

**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(2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CREG W. DANCE  
and STEVEN L. OLSON

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Appeal No. 96-0570  
Application 08/101,989

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REHEARING

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Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

**ON REQUEST FOR REHEARING**

This case comes before us again on request for rehearing of our decision of February 12, 1998, wherein we affirmed-in-part the examiner's decision and added a new ground of rejection. Five points were raised by the appellants. In

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each case, we have considered the arguments presented, but we have not been persuaded that the positions we have taken were in error.

*The Rejections Under Section 112*

1. Claim 10. The problem with this claim was that it added to the basic method "additional interventional therapeutic procedures," which we agreed with the examiner had not been adequately defined in the specification. The appropriate time to present arguments in opposition to the examiner's rejections is in the appeal brief, and arguments not presented at that time will be refused consideration, unless good cause is shown (37 CFR § 1.192(a)). The appellants chose not to respond to this rejection at that time. Inasmuch as no showing of good cause for this failure to act has been made, we will not consider the arguments now presented for the first time.

2. Claim 15. We stand by the comments we made on page 5 of our decision.

3. Claim 17. The appellants' offer to correct this problem by way of amendment does not cause us to alter our position

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with regard to the propriety of the rejection of the claim as it presently stands.

*The Rejection Under Section 102*

The arguments raised by the appellants in the Request for Rehearing are essentially the same as those presented in the Brief. We have considered them in detail. However, we see no need to further explain or alter the position we expressed on pages 6-8 of our decision.

*The Rejection Under Section 103*

We stand by the explanation we presented on pages 9 and 10 of our decision, in which we treated the issues which the appellants have raised in the Request for Rehearing. With regard to the argument that we have taken liberties in our interpretation of the phrase "a fixed dimension infusion zone," we point out that if the limitations in the specification were required to be read into the claims there would be no need for claims and no basis for the requirement of 35 U.S.C. § 112 that the specification conclude with claims

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particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention. See *Sjolund v. Musland*, 847 F.2d 1573, 1581, 6 USPQ2d 2020, 2027 (Fed. Cir. 1988). Since the infusion zone clearly has a length and a diameter, it is incumbent upon the appellants to particularly point out which of the two dimensions is limited by the claim.

**SUMMARY**

The Request for Rehearing is granted to the extent that we have reviewed our decision in the light of the arguments set forth in the request, but it is denied insofar as altering our decision is concerned.

**DENIED**

	Neal E. Abrams	)	
	Administrative Patent Judge	)	
		)	
		)	
	Lawrence J. Staab	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND

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Jeffrey V. Nase )  
Administrative Patent Judge ) INTERFERENCES  
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