

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEUNG-GYU JANG

Appeal No. 97-2761
Application No. 07/981,126¹

Before KRASS, BARRETT, and FRAHM, Administrative Patent Judges.
KRASS, Administrative Patent Judge.

ON REQUEST FOR REHEARING

Appellant requests that we reconsider our decision of March 18, 1999 wherein we affirmed the examiner's decision rejecting claims 1 through 6, 8, 10, 14, 16, 18, 19 and 25 through 28 under 35 U.S.C. 103.

¹ Application for patent filed November 24, 1992.

Appellant first argues a procedural point, contending that it was error on our part not to consider a reply brief which was not entered into the record by the examiner. Whether or not an examiner enters a reply brief is a petitionable matter under 37 CFR 1.181. Since the denial of entry of a reply brief is not an appealable matter, we have no jurisdiction to consider a reply brief which has not been entered into the official record of the case by the examiner.

While the current rule 37 CFR 1.193(b)(1), in effect as of the date of our decision does, indeed, require the examiner to either "acknowledge receipt and entry of the Reply Brief or withdraw the final rejection and reopen prosecution to respond to the Reply Brief," it is not the date of our decision which is dispositive but, rather, the date of filing of the reply brief which determines which rule applies. Appellant admits that as of the date of the filing of the reply brief, current rule 37 CFR 1.193 (b)(1) was not yet in effect and so, at this time, the examiner had more discretion as to whether or not to enter a reply brief. In any event, any dispute as to the propriety of the entry of a reply brief must be resolved by

petitioning the Commissioner under 37 CFR 1.181. It is not within our jurisdiction [see 35 U.S.C. 134 and 37 CFR 1.191] to decide whether an examiner should have entered a reply brief.

Thus, any argument by appellant anent the entry of a reply brief is unpersuasive to us as to the patentability of the claims under rejection.

Appellant next contends that our decision committed reversible error with regard to the claimed feature of an *adhesive tape* as compared to the teaching in Uchida of a white level reference being "fixed in position." More particularly, appellant contends that the art did not teach or suggest appellant's claimed "adhesive...tape." As we pointed out in our decision, Uchida discloses that the white level reference 2 is a "piece of white tape or paper" and that this tape is "fixed in position." Since the tape in Uchida is "fixed in position," it would have been clear to artisans that the tape was "adhered" to that position, making it an "adhesive" tape, as claimed. This suggestion, by Uchida, of employing an adhesive tape, in view of the artisan's knowledge that a

reference scanning surface becomes contaminated through prolonged use [specification-page 2], would clearly have led the artisan to employ a removable adhesive tape which is easily removable and replaceable.

Appellant also contends that the claims call for a "scanning plate" and that nothing in the applied art shows the claimed combination of a "scanning plate with a reflective reference scanning surface" and "an adhesive scanning tape having a reference color" adhered to the reflective reference scanning surface. Thus, appellant argues that the art of record does not disclose both a "scanning plate" and "an adhesive scanning tape." However, as we explained, at page 9 of our decision, tape 2 of Uchida is placed over a surface and becomes the "reflective reference scanning surface," as artisans would understand that term. Therefore, Uchida does, indeed, disclose both a scanning plate and an adhesive scanning tape, as broadly claimed.

Insofar as appellant makes arguments which refer to the unentered reply brief, these arguments will not be entertained

and are unconvincing of any reversible error on our part since, as explained supra, the reply brief is not properly before us.

We have considered appellant's request for rehearing and grant it to the extent that we have reconsidered our decision but we deny it 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 CFR § 1.136(a).

DENIED

ERROL A. KRASS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LEE E. BARRETT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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ERIC FRAHM)	
Administrative Patent Judge)	

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