

Keywords: Request for Rehearing; review waiver; appealable matter

General: The B.P.A.I. finds that on a Request for Rehearing, an Appellant is entitled to review only of issues previously challenged by the Appellant and that on Appeal, the particular finding(s) contested by an Appellant are to be reviewed anew by the Board based on the totality of the record, i.e., in light of all the evidence and arguments on that issue.

Ex parte Quist

95 U.S.P.Q.2d 1140 (B.P.A.I. 2010) (precedential)

Decided June 2, 2010

I. Facts

Appellants filed a patent application in 2005 with claims directed to a process for manufacturing decorative boards that included a) cutting a carrier board to a desired dimension and making edges with at least one joining element, b) applying radiation curable dry acrylic lacquer powder to an upper surface of the board, c) heating the acrylic lacquer so that it melts, and d) curing the acrylic lacquer by means of UV-radiation or electron beam radiation. The claims were rejected under Section 103(a) and this rejection was appealed in October 2006. A Board decision affirming the rejection of the Examiner was entered in April 2008. Appellants filed a Request for Rehearing, which is the subject of the instant matter.

In the Request for Rehearing, Appellants presented three issues for review. First, Appellants argued that the Panel misapprehended the subject matter sought to be patented. Specifically, Appellants argued advantages of the claimed process over the prior art in the Request for Rehearing as providing evidence of the non-obviousness of the claimed subject matter. Second, Appellants argued that the Panel misconstrued a declaration supplied in the evidence appendix of the Appeal Brief. Third, Appellants argued that the Panel applied an improper legal standard in considering whether to affirm the Examiner. Specifically, Appellants argued that the Panel reviewed evidence supplied by Appellants in the Appeal Brief for its ability to “knock down” the *prima facie* case of obviousness by the Examiner instead of properly weighing evidence supporting patentability against evidence supporting the *prima facie* case.

II. Issues

- A) Did the Panel misapprehend the subject matter sought to be patented?
- B) Did the Panel misconstrue a declaration supplied in the evidence appendix of the Appeal Brief?
- C) Did the Panel apply an improper legal standard in considering whether to affirm the Examiner?

III. Discussion

- A) No. In the Request for Rehearing, Appellants for the first time argued that an advantage of the claimed process was the reduction of wasted coating material, i.e., a cost savings, since the steps of cutting the board and making edges in the board are performed prior to the step of applying a coating material. The Board noted that this argument was not made in the Appeal Brief, in the Reply Brief, or in the remainder of the record. Accordingly, the Board held that the argument regarding suggested advantages of the claimed process over the prior art was improper and untimely as it was raised for the first time in a Request for Rehearing. Moreover, the Board suggested that the claimed subject matter was properly construed to broadly include a coated board that was then milled. Thus, under this broad interpretation of the claimed subject matter, even if the proposed advantage of the claimed process (reducing wasted coating material) was admitted, there would be no advantage over the prior art, since milling a coated board would necessarily cause waste (through removal) of that coating.

- B) No. The Board found that the Declaration filed by Appellants was properly considered during Appeal. The Board noted that the Declaration included statements that it was not recognized or conventional to form joining elements on laminate flooring prior to applying a coating. The Declaration also stated that no manufacturer had manufactured floor elements by forming joining elements on laminate floor elements prior to applying a coating. However, the Board concluded that the statements did not establish a sufficient nexus between the merits of the claimed invention and the objective evidence of non-obviousness. Specifically, because the Panel was found to have properly interpreted the claims to include a coated board that was then milled to form joints, the Board held that statements in the Declaration regarding the lack of coating boards prior to forming joining elements was to be given little weight as objective evidence of non-obviousness.
- C) No. Appellants argued that the Panel applied an improper legal standard in considering whether to affirm the Examiner, noting that the Panel stated “Appellants have not successfully rebutted the *prima facie* case” of obviousness. Specifically, Appellants argued that the Panel reviewed evidence supplied by Appellants in the Appeal Brief for its ability to “knock down” the *prima facie* case of obviousness by the Examiner instead of properly weighing evidence supporting patentability against evidence supporting the *prima facie* case. The Board noted that if an Appellant raises the issue as to whether the Examiner’s conclusion of obviousness was in error, based in part on the proffered evidence of secondary considerations, the Panel must consider if the Examiner erred in determining patentability, based upon the totality of the record. Furthermore, the Panel must review the Examiner’s conclusion of obviousness anew to see if the preponderance of relevant evidence properly before the Office supports that conclusion. The Board analyzed the findings of the Panel and submitted that the totality of the record was considered by the Panel during the Appeal. Thus, the Board found that the Panel applied the proper legal standard in considering whether to affirm the Examiner

IV. Conclusion

The Board upheld the Panel’s decision to affirm the Examiner. The Board made clear that the Panel is to review anew the particular finding(s) contested by an Appellant in light of all the evidence and argument on that issue. Moreover, the Board found that an Appellant must have previously presented arguments to all issues (i.e., aspects of rejections) that the Appellant wishes to contest on Rehearing, else the Appellant essentially waives those arguments.