

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

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOUGLAS R. PETERSON

Appeal No. 1998-2516
Application 08/422,440

ON BRIEF

Before THOMAS, JERRY SMITH and BARRETT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant has filed a paper under 37 CFR § § 1.197(b) requesting that we reconsider our decision of October 27, 2000 wherein we affirmed the rejection of claims 1-3, 12, 13, 16, 17 and 20 as unpatentable under 35 U.S.C. § 103.

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Appellant points to page 7 of the original decision wherein the Board stated that "Smith suggests that the common mode problem in Jove can be solved by connecting a controllable current sink across the MR element" [Request, page 2]. Appellant essentially argues that this conclusion by the Board is unwarranted by anything stated or shown in the Smith reference. Appellant also presents an analysis of the proposed modification of Jove and asserts that the proposed modification either would not work at all or would seriously degrade the performance of the Jove amplifier [*id.*, pages 3-6].

We have reconsidered our decision of October 27, 2000 in light of appellant's comments in the request for rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior decision for the reasons which follow.

The majority of appellant's request for rehearing raises factual questions resulting from the examiner's and the Board's modification of Jove using the teachings of Smith. These factual questions are being raised for the first time in this request for rehearing and have not been considered by the

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examiner. Since appellant never raised these factual questions with the examiner, we do not have the benefit of the examiner's position on these questions of fact. A new argument advanced in a request for rehearing but not advanced in the brief or reply brief¹ is not properly before the Board because an argument advanced in such a manner has not afforded the examiner an opportunity to respond to the new argument.

Note Ex parte Hindersinn, 177 USPQ 78

(Bd. App. 1971). Consequently, we will not consider these new arguments of fact as a basis for changing our prior decision in this case.

The only question properly raised by the request for rehearing is the assertion by appellant that Smith does not support the Board's statement that Smith suggests that the common mode problem in Jove can be solved by connecting the controllable current sink across the MR element. As noted in the original decision, Smith specifically refers to the Jove patent relied on and notes the problem caused by common mode

¹ The two reply briefs filed in this case were not entered by the examiner and, consequently, were not considered by the Board.

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DC and low frequency components [Smith, column 2, line 62 to column 3, line 17]. Smith notes that the arrangement in Jove still requires coupling capacitors to connect the Jove amplifier to other amplification circuitry.

Smith describes a solution to Jove's problem caused by common mode DC and low frequency components. This solution is achieved by coupling a controllable current sink to one end of the MR element. Smith discloses that the feedback loop comprising the controllable current sink controls common mode DC and low frequency components, and effectively performs the function of a coupling capacitor [column 11, lines 15-23]. Thus, the second feedback loop of Smith functions as a replacement for the coupling capacitor alleged to be necessary in Jove while still controlling common mode DC and low frequency components.

Our inquiry in the original decision and our inquiry now only concerns the nonobviousness of the invention as broadly recited in claim 1². We still agree with the examiner that the broad modification of Jove to include a feedback loop comprised of a controllable current sink to solve the recognized problem caused by common mode DC and low frequency components would have been obvious to the artisan based on the suggestions of Smith. The arguments of appellant properly

² The rest of the appealed claims stand or fall together as a single group with claim 1.

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raised in the brief and considered in our original decision are not convincing of error in the examiner's rejection.

We have carefully considered the arguments raised by appellant in the request for rehearing, but we can find no errors in our original decision. We are still of the view that the invention set forth in claim 1 would have been obvious within the meaning of 35 U.S.C. § 103 in view of the collective teachings of Jove and Smith.

We have granted appellant's request to the extent that we have reconsidered our decision of October 27, 2000, but we deny the request 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 C.F.R. § 1.136(a).

REHEARING DENIED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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JERRY SMITH)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND

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) INTERFERENCES
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