

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(2) is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SPECTRA-PHYSICS SCANNING SYSTEMS, INC.,
a Corporation of Eugene, Oregon

Appeal No. 98-0155
Reexamination Control No. 90/003,963¹

HEARD: January 14, 1998

Before and THOMAS, HAIRSTON and CARMICHAEL, ***Administrative
Patent Judges.***

CARMICHAEL, ***Administrative Patent Judge.***

ON REQUEST FOR REHEARING

¹ Application for Reexamination filed September 22, 1995. This application is for reexamination of Application 07/116,962 filed November 5, 1987, Patent No. 4,861,972 issued August 25, 1989.

Appeal No. 98-0155
Reexamination Control No. 90/003,963

This is a decision on rehearing of our original decision dated January 28, 1998, in reexamination No. 90/003,963. On March 2, 1998, appellants filed a request for remand to the examiner on the basis that our decision allegedly contained a new ground of rejection, along with an amendment. We will treat the request for remand as a request for rehearing under 37 CFR § 1.197(b).

Appellants cite 37 CFR § 1.196(b) and ask that our original decision be considered as including a new ground of rejection.

In affirming a multiple reference rejection under 35 U.S.C. § 103, the Board may rely on one reference alone in an obviousness rationale without designating it as a new ground of rejection. *In re Bush*, 296 F.2d 491, 496, 131 USPQ 263, 266-67 (CCPA 1961); *In re Boyer*, 363 F.2d 455, 458, n.2, 150 USPQ 441, 444, n. 2 (CCPA 1966). However, an anticipation rationale may constitute a new ground of rejection. *In re Meyer*, 599 F.2d 1026, 1031, 202 USPQ 175, 179 (CCPA 1979); *In re Echerd*, 471 F.2d 632, 635, 176 USPQ 321, 323 (CCPA 1973).

Appeal No. 98-0155
Reexamination Control No. 90/003,963

Section 3 of our original decision, entitled "Intermec alone," presents an anticipation rationale. Upon consideration of appellants' request, we hereby designate that rationale as a new ground of rejection. Specifically, claims 11, 18, 30, 32, and 34 are rejected under 35 U.S.C. § 102 as anticipated by Intermec. The rationale remains that set forth in section 3 of our original decision.

Appellants do not seek any other change in our original decision, and we make no other change. Thus, the examiner's rejection of claims 11, 18, 30, 32, and 34 under 35 U.S.C. § 103 for obviousness remains sustained for the reasons set forth in our original decision.

CONCLUSION

The rejection of claims 11, 18, 30, 32, and 34 under 35 U.S.C. § 103 for obviousness remains sustained. The rejection of claim 33 remains not sustained. A new ground of rejection is entered against claims 11, 18, 30, 32, and 34 under 35 U.S.C. § 102 for anticipation.

Our decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997,

Appeal No. 98-0155
Reexamination Control No. 90/003,963

by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Appellants have chosen option (1). Therefore, this reexamination is remanded to the examiner pursuant to 37 CFR § 1.196(b)(1).

Appeal No. 98-0155
Reexamination Control No. 90/003,963

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

AFFIRMED-IN-PART; REMANDED - 37 CFR § 1.196(b)

JAMES D. THOMAS)	
Administrative Patent Judge)	
)	
)	
)	
KENNETH W. HAIRSTON)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JAMES T. CARMICHAEL)	
Administrative Patent Judge)	

Appeal No. 98-0155
Reexamination Control No. 90/003,963

LYON & LYON
John A. Rafter, Jr.
611 West Sixth Street, 47th Floor
Los Angeles, CA 90017