

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JIMMY L. HOLLINGSWORTH, JR.

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Appeal 2009-014399  
Application 10/170,069  
Patent 6,073,699  
Technology Center 3600

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Decided: June 29, 2010

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Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,  
and LINDA E. HORNER and ROBERT E. NAPPI, *Administrative Patent  
Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON REQUEST FOR REHEARING

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Jimmy L. Hollingsworth, Jr. (Appellant) filed a request for rehearing under 37 C.F.R. § 41.52 requesting that we reconsider our decision of February 17, 2010 (“Decision”). Requests for rehearing are limited to matters misapprehended or overlooked by the Panel in rendering the original decision. 37 C.F.R. § 41.52(a)(1).

In the Decision, we affirmed the rejection of claims 4-7<sup>1</sup> under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. The Board’s Decision was based on the fact that Appellant failed to meet his burden to show how reissue claim 4 patentably distinguishes over the art, and thus failed to show how reissue claim 4 is directed to a materially-narrowed, overlooked aspect of the claimed invention, such that the recapture rule does not apply. Decision 21-25. In the Briefs, Appellant simply argued that “[i]n light of the Examiner’s failure to reject the claims based on any prior art, Applicant can only presume that the Examiner agrees pending claims 4-7 are patentably distinguished over the prior art” (App. Br. 9) and “the Examiner has not presented any prior art rejection of the claims” (Reply Br. 3). We held that “Appellant cannot meet the burden of showing an overlooked aspect patentably distinguishes over

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<sup>1</sup> We take this opportunity to correct a typographical error in the statement of the rejection on page 5 of the Decision. This statement should have stated that Appellant seeks review of the Examiner’s rejection of reissue claims 4-7 under 35 U.S.C. § 251. The remainder of the opinion discusses reissue claims 4-7.

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the art solely by inferring such facts based on the Examiner's omission of a prior art rejection." Decision 23 (noting that the Examiner may have opted not to enter a prior art rejection against the claim because the Examiner may have felt the recapture rejection was sufficient).

Appellant now presents for the first time in the Request for Rehearing substantive arguments as to why reissue claim 4 patentably distinguishes over the art. Appellant does not, and cannot, argue that the Board misapprehended or overlooked these arguments in reaching its Decision because Appellant's arguments as to how claim 4 patentably distinguishes over the art were not before the Board at the time it made its Decision. The Board put Appellant on notice of Appellant's burden of proof on this issue in a prior 2007 Board decision in the present reissue application. *Ex parte Hollingsworth, Jr.*, 2007 WL 1813755, Appeal 2007-0040 (BPAI June 25, 2007). This prior 2007 Board decision explained to Appellant that an examiner has the burden of making out a prima facie case of recapture including a rebuttable presumption of surrender, and then the burden of persuasion shifts to the appellant to establish that the prosecution history of the application, which matured into the patent sought to be reissued, establishes that a surrender of the subject matter did not occur or that the reissue claims are materially narrowed. Decision 20 (citing to prior 2007 Board decision at 24-32). The Board also explained that to rebut a presumption of surrender by showing the claim to be "materially narrowed in overlooked aspects," the Appellant must show that the claim is limited to

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aspects of the invention which had not been claimed and which patentably distinguish over the art. Decision 20 (citing to prior 2007 Board decision at 33-39).

Despite this explanation in the prior Board decision, Appellant failed to address the patentably distinguishing aspects of reissue claims 4-7 in the briefs, and Appellant was unable to address the Board's concerns as to the obviousness of the subject matter of reissue claims 4-7 in view of Taylor when raised at the oral hearing. Hearing Transcript 4-5, 9-10, 13.

Given that the new limitations added to the reissue claims pertain to the addition of lifting ears to the claimed elevator (Decision 5 and Decision 16 (Fact 43)), and given that the prior art of record the Examiner used to reject the claims in the original prosecution demonstrates that lifting ears positioned on first and second body parts of an elevator and having a hinge and a latch mechanism therebetween were well known in the art at the time of Appellant's invention (Decision 11 (Facts 15, 19, 20); Decision 14 (Fact 29), Decision 24), it is our view that an "objective observer" would not reasonably view the reissue claims as directed to a materially narrowed and overlooked aspect. Thus, the burden was squarely on Appellant to make some showing to demonstrate that these reissue claims patentably distinguish over the art in order to show that the claimed lifting ears were an overlooked aspect of the invention.

For the reasons stated in our original Decision, Appellant cannot meet this burden by relying solely on the Examiner's failure to enter a prior art

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rejection of the claims. As such, we will not allow Appellant to introduce for the first time in a Request for Rehearing arguments that he could have presented in the Appeal Brief.

#### DECISION

The Request is denied with respect to making any changes in the Decision, except that we take this opportunity to correct a typographical error in the Decision as noted in footnote 1 *supra*. No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

DENIED

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