

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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ZOOEY C. CHU

Appeal No. 98-2307
Application 08/548,218¹

ON BRIEF

Before THOMAS, MARTIN, and TORCZON, Administrative Patent Judges.
THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final
rejection of the following design claim:

¹ Application for patent filed October 25, 1995 for Reissue of Patent No. D 340,589, granted October 26, 1993; based on Application 07/419,634, filed October 11, 1989; which is a continuation-in-part of Application 07/150,093, filed January 29, 1988 (abandoned).

Appeal No. 98-2307
Application 08/548,218

The ornamental design for a chair, as shown and described.

There are no references relied upon by the examiner.²

The design claim stands rejected, according to the examiner's reasoning at page 4 of the answer, "as lacking statutory basis for a reissue because 35 U.S.C. § 251 does not permit the introduction of new matter."

We refer to the brief and the answer generally for the respective positions of the appellant and the examiner.

OPINION

We pro forma reverse the outstanding rejection under 35 U.S.C. § 251.

In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981), indicates that the proper basis to reject a claim amended to recite elements thought to be without support in the original disclosure is 35 U.S.C. § 112, first paragraph, and not 35 U.S.C. § 132. Similarly, the court indicated at 650 F.2d 1215, 211 USPQ 326, in footnote 6 that "rejections of claims for

² The file history of this application reveals that the examiner has not instituted any art rejections even though appellant admits the newly claimed embodiments are broader than that presented in the patent from which this is a reissue application.

Appeal No. 98-2307
Application 08/548,218

lack of support when required in reissue applications should be made under § 112, first paragraph, rather than under the new matter prohibition of 35 U.S.C. § 251." Therefore, we reverse the examiner's rejection of the design claim on appeal under 35 U.S.C. § 251.

We note that reasoning in a rejection for lack of "support" for a claimed invention implicitly refers to the written description portion of 35 U.S.C. § 112, first paragraph. In re Higbee, 527 F.2d 1405, 1406, 188 USPQ 488, 489 (CCPA 1976).

We observe that on June 15, 1998 appellant filed Paper No. 15 as a supplemental communication. This paper apparently has not been reviewed or noted by the examiner. Appellant's communication notes that Ex parte Daniels, 40 USPQ2d 1394 (Bd. Pat. App. & Int. 1996), has been reversed by our reviewing court. We note also that other case law cited and relied upon by the examiner here has been discussed within the court's decision in Daniels and distinguished.

Appeal No. 98-2307
Application 08/548,218

In view of the foregoing, the decision of the examiner rejecting the design claim on appeal under 35 U.S.C. § 251 is reversed.

REVERSED

James D. Thomas)	
Administrative Patent Judge)	
)	
)	
)	
John C. Martin)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
Richard Torczon)	
Administrative Patent Judge)	

Appeal No. 98-2307
Application 08/548,218

JDT/cam
Price, Heneveld, Cooper, Dewitt & Litton
695 Kenmoor Drive S.E.
P. O. Box 2567
Grand Rapids, MI 49501