

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GYANENDRA GUPTA

Appeal No. 1997-3102
Application 08/476,526

ON BRIEF

Before JOHN D. SMITH, PAK, and WALTZ, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant requests reconsideration¹ of our decision

¹Requests for Reconsideration under 37 CFR § 1.197 are now denominated as Request for Rehearing. See 37 CFR § 1.197(b) as amended effective December 1, 1997, by final rule notice, 62 Fed. Reg. 53, 131, 53, 197 (October 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (October 21, 1997).

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entered May 18, 2000, wherein we affirmed the rejection of claims 35 and 36 as unpatentable under 35 U.S.C. § 103 over the Caravona patent in view of the Bivar publication. More specifically, we noted in our decision, (page 11) that appellant made no argument and no challenge in his brief to the examiner's reasonable finding that the same patentable invention, as defined in 37 CFR § 1.601(n), is claimed by the Caravona patent. Thus, we held that 37 CFR § 1.131 was not available as a vehicle for appellant to overcome the examiner's rejection under 35 U.S.C. § 103 of the appealed claims as unpatentable over Caravona in view of the Bivar publication.

In appellant's request at page 2, appellant argues that the claims of the Caravona patent are for a "different invention", and that appellant's declaration filed under 37 CFR § 1.131 was proper. In support of this conclusion, and for the first time in this record, appellant presents reasons at page 2 of his request why the claims of Caravona are allegedly for a separate patentable invention. Since these arguments were not originally presented in appellant's main

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and reply briefs, the submission of such arguments at this time is improper and we decline to consider or further comment upon them. See, for example, Ex parte Hindersinn, 177 USPQ 78 (Bd. App. 1971) and 37 CFR § 1.192(a).

At pages 3 and 4 of appellant's request, appellant contends that, should the Board's decision be sustained, it would be incumbent upon the examiner to declare an interference, or alternatively, the appellant herein would request a interference based upon the decision be declared. In light of our disposition of the issues raised in this appeal, and in light of appellant's arguments in the request at pages 3 and 4, this application is returned to the examiner to take action not inconsistent with our decision and not inconsistent with the principles set forth in In re Eickmeyer, 602 F.2d 974, 979, 202 USPQ 655, 660 (CCPA 1979), where the court indicated that the reason for not permitting a 37 CFR § 131 affidavit, where a U.S. patent reference claims the invention of rejected claims of an application, as here, "is to compel the use of an interference to determine priority of invention."

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Appellant's request (page 2) that the examiner's final rejection be reversed is denied. However, the application is returned to the examiner to take action not inconsistent with our decision entered May 18, 2000. To the extent indicated above, appellant's request is denied.

DENIED

JOHN D. SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT

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CHUNG K. PAK)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
)	
THOMAS A. WALTZ)	
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