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 GEOFFERY SCOTT MITCHELL,
CHRISTOPHER PAUL BURMESTER,
RUTH M. LASSMAN, and
CORINNE WAYSHAK

Appeal 2007-1928
Application 10/163,282
Technology Center 3700

Decided: August 28, 2007

Before WILLIAM PATE, III, TERRY J. OWENS, and MURRIEL E. CRAWFORD, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal from the Final Rejection of claims 119-301. Theses are the only claims remaining the application. It appears that the Appellants and the Examiner have overlooked the status of claims 138 and 139. Since these claims

have not been expressly allowed on the record, we have considered them as rejected under the grounds of rejection of claim 133 from which they depend.

We have jurisdiction under 35 U.S.C. § 134.

Appellants claim bits of material or confetti that are customizable. Claims 119, 142, and 205 are reproduced below as exemplary of the claimed subject matter.

> 119. A collection of bits of material, comprising a first plurality of bits of material, wherein each bit of material within the first plurality is individually customizable.
>
> 142. A collection of confetti, comprising a first plurality of unconnected pieces of confetti, wherein each piece of confetti within the first plurality is individually customizable.
>
> 205. A bit of material customizable on two or more sides.

The references of record relied upon by the Examiner as evidence of obviousness are:

Guertin	US 4,375,288	Mar. 1, 1983
Viveiros	US 5,083,783	Jan. 28, 1992
Walker	US 5,454,569	Oct. 3, 1995
Logan	US 5,683,251	Nov. 4, 1997
Jaffe	US 6,089,871	Jul. 18, 2000
Sterr	US 6,027,773	Feb. 22, 2000
Sterr	US 6,312,310 B1	Nov. 6, 2001

Claims 119 -127, 133, 136, *138, 139,* 137, 142-150, 156, 159-162, 165-171, 179-191, 199-202, 205-211, 217, 220-223, 226-232, 238, 241-244, 247-252, 260-263, 266-270, 278-281, and 284-301 stand rejected under 35 U.S.C. § 102 as anticipated by Guertin.

Claims 119-121, 124, 129, 133, 136, *138, 139,* 142, 143, 147, 152, 156, 159, 161, 168, 169, 173, 179, 182, 188, 189, 193, 199, 201, 207-209, 213, 220, 222, 229, 230, 234, 241, 243, and 278 stand rejected under 35 U.S.C. § 102 as anticipated by Sterr '310.

Claims 128-130, 151-153, 172-174, 192-194, 212-214, 233-235, 253-255, and 271-273 stand rejected under 35 U.S.C. § 103 as unpatentable over Guertin in view of Walker.

Claims 131, 154, 175, 195, 215, 236, 256, and 274 stand rejected under 35 U.S.C. § 103 as unpatentable over Guertin in view of Jaffe.

Claims 132, 155, 176, 196, 216, 237, 257, and 275 stand rejected under 35 U.S.C. § 103 as unpatentable over Guertin in view of Viveiros.

Claims 134,135, 157, 158, 177, 178, 197, 198, 218, 219, 239, 240, 258, 259, 276, and 277 stand rejected under 35 U.S.C. § 103 as unpatentable over Guertin

Claims 140, 141, 163, 164, 183, 184, 203, 204, 224, 225, 245, 246, 264, 265, 282, and 283 stand rejected under 35 U.S.C. § 103 as unpatentable over Guertin in view of Logan.

Claims 127, 150, 171, 191, 211, 232, 252, and 270 stand properly rejected under 35 U.S.C. § 103 as unpatentable over Sterr '301 in view of Sterr '773.

ISSUES

In view of the above-noted rejections, the issues presented for our decision are whether the Examiner has established the lack of novelty and the prima facie obviousness of the claimed subject matter.

FINDINGS OF FACT

1. Guertin discloses a game used to instruct players in how to do genealogical research. The game is played on a family tree 10 as shown in Figure 1, which has recesses 17 for the reception of tokens 18. The tokens carry facial indicia of selected ancestors. As the game is played, the players receive additional tokens, and game play consists of a race between the players to fill all slots 17 on each player's family tree 10. The game also includes a deck of cards 20. Presumably, the cards are less than 4 x 4 inches square.

2. Sterr '310 discloses specialty confetti dye-cut out of plastic foam. The foam is stacked into tube 34 and shot into the air using compressed gas. Sterr mentions the prior art uses paper such as tissue paper for making confetti. Also Sterr discloses that waste paper and other goods have often been used to make confetti. Sterr discloses many shapes for his die-cut foam pieces, and the pieces are die cut in stacks of foam sheets. Sterr believes that the foam confetti can provide an interesting memento of an occasion in which it is utilized. Sterr mentions that a logo or message maybe imprinted on the surface of the foam to enhance the unique confetti experience.

3. Walker discloses an African-American trivia game in which tokens or chips are used as games pieces. The token chips can be made of material such as paper, plastic or metal and can be luminescent, although metal is preferred. Further, Walker discloses a card with an image of a person on one side, as seen in Figure 5, and a descriptive text on the opposite side. Presumably, these cards are less than 4 x 4 inches square.

4. Jaffe discloses a mathematical board game which uses markers or chips 370 and random number generating dies as shown in Figure 3. The chips are colored coded and can be preferably manufactured of translucent plastic so that the game board shows through the translucent chips. The dies are three-dimensional objects customized with indicia such as prime numbers.

5. Viveiros discloses a poster game which is variation on the Pin the Tail on the Donkey game known by children for many years. In this case, hat tokens 23 are provided with perforated outlines so that they can be separated from the support base and used in game play.

6. Logan discloses a method of keeping track of dietary consumption. Figure 1 discloses a chart or board 1 that sticks to a refrigerator magnetically or by use of adhesive. A number of tokens are provided which removeably fasten to the game board, once again via adhesive or magnetic material.

7. Finally, Sterr '773 discloses dye cut confetti wherein the angular shape of the confetti gives a unique aerodynamic pattern of flight. Sterr discloses in column 7, ll. 10-21, that confetti is desirably less than four square inches.

PRINCIPLES OF LAW

Our reviewing court stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 75 USPQ2d 1321, 1327 (Fed. Cir. 2005), *cert. denied*, *sub nom. AWH Corp. v Phillips*, 126 S. Ct. 1332 (2006):

> The claims, of course, do not stand alone. Rather, they are part of "a fully integrated written instrument," *Markman*, 52 F.3d at 978, consisting principally of a specification that concludes with the claims. For that reason, claims "must be read in view of the specification, of which they are a part." *Id.* at 979. As we stated in *Vitronics*, the specification "is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term." 90 F.3d at 1582.

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. *Regents of Univ. of Cal. v. Eli Lilly and Co.,* 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), cert. denied, 523 U.S. 1089 (1998)(citing *Vas-Cath Inc. v. Mahurkar,* 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Id.* citing *Lockwood v. American Airlines, Inc.,* 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997) and *In re Gosteli,* 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the

written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Id.* citing *Lockwood,* 107 F.3d at 1572, 41 USPQ2d at 1966.

It is important to note that "[t]he invention is, for purposes of the 'written description' inquiry, whatever is now claimed." *Vas-Cath* at 1564, 19 USPQ2d at 1117.

Section 112, second paragraph, is satisfied if a person skilled in the field of the invention would reasonably understand the claim when read in the context of the specification. *Marley Mouldings Limited v Mikron Industries, Inc.,* 417 F.3d 1356, 1359, 75 USPQ2d 1954, 1956 (Fed. Cir. 2005) (citing *Union Pac. Res. Co. v. Chesapeake Energy Corp.,* 236 F.3d 684, 692, 57 USPQ2d 1293, 1297 (Fed. Cir. 2001) (the definiteness requirement set forth in § 112, ¶ 2 "focuses on whether those skilled in the art would understand the scope of the claim when the claim is read in light of the rest of the specification")); *Miles Labs., Inc. v. Shandon,* 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993) (if the claims "reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more"); *In re Moore,* 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971) (the indefiniteness inquiry asks whether the claims "circumscribe a particular area with a reasonable degree of precision and particularity").

The prior art may anticipate a claimed invention, and thereby render it non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.,* 301 F.3d 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907

(2003). Express anticipation occurs when the prior art expressly discloses each limitation (i.e., each element) of a claim. *Id*. In addition, "[i]t is well settled that a prior art reference may anticipate when the claim limitations not expressly found in that reference are nonetheless inherent in it." *Id*.

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). It is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. *See id.* at 1073, 5 USPQ2d at 1598. In so doing, the examiner is expected to make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), *viz.*, (1) the scope and content of the prior art; (2) the differences between the prior art and the claims at issue; and (3) the level of ordinary skill in the art. In addition to these factual determinations, the examiner must also provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) (*cited with approval in KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007)). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *Id.* at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. Obviousness is then determined on the basis of the evidence as a whole and the

relative persuasiveness of the arguments. *See Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444; *Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

The Court recently expounded on the obviousness determination in *KSR*, stating:

> The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.

KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397.

The Court further explained:

> When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740, 82 USPQ2d at 1396.

ANALYSIS

Turning first to a construction of the claim language on appeal, we turn to Appellant's specification for guidance. An image is defined as including a photograph, graphic, text, icon, or logo. Specification at 8:15. "Customized image" is used to refer to an image that has been selected and/or modified in shape,

size, content, or in any other manner so as to be personally expressive. Specification at 8:20. We note that the broadest claims refer not to a customized image but to a customizable bit of material. Thus, we infer that to customize a bit of material can refer merely to the selection of the size, shape, or content of the material. This interpretation is buttressed by express claim language. See, e.g., claims such as claims 123, 146, 167, etc.

Additionally, as we survey the claimed subject matter we are mindful of the full import of the expression "customizable." The suffix "–able" indicates in English that the word so modified "is capable of." Consequently, "customizable" denotes an article that can be, but is not required to be, custom-made. Note the following holding from *In re Collier,* 397 F.2d 1003, 1006, 158 USPQ 266, 268 (CCPA 1968), a decision of the predecessor to our reviewing court:

> "The main fault we observe in claim 17 is indefiniteness in the sense that things which may be done are not required to be done. For example, the ferrule or connector member is crimpable but not required, structurally, to be crimped; the ground wire "means," which we take to be a piece of wire, is for disposition under the ferrule but is not required to be disposed anywhere; it becomes displaced when the ferrule is crimped but that may never be, so far as the language of claim 17 is concerned. These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art."

The court is treating "crimpable" and like expressions as optional in the sense that crimping is not required. Thus, that some stock material is "customizable" relates to a situation which may never be. It is certainly not required by the express claim

language. Therefore, the customizable feature cannot be regarded as a structural limitation in any positive sense, and Appellants cannot rely on it to distinguish over the prior art. Consequently, the claims containing the customizable limitation are seen to read on mere bits of stock material or confetti made of such stock materials. As we read the above-noted case, the stock material does not have to possess the capability of being selectable and/or modifiable, since customizable indicates that being custom-selected or custom-modified is an optional feature of Appellants' invention. As such, claim 205, taken as an example, is directed merely to any article that has two or more sides, inasmuch as the article so claimed may never be required to be customized.

Stated another way, the court's analysis of the limitation of "crimpable" is that the claim is directed to two groups of articles—articles that are crimped and articles that are never required to be crimped. Since articles of the second group meet the claim, the expression "crimpable" cannot be regarded as a structural limitation that positively limits the claimed subject matter structurally.

We further note, however, that the Examiner has shown the prior art to contain stock materials and confetti that can be selected and/or modified, some prior art specifically customized by having an image printed thereon. So in this sense the Examiner's applied prior art is narrower than that required by Appellant's claims. This is not a problem for the Examiner, inasmuch as a species is anticipatory of a genus. *Titanium Metals Corporation of America v. Banner*, 778 F.2d 775, 782, 227 USPQ 773, 778 (Fed. Cir.1985) (holding that an earlier species disclosure in the prior art defeats any generic claim).

We affirm the anticipation rejection based on the Guertin reference. Appellants argue the tokens of Guertin are not customizable by the players. The claims do not state exactly who customizes the claimed subject matter. Additionally, as we understand Appellants' invention, the confetti or bits of material are customized by the manufacturer of the confetti not by the user or the recipient. Appellants further argue that Guertin does not teach confetti. Guertin teaches customized claim tokens of the size and material of Appellants' claimed confetti. Therefore, the tokens of Guertin are indistinguishable from Appellants' confetti. Consequently, we must hold that Appellants' claimed confetti lacks novelty over the tokens of Guertin. At any rate, this confetti argument is seen to only run to claims that specify confetti. We must remind Appellants that many of the claims in this group are directed simply to bits of material.

Appellants argue that the tokens of Guertin are not individually customizable. As can be seen these tokens have different images. Therefore, the tokens with different images have been individually customized. Furthermore, as noted above, customizable relates to a state that may not be used at all.

Presumably the tokens of Guertin have an image on one side thereof. We note that the cards of Guertin are printed with a different printed material on either side. Therefore, Guertin does disclose bits of material with two or more different

images. As to the process imagery which is an alteration of the source image, it is clear that the photographs on the tokens of Guertin have been processed from an original image, drawing, or photograph to be reduce in size and printed on the tokens. The Examiner has made the factual findings that this is the case. See, for example, Page 4, ll. 8-11 of the Answer. This factual finding has not been rebutted with any evidence by the Appellants.

Appellants argue in the Reply (Page 8) that the Examiner has stated that the tokens of Guertin can be customizable by being made round, flat, or not. Appellant states that this is not how "customizable" is used in the present application. In the paragraph preceding this argument, Appellant's discuss how an image can be customized by being selected or modified in shape, size or, content. It seems to be a fair inference on the part of the Examiner that a bit of material that is customizable can be a bit that is modified in size, shape, content or the like, as the Examiner has argued.

Appellants further admit that the tokens of Guertin may be replaced by actual photographs of a player's relatives. We note that Appellant has argued elsewhere that the tokens are not customizable by the user. We are of the view that replacing the tokens with actual photographs is using bits of material (photographic paper or the like) that have been customized by the user.

Finally to the extent that the claims on appeal are said to define over Guertin, or for that matter over Sterr, with respect to some bit of material or confetti bearing one graphic, design, word, image or logo and another bit having a different graphic, design, word, image or logo, or to bits, sets or pluralities having

different indicia, we remind Appellants that nonfunctional descriptive material cannot render nonobvious an invention that is otherwise obvious over the prior art. *In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983)(when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Our reviewing court and its predecessor have frequently cautioned the Patent and Trademark Office (PTO) that all claim limitations must be considered when determining patentability over the prior art. *In re Lowry,* 32 F.3d 1579, 1582-83, 32 USPQ2d 1031, 1034 (Fed. Cir. 1994) *quoting In re Gulack* 703 F.2d 1381, 1384, 217 USPQ 401, 403-04 (Fed. Cir. 1983). Furthermore, the Federal Circuit has cautioned against a liberal use of a printed matter rejection. *Id,* 32 F.3d at 15821-83, 32 USPQ2d at 1034. Nonetheless, we recognize in the instant case the classic printed matter situation in which Appellants are advancing patentability based on the content of individual indicia on the bits of material or confetti or the differences in these indicia one from another. These printed matter cases "dealt with claims defining as the invention certain novel arrangements of printed lines or characters, useful and intelligible only to the human mind." *Id.* quoting *In re Bernhart,* 417 F.2d 1395, 1399, 163 USPQ 611, 615 (CCPA 1969). Accordingly, although we will not disregard any claim limitations and will assess the claimed invention as a whole, we will follow the Federal Circuit's guidance as in the *Gulack* decision and will "not give any patentable weight to printed matter absent a new and unobvious functional relationship between the printed matter and the substrate." *Id.* (Emphasis supplied).

We also affirm the rejections of the claims rejected under § 102 as anticipated by Sterr '310. We agree with the Appellants that Sterr teaches specialty foam confetti. We further agree that Sterr teaches that a logo or message may be imprinted on the surface of the foam. We note that the foam confetti of Sterr '310 is three-dimensional. Appellants argue that Sterr does not teach that individual pieces of confetti are bits of material that are individually customizable. Customized as used by Appellants refer to selecting material, selecting the shape, or the size of the material, in addition to providing indicia on the material. It is clear that Sterr selects a material. He has a preferred foam. It is further clear that he selects the shape and size of the material, as many shapes are illustrated in the patent and presumably many shapes can be used at a single celebration. With respect to the Appellants' non-customizable arguments, found on page 20 of the Brief, we note that Sterr cuts foam shapes from a stack of rectangular sheets of foam. It may well be that the flashing or excess material could be consider as non-customizable bits of material. Furthermore, inasmuch as Appellants' definition of image includes text, graphics, or icon, the pieces of confetti of Sterr are seen to contain individually customizable images.

Appellants argue that the foam confetti of Sterr is not individually customizable. Reply at 10. Even if we were to consider the claims as directed to customized confetti, rather than to mere customizable bits of material, the import of this argument is that each of Appellants' bits of material are different from one another. Such a feature has not been claimed. In our view, the confetti of Sterr is

made of a material in a shape and size that has been selected by a customizer. Even if each of the pieces of confetti has this same shape or size choice applied to it, each individual piece has been customized in some way. Thus, each piece of confetti is individually customizable.

On Page 22 of the Brief, Appellants argue that the rejections of Claims 168, 169, 173, 139, 182, 188, 189, 193, 199, 201, 207-209, 213, 220, 222, 229, 230, 234, 241, 243, and 278 are improper in that the base claim from which these claims depend has not also been rejected under §102. While slightly irregular, we do not believe these rejections to be improper, and we will not reverse them solely on this ground.

With the respect to the rejections which add teachings from Walker, Jaffe, Viveiros, Logan, and Sterr '773 considered collectively with Guertin or Sterr '310 under § 103, we note Appellants have not provided separate arguments specifically directed to these references or to the combined teachings of these references taken with Guertin or Sterr '310. Therefore, we hold these claims to fall with the rejections of the independent claims from which they depend.

With respect to claims 134, 135, 157, 158, 177, 178, 197, 198, 218, 219, 239, 240, 258, 259, 276, and 277 as rejected under § 103 as unpatentable over Guertin, the Examiner has taken official notice that images created by digital computers are known in the art of printing and photography. We credit the official notice of the Examiner and are in agreement that it would have been obvious to use computer digital techniques for the art work in Guertin or for that matter the text, icon, or graphic in Sterr '310. Appellants have not provided any evidence to rebut

this finding by the Examiner.

REJECTIONS UNDER 37 C.F.R. § 41.50(b)

Claims 120, 143, 289, 290, 291, 295, 297, 298, 300, and 301 are hereby rejected under 35 U.S.C. § 112, first and second paragraphs. As defined by Appellants, and as discussed previously, "customized" is used to refer to material that has been selected and or modified in shape, size, or content. In our view making bits of material or confetti from stock material is either selecting material or modifying it in shape and/or size. Accordingly, it is difficult to imagine bits of material or confetti that are non-customizable, since any material must be selected, and must be sized and shaped. Accordingly, we enter the rejection of these claims under the first paragraph of § 112, inasmuch as non-customizable bits of material or confetti have not been described and enabled by Appellants in the Specification. We enter a rejection of theses claims under the second paragraph of § 112, inasmuch as we believe "non-customizable" as used in the claims conflicts with the definition given in Appellants' Specification.

CONCLUSION

The Examiner's rejections of all claims on appeal are affirmed. A new rejection of claims 120, 143, 289, 290, 291, 295, 297, 298, 300, and 301 under § 112, first paragraph, and § 112, second paragraph has been entered by the Board.

Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides "Appellant may file a single request for rehearing within two months from the date of the original decision of the Board."

In addition to affirming the Examiner's rejection(s) of one or more claims, this opinion contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 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 Appellant, *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. . . .

Should the Appellant elect to prosecute further before the examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C.§§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the Appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case

should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(vi)(effective Sept. 13, 2004).

AFFIRMED; 37 C.F.R. § 41.50(b)

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