

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FREDERIC C. FEILER

Appeal No. 2000-0451
Application No. 08/726,088

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, COHEN,¹
and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellant's request for rehearing of our decision mailed March 29, 2001, wherein (among other determinations) we affirmed the examiner's rejection of claims

¹ Judge Cohen has been substituted on the merits panel of the present application in place of Judge Lazarus, who has retired. See, In re Bose Corp., 772 F.2d 866, 869, 227 USPQ 1, 4 (Fed. Cir. 1985).

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1, 3 and 6 through 10 under 35 U.S.C. § 102(b) as being anticipated by Noiles (U.S. Patent No. 4,978,356).

We have carefully reviewed the points of argument raised by appellant in the request, however, we note that instead of directing the request for rehearing to points which were misapprehended or overlooked in rendering the decision on appeal as is mandated by 37 CFR § 1.197(b), appellant has essentially made new grounds of argument (regarding dependent claim 8) which were not previously presented in the brief on appeal.

While appellant recognizes that no separate argument was presented in the brief (Paper No. 11) or in the reply brief (Paper No. 13) concerning the examiner's rejection of dependent claim 8 under 35 U.S.C. § 102(b) as being anticipated by Noiles, appellant now urges that claim 8 deserves substantive consideration and characterizes this Board's determination that dependent claims 7 and 8 (particularly claim 8) should fall with independent parent

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claim 6 as being "a specious basis for upholding an otherwise defective rejection" (request, page 2).

37 CFR §§ 1.192(c)(7) and 1.192(c)(8)(iii) clearly place the burden on appellant to state in the brief that the claims of a given group subject to a particular ground of rejection "do not stand or fall together" and also to present arguments for the separate patentability of each of the claims to be contested, and, with regard to a rejection based on 35 U.S.C. § 102, requires appellant to specify the error in the rejection and to set forth why a particular claim or group of claims is patentable, including any specific limitations in the rejected claim or claims which are not present in the prior art relied upon in the rejection. If, as in the present case, appellant has not complied with the above dictates of 37 CFR § 1.192, then the regulation provides that the Board "shall select a single claim from the group and shall decide the appeal as to the ground of rejection on the basis of that claim alone." As was made clear in the paragraph bridging pages 12 and 13 of our decision mailed March 29, 2001, this is essentially what transpired with regard to appellant's

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dependent claims 7 and 8 on appeal rejected under 35 U.S.C. § 102(b) over the Noiles patent. Finding no argument from appellant as to the separate patentability of dependent claims 7 and 8, and no indication of any particular limitation in those claims which appellant believed not to be present in the prior art Noiles patent, we concluded that those claims would fall with independent claim 6 from which they depend, the rejection of which we had already sustained.

As for appellant's implication that our treatment of dependent claim 8 was somehow incomplete or improper, we do not agree. It has been a longstanding precept in patent law that where an applicant argues a ground of rejection with regard to less than all of the claims to which it applies, the unargued claims are treated as standing or falling with the claims which were argued. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983); and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

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Appellant's attempt to belatedly present new arguments directed to the examiner's rejection of claim 8 under 35 U.S.C. 102(b) as being anticipated by Noiles is unavailing, since a new argument advanced in a request for rehearing, but not advanced in appellant's brief, is not properly before the Board and will not be considered. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) and Ex parte Harvey, 163 USPQ 572, 573 (Bd. App. 1968) (Question not presented to Board in appeal and not discussed by examiner is not appropriate for decision by Board on petition for reconsideration). Note also In re Kroekel, 803 F.2d 705, 708, 231 USPQ 640, 642 (Fed. Cir. 1986) and Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir. 1998) wherein the Court noted that a party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.

Regarding appellant's assertion (request, page 2) that the limitation in claim 8 "is the same limitation on which the Board patentably distinguished claim 4 from Moch," we suggest that appellant might wish to read claims 4 and 8 again, since

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the limitations in these two claims are clearly not the same. The limitations of claim 4 are much more precise as to the curvature of the superior neck of the femoral stem and the planes involved, than the broader recitation in claim 8.

In light of the foregoing, appellant's request is granted to the extent of reconsidering our decision, but is denied with respect to making any changes therein.

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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).

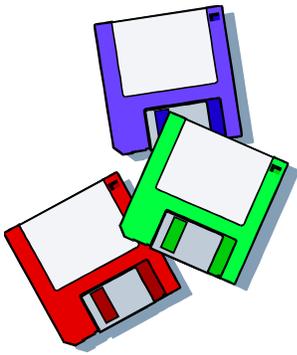
REHEARING DENIED

HARRISON E. MCCANDLISH)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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APJ FRANKFORT

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DECISION: REHEARING DENIED

Prepared: August 20, 2002

Draft Final

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PALM / ACTS 2 / BOOK

DISK (FOIA) / REPORT