

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 52

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal No. 2000-2192
Application 08/943,123

HEARD: July 15, 2003

Before PAK, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

On Request For Rehearing

Appellant requests rehearing of our decision dated July 29, 2003 (Paper No. 50) to the extent that we summarily affirmed the examiner's rejection of appealed claims 72 through 86, all of the appealed claims, under the judicially created doctrine of obviousness-type double patenting over copending application 08/943,125 because appellant stated the intention to file a terminal disclaimer to obviate the rejection in the brief (page 4) and in the reply brief (page 7) (decision, page 4).

Appellant contends that the points we overlooked are: (1) appellant's statement in the brief was that "he would 'file a terminal disclaimer in the appropriate application upon the indication of allowable subject matter in both applications,'" application 08/943,125 has no indication of allowable subject matter, and the "Board . . . did not take into account the examiner made a provisional double patenting rejection in both applications, as she had to, since she had

not allowed claims in either” (request, pages 1-2; emphasis added in the request); (2) that the Manual of Patent Examining Procedure (MPEP) § 822.01 (8th ed., Rev. 1, Feb 2003) “directs the examiner to allow an application where the only remaining rejection is a provisional double patenting rejection, and the other application still contains claims provisionally rejected under the doctrine of obviousness-type double patenting,” and since “the Manual indicates the examiner should finish the prosecution by withdrawing that rejection and allowing the application to issue as a patent . . . [t]he Board can facilitate [this action by the examiner] by modifying its . . . decision to include a provision that they remand the application to the examiner for further proceedings” (request, pages 2-3); and (3) the rules of practice provide for remands to the examiner and thus provide a basis for the Board to remand this application to the examiner for purposes of complying with MPEP § 822.01 (request, pages 3-5).

Requests for rehearing must comply with 37 CFR § 1.197(b) (2003) which specifies that “[t]he request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought.”

We have carefully considered appellant’s request but we are unconvinced that there is error in our decision with respect to the subject ground of rejection because appellant has failed to particularly point out any point that we have misapprehended or overlooked in rendering the decision and has stated no other grounds which are of such merit as to support the request. It is clear from the brief and reply brief that appellant expressed the intent to file a terminal disclaimer in order to avoid the ground of rejection based on the nonstatutory, judicially created doctrine of obviousness-type double patenting, in lieu of presenting any argument in these documents that specifies errors in this ground of rejection or any other reason which causes this ground of rejection to be in error as provided in 37 CFR § 1.192(c)(8)(v) (1999). *See also* MPEP § 1206 (7th ed., July 1998). An appeal will be dismissed for failure to argue a ground of rejection involving all the appealed claims. *See* MPEP § 1214.06, V. Appeal Dismissed, and § 1215.04 (7th ed., July 1998).

The practice with respect to the filing of a terminal disclaimer to avoid a *nonstatutory* double patenting rejection is a long standing one and is set forth in 37 CFR § 1.130(b) (1999);

2003) and MPEP § 804.02, II. Nonstatutory (7th ed., July 1998; 8th ed., Rev. 1, Feb 2003), the latter providing in pertinent part (emphasis supplied):

A terminal disclaimer filed to obviate a double patenting rejection is effective only with respect to the application identified in the disclaimer, unless by its terms it extends to continuing applications. *If an appropriate double patenting rejection of the nonstatutory type is made in two or more pending applications, an appropriate terminal disclaimer must be filed in each application.*

Claims that differ from each other . . . whether or not the difference is obvious, are not considered to be drawn to the same invention for double patenting purposes under 35 U.S.C. 101. In cases where the difference in claims is obvious, terminal disclaimers are effective to overcome double patenting rejections. However, such terminal disclaimers must include a provision that the patent shall be unenforceable if it ceases to be commonly owned with the other application or patent. Note 37 CFR 1.321(c).

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See also MPEP § 804.02, III. Terminal Disclaimer Required Despite Request To Issue On Common Issue Date (7th ed., July 1998; 8th ed., Rev. 1, Feb 2003).

In view of this practice, we accepted appellant's statement of intent to file a terminal disclaimer in the *present* application as an appropriate response to the ground of rejection in lieu of an argument based on error in the ground of rejection. Indeed, the appeal in the present application involves *only* the record of the present application. However, it is the filing of the terminal disclaimer in the present application and not the intent to file such a document, that would avoid the ground of rejection based on the nonstatutory judicially created doctrine of obviousness-type double patenting. Therefore, until such time as this document is filed, the ground of rejection of all of the appealed claims based on the nonstatutory, judicially created doctrine of obviousness-type double patenting stands in the present application and indeed, is affirmed on appeal. Thus, this ground of rejection has the same standing as any other affirmed ground of rejection upon the disposition of an appeal.

Accordingly, the relief which appellant seeks is subsequent to the final decision by the Board and thus, not within the purview of the Board. Therefore the application must be taken up with the examiner in a manner consistent with current examining practice and procedure. We note in this respect that 37 CFR § 1.197(a) (2003) provides that “[a]fter decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant’s right of appeal or other review, for such further action by appellant or by the examiner, as the

condition of the application may require, to carry into effect the decision.” The policy of the Board of Patent Appeals and Interferences to retain the file of the application during the time period in which appellant can appeal the decision by the Board, *see* 37 CFR § 1.304 (2003), related to appellant (request, pages 3-4), is administrative with respect to the movement of application files, and is not based on any statute, rule or practice which restricts further action in the application by appellant and/or the examiner. Indeed, there are no restraints on appellant filing any communication or otherwise contacting the examiner with respect to the application. For prosecution subsequent to a decision by the Board, *see* 37 CFR 1.198 (2003); MPEP § 1214.07 (8th ed., Rev. 1, Feb 2003).

We have granted appellant’s request to the extent that we have reconsidered our decision of July 29, 2003 (Paper No. 50), but we deny the request with respect to making any changes therein.

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

DENIED

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| CHUNG K. PAK |) | |
| Administrative Patent Judge |) | |
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| CHARLES F. WARREN |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
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| PETER F. KRATZ |) | |
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