

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Nathaniel P. Langford

Appeal No. 2003-0188
Application No. 09/781,386

ON BRIEF

Before WARREN, JEFFREY T. SMITH and POTEATE, *Administrative Patent Judges*.
JEFFREY T. SMITH, *Administrative Patent Judge*.

ON REQUEST FOR REHEARING

Appellant has filed a paper under 37 CFR § 1.197(b) requesting that we reconsider our decision of June 20, 2003, wherein we affirmed the rejection of claims 21, 24 to 30 and 33 to 36.

I.

In our previous decision, we affirmed the rejection of claims 24, 25 and 28 as unpatentable under 35 U.S.C. § 102(b) as anticipated by Williams or Struss; claims 21, 29, 30, 33, 35 and 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Patel; and claims 21, 29, 30 and 34 to 36 17-18 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Smith.

In review of our previous decision, it has come to our attention that there was an error in the statement of the basis of rejection for claims 21, 26, 27 and 34 to 36 over the Williams and Struss references. More specifically, the Examiner in the Answer and the Appellant in the Briefs indicated that the claims 21, 26, 27 and 34 to 36 were rejected as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Williams or Struss.¹ Our decision properly responded to the rejection as argued by the Appellant and the Examiner.² We now clarify the record by indicating that we affirmed the rejection as presented by the Examiner in the Answer and our statements in the body of the original decision (pages 7 and 8) are correct, while the statement of the basis of

¹ See Answer, page 4; Brief, page 13; and Reply Brief, page 5. We also note that Appellant has presented arguments in the rehearing request acknowledging that claim 26 was rejected under § 102 over Williams and Struss.

² In the body of our discussion of the rejections we included the statement “Accordingly, we determine that the Examiner has met the initial burden of establishing a *prima facie* case of unpatentability under sections 102 and 103.” (Decision, page 8).

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rejection appearing in that decision is incorrect. Thus, we affirmed the Examiner's rejection of claims 21, 26, 27 and 34 to 36 as unpatentable under 35 U.S.C. § 102(b) or in the alternative under 35 U.S.C. § 103(a) over Williams or Struss for the reasons appearing on pages 7 and 8 of the original decision.

II.

37 CFR § 1.197(b) provides as follows:

Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See § 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

Appellant asserts that the Board's June 20th decision is premised on a misunderstanding of the claimed invention. (Request for Rehearing, p. 3). Specifically, Appellant asserts that the invention of claims 21, 28, and 29-36 required adding a dust reducing additive to an existing joint compound or wall repair compound. This is the same argument that appears on page 18 of Appellant's Brief. Specifically, Appellant argued "[t]he present invention provides a method of reducing the quantity of dust

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generated by joint compounds such as those disclosed by Patel and Smith et al. by adding to the complete and functional joint compounds a dust reducing additive.”

We responded to Appellant’s argument on pages 10 and 11 of our decision. As stated therein, the claimed invention does not specify the time when a dust reducing additive is incorporated into a joint compound.³

The remainder of Appellant’s arguments are not directed to specific errors in the rejection of claims 21, 24 to 30 and 33 to 36. Appellant has not specifically identified the basis of rejection in which our decision was based on erroneous findings of fact concerning the prior art. Rather, we find the Appellant in essence is expressing their disagreement with the merits of our opinion. In support of their general position, Appellant now argues that joint compound and conventional joint compound refer to end products. (Request for Rehearing, p. 3). The scope of this argument is unclear. Specifically the specification, page 5, discloses that joint compound formulations include a filler and binder material as required components. It is not clear what additional components are required for the newly argued end product. Moreover, this issue has not been previously presented for the Examiner’s consideration. We will not consider any new arguments and/or new evidence which were not raised in the Brief. See 37 CFR

³ We note the specification, page 4, supports our position that the dust reducing additive can be pre-mixed into the wet joint compound.

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§ 1.192(a) (1997)(“Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.”); see also Ex parte Hintersinn, 177 USPQ 78 (Bd. App. 1971).

In summary, we have reconsidered our decision in light of all of the arguments made in the Appellant’s request. However, we see no compelling reason justifying a different result.

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Time for taking action

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

REQUEST FOR REHEARING - DENIED

CHARLES F. WARREN
Administrative Patent Judge

JEFFREY T. SMITH
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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