

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN R. BOWLIN, HOWARD L. MCKINZIE
and BILLY W. SURLES

Appeal No. 1999-1095
Application 08/751,632¹

ON BRIEF

Before SCHAFFER, LEE and MEDLEY, Administrative Patent Judges.
LEE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

On May 14, 2001, we issued a decision affirming the examiner's rejection of appellants' claims 13, 15 and 17-20. (Paper No. 16). On June 14, 2001, the appellants filed a request for rehearing. For reasons explained below, the request is **DENIED**.

In the first paragraph on page 2, the appellants state that "required findings are absent from the Board's decision."

¹ Application for patent filed November 18, 1996.

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However, nowhere does the appellants point out what findings we allegedly failed to make. Evidently, the appellants simply disagree with the findings we did make. In the full paragraph on the middle of page 5 of the decision, and in response to the appellants' argument in the appeal brief that Ennis '429 does not teach use of a coloring agent in the sense of the appellants' invention because the coloring pigment of Ennis '429 has no color that is described, we specifically found that Ennis '429 discloses use of a coloring agent as has been claimed:

Ennis '429 generally refers to the addition of a coloring pigment without particularly specifying the color. That would have indicated to one with ordinary skill in the art that the particular coloring is not important, and that whatever color is used would be fine so long as the light transmissivity of the coloring pigment is between that of water and oil. None of this makes Ennis '429's coloring pigment not a coloring agent. **That the coloring pigment in Ennis '429 is used for changing light transmissivity and not so much for providing a color does not disqualify it from being a coloring agent.** (Emphasis added.)

In the request for rehearing, the appellants re-present the same argument which we have rejected, only in different words:

As mentioned previously, the critical test for a § 103 rejection is whether Ennis '429 teaches or

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suggests to one skilled in the art the use of a coloring agent for the present invention. Applicant respectfully assert that no suggestion is made within Ennis '429 that the use of coloring agents is obvious for techniques that don't require coloring agents in order to function, but rather merely to help to improve the technique. (Emphasis in original).

The argument is also not commensurate in scope with what the appellants have claimed. The claims on appeal do not limit the purpose or need for which a coloring agent is used or the degree of such purpose or need. For instance, independent claim 13 recites merely the following with respect to a coloring agent: "displacing and replacing the wellbore fluid in said selected interval of a borehole with a transparent water mixture having a viscosifying agent, a coloring agent, and optionally sufficient salt to increase the mixture density."

The request for rehearing is also not an opportunity for a dissatisfied appellants to introduce new arguments for the first time, i.e., arguments not presented in the appeal brief. Accordingly, all of the arguments contained in the rehearing request concerning unexpected results are improper and not entitled to consideration. In any event, the appellants have not submitted objective evidence in the form of declarations

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in connection with the belated argument of unexpected results.

Finally, the appellants take exception to a statement which they assert the examiner made but which the examiner did not make. In that regard, on page 4 of the request for rehearing it is stated:

Applicant also assert that the Examiner's unsubstantiated statement that viscosifying agents are **solely** intended to prevent charge material from being driven into the underground formation (see Board decision, p. 8) overlooks the nonobvious results produced by this invention. (Emphasis added.)

Our initial decision on page 8 did not indicate any examiner statement which regard viscosifying agents as "solely" intended to prevent charge material from being driven into the underground formation. What was stated in our decision is this:

With regard to Ennis '889, the examiner's answer states that the disclosed functionality of a viscosifying agent to prevent a charging material from being driven into the underground formation is equally applicable to the combination of Riordan and Ennis '429. The finding is facially plausible. Furthermore, in the examiner's answer, on page 5, it is stated that "the use of such 'viscosifying agents' is notoriously well known in the wellbore exploration art for this very purpose." The appellants have not filed any reply to the examiner's answer. Thus, the statement of the examiner as to what is notoriously well known in the art stands unrebutted.

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In any event, it is too late to be challenging, in a request for rehearing, findings made by the examiner in the examiner's answer, where no reply was filed to rebut the finding. An adverse decision is not an invitation for new arguments.

Conclusion

For the foregoing reasons, the request for rehearing is **DENIED**.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(b).

RICHARD E. SCHAFER)
Administrative Patent Judge)
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JAMESON LEE) APPEALS AND
Administrative Patent Judge) INTERFERENCES
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SALLY C. MEDLEY)
Administrative Patent Judge)

JL/dal

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Stephen H. Cagle
HOWREY, SIMON, ARNOLD & WHITE, LLP
750 Bering Drive
Houston, Texas 77057