

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KLAUS-DIETER LEIMBACH,
FALK HECKER, OLIVER JUNDT, and HERBERT SCHRAMM¹

Appeal 2008-1032
Application 10/465,962
Technology Center 3600

Decided: December 30, 2008

Before JAMESON LEE, RICHARD TORCZON, and SALLY C.
MEDLEY, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

¹ The real party in interest is Robert Bosch GmbH.

A. STATEMENT OF THE CASE

The Appellant requests rehearing under 37 C.F.R. § 41.52 of a Decision on Appeal entered July 28, 2008 (the Decision). Specifically, the Appellant requests rehearing on the ground that the Decision should have included a statement that the Boards' affirmance of the rejection of claims 8-11, 14, and 20 under 35 U.S.C. § 103(a) is a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). The Appellant also requests the Board to designate its decision on rehearing as a "new decision."

B. ANALYSIS

In the Decision, the Board affirmed the Examiner's rejection of claims 8-11, 14, and 20 as unpatentable under 35 U.S.C. § 103(a) as unpatentable over U.S. 6,223,114 to Boros et al. (Boros) and WO 97/39928.

The Appellant contends that the Board's obviousness analysis in affirming the rejection of claims 8-11, 14, and 20 is premised on knowledge of a person of ordinary skill in the art that was not relied upon by the Examiner. According to the Appellant, the Board's analysis constitutes knowledge of the Board of grounds for rejecting claims 8-11, 14, and 20 that were not involved in the appeal and the Decision should have included a statement to that effect.

In filing the Request for Rehearing under 37 C.F.R. § 41.52(a), the Appellants' had the opportunity and obligation to "state with particularity the points believed to have been misapprehended or overlooked by the Board." However, the Appellant does not argue the merits of the rejection of claims 8-11, 14, and 20 as explained by the Board or contend that the Board "misapprehended or overlooked" any points relating to the merits of

the rejection as explained by the Board. *See* 37 C.F.R. § 41.52(a)(1). Instead, the Appellant requests that they be afforded the procedural options available under 37 C.F.R. § 41.50(b)(1) for responding to the alleged new ground of rejection. (Request 1:11-16.)

The affirmance of a conclusion of obviousness based on prior art of record may be made on another basis. *See In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). Here, the Board affirmed the rejection of Appellant's claims 8-11, 14, and 20 as obvious based on the same references applied by the Examiner along with analysis reflecting a skilled artisan's recognition of the teachings of those references. That basis for affirming does not establish the Board's "knowledge of any ground not involved in the appeal for rejecting any pending claim" or render the procedural options available under 37 C.F.R. § 41.50(b). However, in situations involving a possible misunderstanding of a procedural matter, the Board, at its discretion, may follow an "abundance of fairness policy." *See Ex parte Letts*, 88 USPQ2d 1854, 1859 (BPAI 2008).

In the circumstances of this case, we exercise discretion to grant the Appellant's request to designate the Decision's affirmance of the rejection of claims 8-11, 14, and 20 under 35 U.S.C. § 103(a) as a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

This decision on rehearing does not constitute a new decision on appeal. Nor does it turn the original Decision into a new decision. Accordingly, pursuant to 37 C.F.R. § 41.52(a)(1), no request for rehearing from this decision on rehearing is permitted. Also, because the Appellant did not argue in the rehearing request the merits of any rejection as explained by the Board, it is not entitled to any further relief under 37 C.F.R.

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§ 41.50(b)(2), once the original decision has been modified to designate the affirmance of the obviousness rejection of claims 8-11, 14 and 20 as a new ground of rejection.

C. CONCLUSION

The Appellant's Request for Rehearing is granted but only to the extent as ordered below.

The procedure under 37 C.F.R. § 41.50(b)(2) for responding to a new ground of rejection is not available to the Appellant.

D. ORDER

The Board's affirmance of the rejection of claims 8-11, 14, and 20 under 35 U.S.C. § 103(a) as unpatentable over Boros and WO 97/39928 is designated as a new ground of rejection under to 37 C.F.R. § 41.50(b).

Pursuant to the applicable sections of 37 C.F.R. § 41.50(b), the Appellant, **WITHIN TWO MONTHS FROM THE DATE OF THIS DECISION**, must exercise the following option 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....

GRANTED-IN-PART, 37 C.F.R. § 41.50(b)

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