

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KENNETH L. BERGER

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Appeal No. 1998-2066  
Application No. 08/315,629

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ON BRIEF  
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Before MCCANDLISH, Senior Administrative Patent Judge, NASE and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellant's request for rehearing<sup>1</sup> (hereinafter "request") of our decision mailed June 29, 2000 (Paper No. 40), wherein we affirmed, inter alia, the

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<sup>1</sup> Filed August 28, 2000.

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examiner's rejections of claims 1 through 4 and 8 through 20 under 35 U.S.C. § 112, second paragraph, and of claim 7 under 35 U.S.C. § 135(b). The request seeks an order (1) remanding the application to the examiner with instructions to reopen prosecution as to the § 112, second paragraph, issues; and (2) reversing the examiner's rejection of claim 7 under 35 U.S.C. § 135(b).

The appellant seeks a remand with instruction to the examiner to enter the amendment filed December 5, 1997, because of a "clear factual error" (emphasis original) by the examiner. See the request, p. 3. However, the appellant has failed to identify any error on the part of the examiner which necessitates a remand in this case.

The examiner's indication in the advisory action mailed November 7, 1997 (Paper No. 34), that the 35 U.S.C. § 112, second paragraph, rejection of claims 8, 14 and 20 had been overcome by the amendment filed with the brief on August 4, 1997, which amendment was refused entry, was an error.<sup>2</sup> However, this error was certainly not the reason for the appellant's failure to present arguments in the brief concerning the § 112, second

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<sup>2</sup> Instead, the examiner should have indicated the status of claims 8, 14 and 20, if the proposed amendments to those particular claims were filed in a separate paper. See MPEP §§ 714.13 and 1207.

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paragraph, issues, since the error occurred after the brief was filed. Nor does the error explain the appellant's failure to file a timely reply brief addressing the § 112, second paragraph, issues after having received the advisory action mailed November 7, 1997 and the examiner's answer repeating the § 112, second paragraph, rejection of claims 1 through 4 and 8 through 20.

We also note that the advisory action mailed December 18, 1997, does not state that the appellant's brief was untimely. Rather, it clearly states that "the proposed amendment filed December 5, 1997 is not timely and cannot be considered and/or entered." See Paper No. 37, p. 2.<sup>3</sup>

Under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and decisions of primary examiners to deny entry of amendments are not subject to our review. See 37 CFR § 1.127 and Manual of Patent Examining Procedure (MPEP) §§ 1002.02(c) and 1201 (7th

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<sup>3</sup> 37 CFR § 1.116(b) reads:

If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

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ed., rev. 1, Feb. 2000); In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967) and In re Deters, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975). Were we to grant the appellant's request, we would, in effect, be overruling the examiner's decision to refuse entry of the amendment filed December 5, 1997. We decline to take such action. Accordingly, the request for a remand is denied.

In our earlier decision we compared appealed claim 7, which corresponds to claim 1 of the Muller patent, to the appellant's original claims 1 through 5 and determined that the subject matter of the appellant's original claims 1 through 5 is directed to an invention that is not "substantially the same" as the invention claimed in claim 7. Specifically, we found that none of the appellant's original claims 1 through 5 contain any express language directed to "a circumferential groove having a first radial depth and a second radial depth extending further radially inwardly than said first radial depth," which based on the file history of the Muller patent we concluded is a material part of the subject matter of claim 7.

The request alleges (request, p. 9) that "Muller's claim 1 and appellant's claim 1 are for substantially the same subject matter." In support, the appellant refers to his specification and drawings and to the language "indentation means being

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positioned below said rim at a location adjacent said opening in said top" in claim 1 and "an indentation in said wall portion to accommodate the lower lip of a consumer" in claim 5.

We, of course, were aware of the language of original claims 1 and 5 at the time of our original decision. Nevertheless, the fact remains that the language of the appellant's original claims 1 and 5 does not require "a circumferential groove having a first radial depth and a second radial depth extending further radially inwardly than said first radial depth."

The appellant also refers to his original specification and drawings as providing support for the limitation. However, the issue of support for the limitation in the appellant's specification, or Muller's for that matter, is not an issue that we must decide in order to determine whether or not claim 7 is properly rejected under 35 U.S.C. § 135(b).

In conclusion, as to the requested rehearing of our underlying decision, we have carefully and fully reconsidered that decision in light of all of the commentary in the request. However, for the reasons discussed above, we are not persuaded to alter that earlier decision. Therefore, the request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

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Additionally, for the reasons given above, we have denied the appellant's request for a remand.

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

REQUEST FOR REHEARING - DENIED

Harrison E. McCandlish, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Jeffrey V. Nase	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
John F. Gonzales	)	
Administrative Patent Judge	)	

JFG:tdl

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