

## Detailed Explanation Not the Same as a New Ground for Rejection Re: Patent and Trademark Office (PTO) Case

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Addressing patentability of claims of an application, the U.S. Court of Appeals for the Federal Circuit upheld a decision by the **U.S. Patent and Trademark Office (PTO)** Board of Patent Appeals and Interferences (Board), finding that the Board did not err in rejecting all of the pending claims as obvious and did not rely on new grounds for rejection. *In Re Adler*, Case No. 12-1610 (Fed. Cir., July 18, 2013) (Wallach, J.).

This case arose from an appeal from the decision of the Board affirming the examiner's final rejection of all pending claims of an application as obvious over several prior art references including Meron and Hirata. The application was directed to a system including a swallowable capsule having an in-vivo imaging device for detecting blood within a body lumen. The Meron reference disclosed a capsule that moves through the gastrointestinal tract in order to generate a map of the tract, but does not specifically disclose a method of detecting the presence of blood inside the tract. The Hirata reference disclosed use of image processing with a video endoscope relating to a study of factors of esophageal variceal rupture. After the examiner finally rejected the pending claims over a combination of Meron and Hirata, asserting that it would have been obvious to one skilled in the art to incorporate Hirata's teaching of a processor for colorimetric analysis of video endoscopic data in order to determine the presence of blood in Meron's device. Adler appealed to the Board the examiner's rejection.

The Board affirmed the examiner's rejection, concluding the claimed invention would have been obvious "because a skilled artisan would have been motivated to combine Hirata—which discloses methods for comparison of the red color content of two reference values of tissue—with Meron, based on Meron's suggestion that the in vivo camera could include a means for detecting the presence of blood." Adler then appealed to the Federal Circuit.

On appeal, the Federal Circuit determined that the application claims are "a predictable variation of the combination of Hirata and Meron," agreeing with the Board's rationale that one skilled in the art "would be motivated to build on Meron's teachings concerning received images from a swallowable device that could be compared to the reference values disclosed in Hirata. Adler argued that an applicant confronting a Board decision such as the one in issue here should be entitled to reopen prosecution by the examiner or to request a rehearing because the Board relied on a new ground of rejection. Specifically, Adler contended that the Board's reliance on Hirata's image processing and

colorimetric analysis changed the thrust of the examiner's rejection based on Hirata's classification of red color signs. The Federal Circuit was not persuaded. Rather, the Federal Circuit explained that the Board's more detailed explanation (as compared to the examiner's) does not amount to a new ground of rejection. As viewed by the Court, the Board did not make new factual findings to which the applicants did not have an opportunity to respond.

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