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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD GOLDEN

Appeal 2010-001401
Application 11/095,355
Technology Center 3700

Before JENNIFER D. BAHR, EDWARD A. BROWN¹ and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

HOELTER, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ Judge Brown has been substituted for Judge Silverberg who is no longer a member of the Board.

STATEMENT OF THE CASE

Appellant has filed a Request for Rehearing (hereafter “Req. Reh’g.”) under 37 C.F.R. § 41.52 of the Decision on Appeal (“Decision”) regarding the rejection of claims 1-5, 8 and 9 under 35 U.S.C. § 102(b).

We do not modify our opinion.

THE REQUEST FOR REHEARING

Appellant seeks rehearing of that part of the Decision affirming the rejection of claims 1-5, 8 and 9 as being anticipated by Nation (Req. Reh’g. 1). Appellant seeks reconsideration based on the contention that the Board is in error “that the device in Nation is not in fact the structural equal to the recitations of claim 1...and further that the device in Nation is, in any event, capable of removing a tooth or root tip” (Req. Reh’g. 2). We address Appellant’s contention below.

ANALYSIS

A request for rehearing must state with particularity the points believed to have been misapprehended or overlooked. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the briefs are not permitted in the request for rehearing. 37 C.F.R. § 41.52(a)(1). A request for rehearing is not an opportunity to express disagreement with a decision. The proper course for an applicant dissatisfied with a Board decision is to seek judicial review, not to file a request for rehearing to re-argue issues that have already been decided. *See* 35 U.S.C. §§ 141, 145.

Appellant argues claims 1-5, 8 and 9 as a group “referencing in particular claim 1 as being representative of the group” (Req. Reh’g. 1).

All of Appellant's arguments are directed to claim 1 which we address below.

Appellant initially contends that the Board's Decision is in error because "no suggestion or inference is provided that the design in Nation be modified for any other application" other than to "grip cylindrical or hexagonal objects of different sizes" (Req. Reh'g. 2). Appellant's contention addresses the "functional and/or applicational aspects" of Nation, not its structure (Req. Reh'g. 2, see also 3-4). It has long been settled that claims directed to an article or apparatus must be distinguished from the prior art in terms of structure rather than function (see *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997)). *Schreiber*, cited in the Examiner's Answer and referenced by the Board in the Decision, also provides instruction that a "reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims" (Ans. 5; Decision 4-5; *Schreiber* 128 F.3d at 1478). The Examiner found that "Nation teaches all the structural limitations of the claim" and the Board sustained this finding (Ans. 7, see also 4; Decision 4-5). No structural modification of Nation was undertaken to reach this result. Accordingly, Appellant's contention is not persuasive.

Appellant also "submits that the Board has respectively misapprehended both the distinguishing aspects of the pointed jaw and pad support recited" (Req. Reh'g. 2). More specifically, Appellant contends that "the upturned nose 9 of lower jaw 5 is not an arcuate and pointed jaw

exhibiting a substantially pointed end” and that the upper jaw 6 in Nation “is not positioned opposite the surfaces of the pointed jaw” (Req. Reh’g. 3).

Addressing Appellant's contention regarding the pointed jaw and upturned nose 9 first, the Board’s Decision indicated that the “Examiner does not generally reference or state that Nation’s nose 9 is pointed,” instead the Board’s Decision reiterated the Examiner’s reliance on Nation’s outermost serration as “exhibiting a substantially pointed end” (Decision 5). The Board’s Decision stated that “Appellant does not address the Examiner’s reference to Nation’s serrated end” and as such, “Appellant’s rebuttal to a position not taken by the Examiner is not persuasive” (Decision 5). In the present Request for Rehearing, Appellant continues to address upturned nose 9, which was not relied on by the Examiner, and Appellant continues to fail to address the outermost serration which the Examiner did rely on. Accordingly, Appellant’s contentions directed to nose 9 are not persuasive and Appellant has not shown how the Board’s Decision misapprehended the distinguishing aspect of the pointed jaw as asserted.

Addressing now Appellant’s contention that the upper jaw 6 of Nation “is not positioned opposite the surfaces of the pointed jaw” (Req. Reh’g. 3), we note that Appellant does not provide a definition of “opposite” in the Specification. As such, this term is provided its ordinary and customary meaning consistent with its use in the Specification and by the Examiner (*DSW, Inc. v. Shoe Pavilion, Inc.*, 537 F.3d 1342, 1347 (Fed. Cir. 2008) (“[A]bsent contravening evidence from the specification or prosecution history, plain and unambiguous claim language controls the construction analysis”). The Board’s Decision addresses the opposite location of the pad support with respect to the arcuate jaw and further notes that Nation’s Figure

2 illustrates support 12 arrayed opposite the pointed jaw (Decision 4). In view of the above, Appellant has not indicated how Nation's support is not opposite the pointed jaw as claimed. Accordingly, Appellant has not shown how the Board's Decision misapprehended the distinguishing aspect of the oppositely located support.

Appellant also contends that error occurred because "the dental pliers design recited in claim 1 and depicted in Fig. 2 would be completely unsuitable and, in any event, wholly ineffective in gripping and rotating a cylindrical or hex shaped pipe" (Req. Reh'g. 3). Appellant does not indicate where this argument was previously set forth in the briefs; nevertheless, we will address it. Appellant confuses the issue here; the issue to be addressed is whether Nation's device is "capable of removing teeth from a patient's gum line and bone" as claimed (see Ans. 4), not whether Appellant's dental pliers can function as a pipe wrench. Accordingly, this contention is not persuasive.

Appellant recommends that the Board consider "a more detailed and sophisticated explanation of the structure and operation of the dental pliers" which is presently available on Applicant's website (Req. Reh'g. 4). However, any arguments or information on this website which is duplicative of that in Appellant's briefs has already been considered while any arguments or information on this website not already raised in Appellant's briefs are not to be considered without a showing of good cause (37 C.F.R. § 41.52(a)(1)). As no showing of good cause has been presented, we do not address this website.

Appellant also contends that Nation's wrench is not "an acceptable structural substitute [for Appellant's dental pliers] to be employed in the

Appeal 2010-001401
Application 11/095,355

removal of a tooth or root tip” (Req. Reh’g. 4-5). Without addressing whether this argument was previously raised in the briefs or not, it is sufficient to note that the Board’s Decision did not address the substitution of Nation’s wrench for Appellant’s pliers. Instead the Board’s Decision sustained the Examiner’s rejection that Appellant’s claims, as currently proposed, are anticipated by Nation. We further note that Appellant, in this contention, does not identify any particularities that are believed to have been misapprehended or overlooked by the Board. Accordingly, this contention is not persuasive.

Based on the record presented, Appellant’s Request has not persuaded us that the Board erred in sustaining the anticipation rejection of claims 1-5, 8 and 9 in view of Nation.

ORDER

Upon consideration of Appellants’ request for rehearing and for reasons given, it is ordered that the decision affirming the rejection of claims 1-5, 8 and 9 under 35 U.S.C. § 102(b) as being anticipated by Nation shall not be modified.

REHEARING DENIED

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