

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD M. RENDLEMEN, HOWARD W. DeMOORE and JOHN W. BIRD

Appeal No. 1999-1348
Application No. 08/435,798

HEARD: May 9, 2001

Before McCANDLISH, Senior Administrative Patent Judge, NASE¹ and
BAHR, Administrative Patent Judges.

BAHR, Administrative Patent Judge.

DECISION ON REHEARING

This is a decision on appellants' request for rehearing under 37 CFR § 1.197 of the Board's decision mailed June 15, 2001 sustaining the examiner's rejections of claims 1-3, 5, 7,

¹ Calvert, Administrative Patent Judge, retired before this case was reached for rehearing. Legal support for substituting one Board member for another can be found in In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

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8, 10-16, 22 and 23 under 35 U.S.C. § 103 and reversing the rejections of claims 4, 17 and 20 under 35 U.S.C. § 103, claim 17 under 35 U.S.C. § 102 and claims 3, 22 and 23 under 35 U.S.C. § 112, first paragraph. Appellants seek rehearing only of our affirmance of the examiner's decision to reject claims 3 and 23 under 35 U.S.C. § 103.

Appellants' request (page 1) contends that the Board wrongly characterized the rollers of Rhorer and Goettsch as resilient anilox rollers in the earlier decision. However, appellants have failed to clearly articulate a definition of resilient anilox roller or "anilox roller having a resilient transfer surface" (the language used in claims 3 and 23) which distinguishes over the Rhorer and Goettsch rollers. The only structural feature of an "anilox" roller set forth in appellants' specification is that "[t]he surface of an anilox roller is engraved with an array of closely spaced, shallow depressions referred to as 'cells'" (page 12). From this, the Board interpreted an "anilox roller" as "an applicator roller having a surface engraved with an array of closely spaced, shallow depressions" (decision, page 4). For the reasons set forth on page 15 of the earlier decision, it is our view that

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the rollers disclosed by Rhorer and Goettsch are anilox rollers having a resilient transfer surface in accordance with this interpretation.

To the extent that appellants are attempting to define "anilox roller" on page 2 of the request, this attempt is unavailing. First, appellants provide neither a precise nor a consistent definition of "anilox roller." On page 2, in lines 7-8 of the request, appellants state that "[a]nilox rollers are well known as a term of art in the printing industry for metering rollers having the entire surface covered uniformly with fine ink holding cells." In that the rollers of Rhorer and Goettsch are covered uniformly with fine ink holding cells, they would appear to meet such a definition. On page 2, in lines 14-16 of the request, appellants urge that "Exhibits A, B and C taken from a commercial web site (pamarcotech.com) evidence generic use of the term 'anilox' to describe uniformly patterned steel or ceramic metering rollers." While there is an Exhibit C attached to appellants' request, Exhibits A and B are not attached. In any event, appellants had the opportunity to present evidence as to the definition of "anilox roller" prior to the Board's earlier

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decision and elected not to do so.² Accordingly, we decline to consider such evidence upon rehearing, especially where the evidence, as in the case of Exhibit C, does not expressly define the term at issue.³

Moreover, even if we were to combine the two statements on page 2 of appellants' request mentioned *supra*, and give "anilox roller" a narrow definition consistent with both of these statements, namely, a uniformly patterned steel or ceramic metering roller having the entire surface covered uniformly with fine ink holding cells, we must not lose sight of the fact that the terminology used in appellants' claims 3 and 23 is "anilox roller having a resilient transfer surface." Stated differently, according to appellants, the roller recited in the claims clearly differs from a conventional prior art anilox roller in that the recited roller has a resilient transfer surface. As the Rhorer and Goettsch

² 37 CFR § 1.195 provides that "[a]ffidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented."

³ At best, Exhibit C evidences that at least one anilox roller on the market includes a laser engraved ceramic outer coating over an aluminum layer. This product description is ineffective to establish that all anilox rollers have these features.

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rollers have resilient transfer surfaces, rather than hard steel or ceramic surfaces on which the cell pattern is fixed, they appear to respond structurally to the claim limitations.

The only argument offered in appellants' request as to why the Rhorer and Goettsch rollers are not resilient anilox rollers is that they are "rubber printing rollers" (request, page 1). From our perspective, the distinction argued by appellants is directed to the intended use of the roller, not to the actual structure of the roller, and thus cannot be relied upon for patentability. It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

As a final observation with regard to whether or not the Rhorer and Goettsch rollers are an "anilox roller having resilient transfer surfaces" as claimed by appellants, we note that, in response to the examiner's enablement rejection, appellants (brief, page 7) pointed to the examiner's citation of the Rhorer and Goettsch references as prior art disclosing such a roller to support the conclusion that one of ordinary skill in the art would be aware of such a roller (i.e., an

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anilox roller having a resilient transfer surface). This statement implies a concession by appellants that the Rhorer and Goettsch rollers are anilox rollers having a resilient transfer surface.

Appellants also add a new argument that, in essence, there is no suggestion or teaching or reason to modify Bird as proposed by the examiner because, if a skilled artisan were to use a roller of the type disclosed by Rhorer or Goettsch in Bird, such an artisan would replace the plate cylinder 19b and relief plate 20b, not the applicator roller 33, with such a roller (request, page 3). This argument was not presented by appellants in either their brief or reply brief. In fact, with regard to the examiner's obviousness rejection of claims 3 and 23, and the substitution of the roller of either Rhorer or Goettsch for the applicator roller 33 of Bird in particular, appellants' sole argument was a glib statement that the examiner's position was inconsistent with the rejection of claims 3 and 23 under the first paragraph of 35 U.S.C. § 112 (brief, page 10). Appellants' attempt to belatedly present such a new argument is unavailing, since a new argument advanced in a request for rehearing, but not

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advanced in appellants' brief, is not properly before the Board and will not be considered.⁴

As should be evident from our discussion above, appellants' request for rehearing has been reviewed and the request granted to the extent of our reconsidering our earlier decision in light thereof, but is denied with respect to making any changes in that decision.

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

⁴ See Schreiber, 128 F.3d at 1479, 44 USPQ2d at 1433; In re Kroekel, 803 F.2d 705, 708, 231 USPQ 640, 642-43 (Fed. Cir. 1986) and Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998).

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DENIED

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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