

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PIER M. CIPRIANI

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Appeal No. 1997-3137  
Application No. 07/978,670

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ON REHEARING

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Before WINTERS, WILLIAM F. SMITH, and GRIMES Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

Appellant requests rehearing of this appeal in light of our decision entered January 11, 2001 (Paper No. 21) wherein we vacated the examiner's rejection and instituted a new of ground of rejection under 37 CFR § 1.196(b). This rule provides

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appellant with two options. First, appellant may submit an appropriate amendment of the claims or a showing of facts relating to the claims and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. Second, appellant may request that the appeal be reheard by the Board upon the same record. At page one of the request for rehearing appellant states that he wishes to “be reheard under 37 CFR § 1.197(b) upon the same record, as supplemented by the arguments set forth herein and as supported by the accompanying declarations of Joseph Hines and Dr. Douglas Burkett.” Manifestly, the request is improper. In essence, appellant is requesting that we create a third option under 37 CFR § 1.196(b). We decline to do so.

Since appellant’s submissions have created a new record, we interpret appellant’s intent is to have the matter reconsidered by the examiner upon the new record. Accordingly, we remand the application to the examiner to consider appellant’s submissions and take whatever action is deemed appropriate.

Appellant’s request for rehearing is denied to the extent it asks the merits panel to review the new ground of rejection in light of the new record. Upon return of the

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application the examiner should consider the submissions and take whatever action is deemed appropriate.

REHEARING DENIED; REMANDED

Sherman D. Winters  
Administrative Patent Judge

William F. Smith  
Administrative Patent Judge

Eric Grimes  
Administrative Patent Judge

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