

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL SMIT et al.

Appeal No. 1999-2034
Application No. 08/718,573

ON BRIEF

Before CALVERT, FRANKFORT¹, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to the appellants' request for rehearing² of our decision mailed August 16, 1999, wherein we affirmed the examiner's rejection of claims 36 to 41 under 35 U.S.C. § 103.

We have carefully considered the arguments raised by the appellants in their request for rehearing, however, those

arguments do not persuade us that our decision was in error in any respect.

The first issue (pp. 1-2) raised by the appellants is that the Board's affirmance of the rejection of claims 36 to 41 under 35 U.S.C. § 103 relied upon an entirely new interpretation of the "positioning said nozzle a distance above said bed" step of claim 36, and therefore should have been made as a new ground of rejection pursuant to 37 CFR § 1.196(b).

In our view, our affirmance of the rejection of claim 36 under 35 U.S.C. § 103 did not rely upon an entirely new interpretation of the "positioning said nozzle a distance above said bed" step. In that regard, our interpretation of the "positioning said nozzle a distance above said bed" step of claim 36 set forth on pages 7-8 of our August 16, 1999 decision is consistent with the examiner's interpretation of this step as set forth in the first paragraph of the response to argument section of the answer (p. 5). Thus, designating our affirmance of claim

The second issue (pp. 2-3) raised by the appellants is that the Board's construction of the "positioning said nozzle a distance above said bed" step of claim 36 is unreasonably broad. We do not agree.

In proceedings before it, the United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

36 is met by Cousineau. From the above-noted teachings of Cousineau and the common sense³ of the artisan, we conclude that to have reached the position of the nozzles 18 shown in Figure 6, the nozzles at some point in time would have had to be positioned above the bed (i.e., lake bottom 20).

In our view, the appellants' argument as to why the Board's construction of the "positioning said nozzle a distance above said bed" step of claim 36 is unreasonably broad would improperly read limitations from the specification into claim 36. Moreover, the appellants have not furnished any evidence⁴ that our construction of the positioning step of claim 36 would be considered unreasonable by one of ordinary skill in the art when taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification.

³ An artisan is presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re

The third and final issue (pp. 3-4) raised by the appellants is that the Board should include a statement pursuant to 37 CFR § 1.196(c) that claim 36 would be allowable upon the appellants amending claim 36 as set forth on page 4 of the request for rehearing. We decline to include such a statement since the inclusion of such a statement is within the discretion of the Board and this panel of the Board chooses not to exercise such discretion.⁵

In light of the foregoing, the appellants' request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

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

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
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