

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ASAHI/AMERICA INC.

Appeal No. 93-2933
Reexamination Control No. 90/002,336¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, and
FRANKFORT and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

ON REQUEST FOR RECONSIDERATION

Pursuant to 37 CFR § 1.197(b), the appellant requests reconsideration of our decision, dated August 23, 1996, on remand from the United States Court of Appeals for the Federal Circuit (Paper No. 36). In this decision:

¹ Request filed May 1, 1991 for the Reexamination of U.S. Patent No. 4,930,544, issued June 5, 1990, based on Application 07/260,444, filed October 20, 1988; which is a division of Application 07/066,936, filed June 25, 1987, now U.S. Patent No. 4,786,088, issued November 22, 1988.

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a) we concurred with the examiner's determination that the 37 CFR § 1.131 declarations made of record by the appellant were not effective to swear back of U.S. Patent No. 4,779,652 to Sweeney and remove it as a prior art reference with respect to the subject matter on appeal because this patent claims the same patentable invention, as defined in 37 CFR § 1.601(n), as the rejected invention; and

b) we reaffirmed the examiner's decision to reject claims 1 through 3 under 35 U.S.C. § 102(e) as being anticipated by the Sweeney patent.²

The appellant's request for reconsideration (Paper No. 38) was submitted with, inter alia, a petition under 37 CFR § 1.183 (Paper No. 41) requesting "suspension of the portion of Rule [37 CFR § 1.]131 that incorporates the 'obvious in view of' provisions of Rule [37 CFR § 1.]601(n)" (page 1). This petition has since been granted by the Patent Legal Administrator, Office of

² We initially affirmed the examiner's decision to reject claims 1 through 3 under 35 U.S.C. § 102(e) as being anticipated by Sweeney in an earlier decision dated August 18, 1993 (Paper No. 29). In this earlier decision, we also reversed the examiner's decision to reject claims 1 through 3 under 35 U.S.C. § 102(a) as being anticipated by Sweeney, to reject claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Sweeney in view of U.S. Patent No. 4,157,194 to Takahashi, and to reject claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Sweeney in view of U.S. Patent No. 2,475,635 to Parsons.

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the Deputy Assistant Commissioner for Patent Policy and Projects
(Paper No. 43).

The examiner's position in this appeal with regard to the
appellant's 37 CFR § 1.131 declarations was

(1) that the evidence submitted is insufficient to
establish conception of the invention prior to the
effective date of the Sweeney reference and (2) that a
131 declaration was not considered applicable since the
Sweeney reference was considered to claim "the same
patentable" invention as defined in 37 CFR § 1.601(n)
[main answer, Paper No. 23, page 11, emphasis in the
original]

In its decision (Paper No. 33), the United States Court
of Appeals for the Federal Circuit found that the appellant's
declarations establish actual reduction to practice of the
appellant's invention prior to the filing date of the Sweeney
patent. This finding meets the first of the examiner's concerns.

In our decision on remand from the court (Paper No. 36), we
implicitly found, and hereby explicitly confirm, that the
appellant's claims and Sweeney's claims are not directed to the
same invention. This finding, coupled with the suspension of the
portion of 37 CFR § 1.131 that incorporates the "obvious in view
of" provisions of 37 CFR § 1.601(n), meets the second of the
examiner's concerns.

In this light, the examiner's position that the appellant's
37 CFR § 1.131 declarations are not effective to swear back of

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Sweeney is no longer valid. Since it is not apparent why the declarations otherwise would be ineffective to swear back of Sweeney, we consider Sweeney to be removed as a prior art reference with respect to the subject matter on appeal. It follows that the standing 35 U.S.C. § 102(e) rejection of claims 1 through 3 as being anticipated by Sweeney cannot now be sustained. Therefore, the appellant's request for reconsideration is granted to this extent.

To summarize the outcome of this appeal in its entirety, the decision of the examiner:

a) to reject claims 1 through 3 under 35 U.S.C. § 102(a) as being anticipated by Sweeney is reversed;

b) to reject claims 1 through 3 under 35 U.S.C. § 102(e) as being anticipated by Sweeney is reversed;

c) to reject claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Sweeney in view of Takahashi is reversed; and

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d) to reject claims 4 and 5 under 35 U.S.C. § 103 as being unpatentable over Sweeney in view of Parsons is reversed.

GRANTED

BRUCE H. STONER, Jr. Chief)	
Administrative Patent Judge)	
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)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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Gerald E. Hespos
Casella & Hespos
274 Madison Avenue
New York, New York 10016

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JPM/jrg

APPEAL NO. 93-2933 - JUDGE McQUADE
APPLICATION NO. 90/002,336

APJ McQUADE

APJ FRANKFORT

Chief APJ STONER

DECISION: **GRANTED**

Typed By: Jenine Gillis

DRAFT TYPED: 14 Jul 97

Revision: 15 Jul 97

FINAL TYPED: