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WOOD, PHILLIPS, KATZ, CLARK & MORTIMER 500 W. MADISON STREET SUITE 1130 CHICAGO, IL 60661			LUONG, PETER	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* NELSON E. GENCHEFF

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Appeal 2017-011544  
Application 14/531,482  
Technology Center 3700

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Before ERIC B. GRIMES, TAWEN CHANG, and TIMOTHY G. MAJORS,  
*Administrative Patent Judges.*

CHANG, *Administrative Patent Judge.*

DECISION ON REQUEST FOR REHEARING

Appellant requests rehearing of the decision entered March 27, 2019 (“Decision”) that affirmed the Examiner’s rejections of claims 14–19 as indefinite and claims 14–16 as being in improper dependent form.

Appellant argues that claim 14 “is not *per se* in improper [dependent] form by reason of extracting a structure specifically set forth in method claim 1 and using the form at issue to abbreviate the claim.” (Rehearing Req. 1.) Appellant argues that claim 14 “is inherently broader than claim 1,” which “recites the use of components in addition to the guide assembly structure,” and thus “is on its face not in dependent form.” (*Id.* at 1–2.) Appellant argues that “[t]he fact that the structure in claim 1 is usable in a method parallels functional language and description of environmental

interaction routinely appearing in straightforward apparatus claims.” (*Id.* at 2.)

Appellant states that their argument that the improper dependency rejection would not apply “if claim 14 were rewritten to recite each of the limitations of claim 1 relating to the apparatus” was “not made to suggest that the claim could be substantively rewritten and changed in scope to be definite.” (*Id.*)

With respect to the indefiniteness rejection, Appellant additionally argues that

[t]he method of claim 1, as referenced in claim 14, is significant from the standpoint that the guide assembly must be extendible into a human body vessel. . . . [T]here is nothing unclear or indefinite about the structure, which is supported by the fact that the Examiner was able to make a prior art rejection. No additional limitations are brought in by the method steps that would render the scope of the claim indefinite.

(*Id.*)

We are not persuaded. Appellant’s arguments were addressed in our Decision.<sup>1</sup> (Dec. 4, 5–7.) They do not “state with particularity the points

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<sup>1</sup> Our Decision did not explicitly address Appellant’s argument that the definiteness of the claims is supported by the fact that the Examiner was able to make a prior art rejection. (Rehearing Req. 2.) Appellant did not make this argument in the Appeal Brief or the Reply Brief. As noted in 37 C.F.R. § 41.52, “[a]rguments not raised, and Evidence not previously relied upon, pursuant to §§ 41.37, 41.41, or 41.47 are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) through (a)(4) of this section.” Those exceptions do not apply in this case, so the new argument is not permitted. In any event, we note that the existence of prior art rejections does not indicate that the claims are not indefinite, for instance where a claim is amenable to multiple interpretations but is anticipated or obvious even under the narrowest interpretation.

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believed to have been misapprehended or overlooked by the Board,” as required by 37 C.F.R. § 41.52. The essence of Appellant’s arguments is that Appellant disagrees with our interpretation of the claims and/or 35 U.S.C. § 112 and with the conclusions that we reached based on the evidence of record. That is not a proper basis for a Request for Rehearing. For an applicant dissatisfied with the outcome of a Board decision, the proper course of action is to appeal, not to file a Request for Rehearing to re-argue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

Appellant’s Request for Rehearing does not point to any evidence of record, or any legal authority, that we overlooked or misunderstood in reaching the conclusions set forth in the Decision. We therefore decline to revisit our earlier conclusions or to address the prior art rejections of claims 14–19 and 22 as requested by Appellant.

REHEARING DENIED