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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte H. EDWIN CARLEY
and ASHOK K. SHARMA

_____

Appeal No. 94-2153
Application 07/333,362[1]

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ON BRIEF

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Before WINTERS, WILLIAM F. SMITH, and JOHN D. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

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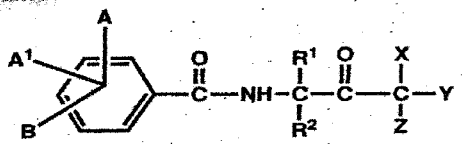
[1] Application for patent filed April 4, 1989. According to appellants, the application is a division of Application 06/634,916, filed July 26, 1984.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 16 through 18, 21 through 27, and 30 through 32. Claim 34 is pending and has been allowed by the examiner. Claims 19, 20, 28, 29, and 33 are also pending and are stated by the examiner to be "objected to."

Claim 16 is illustrative of the subject matter on appeal and reads as follows:

16. A compound of the formula:



wherein:

A is a chloro, bromo, fluoro, iodo, trifluoromethyl, trifluoromethoxy, fluorosulfonyl, methyl, ethyl, phenyl, methoxy, chloromethyl, $(C_1$-$C_2)$alkoxycarbonyl, cyano or hydroxy group;

A^1 and B are each independently selected from the group consisting of hydrogen, chloro, bromo, fluoro and methyl group;

X is bromo, iodo, fluoro, cyano, thiocyano, isothiocyano, methylsulfonyloxy, thio$(C_1$-$C_2)$alkyl, $(C_1$-$C_2)$alkoxy, carbamoyloxy of the formula $(-OC(O)N(R^3)_2)$, thiocarbamoylthio of the formula $(-SC(S)N(R^3)_2)$, hydroxy, azide, $(C_1$-$C_4)$alkylcarbonyloxy, phenylcarbonyloxy, phenoxy, phenylthio, trifluoromethylcarboxy, $(C_1$-$C_3)$alkylthioacetyl, imidazolyl or triazolyl group; and when X is a phenylcarbonyloxy, phenoxy or phenylthio substituent, the phenyl moiety may be substituted with one substituent selected from the group consisting of chloro, fluoro, bromo, iodo or methyl group;

Y and Z are each independently a hydrogen, bromo, chloro, iodo, fluoro, cyano, thiocyano, isothiocyano, methylsulfonyloxy, thio$(C_1$-$C_2)$alkyl, $(C_1$-$C_2)$alkoxy, carbamoyloxy of the formula $(-OC(O)N(R^3)_2)$, hydroxy, azide or $(C_1$-$C_4)$alkylcarbonyloxy group and either, but not both, Y or Z may be an imidazolyl or triazolyl group;

provided when X and Y are halogens and Z is hydrogen or X, Y and Z are all halogens, then the halogens are all the same halogen;

further provided that when

X is cyano, thiocyano, isothiocyano, methylsulfonyloxy, thio(C_1-C_2)alkyl, (C_1-C_2)alkoxy, carbamoyloxy of the formula (-OC(O)N(R^3)$_2$), thiocarbamoylthio of the formula (-SC(S)N(R^3)$_2$), azide, (C_1-C_4)alkylcarbonyloxy, phenylcarbonyloxy, phenoxy, phenylthio, trifluoromethylcarboxy, imidazolyl or triazolyl group; and when X is a phenylcarbonyloxy, phenoxy or phenylthio substituent, the phenyl moiety may be substituted with one substituent selected from the group consisting of chloro, fluoro, bromo, iodo or methyl group;

Y and Z are not a hydrogen, cyano, thiocyano, isothiocyano, methylsulfonyloxy, thio(C_1-C_2)alkyl, (C_1-C_2)alkoxy, carbamoyloxy of the formula (-OC(O)N(R^3)$_2$), azide, (C_1-C_4)alkylcarbonyloxy, imidazolyl, or triazolyl group;

R^1 and R^2 are each independently a hydrogen atom or a (C_1-C_6)alkyl group; and each R^3 is independently a hydrogen or a (C_1-C_4)alkyl group.

As set forth at page 3 of the Examiner's Answer:

Pursuant to Markush practice, the claims have only been examined to the extent that "A" is halogen; "AN" and "B" are hydrogen, halogen, and methyl; "X" is bromine, iodine, fluorine, and cyano; "Y" and "Z" are hydrogen or halogen; "R^1" and "R^2" are hydrogen or alkyl.

The allowable subject matter comprises that wherein "A" is halogen; "AN" and "B" are hydrogen, halogen, and methyl; "X" is bromine, iodine, and fluorine; "Y" and "Z" are hydrogen or halogen; "R^1" and "R^2" are hydrogen or alkyl.

The references relied upon by the examiner are:

McNulty et al. (McNulty)	3,661,991	May 9, 1972
Bosone et al. (Bosone)	4,425,357	Jan. 10, 1984
Takahashi et al. (Takahashi '582)	4,647,582	Mar. 3, 1987
Takahashi et al. (Takahashi '514)	4,710,514	Dec. 1, 1987
Carley et al. (Carley)	4,822,902	Apr. 18, 1989

The claims stand rejected as follows:[2]

I. Claims 16 through 18, 21 through 27, and 30 through 32 under 35 U.S.C. § 103 as unpatentable over McNulty in view of Bosone, Takahashi '582, and Takahashi '514, and,

II. Claims 16 through 18, 21 through 27, and 30 through 32 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1 and 2 of Carley.

Discussion

1. Preliminary issue

This is the second appeal in this application. The previous appeal, Appeal No. 91-0802, resulted in a decision by a merits panel of this board reversing the rejections then pending under 35 U.S.C. § 103. See, Decision on Appeal, Paper No. 12, March 6, 1992.

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[2] In addition to the two rejections, the examiner has objected to the specification under 35 U.S.C. § 132 and § 112, first paragraph, on pages 3 and 4 of the Examiner's Answer. However, the examiner has not rejected the claims based upon either objection. Objections to the specification are petitionable, not appealable. Therefore, the issues raised by the examiner in objecting to the specification are not before us for decision.

Subsequent to that decision, the examiner reopened prosecution, apparently on his own authority. See Paper No. 13, May 1, 1992. As set forth in the Manual of Patent Examining Procedure (MPEP) § 1214.04, **Examiner Reversed** (6th Edition, Rev. 3, July 1997):

> If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the group director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. Note MPEP § 1002.02(c), item 2, and MPEP § 1214.07. The group director's approval is placed on the action reopening prosecution.

This record does not indicate that the group director authorized the examiner to reopen prosecution. Rather than remand the application to the examiner to follow proper procedure, in the interest of administrative economy, we have proceeded to decide the issues presented in this appeal.

2. Obviousness

Having considered the record in this application, we reverse the prior art rejection for the reasons set forth in the Appeal Brief.

3. Obviousness-tyoe Double Patenting

Appellants were aware of the obviousness-type double patenting rejection prior to the filing of the Appeal Brief. See page 6 of Paper No. 18, July 29, 1993, wherein appellants stated that they would "consider timely filing of a terminal disclaimer . . .

after receipt of a Notice of Allowance." Appellants did not argue in the Appeal Brief that the obviousness-type double patenting rejection was either legally or factually unsound. The examiner repeated the obviousness-type double patenting rejection in the Examiner's Answer. See page 6 of the Examiner's Answer.

Since appellants were aware of the obviousness-type double patenting rejection prior to filing of the Appeal Brief and did not argue the merits of the rejection in the Appeal Brief, we will affirm the obviousness-type double patenting rejection.

The decision of the examiner is affirmed.

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

AFFIRMED

Sherman D. Winters Administrative Patent Judge	)	
William F. Smith Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
John D. Smith Administrative Patent Judge	)	

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