

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 JOHN CHU CHEN and
JAMES KENNETH WEDDELL

Appeal 2006-1781
Application 10/230,015
Technology Center 1700

Decided: September 28, 2006

Before KRATZ, GAUDETTE, and TIMM, *Administrative Patent Judges*.
KRATZ, *Administrative Patent Judge*.

REMAND

On consideration of the record, we determine that the above-identified application is not ready for a final decision on appeal under 35 U.S.C. §134. Accordingly, we remand this application to the Examiner for further consideration and action not inconsistent with our opinion below. 37 C.F.R. § 41.50(a)(1).

As evident by a review of the Briefs and the Answer, issues of overlapping ranges appear to be involved in at least several of the four anticipation rejections maintained by the Examiner. See, for example, the paragraph bridging pages 4 and 5 and page 8 of the Answer and the Amended Brief at pages 10-12.

On December 20, 2005, the case of *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 77 USPQ2d 1321 (Fed. Cir. 2005) was decided. Thereafter, *Atofina v. Great Lakes Chem. Corp.* 441 F.3d 991 78 USPQ2d 1417 (Fed. Cir. 2006) was decided. In those cases, our reviewing court addressed anticipation issues that appear to involve applied prior art that disclosed a component that is used in a process, in terms of ranges, as in *Perricone*, or a reactant and a process condition in terms of ranges, as in *Atofina*, as applied to claims that included corresponding narrower and/or overlapping range limitations for those items.¹

Neither the Examiner nor the Appellants address the recent holdings in the *Perricone* and/or *Atofina* decisions with regard to the issues in the anticipation rejections advanced by the Examiner in this appeal. In this regard, *Atofina* was decided after the Certificate of Mailing date (March 20, 2006) associated with Appellants' Reply Brief.

Consequently, we remand this application to the Examiner to review those anticipation rejections in light of the recent *Perricone* and *Atofina* decisions. The Examiner should submit a Supplemental Examiner's Answer explaining how the respective holdings of our reviewing court in each of those cases (especially *Atofina*) can be regarded as being consistent with

¹ Also, see Section 2131.03 of the most recent edition (Rev. 5, Aug., 2006) of the Manual of Patent Examining Procedure.

regard to any anticipation rejection that the Examiner continues to maintain subsequent to this Remand.

In addition, the Examiner should revisit the Brief and Reply Brief for a review of the arguments and evidence furnished by Appellants with respect to any anticipation and/or obviousness rejection(s) being maintained subsequent to this Remand. Those arguments and evidence should be taken into account, and addressed as may be appropriate, in any supplemental answer furnished in response to this Remand.

This Remand to the Examiner pursuant to 37 C.F.R. ' 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. ' 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this Remand by the Board.

REMANDED

PFK/tf

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