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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/350,181	01/07/2009	William J. Endres	62859/R177	6419
23363	7590	10/02/2019	EXAMINER	
Lewis Roca Rothgerber Christie LLP PO BOX 29001 Glendale, CA 91209-9001			SWINNEY, JENNIFER B	
			ART UNIT	PAPER NUMBER
			3724	
			NOTIFICATION DATE	DELIVERY MODE
			10/02/2019	ELECTRONIC

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte WILLIAM J. ENDRES, DOUGLAS J. WOODRUFF,
JOHN W. LOOSEMORE, and THIMMAIAH G. KUMBERA

Appeal 2018-007479
Application 12/350,181
Technology Center 3700

Before LINDA E. HORNER, DANIEL S. SONG, and
BRANDON J. WARNER, *Administrative Patent Judges*.

WARNER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

William J. Endres et al. (“Appellants”)¹ filed a Request for Rehearing under 37 C.F.R. § 41.52(a) (“Request”), dated September 6, 2019, of our Decision dated July 8, 2019 (“Decision”). In the Decision, we affirmed the Examiner’s rejections of claims 1, 13, 14, 50–58, and 61–77.

The Request is DENIED.

¹ According to Appellants, the real party in interest is Rotary Technologies Corporation. Appeal Br. 1.

OPINION

An appellant's request for rehearing is limited in scope to points, stated with particularity, believed to have been misapprehended or overlooked by the Board in rendering its original decision. *See* 37 C.F.R. § 41.52; *see also Ex parte Quist*, 95 USPQ2d 1140, 1141 (BPAI 2010) (precedential) (quoting MPEP § 1214.03). The request may not rehash arguments originally made in the Brief that have been specifically addressed by the Board, nor is it an opportunity to merely express disagreement with a decision.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) and (a)(3).² *Id.* The proper course of action for an appellant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to reiterate issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

Appellants' stated basis for seeking rehearing is an assertion that "the Board misapprehended [Appellants'] argument relating to lack of motivation to combine" the references applied in the rejection. Request 1; *see id.* at 1–3. In particular, Appellants reproduce a section of their Appeal Brief emphasizing differences in operation between Falger's arrangement (where the insert remains stationary with respect to the rest of the tool) and Briese '184's arrangement (where the insert itself rotates). *See id.* at 1–2 (quoting Appeal Br. 5). Appellants contend that such a difference in

² Paragraph (a)(2) allows for new arguments based upon a recent relevant decision of either the Board or a Federal Court upon showing of good cause, and paragraph (a)(3) allows for new arguments responding to a new ground of rejection made by the Board. 37 C.F.R. § 41.52. Neither of these exceptions applies in this case.

function indicates an absence of a reason to combine the teachings. This contention was addressed in our Decision and remains unpersuasive.

More specifically, Appellants urge that “[i]f the grooves taught by Falger were incorporated into the insert of Briese ’184, the grooves would rotate with the insert, and would not be stationary thus not allowing, or making difficult, the delivery of coolant to the inlet end of each groove, and the passing of the coolant through each of the grooves for cooling purposes.” Request 2. But, as we stated in the Decision, this urging “is premised on bodily incorporation of the entirety of Falger’s cutting insert into the tool assembly of Briese ’184, which is neither the standard for an obviousness determination, nor an accurate characterization of the rejection presented.” Decision 5 (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)).

Appellants “argued in the Appeal Brief that one skilled in the art would not be motivated to include grooves of Falger that must be stationary for receiving and transferring coolant for cooling purposes in the insert of Briese ’184 in which the grooves would have to rotate.” Request 3. Here, again, we pointed out that “the Examiner’s rejection applied the relevant teaching from Falger—namely, providing the inner central axial opening surface with a plurality of circumferentially spaced apart peaks and valleys—to the inner surface of the central axial opening in Briese ’184 to yield the structure claimed.” Decision 5 (citing Final Act. 6). In other words, the rejection did not incorporate any details from Falger’s central coolant source (which Appellants urge would only be effective with a stationary cutter), but instead “simply incorporate[ed] the scalloped arrangement of the inner surface of the central opening in Falger’s insert to

the inner surface of the central bushing opening in Briese '184's insert to enhance cooling.” Decision 5–6 (citing Ans. 13).

Appellants assert that “the Examiner did not provide any evidence that showed that rotating grooves would be able to receive sufficient coolant and *allow coolant to flow there through the same way as* stationary grooves are able to receive coolant and allow the coolant to flow through such grooves for cooling.” Request 3 (emphasis added). However, the Examiner’s rejection did not involve incorporating the central coolant *source* from Falger, such that whether the structure of the modified insert would necessarily receive sufficient coolant in “the same way” is not critical to the rejection presented.

As we stated in the Decision, the Examiner explained that “one of ordinary skill in the art would have recognized a benefit in providing cooling channels (the scalloped arrangement defined by the plurality of circumferentially spaced apart peaks and valleys) that would be ‘applicable to both a stationary cutting tool (as disclosed by Falger, in which the insert is stationary and the cutting body of the tool is in rotation) and a rotary cutting tool (as taught by Briese [’184], in which the cutting insert is rotating).” Decision 5 (quoting Ans. 13). For example, it cannot be reasonably disputed by one of skill in the art that adding the structure of Falger’s grooves to the insert of Briese '184 (to create a scalloped arrangement) would increase the amount of surface area of the insert’s central axial opening, which would ordinarily be exposed to some cooling fluid during use (e.g., even ambient air or a cooling spray commonly applied while cutting). Whether such cooling fluid is specifically a liquid supplied to stationary grooves, as in Falger, does not change this fundamental characteristic, which would

provide some benefit to the structure of Briese '184's insert as the Examiner stated.³ Accordingly, the Examiner's reasoning is sufficient to combine the prior art teachings applied in the rejection.

For the above reasons, Appellants' Request does not persuade us that we misapprehended the argument relative to an asserted lack of motivation to combine the teachings from Briese '184 and Falger. Appellants do not identify any other point as allegedly being misapprehended or overlooked by the Board. As noted *supra*, a request for rehearing is not the proper forum for requesting reconsideration.

DECISION

We have considered the arguments pertaining to points allegedly misapprehended or overlooked with respect to our affirmance of the rejection of claims 1, 13, 14, 50–58, and 61–77, and we deny the Request to make any modification to the Decision. The Examiner's rejections remain affirmed.

³ We note that Appellants' claims recite, in relevant part, the structural detail of the insert body's inner surface having a scalloped arrangement defined by a plurality of circumferentially spaced apart peaks and valleys, without reciting any necessary function provided by such arrangement (e.g., cooling if the resulting spaces are open, or insulating if they are closed), or reciting further structure that might constrain any such function; thus, any particular function to the scalloped arrangement is beyond the scope of the claims. As explained herein, the Examiner has set forth adequate reasoning to combine the prior art teachings relied upon to yield the structure of a scalloped arrangement of the inner surface as recited.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED