

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(2) is not binding precedent of the Board.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

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte

Appeal No.
Application No.

ON BRIEF

Before KRASS, and, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

On Request for Re-hearing

Appellants request re-hearing of our decision of March 13, 2001, in which we affirmed the rejection of claims 7-11, 14-17 and 20 under 35 U.S.C. § 102 as being anticipated by the admitted prior art and affirmed the rejection of claims 14, 18 and 21 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art.

Appellant's request fails to show any points raised by them on appeal which were misapprehended or overlooked by the board in rendering its decision.

At page 3 of the request, appellants state that,

If any of claims 7-11, 14-17 and 20 were to be asserted against the prior art acknowledged in Fig. 2 of the present application, it is very clear that there would be no infringement. By the same token, such an arrangement does not anticipate the claims.

This argument is unpersuasive. The mode of claim interpretation used by courts in litigation when interpreting claims of issued patents in connection with infringement or validity determinations is not the mode of claim interpretation applicable during prosecution of a pending application. During patent examination claims must be interpreted as broadly as they reasonably allow. In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

Also at page 3 of the request, it is argued,

In addition, it is noted that lines 23-25 of page 8 of the specification point out that "substantially at the start of the wanted information area" is synonymous with "substantially at the start of the control field." This makes it very clear that bit position no. 12 in a 16-bit control field is not considered to be substantially at the start of the information area. This is not a case of reading extra limitations into the claims, but simply a proper reliance on the specification to determine the meaning of a claim term.

This position is unpersuasive because claim 17 itself defines the information area as in the form of at least one data field and at least one control field. Thus, there is no requirement that the admitted prior art disclose bit position no. 12 substantially at the start of the control field itself.

The gist of appellant's request with respect to claims 12, 18 and 21 in the paragraph bridging pages 4 and 5 is not that the Board misapprehended or overlooked any points raised by appellants on appeal

but is simply that appellants do not agree with the conclusions and ultimate decision reached by the board. Manifestly, it constitutes insufficient basis for us to change our decision.

Lastly, pages 5 and 6 of the request appellants address the examiner's position in the answer that detecting a bad frame earlier would have been obvious because it would permit better reduction of congestion. The position is taken and argument is made that the motivation given by the examiner does not make sense. This argument by appellants is entitled to no consideration. The argument should have been made in appellants' reply brief such that the examiner would have had the opportunity to rebut the position in a supplemental answer. We will not address a new argument which the examiner has had no opportunity to answer. Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971).

For the reasons given above, the request is granted only to the extent that our decision has been reconsidered but is denied with respect to making any changes in that decision.

DENIED

ERROL A. KRASS)
Administrative Patent Judge)
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