

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte GABRIEL LOPEZ-BERESTEIN,
ANA M. TARI and RALPH B. ARLINGHAUS

Appeal No. 2005-0740
Application No. 08/679,437

ON BRIEF

SCHAFER,¹ ELLIS and SCHEINER, Administrative Patent Judges.
ELLIS, Administrative Patent Judge.

REQUEST FOR REHEARING

On July 29, 2005, this merits panel issued a final decision affirming the examiner's rejection of claims 1-12, 15 and 16. In addition, the panel entered a new ground of rejection (37 CFR § 41.50(b)) with respect to claims 13, 14 and 17-28.

On September 29, 2005, the appellants submitted a Request for Rehearing.

The Request for Rehearing is DENIED.

¹ Judge Schafer was substituted due to the unavailability of Judge Mills.

The appellants outline the prosecution history starting with the filing of their Appeal Brief on December 29, 1997, as follows (Request, p. 2):

1. A Supplemental Appeal Brief was submitted on December 28, 2001.
2. An Examiner's Answer was mailed on February 26, 2002.
3. A Reply Brief was filed on April 26, 2002, after which the present application was sent to the Board of Appeals and Interferences.
4. On September 22, 2003, an administrator at the Board remanded the application to the examiner to provide copies of the Brief filed January 2, 1998 and the Reply Brief filed March 4, 1998.
5. The appellants submitted an Amendment to cancel claims 1, 3, 7, 9, 11, 13, 14 and 15 and to amend claims 17 and 20 on December 18, 2002 (see Exhibit 1).
6. On June 12, 2003, Supervisor Patent Examiner LeGuyader denied entry of the appellants' request stating that "said amendment would raise new search and examination issues that have not been considered heretofore. . . . This amendment would raise new prior art issues because a new search would be required. Accordingly entry is not considered and is denied." The examiner further stated that "the proposed amendment to cancel claims 1, 3, 7, 9 and 11-13, if filed separately, would be entered since cancellation [sic, cancellation] of said claims would reduce the issues on appeal." Exhibit 2.

7. The appellants submitted an amendment to Examiner Wang on July 16, 2003, which cancelled claims 1, 3, 7, 9, 11, 13-15, 17 and 20. Exhibit 3.
8. According to the appellants, the July 16, 2003 Amendment was posted on the Private Pair site “with a handwritten note on the first page indicating “Please Enter” (see Exhibit 4). The note is initialed ‘JDS,’ and is dated 8-12-03.”

The appellants now request that the Decision on Appeal of July 29, 2005 be withdrawn and a new Decision be entered which is directed to claims 2, 4, 8, 10, 12, 16, 18, 19 and 21-28. Request, p. 4. The request is denied for several reasons.

First, although the appellants argue that the Private Pair site contains a posting of their amendment requesting cancellation of the aforementioned claims which has a notation which directs its entry, the paper provided in Exhibit 4 is not evidence that the amendment was ever entered into the file. In 2003, the practice in the U.S. Patent and Trademark Office for entering such an amendment involved several steps. First, the examiner made a notation on the first page of the amendment indicating that it was “OK to enter.” Second, the examiner took the entire patent application to a designated file clerk who “entered” the amendment by crossing out the relevant claims throughout the file and on the file wrapper. Third, the examiner mailed an advisory action to the applicant stating that the amendment had been entered. Finally, if the case was on appeal, the examiner amended the briefings to reflect the change in status of the claims.

The problem here is that even if we assume, arguendo, that the paper attached as Exhibit 4 was posted on the Public Pair site, at best, it is only evidence of

someone's² intent to have the amendment entered,³ but it is not evidence that it actually was. The appellants have not provided a copy of the file wrapper showing the claims were actually cancelled, or receipt of an advisory action from the examiner stating that the claims had been cancelled. It goes without saying, the appellants did not submit a supplemental briefing to the Board. Accordingly, absent evidence that the aforementioned claims were cancelled, we decline to revise our Decision on Appeal.

Second, the cancellation of claims in the manner requested by the appellants raises new issues which have not been briefed. That is, the appellants' amendment requests, inter alia, the cancellation of claim 17. We point out that claims 18-19 and 21-28⁴ are dependent on claim 17. Thus, should the appellants' amendment be entered now, these claims, standing alone, would raise indefiniteness issues (35 U.S.C. § 112, second paragraph). Accordingly, the entry of the appellants' amendment is not

² We point out that the appellants have not provided any explanation or evidence as to who "JDS" is.

³ Contrary to the appellants' argument (Request, p. 3, line 1), there is a discrepancy between the claims the examiner agreed to cancel (claims 1, 3, 7, 9 and 11-13) and those which the appellants' amendment requests cancellation (claims 1, 3, 7, 9, 11, 13-15, 17 and 20). Thus, it is not clear that there was ever a meeting of the minds between the appellants and the examiner as to which claims could be cancelled.

⁴ The appellants' amendment requests cancellation of claim 20, which is also dependent on claim 17.

simply a matter of removing claims,⁵ but it requires this merits panel to consider issues which have not been briefed. We decline to revise our Decision on Appeal in this regard.

Accordingly, in view of the foregoing, the Request for Reconsideration is denied.

DENIED

<u>/Richard E. Schafer/</u> RICHARD E. SCHAFER Administrative Patent Judge))))))) BOARD OF PATENT
<u>/Joan Ellis/</u> JOAN ELLIS Administrative Patent Judge))) APPEALS AND))) INTERFERENCES
<u>/Toni R. Scheiner/</u> TONI R. SCHEINER Administrative Patent Judge))

⁵ We point out the new rules governing the appeals process which took affect September 13, 2004, include 37 CFR § 41.33 which states, in relevant part, that

Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

- (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

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JE/jlb

David L. Parker
Fulbright & Jaworski
600 Congress Avenue
Suite 2400
Austin, TX 78701

(2) To rewrite dependent claims into independent form.