

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE**

Ex parte JOACHIM GANTE, HORST JURASZYK,
PETER RADDATZ, HANNS WURZIGER,
SABINE BERNOTAT-DANIELOWSKI, GUIDO MELZER,
MATHIAS WIESNER, and CLAUD FITTSCHEN

Appeal No. 1999-1686
Application No. 08/552,206

ON REQUEST FOR REHEARING

Before STONER, Chief Administrative Patent Judge; HARKCOM, Vice Chief Administrative Patent Judge; and WILLIAM F. SMITH, Administrative Patent Judge.¹

WILLIAM F. SMITH, Administrative Patent Judge.

ON REQUEST FOR REHEARING

In the original decision and supporting opinion entered on January 30, 2002, we reversed two rejections and vacated a third. It is the latter action which appellants request rehearing. Specifically, appellants ask:

¹ Senior Administrative Patent Judge (SAPJ) McKelvey served on the merits panel which rendered the original decision in this appeal. Subsequent thereto, SAPJ McKelvey retired from the USPTO. Accordingly, Vice Chief Administrative Patent Judge Harkcom has been designated as a member of the merits panel to decide this request. Compare In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

- A. If the PTO insists on this law-based approach to solve its Markush claim problem, it is requested that the Board withdraw its remand, reinstate the examiner's Markush rejection after considering the additional facts outlined below and permit applicants to appeal to the Federal Circuit so that the patent community can get that court's first take on this issue.

- B. Alternatively, if the Board prefers, it is respectfully submitted, to respect clear precedent, then, it is requested that it withdraw its remand, confirm the propriety of appellant's [sic] Markush group, and leave it to the director to establish a fair procedure to limit unreasonable searching burdens caused by Markush claims.

We decline to take either action.

As explained at page 12 of our original opinion, "[r]ather than reverse the rejection, we believe it more appropriate to vacate the rejection and remand the application to the examiner for fact-finding in the first instance with respect to the Markush issue." We then set forth certain factors which we believe relevant in determining whether a Markush group is proper. As made clear at page 20 of our opinion "nothing in this opinion should be construed as precluding a further rejection of the claims based on (1) an improper Markush or other group or (2) prior art uncovered as a result of an examination on the merits of the R¹ embodiments of claim 1 which are not phenyl embodiments, matters on which we express no opinion on the merits" (emphasis added).

The substance of appellants' request takes issue with our observations concerning factors which may be relevant in determining whether a Markush group is proper. We decline to reinstate the examiner's rejection as requested because, as set forth in detail in our original opinion, the examiner failed to make appropriate findings of fact to support such a rejection. In making our observations in regard to improper

Markush groups, we made clear that we were not making such findings but, rather, delineating factors which may prove helpful in resolving the issue. What is needed is a reasoned exchange of views by the examiner and applicants in the context of an ex parte examination/prosecution, not in the context of a request for rehearing in an appeal proceeding before this board.

Nor do we find appellants' proposed alternative relief that we "confirm the propriety of appellants' Markush group" appropriate. Again, as explained in our original opinion, we believe there is a substantive issue in this application concerning whether the Markush group set forth in the claims on appeal is proper. By vacating the examiner's rejection and remanding the application to the examiner to further consider the issue, appellants will have their "day in court" in front of the examiner in the context of an ex parte examination where this issue can be fully explored. Any further action in this application by the examiner will undoubtedly take into account the views expressed by appellants in their request for rehearing before this board. It may be that the examiner will determine that the claims do not contain an improper Markush group which would end the matter. On the other hand, if the examiner does determine that the claims contain an improper Markush group, he will undoubtedly reopen prosecution and institute such a rejection in a manner which provides appellants a full and fair opportunity to respond. It is only after such a reasoned exchange of views that this board will be in a position to finally determine the matter.

We have carefully reviewed appellants' request for rehearing but decline to change our decision in any manner.

REHEARING DENIED

Bruce H. Stoner, Jr., Chief
Administrative Patent Judge

Gary V. Harkcom, Vice Chief
Administrative Patent Judge

William F. Smith
Administrative Patent Judge

)
)
)
)
)
) BOARD OF PATENT
) APPEALS AND
)
) INTERFERENCES
)
)

Appeal No. 1999-1686
Application No. 08/552,206

Page 5

Millen, White, Zelano, & Branigan
Arlington Courthouse Plaza I, Suite 1400
2200 Clarendon Boulevard
Arlington, VA 22201

dem