

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TIMOTHY D. DURANCE, JUN FU, and
PARASTOO YAGHMAEE

Appeal 2016-007246
Application 12/682,989
Technology Center 3700

Before LYNNE H. BROWNE, ERIC C. JESCHKE, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

BROWNE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Timothy D. Durance et al. (Appellants) filed a request for rehearing under 37 C.F.R. § 41.52 (hereinafter “Request”), dated October 24, 2016, of our Decision mailed August 23, 2016 (hereinafter “Decision”). In the Decision, we affirmed the Examiner’s rejection of claims 1–13, 16–20, 21–23, and 26–35 and reversed the Examiner’s rejection of claims 14, 15, 24, 25, 36, and 37. Decision 7. Appellants seek rehearing as to the portion of the Decision rejecting claims 1–13, 16–20, 21–23, and 26–35. Request 1.

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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 It may not rehash arguments originally made in the Brief, neither is it an opportunity to merely express disagreement with a decision.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.

Appellants assert that “[t]he Board’s decision misapprehends the requirements for a claim element to be shown inherently in the prior art.” Request 2. However, neither the rejection at issue nor our Decision rely on the doctrine of inherency. Final Act. 3–6; Decision 4. Rather, Appellants raised the issue of inherency by admitting that “tumbling would be dependent on speed of rotation as well as the adherence of the contents to the inner surface of the container.” Appeal Br. 11. We noted Appellants’ admission as it supports the Examiner’s determination that tumbling of the material would have been obvious. *See* Final Act. 6. As the doctrine of inherency was not invoked in the Examiner’s rejection or relied upon in our Decision, we cannot have misapprehended the requirements of the doctrine.

Appellants further assert that we ignored Appellants’ argument in the Reply Brief that “the structure resulting from the Examiner’s combination of Wefers and Burger would be different than the structure shown and claimed

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in the present application.” Request 3. However, as we noted in the Decision, without a showing of good cause, we do not consider new arguments raised in the Reply Brief which are not responsive to an argument raised in the Answer. Decision 6 (citing 37 C.F.R. § 41.41(b)(2)). Appellants did not provide such a showing or indicate where a new argument requiring such response was raised in the Answer. Accordingly, we did not consider this new argument. We cannot have ignored that which we did not consider.

In addition, Appellants assert that we ignored Appellants’ argument that “the contents of a rotating container will only tumble, even at an appropriate speed, if the contents are loosely packed within the container such that there is sufficient space to permit tumbling.” Request 4 (citing Reply Br. 3). Appellants contend that this argument was raised in response to

the Examiner’s assertion in the Answer at pages 17–18 that “[s]ince there is no structural difference between the claimed means for rotating the container inside the vacuum chamber and means for rotating the container inside the vacuum chamber of Burger, therefore, the rotating means of Burger will perform the claimed function of tumbling the organic material in the container.”

Id. at 5 (quoting Answer 17–18). We do not understand the Examiner’s further explanation on pages 17–18 of the Answer, quoted *supra*, to constitute a new argument raised for the first time in the Answer, as the rejection set forth in the Final Action equates Burger’s means for rotating with the claimed means for rotating. *See* Final Act. 5–6. However, in the interest of fairness, we consider this argument *infra*.

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Appellants assert that “the contents of a rotating container will only tumble, even at an appropriate speed, if the contents are loosely packed within the container such that there is sufficient space to permit tumbling.” Request 4 (citing Reply Br. 3). In support of this assertion, Appellants contend that

It would be natural for a user of the Examiner’s proposed combination to fully fill the containers to maximize the amount of material moved in each container. In any event, it is beyond dispute that a user could use the Examiner’s proposed Burger and Wefers combination with completely filled containers, which would preclude tumbling.

Id. Based on this contention, Appellants conclude that “use of partially filled containers that would permit tumbling of material within the containers are not a necessary characteristic of the proposed Burger-Wefers combination.” *Id.* Appellants present essentially the same argument with respect to method claims 16, 34, and 35. *Id.* at 5.

However, Appellants provide no evidence or persuasive argument in support of their contention that it would be “natural for a user of the Examiner’s proposed combination to fully fill the containers.” *Id.* Rather, one skilled in the art (or for that matter anyone knowledgeable regarding the operation of a clothes dryer) would understand that fully filling the container would prevent the contents from tumbling. Thus, it would have been natural for one skilled in the art to leave enough room to allow tumbling. Moreover, when the rejection is based on obviousness, there is no requirement that particular features (in this case, unclaimed features) necessarily be present. This is true for both system and method claims.

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Accordingly, these arguments are not persuasive of error in the rejection or 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