

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASHWINKUMAR C. BHATT, JOHN C. CAMP,
MARY BETH FLETCHER, KENNETH L. POTTER, and JOHN A. WELSH

Appeal No. 2005-1195
Application No. 09/906,984

ON BRIEF

Before GARRIS, TIMM, and DELMENDO, Administrative Patent Judges.
GARRIS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a request, received August 30, 2005 for rehearing of our decision, mailed July 18, 2005, wherein we sustained each of the section 102 and section 103 rejections advanced by the examiner.

Our reasons for sustaining these rejections included rebuttals to the appellants' several arguments thereagainst

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including the argument that, "[s]ince the examiner has held that the claims of the instant application are not patentably distinct from the claims of the 6,274,291 patent, and these claims have been held allowable, the claims in the instant application are allowable" (reply brief, page 1). In rebutting the aforequoted argument, we stated that "[w]hether similar claims have been allowed in U.S. Patent No. 6,274,291 is immaterial to the patentability issue before us," (decision, pages 5-6) citing In re Giolito, 530 F.2d 397, 400, 188 USPQ 645, 648 (CCPA 1976). In these respects, see the paragraph bridging pages 5 and 6 of our decision. The subject request relates only to the above quoted argument and our rebuttal thereof. In essence, it is the appellants' position in this request that we erred in determining this argument to be unpersuasive and in relying on Giolito, id. as support for this determination.

In this latter regard, the appellants attempt to distinguish their factual circumstance from that of Giolito. For example, the appellants stress that the claims of Giolito were merely similar to those in a patent to another. However, even when the involved claims are the same, it is simply immaterial in ex parte prosecution that such claims have been previously allowed. See In re Wertheim, 541 F.2d 257, 264, 191 USPQ 90, 97 (CCPA 1976).

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Moreover, it is irrelevant that the involved claims are related to the same or different inventive entities. The statutory tests for determining patentability simply do not include whether the same or similar claims have been previously allowed by the Patent and Trademark Office.

Concerning this point, it is appropriate to here emphasize that the claims of U.S. Patent No. 6,274,291 were allowed based on prior art which did not include the NA '433 reference or the 1964 IBM Technical Disclosure Bulletin applied by the examiner in the present appeal. Thus, the prior art evidence which forestalls patentability of the appellants' claims differs from the prior art evidence cited in the aforementioned patent. For this reason, a denial of patentability in the former is not inconsistent with a grant of patentability in the latter as the appellants seem to presume.

Finally, it is significant that the appellants have cited no authority in support of the argument under consideration in their brief or their reply brief or the instant request for rehearing. This is not surprising since the argument is based on an illogical premise, namely, that claims are patentable merely because they are not patentably distinct from previously allowed claims. For example, this premise would lead to the illogical

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allowance of claims which are so broad as to be not patentably distinct from narrow patent claims even when the broad claims encompass prior art subject matter avoided by the narrow patent claims.

For the above stated reasons, we continue to regard the argument in question as unpersuasive.

The request for rehearing is denied.

REHEARING - DENIED

Bradley R. Garris)	
Administrative Patent Judge)	
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)	
Catherine Timm)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Romulo H. Delmendo)	
Administrative Patent Judge)	

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