

1 The opinion in support of the decision being entered today was *not* written
2 for publication and is *not* binding precedent of the Board.
3

4
5 UNITED STATES PATENT AND TRADEMARK OFFICE
6

7
8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
10

11
12 *Ex parte* JOHN RICCI, HAROLD ALEXANDER, HARRIET T. NAIMAN,
13 BRUCE L. HOLLANDER, and INGO KOZAK
14

15
16 Appeal 2006-2017
17 Application 09/784,284
18 Technology Center 3700
19

20
21 Decided: March 2, 2007
22
23
24

25 Before HUBERT C. LORIN, JENNIFER D. BAHR, and
26 ANTON W. FETTING, *Administrative Patent Judges*.

27
28 LORIN, *Administrative Patent Judge*.
29

30 ORDER REQUIRING APPELLANTS TO BRIEF AN ADDITIONAL
31 MATTER
32

33 The decision of the Examiner rejecting claims 2, 3, 8-10, 15-17, 22-24
34 and 29 over the prior art is appealed. 35 U.S.C. § 134 (2002). We have
35 jurisdiction under 35 U.S.C. § 6 (b) (2002).

1 Our review of the record leads us to conclude that this appeal is not in
2 a condition for a decision. Pursuant to 37 C.F.R. § 41.50, we order
3 appellants to submit a supplemental brief addressing the issue discussed
4 below.

5 The Examiner has rejected claims 2, 3, 8-10, 15-17, 22-24 and 29 over
6 Naiman (US Patent 5,607,607) under 35 U.S.C. § 102(e).

7 There is no dispute that Naiman describes the claimed subject matter.
8 The issue is whether Naiman is available as prior art under 35 U.S.C. §
9 102(e) such that Appellants may, as has been done here (see Declaration
10 filed October 8, 2002), submit an affidavit under 37 C.F.R. § 1.131 to
11 antedate Naiman and thus attempt to overcome the rejection.

12 It does not appear from the record that the effective filing date of the
13 claims on appeal has been determined. This is important because the
14 09/784,284 ('284) application is stated to be a continuation-in-part of
15 application 09/500,038 ('038), now U.S. Patent 6,419,491, filed February 8,
16 2000, and the '038 application is stated to be a continuation-in-part of
17 application 08/996,244¹ ('244), now abandoned, filed December 22, 1997.
18 See p. 1 of the specification of the '284 application. If the present claims are
19 not entitled to the benefit under 35 U.S.C. § 120 of the earlier filing dates of
20 the '038 and '244 applications, Naiman, which issued on March 4, 1997
21 qualifies as prior art under 35 U.S.C. § 102(b). *In re Katz*, 687 F.2d 450,
22 454, 215 USPQ 14, 17 (CCPA 1982). A patent describing the claimed
23 invention available as prior art under 35 U.S.C. § 102(b) stands as a

¹ Page 1 of the Specification incorrectly refers to the application as
"08/996,224."

1 statutory bar and cannot be antedated through an affidavit filed under 37
2 C.F.R. § 1.131. See 37 C.F.R. § 1.131(a)(2) (2004).

3 Appellants have made a claim of priority under 35 U.S.C. § 120 (see
4 the Oath filed February 16, 2001). However, the requirements of 35 U.S.C.
5 § 120 must be met before claims in an application are *entitled* to the benefit
6 of the filing date of any earlier-filed application to which Appellants have
7 made a claim of priority under 35 U.S.C. § 120. In the case before us, in
8 order for the claims on appeal to be entitled to the benefit of the filing dates
9 of the '038 and '244 applications under 35 U.S.C. §120, the record must
10 show that the '038 and '244 applications contain a disclosure which
11 complies with 35 U.S.C. § 112, first paragraph, for each claim in the
12 subsequently filed '284 application. *Studiengesellschaft Kohle m.b.H. v.*
13 *Shell Oil Co.*, 112 F.3d 1561, 1564-65, 42 USPQ2d 1674, 1677-78 (Fed. Cir.
14 1997).

15 To settle any question that Naiman is a statutory bar to the patenting
16 of the claims on appeal, Appellants must analyze each application in the
17 train of earlier-filed applications to see if they contain a disclosure which
18 complies with 35 U.S.C. § 112, first paragraph, for each claim in the
19 subsequently filed '284 application and make the necessary findings
20 showing that the claims on appeal are entitled to the benefit under 35 U.S.C.
21 § 120 of the filing dates of at least the '038 and '244 applications.

1 Appellants are given a time period of **TWO MONTHS** from the date
2 of mailing of this order within which to respond to the order. Extension of
3 this time period under 37 C.F.R. § 1.136(a) will not be permitted. Failure to
4 timely comply with this order may result in the sua sponte dismissal of the
5 appeal.

6 ORDER UNDER 37 C.F.R. § 41.50

7

8

9

10

11

12

13

14

15

16

17

18

19

20 hh

21

22

23

24 *MELVIN K. SILVERMAN*
25 *500 WEST CYPRESS CREEK ROAD*
26 *SUITE 500*
27 *FORT LAUDERDALE, FL 33309*