

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AMOCO CORPORATION

Appeal No. 97-0109
Reexamination Control No. 90/003,598¹

ON BRIEF

Before KIMLIN, METZ and GARRIS, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified reexamination file is being remanded to the examiner for appropriate action consistent with this communication.

¹ Reexamination proceeding, requested October 11, 1994, of U.S. Patent No. 5,310,584 issued May 10, 1994, based on Application No. 07/868,110 filed April 14, 1992.

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The record advanced by the examiner on this appeal lacks adequate clarity with respect to the particular claims and references which are included in the many rejections set forth in the examiner's answer.

For example, the answer reflects that claim 1 is rejected under 35 U.S.C. § 103 as being unpatentable over Voeks in view of Shi or the Chinese reference or alternatively over Winkel or alternatively over Shi in view of Breidt and Winkel and Irwin or alternatively over Jacoby '953 or Jacoby '129 in view of Shi and Breidt. Additionally, page 6 of the answer discloses that claims 2, 3 and 4, which depend ultimately from claim 1, "stand rejected as being unpatentable over Jacoby et al. (-953) or Jacoby (-129) in view of Breidt, Jr. et al. and Shi et al., and unpatentable over Voeks in view of Shi et al. or the Chinese reference, all of these references discussed supra; the Winkel publication; and unpatentable over Shi et al. in view of Breidt, Jr. et al. and Winkel and the Irwin publication all discussed above, and all considered in light of Jacoby et al. and Jacoby." It is not clear to us whether the alternative rejections applied against dependent claims 2 through 4 are identical to the alternative rejections applied

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against parent claim 1 or whether the rejections of these dependent claims include not only the references applied against claim 1 but also the "Jacoby et al. and Jacoby" references. The former possibility, which the appellant has presumed to be the case (see the ISSUES section of the brief), is inconsistent with the examiner's aforementioned statement "all considered in light of Jacoby et al. and Jacoby." On the other hand, the latter possibility would lead to the irrational rejection of claims 2 through 4 "as being unpatentable over Jacoby et al. (-953) or Jacoby (-129) in view of Breidt, Jr. et al. and Shi et al. ... all considered in light of Jacoby et al. and Jacoby."

As a further example, we observe that page 8 of the answer indicates that claims 9 through 14 "stand rejected as being unpatentable on the same art as relied on in the previously discussed rejections of claims 1-8, with the exception of Fujii et al. and Park et al.." The appellant has interpreted the confusing phrase "with the exception of Fujii et al. and Park et al." as meaning "additionally in view of Fujii et al. and Park

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et al.” (see Item 6 in the ISSUES section of the brief). However, this interpretation by the appellant is seemingly contrary to the literal meaning of the examiner’s quoted phrase. More significantly, the examiner indicates that claims 9 and 10 would have been obvious over Yazaki and Yamada without referring to the Fujii and Park references (answer, pages 8-9) and that claim 11 would have been obvious “over Winkel et al., Fujii et al. or Park et al.” (answer, page 9). These obviousness comments by the examiner regarding claims 9 through 11 reflect that some of the rejections of claims 9 through 14 do not include the Fujii or Park references (contrary to the appellant’s aforementioned interpretation) whereas some of these rejections do include Fujii or Park (though whether as primary or secondary references is unclear).

The lack of clarity which taints the rejections of claims 9 through 14 is particularly egregious with respect to claim 12 since this is an independent claim and since the examiner’s obviousness statements regarding claim 12 (see page 10 of the answer) seem to involve the Winkel reference only (although the Fujii and Park references may or may not be additionally

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relied upon). Adding to this confusion is the examiner's stated rejection of claim 13 (which depends from claim 12) "as being unpatentable over Jacoby et al. and Jacoby under 35 U.S.C.

§ 103" (answer, page 10; emphasis added). This rejection is inconsistent with the examiner's previously quoted statement that claims 9 through 14 "stand rejected as being unpatentable on the same art as relied on in the previously discussed rejections of claim 1-8, with the exception of Fujii et al. and Park et al.." This is because none of the "previously discussed rejections of claims 1-8" is based upon the "Jacoby et al. and Jacoby" references applied against claim 13.

For the above stated reasons, the examiner must clarify the file record for this reexamination proceeding (e.g., via a supplemental examiner's answer) in such a manner as to clearly and completely list all claims subject to a given rejection and to clearly and completely list all references applied in a given rejection. To the extent that such a listing of claims and references may differ from those thought by the appellant to be at issue on this appeal (again see the ISSUES section of the brief), the examiner as a minimum must give the appellant

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an opportunity for responding to the clarified listing of claims and references relied upon by the examiner in his rejections. In short, the examiner should comply with the guidelines set forth in the Manual of Patent Examining Procedure (M.P.E.P.) § 706.02(j) which emphasizes that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to respond" (Revision 3, July 1997; page 700-17).

In addition to the foregoing, we observe that the examiner has proffered on this appeal an extremely large number of alternative rejections involving 12 different references applied in a variety of differing combinations. It appears to us that the examiner has again failed to comply with guidelines set forth in the M.P.E.P., specifically, the admonition that "[p]rior art rejections should ordinarily be confined strictly to the best available art" and that "[m]erely cumulative rejections ... should be avoided" (§ 706.02; Revision 3, July 1997; page 700-10). It follows that the examiner, in effecting the clarification required above, should strictly confine his prior art rejections to the best

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available prior art and should avoid rejections which are
merely cumulative.

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This application, by virtue of its "special status", requires an immediate action; see M.P.E.P. § 708.01(d) (Revision 3, July 1997). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

	EDWARD C. KIMLIN)	
	Administrative Patent Judge))	
)	
)	
	ANDREW H. METZ)	BOARD OF
PATENT	Administrative Patent Judge))	APPEALS AND
)	INTERFERENCES
)	
	BRADLEY R. GARRIS)	
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