THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER MECKEL, EDUARD HANSEL, KLAUS KONIG,
OTTO GANSTER and JORG BUCHNER

Appeal No. 96-3821
Application No. 08/122,264[1]

ON BRIEF

Before WINTERS, GARRIS and WEIFFENBACH, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellants request rehearing of our decision mailed September 29, 1998, affirming the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, as not particularly

---

[1] Application for patent filed September 16, 1993.

pointing out and distinctly claiming the subject matter which the appellants regard as their invention.

In our original decision (Paper No. 21), we agreed with the examiner's conclusion that claim 1 is indefinite under 35 U.S.C. § 112, second paragraph, in view of these recitations: (1) 10 to 30 mole % of at least one higher alcohol selected from the group consisting essentially of trimethylolpropane, glycerol, pentaerythritol, and mixtures of these polyols; (2) polyether polyols with an average molecular weight of 400 to 1500; and (3) the isocyanate group containing prepolymer (B) is substantially free of urea and groups. In the "Request for Reconsideration" (hereinafter Request for Rehearing, Paper No. 22), appellants do not argue that we erred with respect to recitations (1) and (3). Appellants' request does not extend to recitations (1) and (3). Rather, appellants request rehearing only to the extent that we agreed with the examiner's conclusion that claim 1 is indefinite in view of recitation (2).

Appellants argue that a person having ordinary skill in the art would readily understand that "polyether polyols with an average molecular weight of 400 to 1500" refers to

polyether polyols having a number average molecular weight of 400 to 1500. According to appellants, such hypothetical person would not question whether this recitation refers to weight average molecular weight, number average molecular weight, viscosity average molecular weight, z average molecular weight, etc. This argument, set forth in the Request for Rehearing, page 2, first full paragraph, includes references to pages 5, 6, and 8 of the specification and to the Encyclopedia of Polymer Science and Technology, Vol. 6, 164-65 (Interscience Publishers 1967) and to Patrick Meares Ph.D, Polymers; Structure and Bulk Properties 55-56 (D. Van Nostrand Co. 1965). For the sake of completeness, we here reproduce the argument in its entirety:

> Appellants respectfully submit that one of ordinary skill in the art having knowledge of the relevant literature would readily understand the nature of the polyols specified by Appellants, including their molecular weights. Appellants disclose the general preparation of polyether polyols to prepare prepolymers using known types of isocyanates and isocyanate-reactive compounds, (see page 5, lines 19 - 35 and page 6, lines 1 - 27 of the Specification), and specifically, exemplify the preparation of prepolymers from isocyanates and isocyanate-reactive compounds having either specific molecular weights or average molecular weights defined in terms of OH numbers (see Specification, page 6, lines 9 - 10; and page 8, lines 12 13, 19, and 26). Because OH numbers are determined by end-

> group analysis, a characteristic feature of number average molecular weight determinations (e.g., *Polymers; Structure and Bulk Properties,* by Patrick Meares (D. Van Nostrand Company, 1965), pages 55-56, and *Encyclopedia of Polymer Science and Technology,* Vol. 6 (Interscience Publishers, 1967), pages 164-165 (copies enclosed)), Appellants submit that one skilled in the art would understand that the term "average molecular weight" refers to <u>number</u> average molecular weight. Appellants submit that because their specification reasonably conveys to those skilled in the art what they have invented, they have fully satisfied the requirements of 35 U.S.C. § 112. Compare *Staehelin v. Secher,* 24 U.S.P.Q.2d 1513 (B.P.A.I. 1992); *In re Johnson and Farnham,* 194 U.S.P.Q. 187 (C.C.P.A. 1977); and *In re Moore and Janoski,* 439 F.2d 1232, 169 U.S.P.Q. 236, 238 (C.C.P.A. 1971).

The entire line of argument, including the reference to passages in pages 5, 6, and 8 of the specification and to the aforementioned texts, is advanced for the first time in appellants' Request for Rehearing.

A brief before the Board of Patent Appeals and Interferences ("Board") "must set forth the authorities and arguments on which appellant will rely to maintain the appeal." 37 CFR § 1.192(a). A new argument advanced in a petition for rehearing, but not advanced in appellants' Brief, is not properly before the Board and will not be considered. <u>In re Kroekel</u>, 803 F.2d 705, 709, 231 USPQ 640, 642-43 (Fed.

Cir. 1986). By the same token, new evidence proffered in a request for rehearing is not properly before the Board. In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974). On these facts, we find that appellants' argument, set forth for the first time in the Request for Rehearing, page 2, first full paragraph, is not properly before the Board and will not be considered. Likewise, the new evidence proffered in the Request for Rehearing is not properly before the Board and will not be considered.

In conclusion, appellants' request does not extend to claim 1, recitations (1) and (3). Respecting recitation (2), the request contains a line of argument and proffered evidence which is not properly before the Board and will not be considered. We therefore adhere to our original opinion and decision in every respect, and the request for rehearing is denied.

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

DENIED

SHERMAN D. WINTERS Administrative Patent Judge	)	
BRADLEY R. GARRIS Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
CAMERON WEIFFENBACH Administrative Patent Judge	)	

clm

Patent Dept.
Miles Inc.
Mobay Road
Pittsburgh, PA 15205-9741