

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS F. STECKEL

Appeal No. 1995-4122
Application No. 08/067,647¹

ON REQUEST FOR REHEARING

Before JOHN D. SMITH, PAK, and ELLIS, Administrative Patent Judges.

PAK, Administrative Patent Judge.

ON REQUEST FOR REHEARING

¹ Application for patent filed May 26, 1993. According to appellant, the application is a continuation of Application No. 07/740,399, filed August 5, 1991, now U.S. Patent No. 5,242,608, issued September 7, 1993; which is a continuation of Application No. 07/564,669, filed August 7, 1990, now U.S. Patent No. 5,064,545, issued November 12, 1991; which is continuation of Application No. 06/943,297, filed December 17, 1986, now abandoned.

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Appellant requests rehearing of our decision mailed November 9, 1998, affirming the examiner's rejection of claims 29 through 47 under the judicially created doctrine of obviousness-type double patenting as unpatentable over the claims of U.S. Patent 5,242,608. Appellant, however, does not assert any points believed to have been misapprehended or overlooked by us in rendering our decision. See 37 CFR § 1.197(b)(1998). Rather, appellant relies on for the first time the terminal disclaimer filed on March 22, 1999 to overcome the obviousness-type double patenting rejection in question. However, the newly proffered terminal disclaimer is not properly before us since it was not considered by the examiner and was not the basis of any argument in appellant's original brief. See 37 CFR § 1.192(a)(1998). We will not decide the merits of the terminal disclaimer in the first instance.

According to a decision on the petition dated June 1, 1999, the Director of Technology Center 1700 granted, *inter alia*, appellant's request of entry of the terminal disclaimer in question. See Paper No. 22. We, therefore, remand this

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application to the examiner to determine whether the newly introduced terminal disclaimer overcomes the obviousness-type double patenting rejection in question.

In summary, we deny appellant's request for rehearing and remand this application to the examiner for appropriate action consistent with the above instruction.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST DENIED/REMANDED

JOHN D. SMITH)
Administrative Patent Judge)
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) BOARD OF PATENT
CHUNG K. PAK) APPEALS

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Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JOAN ELLIS)	
Administrative Patent Judge)	

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APJ PAK

APJ JOHN SMITH

APJ ELLIS

DECISION: DENIED/REMAND

Send Reference(s): Yes No
or Translation (s)

Panel Change: Yes No

Index Sheet-2901 Rejection(s): _____

Prepared: August 8, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT