

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LUKE A. KUTILEK and ROGER L. SCRIVEN

Appeal 2007-4035
Application 10/007979
Technology Center 1700

Decided: January 24, 2008

Before THOMAS A. WALTZ, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants request rehearing of our Decision of September 26, 2007,
wherein we affirmed the Examiner's decision to reject all the appealed
claims under 35 U.S.C. § 103(a).

We note that new arguments which were not presented in the Appeal Brief or a Reply Brief will not be considered. 37 C.F.R. § 41.37(c)(vii) (2007). Also, *see Ex parte Hindersinn*, 177 USPQ 78, 80 (Bd. App. 1971) (argument advanced in petition for reconsideration not advanced in the brief or the reply brief are not properly before us); *cf. Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) (citing cases supporting the proposition that issues not raised before the court are not addressed on rehearing). Indeed, new arguments may cause the Request for Rehearing to not be considered.

In any request for rehearing, Appellants must state with particularity each point of law or fact they believe was overlooked or misapprehended, must argue in support of each point, and must refer with particularity to where the argument was made originally in the Appeal Brief or Reply Brief. This is because failure to point to the page and line number of where the argument was originally made in the Brief or a Reply Brief can be considered evidence of a new argument.

Here, we observe that the subject Request is based substantially on new argument that was not part of the appeal record before us at the time the above-noted Decision was rendered. In this regard, the Request presents arguments with respect to our reliance on the Examiner's determination that Postupack (U.S. Patent No. 4,244,997) discloses the use of a coating nozzle located at an oblique angle relative to a substrate (see, e.g., Request 2-3: Ans. 3; and Board Decision, 6-7). Appellants did not specifically address the above-identified factual determination of the Examiner concerning the disclosure of Postupack in the Appeal Brief or a subsequently filed Reply Brief (see the Brief in its entirety).

Similarly, the Request provides the contentions that Donley (U.S. Patent No. 4,111,150) not only does not disclose a graded coating but teaches away from a graded layer (Request 4-6). However, in the Brief, Appellants did not make the latter arguments, as now made in the Request. Rather, Appellants referred to Donley as “a reference that teaches a coated grading in terms of thickness” (Br. 10; see also Br. 12). Also, the Request furnishes argument against the Examiner’s asserted combination of Donley and Postupack based on an alleged incongruity of the chain-mounted dispensers of Donley with the proposed modification (Request 3-5). However, the latter argument was not presented in the Brief (see the Brief in its entirety). Finally, at pages 5 and 6 of the Request, the new “teaching away from” argument with regard to a graded coating, as discussed above, and a new complex adjustment contention are combined in arguing for reconsideration of the Board’s Decision affirming the Examiner’s obviousness rejection of claims 5, 7, 37, and 39.

However, as noted above, it is well settled that the presentation of new argument in a request for Rehearing is untimely and inappropriate. *See 37 C.F.R. § 41.52 (2007)*. An argument presented for the first time in a Request but not advanced in the Appeal Brief or appropriately furnished in a Reply Brief (if one had been submitted) is not properly before the Board, at least in part, because the Examiner is not afforded a timely opportunity to respond and the Board is deprived of any such response that may have been supplied by the Examiner to the belatedly presented new argument. *See In re Kroekel*, 803 F.2d 705, 709 (Fed. Cir. 1986). "A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration." *Cooper v. Goldfarb*, 154 F.3d

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1321, 1331 (Fed. Cir. 1998) (citing *Moller v. Harding*, 214 USPQ 730, 731 (Bd. Pat. App. & Int. 1982), *aff'd*, 714 F.2d 160 (Fed. Cir. 1983) (table)).

Here, Requestors do not otherwise particularly point out any arguments or specifically contested matter raised in the Appeal Brief that the Board misapprehended or overlooked in rendering a Decision on this appeal.

In accordance with Appellants' Request, we have reconsidered our Decision in light of the Request, but we decline to effect any modification thereof as Requestors have not stated with particularity any points that we misapprehended or overlooked in reaching the Decision. On the appeal record presented to us, we remain of the opinion that the decision of the Examiner to reject claims 1-8, 32-41, 48, 49, and 52 under 35 U.S.C. § 103(a) as being unpatentable over Donley in view of Postupack is properly affirmed.

We have granted Appellants' Request to the extent we have reconsidered our Decision, but we decline to make any change therein.

DENIED

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