UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NICHOLAS THOMAS and PER ANDERSSON
Appellants

Appeal 2008-3116
Application 10/650,412
Patent Application Publication 2004/0058408
Technology Center 1700

Decided: November 5, 2008

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and JAMES T. MOORE *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION ON REHEARING

I. STATEMENT OF THE CASE

Appellants have requested rehearing under 37 C.F.R. § 41.52 of the portions of our opinion which affirmed the following rejections:

claims 22-25 and 33-38 under 35 U.S.C. § 103(a) over Sheppard, Mian, and Cathey;

claims 21, 26, and 29-32 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, and Chen;

claims 27 and 28 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, Chen, and Wolfe; and

claims 39 and 40 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, and Cook.

We do not modify our opinion.

II. ISSUE

Appellants argue that Cathey does not teach a "hydrophobic valve" as required in the apparatus of claim 22. Did we misapprehend or overlook Appellants' arguments in the Appeal Brief regarding Cathey's failure to teach "hydrophobic valves"?

III. PRINCIPLES OF LAW

"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 . . . ." Bd. R. 41.52(a)(1).

"[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result." *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 1740 (2007).

IV. ANALYSIS

In their Appeal Brief, Appellants argued that "[t]he Cathey disclosure uses only capillary valving in its embodiments and does not disclose hydrophobic valves in any figures or working examples. *E.g.* col. 11, ln. 30-31." (App. Br. 8). We disagreed, noting that Cathey teaches hydrophobic valves in its specification at col. 5, ll. 47-55. (Decision on Appeal 16).

Now, in their Request for Rehearing, Appellants argue that

> Cathey . . . teaches slowing or impeding of fluid flow, but this does not teach a valve. The skilled artisan recognizes based on Appellants' disclosure (at least paragraphs **[0036]** and **[0037]** of US 2004/0058408) that a **valve** acts as a point to stop and resume flow, as opposed to merely hindering the flow as in Cathey.

(Req. 4). Appellants also argue that

> even if Cathey had stated 'prevent' that would not have meant that the hydrophobic area was a valve, as it would have been considered a static barrier. A valve is a dynamic device that can change between two or more states – in the case of a hydrophobic valve the states of permitting or preventing the passage of fluid.

(Req. 5). Appellants did not present either of these arguments in their Appeal Brief. Under Bd. R. 41.52(a)(1), these new arguments are not the proper basis for a Request for Rehearing and will not be considered.

Appellants also argue that we overlooked their argument that "Cathey does not support the position that the skilled artisan recognized hydrophobic valves as equivalents to capillary valves" (Req. 6) and that "Cathey makes no disclosure of a reduction to practice of hydrophobic valves. Rather Cathy [sic] exclusively employs capillary valves." (Req. 7).

As we noted in our Decision on Appeal, "[a]ll the disclosures in a reference must be evaluated, including nonpreferred embodiments . . . and a reference is not limited to the disclosure of specific working examples," *In re Mills*, 470 F.2d 649, 651 (CCPA 1972). Cathey teaches hydrophobic regions in its specification, even if not in its figures or working examples. Appellants did not direct us to sufficient evidence in their Appeal Brief that those of skill in the art would not have considered these hydrophobic regions to be hydrophobic valves, as claimed. Because Appellants did not convince

us that Cathey's hydrophobic regions could not have been substituted for the claimed hydrophobic valves with a predictable result, *see KSR*, 127 S.Ct. at 1740, we did not misapprehend Appellants argument.

V. CONCLUSION OF LAW

We did not misapprehend or overlook Appellants' arguments in the Appeal Brief regarding Cathey's failure to teach "hydrophobic valves."

VI. ORDER

Upon consideration of the Request for Rehearing and for the reasons given, it is

ORDERED that the decision affirming the Examiner's rejection of claims 22-25 and 33-38 under 35 U.S.C. § 103(a) over Sheppard, Mian, and Cathey;

the Examiner's rejection of claims 21, 26, and 29-32 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, and Chen;

the Examiner's rejection of claims 27 and 28 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, Chen, and Wolfe; and

the Examiner's rejection of claims 39 and 40 under 35 U.S.C. § 103(a) over Sheppard, Mian, Cathey, and Cook

shall not be modified.

REHEARING DENIED

MAT

Fulbright & Jaworski, LLP
1301 McKinney
Suite 5100
Houston, TX 77010-3095