

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 49

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOICHI KIMURA, TOSHIHIKO OGURA,
HIROAKI AOTSU, and KIICHIRO URABE

Appeal No. 2000-2176
Application No. 08/436,526

Before RUGGIERO, GROSS, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to appellants' request for rehearing of our decision mailed June 28, 2002, where we reversed the rejection of claims 25, 28, 29, 32, 35, and 36 under 35 U.S.C. § 103 but affirmed the provisional rejection of the claims under the judicially created doctrine of obviousness-type double patenting.¹

Appellants' arguments fail to convince us that we erred in any respect in the decision. We therefore decline to make any changes therein. However, we remand the

¹ Decided concurrently herewith is the request for rehearing in appellants' co-pending application No. 08/518,316 (Appeal No. 1999-2840).

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application to the examiner for reconsideration of the double patenting rejection in view of a paper filed by appellants on August 28, 2002.

DISCUSSION

Appellants appear to question the propriety of appellate review of a provisional double patenting rejection, citing In re Wetterau, 356 F.2d 556, 148 USPQ 499 (CCPA 1966). However, in Wetterau the United States Court of Customs and Patent Appeals determined that the Patent Office practice with respect to “provisional” double patenting rejections (i.e., double patenting rejections over claims in copending patent applications) benefits both an applicant and the Office, by identifying possibility of double patenting at an early date and by hastening prosecution. See id. at 558 n.2, 148 USPQ at 501 n.2. The court reviewed the merits of the provisional double patenting rejection before it, while acknowledging that the underlying rejection “might be obviated by future events,” such as the reference application failing to issue as a patent. Id. at 558, 148 USPQ at 501.

The Board has long heard appeals of provisional double patenting rejections where, as here, the claims of the reference application were also rejected over prior art. See Ex parte Karol, 8 USPQ2d 1771, 1773 (Bd. Pat. App. & Int. 1988) (“In our view, the policy reasons enunciated in Wetterau apply equally to the instant case.”).

We are thus unpersuaded that we erred in ruling on the provisional double patenting rejection that was before us. We further note that appellants recognized the

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provisional rejection as an issue on appeal (see appellants' Brief at 5). Appellants addressed the merits of the rejection at page 22 of the Brief. We could not have erred on the basis of overlooking arguments not presented to us. See Keebler Co. v. Murraray Bakery Products, 866 F.2d 1386, 1388, 9 USPQ2d 1736, 1738 (Fed. Cir. 1989) ("Prescience is not a required characteristic of the board.").

Appellants at page 2 of the instant request submit that "[i]t would seem that 37 CFR § 1.197(b) [sic; § 196(b)?] would have been more appropriate" than affirming the rejection. However, 37 CFR § 1.197(b) permits an appellant to file a single request for rehearing within two months of the original decision; appellants have done so. If, on the other hand, appellants mean that we should have cast our affirmance of the provisional rejection as a new ground of rejection, as provided by 37 CFR § 1.196(b), appellants did not set forth such request in the Brief on appeal. Moreover, § 1.196(b) was not available with respect to the provisional rejection because we affirmed the ground of rejection that was entered by the examiner. Cf. 37 CFR § 1.196(b) ("Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim.").

Appellants also argue that a terminal disclaimer has been filed in the instant case, subsequent to our original decision, which would "render moot" the provisional rejection. Appellants request at page 3 that we "grant the present Request for Re-

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hearing and issue a new Decision noting that the provisional obviousness type double patenting rejection has been rendered moot by the Terminal disclaimer and reversing the Examiner's final rejection of the claim." However, the purpose of a request for rehearing is to inform the Board of perceived errors in fact or law in the original decision. See 37 CFR § 1.197(b) (the request for rehearing must "state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought."); see also Manual of Patent Examining Procedure (MPEP) § 1214.03 (Eighth ed. Aug. 2001) (the rule limits requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board). Needless to say, we could not have erred in failing to consider the presence of a terminal disclaimer that had not been filed at the time of our original decision.

Nor do we see any reason to issue a new decision which reverses the provisional double patenting rejection. We rule on the record that is before us; our decisions apply accordingly. Later circumstances may result in patenting of claims that had been earlier rejected and the rejection sustained on appeal; e.g., when an examiner finds later-submitted evidence to be persuasive in rebutting a case of prima facie obviousness under 35 U.S.C. § 103. Appellants have identified no authority requiring that the Board revisit an earlier decision for the sole reason that an applicant alleges that the earlier decision would not be sustainable in view of a later, and different, record.

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Moreover, our function in the ex parte context is to review rejections. The Board does not perform examining functions in the first instance. A terminal disclaimer is proffered to the relevant Technology Center and the examiner, rather than to the Board. See MPEP § 1490, “TERMINAL DISCLAIMER IN PENDING APPLICATION PRACTICE.”

In this regard, we note the presence of a paper, attached to the request for rehearing (and filed August 28, 2002), which purports to be a terminal disclaimer. There is no communication from the examiner in the record with respect to the present status of the provisional double patenting rejection,² most likely because the Board retained jurisdiction over the case due to filing of the instant request for rehearing.

This application is remanded to the examiner for reconsideration of the provisional double patenting rejection in light of appellants' submission of the above-noted paper. In view of the remand, the present decision is not considered final for the purposes of judicial review. If the remand results in further prosecution before the examiner, and such prosecution does not result in allowance of the application, abandonment, or a second appeal, or if there is no further prosecution before the examiner, this case should be returned to the Board of Patent Appeals and Interferences for entry of a final decision.

² Appellants have also attached a copy of an Interview Summary provided by the examiner. However, the Interview Summary is dated July 24, 2002, prior to filing of the paper in question.

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CONCLUSION

In view of the foregoing, we have granted appellants' request to the extent that we have reconsidered our decision mailed June 28, 2002. However, we deny the request with respect to making any changes therein.

This application is remanded to the examiner for reconsideration of the provisional double patenting rejection. This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

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

REHEARING DENIED; REMANDED

JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
ANITA PELLMAN GROSS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

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ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON , VA 22209