

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN A. KATZ

Appeal No. 96-2366
Application 08/076,824¹

REMAND TO THE EXAMINER

Before STONER, Chief Administrative Patent Judge, and WILLIAM F. SMITH and GRON, Administrative Patent Judges.

¹ Application for patent filed June 14, 1993. According to appellant, the application is a continuation of Application 07/803,234, filed December 5, 1991, now abandoned, which is a continuation-in-part of Application 07/644,869, filed January 23, 1991, now Patent No. 5,145,675; which is a continuation of Application 07/334,051, filed April 5, 1989; which is a division of Application 07/091,641, filed August 31, 1987, now abandoned; which is a continuation-in-part of Application 06/810,478, filed December 18, 1985, now abandoned; a continuation-in-part of Application 06/846,321, filed March 31, 1986, now abandoned; a continuation-in-part of Application 06/896,956, filed August 15, 1986, now abandoned; a continuation-in-part of Application 06/925,081, filed October 30, 1986, now abandoned; a continuation-in-part of Application 06/925,082, filed October 30, 1986, now abandoned; a continuation-in-part of Application 06/932,613, filed November 20, 1986, now abandoned; a continuation-in-part of Application 06/933,243, filed November 21, 1986, now abandoned; a continuation-in-part of Application 06/936,520, filed December 1, 1986, now abandoned; and a continuation-in-part of Application 06/940,754, filed December 10, 1986, now abandoned.

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WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our review of the record in this application leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

Circumstances Surrounding Filing of This Application

The examiner should clarify the following matters:

1. Parent Application 07/803,234 lists three inventors, Katz, Chang, and Nacht. The request under 37 CFR § 1.62 for filing a file wrapper continuing application submitted on June 14, 1993, by counsel first indicates an intent to file this application as a continuation-in-part of Application 07/803,234, which names "Martin A. Katz et al." as inventors. For reasons not clear from this record, the administrative records of the Patent and Trademark Office list only Martin A. Katz as the inventor of this application. Counsel was made aware of this fact in that the official filing receipt received from the Patent and Trademark Office is a copy of the information which appears on the front of the administrative file and names Katz as the sole inventor of this application.

Upon return of the application, the examiner and appellant(s) should determine who is or are the correct inventors of the subject matter now claimed in this application. Once that determination has been made, the examiner should see to it that the appropriate records in the Patent and Trademark Office accurately reflect that determination.

2. The “continuing data” set forth on the face of the administrative file, which again, was supplied to counsel in the form of the official filing receipt, does not match the information contained on page 1 of the application. For example, the information on the face of the administrative file indicates that Application 06/810,478 filed December 18, 1985, is a continuation-in-part of an application filed in 1986, which, of course, cannot be.

Upon return of the application, the examiner and appellant(s) should review the various parent applications and determine the correct chronology and relationship between the various applications. Once that determination has been made, the examiner should see to it that the appropriate records in the Patent and Trademark Office are corrected.

3. In filing this application under 37 CFR § 1.62, counsel checked the box on the form which indicated the intent to file a continuation-in-part application. However, in the instructions to amend the specification to insert “continuing data,” counsel checked the box

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which indicated that the now filed application is a continuation, not a continuation-in-part of Application 07/803,234. The request under 37 CFR § 1.62 was accompanied by a Preliminary Amendment containing, inter alia, an amendment to the specification. The Preliminary Amendment also confirmed counsel's apparent intent to file this application as a "FWC-I-P" application. For present purposes, we will assume this application was intended to be a continuation-in-part of Application 07/803,234, not a continuation as counsel indicated in the request.

Under those circumstances, the request for filing the application under 37 CFR § 1.62 should have been accompanied by a new oath or declaration. It was not. Thus, this application, to be considered proper, must be assumed to have been filed under the provisions of 37 CFR § 1.62(d). According to that rule, the Patent and Trademark Office should have notified counsel that an oath or declaration by the applicant was needed and provided a period of time for the purposes of filing the oath or declaration and to pay the required surcharge. It does not appear from this record that the Patent and Trademark Office so notified counsel. However, the needed declaration was filed by counsel on December 14, 1994, but it does not appear that it was accompanied by the required surcharge.

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Upon return of the application, the examiner should determine whether the declaration filed December 14, 1994, was timely as well as determine whether the required surcharge has been submitted.

Effective filing date of the claims on appeal

It does not appear from this record that the examiner has determined the effective filing date of the claims on appeal. This is especially important here since many of the parent applications listed on page 1 of the specification are continuation-in-part applications. In making this determination, the examiner should pay careful attention to the inventorship of each application. Katz, Chang, and Nacht are listed as the coinventors of parent Application 07/803,234. That application is stated to be a continuation-in-part of Application 07/644,869, now U.S. Patent No. 5,145,675 to Won alone. One of the requirements of 35 U.S.C. § 120 which must be met before claims in an application are entitled to the benefit of the filing date of an earlier filed application is that the application under review must be "filed by an inventor or inventors named in the previously filed application." Thus, it does not appear on this record that the claims on appeal are entitled under 35 U.S.C. § 120 to the benefit of the earlier filing date of Won. If the present claims are not entitled to the benefit of the earlier filing date of Won, that patent is available as prior art under 35 U.S.C. § 102(e). Since Won describes the topical composition of

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claims 1 through 10 on appeal and its use in treating acne as set forth in claims 11-17 on appeal (Example 4, column 17, line 67 - column 19, line 64), Won may be an anticipatory reference.

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMAND

Bruce H. Stoner, Jr., Chief Administrative Patent Judge))
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William F. Smith Administrative Patent Judge)) BOARD OF PATENT APPEALS AND INTERFERENCES
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Teddy S. Gron Administrative Patent Judge))

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