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CHITTARANJAN N. NIRMEL
P.O. Box 251
Hancock, MD 21750

EXAMINER
CUOMO, PETER M

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.
STATEMENT OF THE CASE

Appellant filed a request for rehearing under 37 C.F.R. § 41.52, dated May 24, 2017, of our Decision mailed March 24, 2017. In the Decision, we affirmed the Examiner’s rejection of claims 1, 3–5, 10, and 11 and reversed the Examiner’s rejection of claims 9 and 18. Decision 11. Appellant seeks rehearing as to the portion of the Decision rejecting claims 1, 3–5, 10, and 11. Req. 2.
DISCUSSION

A request for rehearing is limited to matters overlooked or misapprehended by the Panel in rendering the original decision. See 37 C.F.R. § 41.52; see also Ex parte Quist, 95 USPQ2d 1140, 1141 (BPAI 2010) (precedential) (quoting Manual of Patent Examining Procedure (MPEP) § 1214.03). It may not rehash arguments originally made in the Brief, neither is it an opportunity to merely express disagreement with a decision. It may not raise new arguments or present new evidence except as permitted by paragraphs (a)(2) through (a)(4). See 37 C.F.R. § 41.52. The proper course for an Appellant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reargue issues that have already been decided. See 35 U.S.C. §§ 141, 145.

Issue A

Appellant argues that the “means for engaging the sheet” of claim 1 has not been correctly construed under 35 U.S.C. § 112, paragraph 6. Req. 4. We do not consider this argument as it is raised for the first time in the Request for Rehearing, is not based on a recent relevant decision of the Board or a Federal Court, and is not responding to either a designated or undesignated new ground of rejection in the Board’s decision. 37 C.F.R. § 41.52.

Appellant also argues for the first time on rehearing that “[t]o modify the teaching of Hill et al. and Hall in light of Katzman’s tape pieces would require a major modification of Katzman’s structure and mode of operation” thereby rendering it unsatisfactory for its intended purpose. Req. 7. This

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1 As identified in Appellant’s Request for Rehearing.
argument is also not based on a recent relevant decision of the Board or a Federal Court, and is not responding to either a designated or undesignated new ground of rejection in the Board’s decision. Accordingly, we do not consider this argument.

**Issue B**

Appellant argues that “[t]he Board has misapprehended the requirement for a clear showing of motivation to combine references as is required by current law to support rejections under 35 USC 103.” Req. 8.

The Supreme Court instructs us that in “rejections on obviousness grounds . . . there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). At the same time, the Supreme Court rejected the “rigid approach” (*id.* at 415), applying “a ‘teaching, suggestion, or motivation’ (TSM) test, under which a patent claim is only proved obvious if the prior art, the problem’s nature, or the knowledge of a person having ordinary skill in the art reveals some motivation or suggestion to combine the prior art teachings” (*id.* at 407). Appellant’s argument fails to show that we misapprehended these or any other requirements under 35 U.S.C. § 103.

Appellant further argues that, “[t]he outstanding rejections are based on a superficial analysis of only the tape pieces, without consideration of the invention as a whole, and without adequate regard for the disclosure per 35 USC 112(6).” *Id.* at 10. Appellant’s mere assertion that the analysis is superficial fails to identify why the analysis is incorrect, or why it does not
apply to the claims, or what the Board overlooked or misapprehended concerning Appellant’s prior arguments.

**Issue C**

Appellant argues that “[t]he Board has overlooked explicit limitations in Claims 10 and 11 and so has improperly rejected them as obvious under 35 USC 103(a) (pre-AIA).” Req. 12. In particular, Appellant argues that the Board’s focus on the claimed “recognizable color” and “distinctive pattern” misses the real issue. *Id.* at 14 (“Everything has some kind of color, and almost anything can be considered a pattern. That is not in issue here.”). Appellant explains: “What matters is that Swagger’s invention would not serve its purpose if his frame members 14 were removed - as would have to be done if its teaching were to be modified to arrive at the invention per Claims 10 and 11.” *Id.*

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). Appellant does not identify any errors in the Board’s focus on the language of the claims or how our analysis “misses the real issue.”\(^2\)

\(^2\)Appellant appears to have misunderstood the rejection. The Examiner relies on Swagger to support the determination that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to include *in the ground cover of Hill* at least one of an easily remembered and recognizable color and a distinctive pattern and a promotional visual display as taught by Swagger for the purpose of advertising.” Final Act. 7 (emphasis added). The Examiner is modifying Hill’s *ground cover* to include a color, pattern, and promotional visual display; but does not suggest including Swagger’s frame.
Accordingly, Appellant’s arguments are not persuasive of error in the rejection or misunderstanding in our decision affirming the rejection.

DECISION AND ORDER

We grant the Request to the extent that we have considered the arguments pertaining to matters allegedly overlooked or misapprehended, but otherwise deny the Request.

DENIED