

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD K. FENRICH, MATTHEW RARICK, SUSANNAH
WURGLER-MURPHY, and DAVID R. COMEAU

Appeal 2008-2248
Application 10/427,985
Technology Center 1600

Decided: November 24, 2008

Before DONALD E. ADAMS, DEMETRA J. MILLS, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

MILLS, *Administrative Patent Judge*.

REQUEST FOR REHEARING

Appellants have requested rehearing of the decision entered June 30, 2008 ("Decision"), which affirmed the Examiner's rejection of the claims under 35 U.S.C. § 103(a). We have jurisdiction under 35 U.S.C. § 6(b).

A 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)).

Appellants allege the following points were misapprehended or overlooked by the Board.

A. Affirming the rejections of claims 1-21 and 23-25 under 35 U.S.C. § 103(a) using a new ground of rejection to which Appellants have not fairly had an opportunity to respond;

B. Affirming the rejections of claims 1-21 and 23-25 under 35 U.S.C. § 103(a) by erroneously applying a definition in the Specification for an "*abrading* or cutting surface" provided in the Specification to recitations of an "*abrasive* or cutting surface" in claims 1-21 and 23-25, and, further, by erroneously truncating the applied definition of an "abrading or cutting surface" found in the Specification to give an overly broad meaning to the recitation of "abrasive or cutting surface" in claims 1-21 and 23-25; and

C. Failing to consider the elements of claims 1-21 and 23-25 as a whole with respect to the functionality recited for the "scraping and collecting apparatus" and the "abrasive or cutting surface" in affirming the rejections under 35 U.S.C. § 103(a).

(Req. Reh'^g. 2.)

We decline to change our decision for the following reasons. With respect to the allegations above, we find no basis to declare a new ground of rejection. “[T]he ultimate criterion of whether a rejection is considered ‘new’ in a decision by the board is whether appellants have had fair opportunity to react to the thrust of the rejection.” *In re Kronig*, 539 F.2d 1300, 1302 (CCPA 1976).

Appellants allege that the Board "provided a definition for 'an abrasive or cutting surface' outside of the plain and ordinary meaning of the words," that the Board found Appellants acted as his own lexicographer, and that this position "has not previously been proffered by the Examiner." (Req. Reh'g. 7.)

However, the record reflects that the Examiner noted:

Appellants argue a teaching of covering an adhesive surface that was used to pull skin cells from a subject does not suggest sealing or even just covering an abrasive or cutting surface used to scrape skin cells from a subject because an adhesive strip is structurally dissimilar from the device that includes a cutting or scraping surface and operates to remove skin cells by a completely different mechanism than a cutting or scraping surface. The mechanism of removal of the skin cells is irrelevant. Appellants claim 1 is broadly drawn and neither specifies a mechanism of removal nor a specific apparatus. The claim is broadly drawn to loosening the epidermal skin cells and scraping off a sample of the loosened epidermal skin cells by rubbing a scraping and collecting apparatus having an abrasive **or** cutting surface on the epidermal skin. (there is not even a requirement that the scraping apparatus and the collecting apparatus be the same apparatus) and collecting the sample on the scraping and collecting apparatus **at or near** the abrasive **or** cutting surface.

(Answer 10-11.)

Thus, Appellants were on notice from the Answer that the Examiner found that the claims did not recite a mechanism of removal of cells or a specific apparatus, or that scraping apparatus and the collecting apparatus be the same apparatus. The Examiner also found and emphasized that the claims required either an "abrasive **or** cutting surface", and that the

Examiner considered the tape of Chung and Rheins to be such an abrasive surface.¹

In our Decision, we essentially agreed with the Examiner's claim interpretation, finding that the term "abrasive", consistently interpreted with the meaning set forth in the Specification², included the mechanical disruption of the skin using an adhesive surface such as tape.³ We further agreed with the Examiner's claim interpretation that claims 1-21 and 23-25 do not require that the scraping apparatus and the collecting apparatus be the same apparatus. Even so, in the present case the tape functions as both a scraping apparatus for scraping skin cells, and a collecting apparatus, collecting the scraped skin cells. In addition, because the claims do not require the scraping and collecting apparatus be the same apparatus, they encompass placing the sample collected in a separate collecting container which may be sealed. Thus we considered claims 1-21 and 23-25 as a

¹ Appellants stipulated at oral hearing that the claims were directed to an "abrasive or cutting surface." [Emphasis added.] (Oral Hearing Transcript, 4.)

² Even if we were to have applied the ordinary meaning of the term "abrasive", we note that the *Cambridge Advanced Learner's Dictionary* defines the term "abrasive" as "a substance used for rubbing away the surface of something." (<http://dictionary.cambridge.org/define.asp?key=229&dict=CALD>.) Such a definition would encompass rubbing away the skin with tape.

³ The heavy presumption in favor of the ordinary meaning of claim language as understood by one of ordinary skill in the art is overcome: (1) where the patentee has chosen to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term. *Johnson Worldwide Assocs., Inc. v. Zebco Corp.*, 175 F.3d 985, 990 (Fed. Cir. 1999).

whole, as well as the functionality recited for the "scraping and collecting apparatus" and the "abrasive or cutting surface".

Since the Board essentially agreed with the Examiner's interpretation of the claim, we find that Appellants had a fair opportunity to respond to the thrust of the rejection and that the Board's decision did not rise to the level of a new ground of rejection.

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.

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

REHEARING DENIED

Ssc:

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