

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN CHU CHEN
and JAMES KENNETH WEDDELL

Appeal 2007-1682
Application 10/230,015
Technology Center 1700

Decided: December 18, 2007

Before PETER F. KRATZ, CATHERINE Q. TIMM, and LINDA M. GAUDETTE, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Appellants' submission (reply) filed September 17, 2007, which submission was styled as a Request for Rehearing under 37 C.F.R. § 41.52, is construed as a request to reopen prosecution of the Application before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1). Accordingly, this application is remanded to the jurisdiction of the Examiner for reopening prosecution and consideration of the aforementioned submission. Our reasoning follows.

In the prior Decision dated July 17, 2007, in Appeal No. 2007-1682, a new ground of rejection of all of the pending claims (claims 1-42) under the second paragraph of 35 U.S.C. § 112, was entered by the Board pursuant to 37 C.F.R. § 41.50(b). The prior Decision stated that:

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the Examiner, in which event the proceeding will be remanded to the Examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

(Decision 6)

Thus, Appellants were presented with the choice of requesting a rehearing before the Board under 37 C.F.R. § 41.52 on the same record pursuant to 37 C.F.R. § 41.50(b)(2) or, in the alternative, requesting reopening of prosecution before the Examiner by submitting an appropriate amendment of the claims and/or new evidence relating to the rejected claims pursuant to 37 C.F.R. § 41.50(b)(1). Of course, 37 C.F.R. § 41.50(b) expressly provides for the selection of only one of the two options; that is, either proceeding under § 41.50(b)(2) or proceeding under § 41.50(b)(1), is permissible.

Here, Appellants' submission or reply, filed on September 17, 2007, refers to searches conducted subsequent to the previous Board Decision on September 17, 2007, and identifies seven U.S. patents as evidence in support of Appellants' argument against the propriety of the 35 U.S.C. § 112, second paragraph, new ground of rejection set forth in our previous Decision (Reply, 3-4). Appellants' submission of new evidence in the reply filed September 17, 2007 cannot be said to comprise the selection of a request for rehearing on the *same record* pursuant to 37 C.F.R. § 41.50(b)(2) notwithstanding the labeling provided by Appellants in the submission.

Hence, we determine that the submission filed September 17, 2007 is a request under 37 C.F.R. § 41.50(b)(1) to reopen the prosecution of this Application for consideration by the Examiner of the new evidence presented therein notwithstanding the use of the "Request for Rehearing" phraseology in the submission.¹

Accordingly, this Application is remanded to the Examiner for reopening prosecution and considering the submission filed September 17, 2007, including the evidence and arguments furnished therein, with respect to the new ground of rejection presented in the Board Decision mailed July 17, 2007. In so doing, the Examiner should take into account Appellants'

¹ See the penultimate sentence of MPEP § 1214.01, p. 1200-56 (Rev. 3, Aug. 2005) under the caption "II. REQUEST FOR REHEARING." This construction of Appellants' filed reply to the Board Decision as a choice to reopen prosecution before the Examiner is further reinforced by Appellants' reported participation in two telephonic interviews with the Examiner after the Board Decision was rendered and prior to this Remand of the Application to the Examiner's jurisdiction (Reply 6). See the Interview Summary dated August 07, 2007.

definition of the Coefficient of Restitution and Atti (PGA) Compression as furnished at pages 17 and 18 of the Specification, particularly wherein spacers or shims and a mathematical adjustment are described as being employed in measuring a PGA compression of polymer spheres of a smaller size than the golf balls than an Atti machine is disclosed as being designed for measuring. The Examiner should determine whether the additional evidence and argument supplied in the September 17, 2007 submission clarify how a particular E/X/Y copolymer has a unique reproducible Atti Compression for the copolymer itself, as claimed, such that the recited limitation respecting the Figure 1 triangle particularly points out a property of a claimed copolymer that is meaningful and the scope of which would be understood by one of ordinary skill in the art based on the description given in the Specification as to how Atti Compression testing is conducted on neat spheres of a differing size than the described Atti Compression Gauge is designed to measure. In this regard, we note that the compression of the shims and spheres are described as being measured together in the Specification (not the sphere alone) and mathematical adjustments applied thereto, as necessary (Specification 17-18). The Examiner should also consider whether or not the incorporated by reference copending Application No. 10/108,793, further attenuates any indefiniteness of the claimed subject matter because the incorporated by reference Specification furnishes a description of a neat sphere Atti Compression test without describing the use of shims or a mathematical adjustment being used in determining an Atti Compression value for a 1.53 inch diameter sphere in seeming contrast to

the testing criteria described at pages 17 and 18 of the instant Specification.² An understanding of the scope of the so rejected claims and the recited copolymer property limitation requires, at a minimum that the Atti Compression value and the Coefficent of Restitution value are both reasonably ascertainable with a reasonable degree of accuracy and would be reasonably reproducible for a given E/X/Y copolymer itself based on the testing criteria furnished in Appellants' Specification as it would have been understood by one of ordinary skill in the art. After all, the scope of the limitation and claims in question cannot be fairly determined if either or both of these property values are themselves incapable of being reasonably assessed for a given copolymer.

In reopening prosecution, the Examiner should apply any other grounds of rejection that are determined to be applicable to the pending claims upon reconsideration in light of the submission filed September 17, 2007. In particular, this is so with regard to any obviousness-type double patenting and/or prior art rejections that may be applicable if either (1) the claim scope can be ascertained given the augmented record; or, (2) the claims are determined to be indefinite but a reasonable assumption can be made respecting the claim scope given the additional evidence and argument submitted in the September 17, 2007 filing.

² See footnote 2 of the July 17, 2007 Board Decision.

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ORDER

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

REMANDED

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