

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

Appeal No. 1998-2747
Application 08/427,203

HEARD: January 12, 2000

Before McCANDLISH, Senior Administrative Patent Judge.
ABRAMS and GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

MODIFICATION OF DECISION

ON APPEAL

In our original decision mailed February 24, 2000 (Paper No. 21), we inadvertently failed to include certain form paragraphs pertaining to procedures under 37 CFR §

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1.196(b) and 37 CFR § 1.197(b). Although these form paragraphs are not an essential or a required part of a decision by this Board, it nevertheless has been a standing practice to include them in a decision containing one or more new grounds of rejection entered pursuant to 37 CFR § 1.196(b). Accordingly, we hereby modify our original decision to include the following form paragraphs:

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63,122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded

to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for reconsideration thereof.

In view of our omission of these two paragraphs from our original decision, the time period for filing a request for rehearing under 37 CFR § 1.197(b) is reset to expire TWO MONTHS from the mailing date of this modification of our decision, and the time period for exercising one of the two options under 37 CFR § 1.196(b) is likewise reset to expire TWO MONTHS from the mailing date of this modification of our decision. Since the time periods under 37 CFR § 1.197(b) and 37 CFR § 1.196(b) have been reset to commence with the

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mailing date of this modification of our original decision, appellant's request for a time extension, presumably under 37 CFR § 1.136(b), is premature and is therefore denied.

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

MODIFIED

HARRISON E. McCANDLISH)
Senior Administrative Patent Judge)
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) BOARD OF PATENT
NEAL E. ABRAMS)
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
JOHN F. GONZALES)
Administrative Patent Judge)

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HEM:pgg

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