

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN W. PAINE

Appeal No. 97-3215
Application 08/619,098¹

ON BRIEF

Before COHEN, MEISTER, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

ON REQUEST FOR RECONSIDERATION (REHEARING) ²

This is in response to a "REQUEST FOR RECONSIDERATION" (REHEARING) of our decision dated September 15, 1998, wherein this panel of the board affirmed the

¹ Application for patent filed March 20, 1996. According to the appellant, the application is a continuation of Application 08/293,507, filed August 22, 1994, abandoned.

² Effective December 1, 1997, paragraph(b) of 37 CFR § 1.197 was amended to change request for "reconsideration" to request for --rehearing--.

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rejection of appellant's claims 16 through 22, 24 through 26, and 30 through 32 under 35 U.S.C. § 103 as being unpatentable over Huch in view of Hall.

In the request (pages 1 and 2), appellant attributes to this panel of the board "a finding of obviousness" that is "based on incorrect factual predicates," citing In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1455 (Fed. Cir. 1998). More particularly, after referring to the "pliable material" of claims 30 and 31 (page 2), appellant argues (page 3) that in contrast to Huch, the neck tie system of claims 30 and 31 requires pockets to be formed from pliable material, a limitation asserted by appellant to have been overlooked by this panel of the board (page 5). Appellant also contends (page 5) that this panel of the board relied upon hindsight to arrive at "the finding of obviousness of claims 30 and 31."

At this juncture, we point out that an argument advanced for the first time in a request for reconsideration or rehearing is improper, with the failure to present the argument prior to submission of the request constituting a waiver of the argument. See Ex parte Hindersinn, 177 USPQ 78, 80 (Bd. App. 1971) and In re Kroekel, 803 F.2d 705, 709, 231 USPQ 640, 642-643 (Fed. Cir. 1986).

As a reading of the "IX ARGUMENT" section of the appeal brief (Paper No. 15) and the reply brief (Paper No. 17) clearly reveals, appellant never argued therein the "pliable material" recitation of claims 30 and 31. The same can be said for the newly presented

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argument regarding “hindsight.” Since these arguments have been presented by appellant for the first time in the request, they are improper and not considered.

In reconsidering our earlier decision regarding claims 30 and 31, pursuant to appellant’s request for rehearing, we determine that we reached a correct conclusion of obviousness fairly based upon correct factual predicates, as can be discerned from the content of our decision.

In conclusion, we have carefully reconsidered our earlier decision in light of appellant’s request. However, for the reasons discussed above, we are not persuaded to alter our position on the obviousness of the presently claimed subject matter. Therefore, the request is granted to the extent of reconsidering our decision, but is denied 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

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IRWIN CHARLES COHEN)
Administrative Patent Judge)

JAMES M. MEISTER)
Administrative Patent Judge)

JOHN P. McQUADE)
Administrative Patent Judge)

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