

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 35

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte YVONICK CHEVALLIER

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Appeal No. 94-0869  
Application No. 07/517,719<sup>1</sup>

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HEARD: August 7, 1996

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Before KIMLIN, PAK and WARREN, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant requests reconsideration of our decision of October 31, 1996, wherein we affirmed the examiner's rejection of claims 1-18 and 27 under 35 U.S.C. § 103 as being unpatentable over Winyall in view of Biegler.

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<sup>1</sup> Application for patent filed May 2, 1990.

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Appellant initially requests that we designate our discussion at page 5 of the decision regarding the unpatentability of the claimed invention over Biegler alone a new ground of rejection in accordance with 37 CFR § 1.196(b). However, we decline to do so inasmuch as we sustained the examiner's rejection of the appealed claims under § 103 over the combined teachings of Winyall and Biegler. Our amplified reasons supporting our affirmance of the examiner's rejection does not differ in substance from the "evidentiary scheme" presented by the examiner and, therefore, does not constitute a new ground of rejection. In re Boon, 439 F.2d 724, 727, 169 USPQ 231, 234 (CCPA 1971). See also In re Kronig, 539 F.2d 1300, 1303, 190 USPQ 425, 426-27 (CCPA 1976). Also, see In re Halley, 296 F.2d 774, 778, 132 USPQ 16, 20 (CCPA 1961), wherein the court held that it is not a new ground of rejection to sustain an examiner's rejection based on a combination of references in view of the disclosure of only one of the cited references.

Appellant also offers a response to language at page 4 of our decision, which reads "appellant's specification fails to set forth any reasonably specific definition of the language

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'substantially spherical,' and does not provide any electron photomicrographs of the claimed silica particles that would serve as a basis for comparing their morphology with the silica particles of Winyall." Appellant points out that the present specification states that "EP 18,866, assigned to the assignee hereof, proposed certain homogeneous silica spheres having a mean particle size greater than 80 Fm, a BET surface area of 100 to 300 m<sup>2</sup>/g and a density of approximately 0.29." In addition, appellant notes that a U.S. patent to Garvey discloses egg-shaped particles shown in Figures 2-3 as being "spheroidal." However, since this argument was not presented in appellant's principal or reply briefs, it is not properly before us. Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971). See also 37 CFR § 1.192(a). Furthermore, appellant has not established the requisite nexus between the claimed "[s]ilica beads having a substantially spherical morphology" and the silica particles of EP 18,866 and Garvey.

The arguments presented at pages 3-5 of appellant's Request, with respect to page 5, lines 3-10 of our decision, are also presented for the first time and, therefore, not properly before us. In addition, we fail to see how a

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comparison to the silica particles of EP 18,866 is relevant to a comparison to the silica particles of Winyall and Biegler, the cited prior art.

In conclusion, appellant's request is denied with respect to making any change in our decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

RECON - DENIED

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	
CHUNG K. PAK	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CHARLES F. WARREN	)	
Administrative Patent Judge	)	

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