendant in any such action, and a judgment or decree may be entered

against the United States: Provided, That any mandatory or injunctive decree shall specify the Federal officer or officers (by name or by title), and their successors in office, personally responsible for compliance. Nothing herein

(1) affects other limitations on judicial review or the power or duty of the court to dismiss any action or deny relief on any other appropriate legal or equitable ground; or

(2) confers authority to grant relief if any other statute that grants consent to suit expressly or impliedly forbids the relief which is sought

§ Section 703. - Form and venue of proceeding

The form of proceeding for judicial review is the special statutory review proceeding relevant to the subject matter in a court specified by statute or, in the absence or inadequacy thereof, any applicable form of legal action, including actions for declaratory judgments or writs of prohibitory or mandatory injunction or habeas corpus, in a court of competent jurisdiction. If no special statutory review proceeding is applicable, the action for judicial review may be brought against the United States, the agency by its official title, or the appropriate officer. Except to the extent that prior, adequate, and exclusive opportunity for judicial review is provided by law, agency action is subject to judicial review in civil or criminal proceedings for judicial enforcement

§ Section 704. - Actions reviewable

Agency action made reviewable by statute and final agency action for which there is no other adequate remedy in a court are subject to judicial review. A preliminary, procedural, or intermediate agency action or ruling not directly reviewable is subject to review on the review of the final agency action. Except as otherwise expressly required by statute, agency action otherwise final is final for the purposes of this section whether or not there has been presented or determined an application for a declaratory order, for any form of reconsideration, or, unless the agency otherwise requires by rule and provides that the action meanwhile is inoperative, for an appeal to superior agency authority

§ Section 705. - Relief pending review

When an agency finds that justice so requires, it may postpone the effective date of action taken by it, pending judicial review. On such conditions as may be required and to the extent necessary to prevent irreparable injury, the reviewing court, including the court to which a case may be taken on appeal from or on application for certiorari or other writ to a reviewing court, may issue all necessary and appropriate process to postpone the effective date of an agency action or to preserve status or rights pending conclusion of the review proceedings

§ Section 706. - Scope of review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall -

(1) compel agency action unlawfully withheld or unreasonably delayed; and

(2) hold unlawful and set aside agency action, findings, and conclusions found to be -

(A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;

(B) contrary to constitutional right, power, privilege, or immunity;

(C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;

(D) without observance of procedure required by law;

(E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or

(F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

35 USC 112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

CODE OF FEDERAL REGULATIONS

§1.132 AFFIDAVITS OR DECLARATIONS TRAVERSING REJECTIONS OR OBJECTIONS.

When any claim of an application or a patent under reexamination is rejected or objected to, any evidence submitted to traverse the rejection or objection on a basis not otherwise provided for must be by way of an oath or declaration under this section.

MANUAL OF PATENT EXAMINATION PROCEDURE

§716 Affidavits or Declarations Traversing
Rejections, 37 CFR §1.132

37 CFR §1.132 Affidavits or declarations traversing
rejections or objections.

When any claim of an application or a patent under
reexamination is rejected or objected to, any evidence
submitted to traverse the rejection or objection on a
basis not otherwise provided for must be by way of an
oath or declaration under this section.

It is the responsibility of the primary examiner to
personally review and decide whether affidavits or
declarations submitted under 37 CFR 1.132 for the
purpose of traversing grounds of rejection are
responsive to the rejection and present sufficient facts
to overcome the rejection.

This rule sets forth the general policy of the Office
consistently followed for a long period of time of
receiving affidavit evidence traversing rejections or
objections. All affidavits or declarations presented
which do not fall within or under other specific rules
are to be treated or considered as falling under this
rule.

Form paragraph 7.65 or 7.66 and any of form
paragraphs 7.66.01 through 7.66.05, as appropriate,
should be used to comment on a 37 CFR
1.132 affidavit or declaration.

7.66 Affidavit or Declaration Under 37 CFR §1.132:
Insufficient

he [1] under 37 CFR 1.132 filed [2] is insufficient to overcome the rejection of claim [3] based upon [4] as set forth in the last Office action because:

Examiner Note:

- 1. In bracket 1, insert either --affidavit-- or --declaration--.
- 2. In bracket 2, insert the filing date of the affidavit or declaration.
- 3. In bracket 3, insert the claim or claims affected.
- 4. In bracket 4, indicate the rejection that has not been overcome, including the statutory grounds, i.e.: insufficiency of disclosure under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph; lack of utility and/or inoperativeness under 35 U.S.C. 101; a specific reference applied under 35 U.S.C. 103; etc. See MPEP § 716.
- 5. Following this form paragraph, set forth the reasons for the insufficiency; e.g., categories include: --untimely--; --fails to set forth facts--; --facts presented are not germane to the rejection at issue--; --showing is not commensurate in scope with the claims--; etc. See MPEP § 716. Also include a detailed explanation of the reasons why the affidavit or declaration is insufficient. Any of form paragraphs 7.66.01 - 7.66.05 may be used, as appropriate.

Excerpt MPEP 2145

Office personnel should consider all rebuttal arguments and evidence presented by applicants.

See, e.g., *Soni*, 54 F.3d at 750, 34 USPQ2d at 1687 (error not to consider evidence presented in the specification). C.f., *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (error not to consider factual evidence submitted to counter a 35 U.S.C. 112 rejection); *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992) (Office personnel should consider declarations from those skilled in the art praising the claimed invention and opining that the art teaches away from the invention.); *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788 (“[Rebuttal evidence] may relate to any of the Graham factors including the so-called secondary considerations.”).