

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte

MARTIN BURKE, MARIA-CHRISTINA WHITE, MARK C. WATTS,
JAE KYOO LEE, BETTY M. TYLER, GARY H. POSNER,
and HENRY BREM

Appeal 2008-2118
Application 10/223,685
Technology Center 1600

Decided: October 31, 2008

Before TONI R. SCHEINER, DEMETRA J. MILLS, and LORA M. GREEN,
Administrative Patent Judges.

SCHEINER, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered June 26, 2008 (“Decision”), which affirmed the Examiner’s rejection of the claims under 35 U.S.C. § 103(a). The request for rehearing is denied.

DISCUSSION

Appellants argue that “the Board failed to consider the extensive data in the specification in making its legal analysis” and “applied the incorrect legal standard for determining obviousness” (Req. Rhg. 2). Essentially, Appellants point to data in the Specification purporting to demonstrate “results [that] were not predictable from the prior art” (*id.* at 4), and argue that we were in error in not considering “the evidence *in the specification and in the cited art showing unpredictability*” (*id.* at 3), even though “the Appeal Brief had not argued unpredictability” (*id.*).

Nevertheless,

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing . . .

(37 C.F.R. § 41.52(a)(1)).

The evidence of unpredictability discussed in the Request for Rehearing was not addressed or relied on in the Briefs before the Board, much less discussed in the context of the claimed subject matter and the prior art of record. Arguments that Appellants could have made, but chose not to make in the Briefs, and evidence not previously relied upon, will not be considered at this late stage.

To the extent Appellants argue that Brem “teaches that the art of locally administering chemotherapeutic agents to tumors was unpredictable” (Req. Rhg. 10), and we “dismissed this teaching” (*id.*), we disagree. On the contrary, we considered Brem’s disclosure in context, but did “not agree

with Appellants that it would ‘discourage[] one of ordinary skill in the art from modifying the teachings of Bishop’” (Decision 9). Essentially, Appellants disagree with the conclusions we reached based on the claims and evidence before us. Under these circumstances, the proper course of action for an applicant dissatisfied with the outcome of a Board decision is to appeal, not to file a Request for Rehearing to re-argue issues that have already been decided. *See 35 U.S.C. §§ 141, 145.*

Appellants’ Request for Rehearing does not point to any argument, any evidence of record, or any legal authority, that was before us in the Briefs, that we overlooked or misapprehended in reaching the conclusions set forth in the Decision. We therefore decline to revisit our earlier conclusions.

REHEARING DENIED

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