

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DONALD A. LONGHURST and FRANZ-JOSEF ZURHOVE

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Appeal No. 2004-0522  
Application No. 09/678,045

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HEARD: MAY 18, 2004

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Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In this request for rehearing (Paper No.28), appellants question the underlying decision (page 3) of this panel of the Board regarding the treatment given claims as to their standing or falling together. Appellants also seek reconsideration of the sustaining of the rejection of claim 27 and of perceived inconsistencies in the treatment of some claims.

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Treatment of claims on appeal

At the outset, it is important to recognize that appellants chose to argue in their brief certain claims on appeal relative to applied prior art and to simply state the content of other claims. This practice on the part of appellants, of course, clearly indicated to this panel of the Board that appellants had decided to specifically contest the rejection of certain claims (those claims specifically argued relative to the teachings of applied prior art) and not others. Of course, during review of a contested prior art rejection on appeal, this panel of the Board needs both the perspective of the examiner and appellants as to the patentability of each claim vis-a-vis applied prior art to evaluate the merits of the rejection thereof. When appellants decided not to present arguments as to why the content of certain claims is patentable over applied prior art, this panel of the Board fairly and reasonably concluded that these certain claims stand or fall from respective claims which appellants did decide to specifically argue. Our determination as to the status of those claims that appellants chose not to specifically argue relative to applied prior art is entirely appropriate on the facts of this case, and consistent with the practice of holding

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certain claims to stand or fall with argued claims when the merits of those certain claims has not been separately argued. See In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998). It follows that the treatment given appellants' claims in our underlying decision was appropriate based upon appellants' own choice to only mention the content of certain claims and not to specifically argue the merits thereof relative to applied prior art. Thus, in this request for rehearing (pages 3 through 7), appellants' viewpoint that we did not comply with settled procedure and law is unsound.

#### Claim 27

Claim 27, dependent from claim 1, was rejected by the examiner along with independent claims 10 through 15 and 18 through 23.<sup>1</sup> Claim 27 was one of those claims which appellants decided to not argue specifically relative to the applied prior art, but only to mention the content thereof (brief, page 31).

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<sup>1</sup> On page 9 of our decision, as to claims 11, 12, 14, 15, and 27, the statement should have read that "we sustain the rejection of these claims since they are considered to stand or fall with claim 10" --and claim 1, respectively--. This omission is considered to be a minor informality and clearly does not substantively alter our underlying decision.

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In this request for rehearing, and based upon our decision, appellants now seek reconsideration of 27 on its merits. As indicated above, appellants decided in their brief to not specifically argue claim 27 relative to the applied prior art. Thus, a merits review of claim 27 on request for rehearing is inappropriate.<sup>2</sup>

#### Claim 10

In this request for rehearing (page 7), appellants assess claim 10 as including "the same limitations" which apparently formed the basis for reversal of the rejection of method claim 18. As was readily apparent to us from our original reading of those claims, apparatus claim 10 and method claim 18 clearly reveal different language, and not "the same limitations" as asserted by appellants. Thus, as specifically addressed in our decision (pages 8 and 9), claim 10, with its different "in communication with" language, is appropriately rejected on prior

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<sup>2</sup> Should claim 27 come before the examiner in a subsequent application, appellants' merits argument can certainly be presented.

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art, and claim 18 is not. Thus, what appeared to appellants as an inconsistency in our decision, is not an inconsistency at all.

In summary, appellants' request for rehearing has been granted to the extent that this panel of the Board has reconsidered its earlier decision, but is denied with respect to making any substantive changes in that decision, for the reasons articulated, supra.

DENIED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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