

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUA WANG,
RANDALL TODD MYERS, and
SCOTT MICHAEL DAVIS

Appeal 2008-5193
Application 10/857,478
Technology Center 1700

Decided: September 19, 2008

Before CHUNG K. PAK, TERRY J. OWENS, and
THOMAS A. WALTZ, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Manual of Patent Examining Procedure (MPEP) § 706.02 (8th ed.
rev. 6, Sept. 2007) provides the following guidance to Examiners
regarding applying the best available prior art:

I. CHOICE OF PRIOR ART; BEST AVAILABLE

Prior art rejections should ordinarily be confined strictly to the best available art. Exceptions may properly be made, for example, where:

- (A) the propriety of a 35 U.S.C. 102 or 103 rejection depends on a particular interpretation of a claim;
- (B) a claim is met only in terms by a reference which does not disclose the inventive concept involved; or
- (C) the most pertinent reference seems likely to be antedated by a 37 CFR 1.131 affidavit or declaration.

Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections, i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

In the present case the Examiner does not indicate that an exception, such as those above, applies. Nevertheless, the Examiner makes twelve rejections of claims 1, 2, 4-14, 15, 16, 54 and 55 under 35 U.S.C. § 103, each over a different primary reference in view of the same secondary reference (Ans. 12).¹

The Examiner argues that “the term ‘best references’ merely refers to the degree of relevance -- if multiple references have substantially equal degrees of relevance, they may all be reasonably considered ‘best

¹ The rejections of claims 1, 2, 4-13, 15, 16, 54 and 55 under 35 U.S.C. § 103 are: Vollenberg (2001/0016626) in view of Shaw (4,643,940); Pickett (2001/0055671) in view of Shaw (4,643,940); Brunelle (2002/0039657) in view of Shaw (4,643,940); Pickett (2003/0072945) in view of Shaw (4,643,940); Brunelle (6,265,522) in view of Shaw (4,643,940); Brunelle (6,291,589) in view of Shaw (4,643,940); Brunelle (6,294,647) in view of Shaw (4,643,940); Brunelle (6,306,507) in view of Shaw (4,643,940); Shakhnovich (6,410,620) in view of Shaw (4,643,940); Shakhnovich (6,414,058) in view of Shaw (4,643,940); Shakhnovich (6,417,253) in view of Shaw (4,643,940); and Suriano (6,538,065) in view of Shaw (4,643,940) (Ans. 12-13).

references’, especially when each of the primary references disclose substantially identical information” (Ans. 22).

If the references applied in all of the Examiner’s rejections disclose substantially the same information, then the rejections are cumulative.

Cumulative rejections are wasteful of the resources of the Examining Corp, the Appellants and the Board.

The Examiner argues that “the reasoning provided in the BRUNELLE ET AL ‘657 in view of SHAW ET AL rejection is clearly and concisely expressed, and is clearly applicable to each combination of the other primary references with SHAW ET AL” (Ans. 24).²

The applicability to the other primary references of the reasoning applied to Brunelle ‘657 indicates that the rejections based upon those other primary references are cumulative with respect to the rejection over Brunelle ‘657.

MPEP § 1211 (8th ed., rev. 3, Aug. 2005) states that “[i]n the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground.”

We remand the application to the Examiner for the Examiner to select and apply the preferred or best ground of rejection under 35 U.S.C. § 103. In view of the Examiner’s indication that the rejections under 35 U.S.C. § 103 are cumulative (Ans. 22), it appears that there should be only one rejection under 35 U.S.C. § 103. If the Examiner applies more than one rejection under 35 U.S.C. § 103, there should be a reason why the

² With respect to the primary references other than Brunelle ‘657, the Examiner merely cites to the references (Ans. 14-16) without explaining how the cited portions apply to the claims.

Appeal 2008-5193
Application 10/857,478

Examiner is making an exception to the general rule, set forth above, that only the best ground of rejection is to be applied. In the present case it appears that there should be, at most, no more than one or two additional rejections.

As to each claim rejected, the Examiner is to follow the guidance set forth in MPEP § 706.02(j) (8th ed., rev. 6, Sept. 2007):

706.02(j) Contents of a 35 U.S.C. 103 Rejection

35 U.S.C. 103 authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation >as to< why >the claimed invention would have been obvious to< one of ordinary skill in the art at the time the invention was made**.

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

Appeal 2008-5193
Application 10/857,478

a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

tf/ls

CANTOR COLBURN, LLP
20 CHURCH STREET
22ND FLOOR
HARTFORD, CT 06103