

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEAKI KASHIHARA,
KATSUYA YAMAGUCHI, and KOJI HATTA

Appeal No. 97-2523
Application 08/337,823¹

Rehearing

Before SCHAFER, LEE and TORCZON, Administrative Patent Judges.
LEE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

A decision on appeal from the examiner's rejection of claims 7-9 and 11-15 was mailed on August 4, 1999, in which we reversed the rejection of claims 7-9 and 11-15. (Paper No. 19).

The appellants filed a request for rehearing (Paper No. 20), focusing on the following statement appearing in our decision:

¹ Application for patent filed November 8, 1994.

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A reversal of the rejection on appeal should not be construed as an affirmative indication that the appellants' claims are patentable over prior art. We address only the positions and rationale as set forth by the examiner and on which the examiner's rejection of the claims on appeal is based.

According to the appellants, the above-quoted statement (1) is a statement "as to" the patentability of claims 7-9 and 11-15 over prior art, (2) is "unwarranted" unless a new ground of rejection is made, and (3) "unreasonably places a cloud on any patent that should issue." The appellant requests that the statement be "expunged" from our decision. The request is **denied**.

The appellants' views regarding our statement are without merit. By its nature, a decision on appeal from the examiner's rejection and reversing the examiner's rejection is not a general indication or expression of patentability, but a pronouncement of the lack of merit of the examiner's stated rationale or reasoning for rejecting the claims on appeal. The Board is not charged with the duty to re-examine the appellants' claims afresh, or ab initio. That fact is unchanged by the authority of the Board to enter new grounds of rejection.

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The "cloud" the appellants refer to as covering any patent which may issue from the appellants' application is fictitious. Our statement reflects a similar expression by the Court of Appeals for the Federal Circuit in In re Fisher, 58 CCPA 1419, 1420 (CCPA 1971) (on petition for rehearing):

As we have often pointed out, we pass only on rejections actually made and do not decree the issuance of patents. After our decision in an ex parte patent case, the Patent Office can always reopen prosecution and cite new references, in which limited sense our mandates amount to remands.

The Board does not prosecute or examine applications. Rather, the examiners do. Consequently, our reversal of the examiner's rejection also amounts to a de facto remand.

The appellants seem to regard our opinion as unnecessarily saying something more about the patentability of the appellants' claims than we should have. To the contrary, our statement keeps the opinion from being read or construed as saying something more about the patentability of the appellants' claims than we have.

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The request for rehearing is

DENIED

RICHARD E. SCHAFER)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JAMESON LEE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
RICHARD TORCZON)	
Administrative Patent Judge)	

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