

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HENRY S. EILTS

Appeal No. 2000-2134
Application No. 08/868,663

ON BRIEF

Before HAIRSTON, BARRETT, and DIXON, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has requested reconsideration of our decision dated June 27, 2002, wherein we affirmed the lack of written description rejection of claims 25, 28 and 29, the anticipation rejection of claims 21, 27 and 29 over either Dudek, Albrow or Barnes, and the anticipation rejection of claims 21 through 29.

Appellant's arguments (request, page 2) concerning the "multiple of 10 milliseconds" delay in claim 25 have been

Appeal No. 2000-2134
Application No. 08/868,663

reconsidered, but we still find that the originally filed disclosure has written description support for a multiple of 40 milliseconds, and not a "multiple of 10 milliseconds." Appellant can not rely on the Golden patent to provide written description support for the now claimed delay (request, page 2).

With respect to claim 28, we can not find any discernible error in our decision based upon appellant's comments (request, pages 2 and 3) concerning this claim. The referenced portion of the specification does not provide written description support for the subject matter set forth in this claim.

Turning to claim 29, appellant argues (request, page 3) that "delay circuits to provide a delay are well known in the art and are continually demonstrated in the prior art as well as in patent applications by blocks rather than specific circuits as is well known to anyone with even a small modicum of knowledge in the art." As indicated in our decision, neither the prior art discussed in the brief nor the skill in the art can take the place of a demonstration by the appellant that he was in possession of the now claimed subject matter on the filing date of the subject application.

Appeal No. 2000-2134
Application No. 08/868,663

Turning next to the prior art rejections, appellant argues (request, page 3) that "[t]he twice rejected decision of the administrative patent judge in this case is the final rejection and not the Examiner's Answer." Appellant also argues (request, page 4) that the examiner never made a showing that the rejected claims are readable on the cited references. If appellant considered the examiner's final rejection of claims 21, 27 and 29 to be premature, then appellant should have protested such an action via a petition to the Director under 37 CFR § 1.181, and not an appeal to the Board under 37 CFR § 1.191. With respect to appellant's argument that the examiner did not present a prima facie showing of anticipation of the noted claims, we find that the examiner presented such a case in the examiner's answer (answer, pages 5 through 11). The reply brief failed to rebut the points made by the examiner in the answer. Thus, we see no need to modify our decision or to remand to the examiner as requested by the appellant (request, pages 4 and 5).

Appellant's argument (request, page 5) concerning declarations supposedly made on the record by Messrs. Eilts and Goldman is not timely since it was not argued in the briefs. Even if they were of record, we do not see the relevance of such declarations to an anticipation rejection.

Appeal No. 2000-2134
Application No. 08/868,663

With respect to the anticipation rejection of claims 21 through 29 based upon the teachings of the Golden patent, appellant argues (request, page 5) that the final rejection (paper number 10) only listed claims 21, 27 and 29 as being rejected based upon the teachings of this reference. The examiner subsequently included claims 22 through 26 and 28 in this rejection based upon admissions by appellant that claims 21 through 29 were copied from Golden (answer, page 11). In view of the lack of surprise to appellant based upon the examiner's action, and appellant's reaffirmation of the act of copying claims 21 through 29 from Golden (reply brief, page 3), we hereby decline to change our decision to affirm the anticipation rejection of claims 21 through 29 based upon the teachings of Golden.

Appellant's arguments (request, page 6) concerning the shortcomings in the teachings of Dudek, Albrow and Barnes in the anticipation rejections of claims 21, 27 and 29 are untimely, and should have been presented in the briefs.

Appellant's request has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

Appeal No. 2000-2134
Application No. 08/868,663

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

REHEARING
DENIED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JOSEPH L. DIXON)	
Administrative Patent Judge)	

KWH/hh

Appeal No. 2000-2134
Application No. 08/868,663

TEXAS INSTRUMENTS, INC.
P.O. BOX 655474
M/S 219
DALLAS, TX 75265