

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF BRÜCK

Appeal 2008-1434
Application 10/457,729
Technology Center 1700

Decided: July 9, 2008

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Pursuant to 37 C.F.R. § 41.52, on April 16, 2008, Appellant timely requested a rehearing of our April 8, 2008, Decision on Appeal (“Decision”), wherein this merits panel reversed the Examiner’s rejection of claims 1-4 and 11 pursuant to 35 U.S.C. § 102(b) as anticipated by Isogawa,

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and claims 8-10 and 12-24 pursuant to 35 U.S.C. § 103(a) as obvious over Isogawa in view of various secondary prior art references, but affirmed the rejection of claims 5-7 pursuant to 35 U.S.C. § 103(a) as obvious over Isogawa in view of Shimai. Shimai was not cited as a secondary reference in any of the other § 103 rejections (Dec. 12-13).

Appellant requests the Board to reconsider the affirmation of the rejection of claims 5-7, and instead reverse the Examiner's rejection of these claims, as well. As a ground for this reconsideration, Appellant states, “[S]ince claims 5-7 are dependent on claim 1, it is believed that the rejection of claims 5-7 also should not be sustained.” Request for Rehearing 1 (hereafter “Req.”).

In requesting a rehearing of a decision of the Board, an Appellant must “state with particularity the points believed to have been misapprehended or overlooked by the Board.” 37 C.F.R. § 41.52(a)(1).

In considering Appellant’s Request in its entirety, we cannot find any point of our earlier decision which Appellant argues or states was misapprehended or overlooked. Appellant appears to infer, *per se*, that the rejection of the dependent claims must be reversed when a rejection of the independent claim on which they depend is also reversed. Appellant’s position is without merit.

Independent claim 1 had been rejected by the Examiner under § 102(b) as anticipated by Isogawa (Ans. 3-4). In the rejection, one element of the invention of claim 1 was not found explicitly in the reference, but the Examiner had found this element to be inherent in the Isogawa disclosure (Ans. 10). We disagreed, finding that the element was not necessarily

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inherent from the disclosure (Dec. 10-11). We therefore reversed the § 102 rejection.

In contrast, claims 5-7, which depend on claim 1, were rejected under § 103(a) as obvious over Isogawa in view of Shimai. The additional elements of claims 5-7 not specified in claim 1 were found in Shimai according to the Examiner (Ans. 5). Upon review of Shimai, we agreed with the Examiner. We also found from our review of Shimai that this reference disclosed the element of claim 1 missing from Isogawa (Dec. 11). Thus, Shimai provided not only the additional elements of dependent claims 5-7, but also supplied the missing element in the anticipation rejection (Dec. 11). On this basis we sustained the Examiner's rejection of claims 5-7 under § 103(a).

Since independent claim 1 and dependent claims 5-7 were rejected on different statutory grounds in view of different prior art references, we determine no misapprehension or oversight in sustaining the rejection under § 103(a) but not the rejection under § 102(b).

Accordingly the Request for Rehearing is denied.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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PL initial:
sld

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