

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID S. BREED, WILLIAM T. SANDERS
and RICHARD M. DOWNS, JR.

Appeal No. 1999-0929
Application No. 08/514,986

ON BRIEF

Before FRANKFORT, STAAB, and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellants' request for rehearing of our decision mailed March 23, 2000, wherein, among other determinations, we affirmed the examiner's rejection of claim 17 under 35 U.S.C. § 102(b) as being anticipated by Matsui

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(U.S. Patent No. 3,859,482) and also the rejection of claim 17 under 35 U.S.C. § 103 as being unpatentable over Matsui in view of Peachey (U.S. Patent No. 4,060,705).

We have carefully considered each of the points of argument raised by appellants in their request, however, those arguments do not persuade us that our decision was in error.

With regard to the rejections of claim 17 under 35 U.S.C. § 102(b) and § 103, we note that appellants now urge that elements (97, 98 and 99) of the detecting device seen in Matsui's Figure 15a, taken individually or in combination, do not insulate the elongated strips (95, 95') from one another, as is required of the "means for coupling" set forth in claim 17 on appeal. Appellants note that it is in fact the spacers (96, 96') of Matsui (Figure 14) which are described in the reference

(column 18, lines 18-23) as being interposed between the strips (95, 95') and as serving to insulate the elongated strips (95, 95') from one another. Thus, appellants argue

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that Matsui does not include coupling means as set forth in claim 17 as there is no element which both couples strips (95, 95') together and insulates one from the other.

In response, we first observe that appellants did not argue this aspect of the claimed subject matter (i.e., the "means for coupling" portion of claim 17) in their Main Brief, and that such a new argument in a request for rehearing would normally not be

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considered by the Board. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) and Ex parte Harvey, 163 USPQ 572, 573 (Bd. App. 1968) (Question not presented to Board in appeal and not discussed by examiner is not appropriate for decision by Board on petition for reconsideration). Note also In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642 (Fed. Cir. 1986) and Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) wherein the Court noted that a party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration. However, since the showing of the detecting device in Figure 15a of Matsui may not be entirely accurate, we take this opportunity to clarify our comments in our decision mailed March 23, 2000. Given that the insulating spacers (96, 96') are not shown in Figure 15a of Matsui, we assumed that their function of spacing and insulating the electrically conductive strips (95, 95') from one another was necessarily performed by the insulating material (97) which is shown in Figure 15a. Column 18, lines 55-58, of Matsui merely indicate that the detecting device in the embodiment of Figures 15a and 15b is "constructed in a manner essentially

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similar to the device illustrated in Figure 14," not that it is identical to the device of Figure 14. However, assuming for argument sake that the insulating spacers (96, 96') seen in Figure 14 of Matsui

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are intended to be part of the detecting device seen in Figure 15a of the patent, we note that the means for coupling the second electrical conductor to the first electrical conductor in the Figure 15a embodiment of Matsui would then constitute the elements 96, 96', 97, 98 and 99, with such elements retaining the first (95) and second (95') electrical conductors parallel and substantially co-extensive to one another to form a sensor assembly and insulating said second electrical conductor from said first electrical conductor.

As for appellants' assertion that the "sensor assembly" as defined in claim 17 on appeal does not include elements that provide mechanical support for the electrical conductors as they extend across the one free, unrestrained span set forth in the claim, we point out that claim 17 is drafted using a "comprising" format and therefore does not exclude the presence of other elements, such as elements (98, 99) of Matsui, being part of the "sensor assembly" and providing a degree of mechanical support for the sensor assembly as it spans the distance between the two spaced apart positions set forth in claim 17. Thus, the mere fact that the sensor

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assembly of Matsui includes elements not expressly set forth or found in the sensor assembly of claim 17 on appeal, is of no moment.

In light of the foregoing, appellants' request is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

DENIED

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| CHARLES E. FRANKFORT |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| LAWRENCE J. STAAB |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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