

The opinion in support of the decision entered today is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER W. WALCZAK, CHARLES HENRY DUFOUR,
MICHAEL STEVENSON, JOHN SHERIDAN RICHARDS,
and ROLAND THOMAS PALMATHER

Appeal No. 2000-0828
Application 08/844,350¹

ON BRIEF

Before LEE, GARDNER-LANE and MEDLEY, Administrative Patent Judges.

MEDLEY, Administrative Patent Judge.

MEMORANDUM OPINION and ORDER

A. Introduction and background

On December 22, 2000, a decision, with accompanying opinion, was entered by the Board in Appeal 00-0828. In its decision, the merits panel

(A) vacated the Examiner's rejections of (1) claims 1, 2 and 16 as being unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza; (2) claims 7 and 8 as being

¹ Application for patent filed April 18, 1997.

unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza and Tittgemeyer; and (3) claims 9-11 as being unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza and Machguth, and

(B) remanded for further proceedings not inconsistent with the views expressed in its opinion.

Apparently, in response to the Board's decision, the Examiner mailed a communication to Applicants. (Paper 19). The communication appears to "supplement" the Examiner's Answer regarding the Examiner's now vacated rejection of (1) claims 1, 2 and 16 as being unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza; (2) claims 7 and 8 as being unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza and Tittgemeyer; and (3) claims 9-11 as being unpatentable under 35 U.S.C. § 103 over Guaraldi in view of Harenza and Machguth. However, in the communication, claims 1, 2, 7, 8-11 and 16 are not again rejected. Furthermore, Applicants were not given a time period to respond to the Examiner's "supplemental" views in the communication. Instead, the application has been returned to the Board. The Examiner apparently assumes that an appeal is still pending before the Board.

B. Opinion

The term "vacate", as applied to an action taken by an appellate tribunal, means to set aside or to void.² When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists. The Board's decision to vacate and remand ends the appeal and returns jurisdiction over the application on appeal to the examiner for further action not inconsistent with the views expressed in the opinion accompanying the Board's decision. Appropriate subsequent action by an examiner upon reassuming jurisdiction over the application would include allowing or rejecting claims previously on appeal. Obviously, if the examiner rejects a claim, an Office Action rejecting the claim should be entered and the applicant given a date to respond to the examiner's rejection. If a rejection is made (e.g., the claims have been twice rejected³) and the applicant is dissatisfied with the examiner's rejection, the applicant can again appeal the rejection to the Board. Following a second appeal, the Board then again can acquire jurisdiction under 35 U.S.C. § 134 and can then decide any issue(s) involved in a second appeal.

In this application, the Board vacated the Examiner's rejections and remanded the application to the Examiner for

² Black's Law Dictionary 1075 (abridged 6th ed. 1991).

³ 35 U.S.C. § 134.

further action not inconsistent with the views expressed in the opinion. In doing so, the Board did not express an opinion as to whether the Examiner's rejections were ultimately right or wrong. Indeed, when an examiner's rejection is vacated, the Board does not take an ultimate position on the correctness of an examiner's rejection. The rejection may or may not have been correct. Most of the time a rejection is "vacated" because the issue sought to be reviewed has not been sufficiently developed to permit meaningful review. The record in connection with this application was determined to be insufficiently developed to permit meaningful review. Accordingly, the Examiner's rejection was "vacated" and a remand was ordered to permit the Examiner to further consider the application and, if a rejection was again to be made, to properly develop the issues for review.

Without making another rejection, the Examiner returned the application to the Board after sending a communication to Applicants. It was not procedurally proper for the Examiner to have sent the case back to the Board at this stage of the prosecution. The Board no longer has jurisdiction over the

application because there is no appeal pending.⁴ Accordingly, the application is returned to the examiner for action not inconsistent with the views expressed in our opinion entered December 22, 2000 (Paper 18).

C. Order

Upon consideration of the record, and for the reasons given, it is

ORDERED that the Board lacks jurisdiction.

FURTHER ORDERED that the application is returned to the examiner for further action not inconsistent with the views expressed in the Board's opinion entered December 22, 2000 (Paper 18).

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JAMESON LEE)	
Administrative Patent Judge)	
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_____)	BOARD OF PATENT
SALLY GARDNER-LANE)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
_____)	
SALLY C. MEDLEY)	
Administrative Patent Judge)	

⁴ The Board has jurisdiction to determine whether it has jurisdiction. In this case, we hold that we do not have jurisdiction; rather jurisdiction over the application is presently before the Examiner.

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