

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte POL SCARPE SPORTIVE S. R. L.

Appeal No. 98-0478
Control No. 90/004,111¹

HEARD: APRIL 8, 1998

Before McCANDLISH, Senior Administrative Patent Judge, STAAB and McQUADE,
Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

On May 27, 1998, we rendered a decision in this appeal (Paper No. 45) wherein
we:

¹ Request, filed January 16, 1996, for the reexamination of U.S. Patent No. 5,044,096, issued September 3, 1991, based on Application 07/448,393, filed December 11, 1989.

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a) reversed the examiner's rejections of claims 1 through 7;
b) entered a new rejection of claims 6 and 7 pursuant to 37 CFR § 1.196(b); and
c) made certain observations pursuant to 37 CFR § 1.552(c) involving "serious questions as to whether the appellant's specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, with regard to the subject matter now recited in claims 1 through 7" (decision, page 10).

In response, the appellant has filed:

a) an amendment directed to the new rejection of claims 6 and 7 (Paper No. 46);
and
b) a request for reconsideration and withdrawal of the observations made pursuant to 37 CFR § 1.552(c) (Paper No. 47).

In the latter, the appellant sets forth a substantive analysis of the written description issue, and submits in light of such analysis that our observations are unwarranted, contrary to law and highly inappropriate.

As explained on pages 10 and 11 of the decision, the current state of reexamination law and practice does not permit the particular 35 U.S.C. § 112, first paragraph, issues raised by our observations to be resolved in a reexamination proceeding. See In re Etter, 756 F.2d 852, 856-857, 225 USPQ 1, 4 (Fed. Cir.), cert. denied, 474 U.S. 828 (1985); 37 CFR § 1.552; and MPEP § 2258. Thus, we have not

considered, and pass no judgment on, the appellant's substantive analysis of these issues. As for the propriety of our making the observations, 37 CFR § 1.552(c) expressly states that "[i]f such questions are discovered during a reexamination proceeding, the existence of such questions will be noted by the examiner in an Office action" (emphasis added). The members of this panel of the Board of Patent Appeals and Interferences are, by statute, examiners-in-chief (35 U.S.C. § 7), and our decisions are tantamount to Office actions. We were, and still are, of the opinion for the reasons set forth in our decision (see page 10) that "serious questions" do indeed exist as to whether the appellant's specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph. This being the case, 37 CFR 1.552(c) required us to note these questions in the manner we did. We would emphasize, however, that our observations should not be construed as being determinative, one way or the other, as to the ultimate merits of these "serious questions." While the dilemma in which the appellant finds itself (see page 12 in the request) is unfortunate, this reexamination proceeding is simply not the proper forum for resolving such questions.

In summary, we have reconsidered our decision to the extent indicated above, but decline to make any changes therein.

This application is being remanded to the examiner pursuant to 37 CFR § 1.196(b)(1) for consideration of the appellant's amendment relating to the new rejection

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of claims 6 and 7 (Paper No. 46).

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

DENIED

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

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Mr. John T. Goolkasian
Oblon, Spivak, McClelland, Maier
& Neustadt, PC
1755 Jefferson Davis Hwy
Suite 400
Arlington, VA 22202

Joseph J. Jochman, Jr.
Andrus, Sceales, Starke & Sawall
100 E Wisconsin Avenue
Milwaukee, WI 53202