

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WILLIAM J. TATE, STEPHEN R. OLSON,  
CRAIG L. KOEHRSEN, KARL W. KLEIMENHAGEN

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Appeal No. 96-1499  
Application 08/133,013<sup>1</sup>

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ON REQUEST FOR REHEARING

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

KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellants request that we reconsider that part of our decision of September 14, 1998 wherein we sustained the

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<sup>1</sup>Application for patent filed April 8, 1991. This application is a National Stage application under 35 USC § 371 of PCT/US91/02437, filed April 8, 1991.

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rejection of claims 1 and 3 through 5 under 35 U.S.C. 102(b).

In particular, appellants now argue that we did not address or consider the limitation of claim 1 which requires:

means for producing a desired engine speed signal wherein said desired engine speed signal is a function of said vehicle identification number; ...

We did not specifically address this limitation of claim 1, with regard to the rejection under 35 U.S.C. 102(b), because, as we stated at page 9 of our decision, all of the claims fell with independent claim 9 in view of the lack of any separate arguments as to the merits of any individual claim. We recognized that appellants did group the claims into three separate groups for purposes of the rejection under 35 U.S.C. 102(b). However, we found no separate arguments as to the merits of any individual claim.

While appellants acknowledge that this feature of claim 1 was not specifically discussed in the section of the appeal brief addressing the rejection under 35 U.S.C. 102(b), they now contend that they did specifically identify the limitation as a distinguishing feature of claim Group 1, referring to

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the principal brief at page 9, and further contend that the feature was

carefully described in the immediately preceding section with reference to the rejections under 35 U.S.C. 112.

First, the limitation of the "vehicle identification number" was discussed with regard to the rejections under 35 U.S.C. 112 because this limitation was the focus of that rejection. We fail to find any relevance of this argument with regard to the rejection under 35 U.S.C. 102(b). If appellants' position was that this was a distinguishing feature over the applied prior art, it could have been argued as such in the section of the brief related to arguments against the rejection under 35 U.S.C. 102(b).

Second, reference to page 9 of the principal brief finds a mere general statement that "[s]everal features distinguish the claims...from Steel" and then two clauses of claim 1, "means for producing..." and "actuator means..." are recited. There is no specific discussion as to how, specifically, such

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limitations distinguished over the applied references nor is it even clear whether appellants were even stressing the "vehicle identification number" element as the distinguishing feature. Moreover, in the very next paragraph, at the top of page 10,

appellants state that "claims 6, 8, 9 and 11-12 all include a *similar feature* that distinguishes over the Steel reference" [emphasis ours]. It is unclear whether this is meant to imply that only claims 6, 8, 9 and 11-12 include a similar feature among themselves or whether this refers back to the discussion of claims 1 and 3-5. If the latter, then it is clear that appellants were not distinguishing between claims with regard to the "vehicle identification number" because independent claims 6 and 9 do not contain this limitation.

While the "vehicle identification number" may very well distinguish claims 1 and 3 -5 over Steel, we have not taken that position and did not treat the subject matter of independent claim 1 on its merits because, as explained in our

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decision and supra, we held these claims to stand or fall with independent claim 9 due to a lack of any separate arguments as to the merits of any one claim.

While appellants are free to make such an argument distinguishing claims 1 and 3-5 over the disclosure of Steel in any future prosecution, as by way, for example, of a continuation

application, we have not found any such specific argument made in the briefs and we find no error in our decision.

The request for reconsideration is granted to the extent that we have reconsidered our decision but it is denied with respect to making any changes therein.

DENIED

ERROL A. KRASS )  
Administrative Patent Judge )  
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Administrative Patent Judge	)	

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