

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte D. STERLING HUBBELL

Appeal No. 2003-1067
Application No. 09/775,662

HEARD: November 5, 2003

Before KIMLIN, OWENS and WARREN, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

REQUEST FOR REHEARING

Appellant requests rehearing of our decision of December 8, 2003, wherein we affirmed the examiner's rejection of the appealed claims under 35 U.S.C. § 103.

We have thoroughly reviewed the arguments presented in appellant's request, but we find nothing therein that persuades us that our decision was in error.

Appellant maintains that we overlooked the separate arguments for claims 17, 18, 22, 27, 28 and 32. This is not so.

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We stated in our decision that "we will sustain the examiner's rejections for essentially those reasons expressed in the Answer" (page 4 of decision, first paragraph). The Examiner's Answer incorporated the rejection of Paper No. 5 wherein the examiner states that Jones' teaching of absorbent material and cellulose-based material would have rendered obvious the selection of any one of a number of well-known cellulose based absorbent materials, including the claimed butyl cellulose acetate. As for claims 17, 18, 27 and 28, it should be apparent from our decision that the particular components of the admittedly known conversion coat solution would have been an obvious choice for one of ordinary skill in the art.

We also do not subscribe to appellant's position that our decision includes a new ground of rejection because our discussion of Brockman was more expansive than the examiner's. As noted above, we affirmed the examiner's rejections for the reasons set forth by the examiner. Furthermore, it is well settled that a decision by the Board is on the merits of the examiner's rejection and not necessarily on the examiner's reasoning.

We also do not agree with appellant that "[t]he Board's decision is completely silent as to the issue of lack of

motivation raised on appeal" (page 5 of Request, last paragraph). The requisite motivation arises from, as discussed in our opinion, the recognition by one of ordinary skill in the art that conventional applicators of the type claimed are known to avoid waste of the material being applied, as well as to allow for a precise application of the material.

As for appellant pointing out that "a materials and process engineer describes appellant's applicator as 'revolutionary' when referring to advantages of using the applicator" (page 6 of Request, last paragraph), we note that the characterization as "revolutionary" speaks more to the novelty of the claimed invention rather than its obviousness under § 103. We remain of the opinion that appellant has not established that the advantages of using the claimed applicator, namely, less waste and danger to the worker compared to using sponges and rags, would have been unexpected to one of ordinary skill in the art. Consequently, based on the foregoing, appellant's request is denied with respect to making any change in our decision.

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

DENIED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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TERRY J. OWENS)	
Administrative Patent Judge)	

ECK:clm

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