UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. MILLER and CHRISTOPHER A. BODE

Appeal 2007-3809
Application 10/225,638
Technology Center 2800

Decided: March 17, 2008

Before KENNETH W. HAIRSTON, JOSEPH RUGGIERO, and ROBERT NAPPI, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

A preliminary review of the record before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we hereby remand the application to the Examiner for input concerning the rejections of record.

In the final rejection, the following rejection was listed by the Examiner:

Claims 1-36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Toprac U.S. Patent Number 6,622,059 issued to Anthony John Toprac and Michael L. Miller (Final Rejection 2).

In the Brief, Appellants indicate that Toprac is not available as prior art in any obviousness determination, pursuant to MPEP §706.02(l)(1) because as quoted by Appellants: "effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention 'were, at the time that the invention was made, owned by the same person or subject to an obligation of assignment to the same person.'" (Br. 5-6). The Appellants further state that the application was filed on or after November 29, 1999 (Br. 6). Finally, the Appellants state that the present application and Toprac, were at the time the present invention was made, owned by the same entity or subject to an obligation of assignment to the same entity (Br. 6).

The entirety of the Answer is devoted to the anticipation rejection of claims 1-36 under 35 U.S.C. § 102(e). The Answer is completely silent as to the status of the anticipation rejection of claims 1-36 based on the possible disqualification of the prior art of Toprac due to the common inventor,

Michael L. Miller, and the statement in Appellants' Brief that at the time the present invention was made, the invention was owned by the same entity or subject to an obligation of assignment to the same entity (Br. 6).

MPEP §706.02(b)(C) as it applies to overcoming a rejection under 35 U.S.C. § 102(e) states that filing an affidavit or declaration under 37 C.F.R. 1.132 showing that the reference is not owned "by another" is sufficient to overcome a prior art rejection (also *see* in MPEP Form Paragraphs Chapter 700, ¶ 7.15.02).

A reply brief was not submitted by the Appellants.

Based upon the record before us on appeal, we are not able to determine the status of the prior art rejection of claims 1-36. In light of the statements made by the Appellants in the Brief, are these claims still subject to the anticipation rejection set forth in the Final Rejection? If the prior art to Toprac can be disqualified based on common ownership at the time the invention was made as asserted by Appellants (Br. 6), then the Examiner must determine the appropriateness of a declaration to be submitted by Appellants under 37 C.F.R. 1.132 showing that the reference is not owned "by another." Thus, the application is hereby remanded to the Examiner for an explanation as to the status of the prior art rejection of claims 1-36.

This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) 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.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). See 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REMANDED

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