

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL D. CASE
and ALAN G. STEPHENSON

Appeal No. 97-0292
Application 07/814,779¹

HEARD: December 11, 1997

Before COHEN, MEISTER and CRAWFORD, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

ON REQUEST FOR REHEARING

The appellants request we reconsider our decision mailed on December 31, 1997, wherein we affirmed the examiner's rejections of (1) claims 1, 4-6, 8, 12-23, 26 and 29-31 as

¹ Application for patent filed December 30, 1991. According to appellants, this application is a continuation of Application 07/541,861, filed June 21, 1990, now abandoned.

Appeal No. 97-0292
Application 07/814,779

being unpatent-able over Cline in view of Hampl and (2) Claims 9-11 as being unpatentable over Cline in view of Hampl and Montoya. We have carefully reconsidered our decision in light of the arguments advanced; however, we decline to alter our decision in any respect.

The appellants note that on page 6 of our decision we quoted column 2, lines 39-43, of Cline wherein it is stated that:

The magnesium oxide may be used as the **sole filler** for the paper **or** it may be used in combination with the other conventional fillers such as calcium carbonate provided at least 15% by weight of the wrapper is magnesium oxide. [Emphasis added.]

The appellants on page 3 of the request thereafter state that (1) "[t]his one statement in Cline, taken independently from the remainder of the reference, may appear to the Board to teach what the Board alleges" and (2) "if the Board actually had considered the reference **as a whole**, they would have noted in the paragraph directly after this statement . . . that Cline contradicts the Board's interpretation." In support of this position the appellants reference column 2, line 65, through column 3, line 20, of Cline wherein it is stated:

Appeal No. 97-0292
Application 07/814,779

Neither magnesium oxide nor the chemical adjuvant salts when used alone as a filler or coating in smoking article wrappers substantially reduce visible sidestream smoke. . . . The amounts of magnesium oxide and chemical adjuvant employed in the wrapper are critical and it has been found that amounts of magnesium oxide less than 15% and of chemical adjuvant salt of less than 0.5% by weight are ineffective in combination to achieve the desired reduction in visible sidestream smoke. . . . Preferably and for maximum sidestream smoke reductions, the wrapper should contain at least 35% magnesium oxide and at least 2.0% of the chemical adjuvant salt.

We must point out, however, the fact that Cline subsequently states that (1) magnesium oxide when used alone does not "substantially reduce" visible sidestream smoke and (2) "preferably" the wrapper should contain at least 35% magnesium oxide, does not "contradict" what has previously been stated in lines 39-43 of column 2 as the appellants allege. While, of course, that portion of Cline noted by the appellants indicates that magnesium oxide when used alone is ineffective or unsatisfactory and that the "preferred" embodiment is one which contains at least 35% magnesium oxide, all of the teachings of a particular reference must be evaluated for what they fairly teach one of ordinary skill in the art, including those teachings that are "phrased in terms of a *non-preferred*

Appeal No. 97-0292
Application 07/814,779

embodiment or as being **unsatisfactory for the intended purpose**" (emphasis ours). **In re Boe**, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). We also observe that what Cline considers "ineffective" vis-à-vis what the appellants consider "ineffective" is not clear.

Moreover, we did not simply rely on lines 39-43 of column 2 of Cline as the appellants imply. In our decision we also made note of the fact that in Cline:

the first line of the Abstract and column 2, lines 17-27, state that the invention is for a wrapper having "at least 15% by weight magnesium oxide in combination with at least 0.5% by weight of a specific chemical adjuvant," without making any mention whatsoever of "other convention fillers" being used. Equally significant is the fact that in independent claim 1 Cline sets forth that the wrapper contains "at least 15% magnesium oxide and at least 0.5% of a chemical adjuvant salt," without setting forth that the wrapper contains "other conventional fillers." [Page 6.]

The appellants also urge that they are the "ones" skilled in the art and imply that, as such, their interpretation of Cline should be dispositive. However, as the court stated in **In re Vamco Mach. & Tool, Inc.**, 752 F.2d 1564, 1575, 24 USPQ2d 617, 623 (Fed. Cir. 1985): "We too can read this patent and understand what it **describes**."

Appeal No. 97-0292
Application 07/814,779

The appellants also note that "there is no clear teaching in the examples of Cline utilizing 15% sole total filler or anything remotely close" (request, page 3) and contend that the "examples in Cline, however, have been wholly overlooked by the Board" (request, page 4). While it is true that there is no specific example in Cline of utilizing 15% sole total filler, a reference must be evaluated for all it teaches and is not limited to its specific examples. *In re Snow*, 471 F.2d 1400, 1403, 176 USPQ 328, 329 (CCPA 1973).

The appellants' request is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

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

DENIED

Appeal No. 97-0292
Application 07/814,779

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
JAMES M. MEISTER)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 97-0292
Application 07/814,779

Charles I. Sherman
BROWN & WILLIAMSON TOBACCO CORP., INC.
1500 Williamson Tower
Louisville, KY 40202

JMM/cam