

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH F. WOODRUFF

Appeal No. 97-3718
Application 08/480,579¹

ON BRIEF

Before COHEN, MEISTER and McQUADE, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

ON REQUEST FOR REHEARING

The appellant requests we reconsider our decision mailed on August 11, 1998 wherein we (1) reversed the rejection of claim 1 under 35 U.S.C. § 102(a), (2) affirmed the rejection of claims 1-3 and 13 under 35 U.S.C. § 102(b), (3) affirmed

¹ Application for patent filed June 7, 1995.

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the rejection of claims 5 and 6 under 35 U.S.C. § 103, (4) reversed the rejection of claims 4 and 19 under 35 U.S.C. § 102(b) and (5) reversed the rejection of claim 20 under 35 U.S.C. § 103. The request is directed to claim 11 (which was inadvertently omitted from the above-noted rejections) and to our affirmance of claims 5 and 6 under 35 U.S.C. § 103.

As to claim 11 (which depends from claim 4), the numeral 11 was inadvertently omitted from our decision in line 14 of page 8, and lines 2 and 12 of page 10. Thus, "claims 4 and 19" in each of these lines should have read -- claims 4, 11 and 19 --.

With respect to claims 5 and 6, the request states that:

The decision by the Board affirmed the rejection of dependent claims 5 - 6, without considering these claims on the merits, because Applicant, in its Appeal Brief, inadvertently grouped Claims 5 and 6 together with independent Claim 1 (not Claim 4) and did not separately argue Claims 5 - 6. However, since Claim 5 depends from Claim 4 and Claim 6 depends from Claim 5, Claims 5 - 6 should have been more accurately and appropriately grouped (and argued) together with Claim 4, the patentability of which was argued separately from independent Claim 1 (pages 11 - 15 of Applicant's Appeal Brief filed on October 22, 1996). [Page 2.]

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In view of the fact that claims 5 and 6 depend directly or indirectly from claim 4 (the rejection of which was reversed in our decision) we will, in the interest of fairness, reconsider our decision as though claims 5 and 6 had been grouped with claim 4 inasmuch as the appellant's grouping of claims 5 and 6 with claim 1 was inadvertent. Our decision is therefore modified by changing our affirmance of claims 5 and 6 under 35 U.S.C. § 103 to a **reversal**.

In summary:

The rejection of claim 1 under 35 U.S.C. § 102(a) as being anticipated by DowElanco is reversed.

The rejection of claims 1-3 and 13 under 35 U.S.C. § 102(b) as being anticipated by Weinblatt is affirmed.

The rejection of claims 4, 11 and 19 under 35 U.S.C. § 102(b) as being anticipated by Weinblatt is reversed.

The rejection of claims 5, 6 and 20 under 35 U.S.C. § 103 as being unpatentable over Weinblatt is reversed.

The appellant's request is granted to the extent of reconsidering our decision and making the above-noted modifications.

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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).

MODIFIED

IRWIN CHARLES COHEN))
Administrative Patent Judge))
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JAMES M. MEISTER)) BOARD OF PATENT
Administrative Patent Judge)) APPEALS AND
)) INTERFERENCES
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JOHN P. McQUADE))
Administrative Patent Judge))

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JMM:yrt

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