

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT FRITZ

Appeal No. 2002-0534
Application No. 08/551,326

ON BRIEF

Before WINTERS, GRIMES, and MILLS, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

REMAND TO THE EXAMINER

The following issue must be addressed before we reach the merits of this appeal. We therefore remand this application to the examiner for appropriate action.

The examiner has rejected all of the pending claims under 35 U.S.C. § 103 as obvious over certain prior art references. See the Examiner's Answer, page 5. The § 103 rejection is the only issue on appeal.

In response, Appellant cites four declarations, two U.S. Patents, and a journal article as evidence of nonobviousness. See the Appeal Brief, page 6. These materials are alleged to show evidence of commercial success,

recognition and adoption by others, long-felt need, and skepticism by others in the field. See id., pages 12-13.

In addition, Appellant submitted with the Appeal Brief, four additional exhibits. Two of these exhibits were characterized as “evidence of non-obviousness” directed to “the level of ordinary skill in the art at or around the time of the invention.” See the attachment to the Appeal Brief, page 1. The other two exhibits were characterized as evidence that “bovine derived phosphatidylserine is undesirable as a nutritional supplement given the general awareness of ‘mad cow’ disease.” Id., page 2. Appellant noted in the Appeal Brief that he “reserve[d] the right to argue newly offered Exhibits A & B and C&D in Applicant’s Reply Brief if the Exhibits or any one of them are admitted.” Appeal Brief, page 17 (footnote).

In the Examiner’s Answer, the examiner addressed the material cited on page 6 of the Appeal Brief (declarations, U.S. Patents, and journal article). However, as best we can tell, the examiner did not address any of the exhibits submitted with the Appeal Brief. Nor did the examiner state in the Answer or in an Advisory Action that these exhibits would not be entered. Appellant did not further rely on the newly submitted material in the Reply Brief.

Thus, it is unclear what evidence is in the record in rebuttal to the rejection on appeal. On the one hand, exhibits submitted after a notice of appeal is filed are not entitled to entry as a matter of right. See 37 CFR § 1.195 (“Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not

earlier presented.”). We cannot, therefore, presume that the exhibits were entered and considered by the examiner, especially since the exhibits were not addressed in the Examiner’s Answer.

On the other hand, evidence submitted after a notice of appeal may be entered, at the discretion of the examiner. See MPEP § 1211.02: “Affidavits or declarations [or exhibits] filed with or after the filing of a notice of appeal but before jurisdiction passes to the Board [e.g., after entry of a Reply Brief] will be considered for entry only if the appellant makes the necessary showing under 37 CFR § 1.195 as to why they were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations [or exhibits]”

(emphasis added). Evidence submitted after the filing of a notice of appeal is treated generally the same as evidence submitted after the final rejection. See MPEP §§ 1211.02, 716.01. If such an exhibit is denied entry, an applicant may petition the Group Director to have the denial reversed. See MPEP § 1002.02(c)(8). Therefore, we decline to treat the exhibits as having been denied entry sub silentio, especially since doing so would also deny Appellant the opportunity to petition an adverse decision.

It is well established that obviousness under § 103 must be determined based on all the evidence in the record. See In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986) (“If a prima facie case is made in the first instance, and if the applicant comes forward with reasonable rebuttal, whether buttressed by experiment, prior art references, or argument, the entire merits of the matter are to be reweighed.”); In re Piasecki, 745 F.2d 1468, 1472, 223

USPQ 785, 788 (Fed. Cir. 1984) (“Rebuttal is merely a ‘showing of facts supporting the opposite conclusion’, and may relate to any of the Graham factors including so-called secondary considerations. If rebuttal evidence of adequate weight is produced, the holding of prima facie obviousness, being but a legal inference from previously uncontradicted evidence, is dissipated.” (citations omitted)). See also In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976): “When prima facie obviousness is established and evidence is submitted in rebuttal, the decision-maker must start over. . . . Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. Though the tribunal must begin anew, a final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached . . . upon a different record.”

Here, we are unable to carry out the analysis prescribed by cases such as Hedges, Piasecki, and Rinehart—that is, to analyze the obviousness of the appealed claims in light of all the evidence in the record—because we do not know whether the rebuttal evidence submitted with the Appeal Brief is properly in the record.

On return of this case, the examiner should expressly state on the record whether or not the exhibits submitted by Appellant with the Appeal Brief have been entered. If the exhibits are not entered, the examiner should communicate to Appellant the reason(s) for denying them entry. If the exhibits are entered, we authorize the examiner to file a Supplemental Examiner’s Answer limited to

addressing the evidence in those exhibits. If a Supplemental Examiner's Answer is filed, Appellant is entitled to file a Reply Brief. See 37 CFR § 1.193(b)(1).

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Sherman D. Winters)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
Eric Grimes)	
Administrative Patent Judge)	APPEALS AND
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)	INTERFERENCES
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Demetra J. Mills)	
Administrative Patent Judge)	

Appeal No. 2002-0534
Application No. 08/551,326

Page 6

Richard Esty Peterson
Patent Attorney
1905-D Palmetto Avenue
Pacifica, CA 94044