

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 67

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD M. EVANS, ESTELITA S. ONG
and ANTHONY E. ORO

Appeal No. 2003-1608
Application No. 08/425,716

ON BRIEF

Before WINTERS, WILLIAM F. SMITH, and ADAMS, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 26, 31, 35, 36 and 43, which are all the claims pending in the application.

Claim 26 is illustrative of the subject matter on appeal and is reproduced below:

26. An isolated *Drosophila melanogaster* knirps-related receptor polypeptide having the sequence set forth in Figure 2.

The reference relied upon by the examiner is:

Oro et al. (Oro), "The *Drosophila* gene knirps-related is a member of the steroid-receptor gene superfamily," Nature, Vol. 336, pp. 493-496 (1988)

GROUND OF REJECTION

Claims 26, 31, 35, 36 and 43 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on an insufficient disclosure to support or enable the claimed invention.

Claims 26, 31, 35, 36 and 43 stand rejected on the grounds of res judicata as the issue and evidence of record in this appeal is exactly the same as the issue and evidence of record in Board of Patent Appeals and Interference, Appeal No. 1999-1361. See, Decision on Appeal No. 1999-1361 (Paper No. 48, entered January 31, 2001), affirming the rejection of claims 26, 31, 35, 36 and 43 under 35 U.S.C. § 112, first paragraph, as being based on an insufficient disclosure to support or enable the claimed invention.

We affirm.

BACKGROUND

Appellants accurately characterize the events leading to this appeal (Brief, page 6). On January 31, 2001, the Board of Patent Appeals and Interference entered a Decision on Appeal in Appeal No. 1999-1361, affirming the rejection of claims 26, 31, 35, 36 and 43 under 35 U.S.C. § 112, first paragraph, as being based on an insufficient disclosure to support or enable the claimed invention.

In response to this Decision on Appeal, appellants filed a request to establish a Continued Prosecution Application on April 2, 2001. On May 1, 2001, the examiner issued an Office Action finally rejecting claims 26, 31, 35, 36 and 43 under 35 U.S.C. § 112, first paragraph, as being based on an insufficient

disclosure to support or enable the claimed invention; and on the grounds of res judicata.

On October 1, 2001, appellants filed a response to this final Office Action, accompanied by a declaration under 37 CFR § 1.132.

On October 15, 2001, the examiner issued an Advisory Action stating, inter alia, "... an 'opinion' declaration, does not obviate the prior Board decision." Paper No. 54, page 1. We note that the examiner did not check either box 6(a) ("the affidavit ... has been considered"), or box 7 ("the affidavit ... will not be considered") of the Advisory Action. Id. While the examiner's treatment of the declaration in the Advisory Action may have been ambiguous, the Answer (page 2) clearly states, appellants' "[d]eclaration was not entered because it constitutes new evidence submitted after-final. ... 37 CFR § 1.116 and 37 CFR § 1.195."

At this time, instead of seeking administrative relief under 37 CFR § 1.181, appellants filed a Reply Brief. However, as set forth in MPEP § 715.08, "[r]eview of an examiner's refusal to enter an affidavit as untimely is by petition and not by appeal to the Board of Patent Appeals and Interferences. In re Deters, 515 F.2d 1152, 185 USPQ 644 (CCPA 1975); Ex parte Hale, 49 USPQ 209 (Bd. App. 1941)."

DISCUSSION

There can be no doubt that by denying entry of appellants' declaration, the record now before this Merits Panel is exactly the same as the record in Appeal No. 1999-1361. See e.g., Reply Brief, page 5, "[t]he declaration

submitted clearly is necessary to supplement the record, ... because in its absence, the record is the same as that in the prior appeal.”

Accordingly, appellants now request the Board to “order the entry of the previously filed response into the record.” Reply Brief, page 9. The Board, however, does not have the authority to grant this request. MPEP § 715.08. We note that a similar situation occurred in In re Berger, 279 F.3d 975, 984-85, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002). In this case, appellant argued that the examiner abused his discretion by refusing to enter the amendments Berger submitted after final rejection of the claims. The court found,

this issue may be the subject of a petition to the Commissioner, but may not be reviewed by the Board in connection with a rejection of claims. ...

The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion. If there is an abuse of discretion, the matter may be remedied by a Rule 181 petition to the Commissioner of Patents. Ultimate judicial review of such matters of practice and procedure may be had in District Court. This court, like the Board of Appeals, does not consider the issue of whether the examiner's refusal to enter the proposed amendment after final rejection constituted an abuse of discretion on his part. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967).

These views were further confirmed in In re Hengehold:

There are a host of various kinds of decisions an examiner makes in the examination proceeding — mostly matters of a discretionary, procedural or nonsubstantive nature — which have not been and are not now appealable to the board or to this court when they are not directly connected with the merits of issues involving rejections of claims, but

traditionally have been settled by petition to the Commissioner.
440 F.2d 1395, 1403, 169 USPQ 473, 479 (CCPA 1971).

Regulations promulgated by the PTO are consistent with these views:

From the refusal of the primary examiner to admit an amendment, in whole or in part, a petition will lie to the Commissioner under §1.181.

37 C.F.R. §1.127 (2000).

The discretionary decision of the examiner to refuse to enter Berger's amendments submitted after final rejection is not reviewable by this court in this proceeding.

As the examiner explains (Answer, page 2), entry of “new evidence in an application on appeal is not a matter of right’ especially when no ‘good and sufficient reasons why they are necessary and were not earlier presented’ have been made by [a]ppellant[s], in accordance with 37 CFR § 116 or 37 CFR § 195.” See In re De Blauwe, 736 F.2d 699, 705 n.9, 222 USPQ 191, 197, n. 9 (Fed. Cir. 1984). As MPEP § 1002.02(c)(3) makes clear,

Petitions invoking the supervisory authority of the Commissioner under 37 CFR [§] 1.181 involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal (37 CFR 1.191) and not otherwise provided for, as for example: ... (e) relative to formal sufficiency and propriety of affidavits under 37 CFR [§] ... 1.132 (MPEP § 716)....

Accordingly, the discretionary decision of the examiner to refuse to enter appellants’ declaration is a petitionable matter and is not susceptible to review by the Board.

As the record stands before us on appeal, appellants’ declaration has not been entered. Therefore, as appellants recognize (Reply Brief, page 5), the record before us is the same as that in the prior appeal. Accordingly, we are compelled to reaffirm the rejection of claims 26, 31, 35, 36 and 43 under 35

U.S.C. § 112, first paragraph, as being based on an insufficient disclosure to support or enable the claimed invention.

Furthermore, since the issue and evidence of record in this appeal is exactly the same as the issue and evidence of record in Appeal No. 1999-1361 we affirm the rejection of claims 26, 31, 35, 36 and 43 on the grounds of res judicata.

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

AFFIRMED

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SHERMAN D. WINTERS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. SMITH)	
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Appeal No. 2003-1608
Application No. 08/425,716

Page 7

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