

PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN B. LETTS

Appeal 2007-1392
Application 10/640,895
Technology Center 1700

Decided: January 31, 2008

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and
FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
PETER F. KRATZ, JEFFREY T. SMITH, LINDA M. GAUDETTE,
ALLEN R. MacDONALD, and LINDA E. HORNER, *Administrative Patent
Judges*.

FLEMING, *Chief Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

The appeal is before an expanded panel to consider a request for rehearing under 37 C.F.R. § 41.52(a)(1) of a Decision on Appeal entered by a merits panel on June 27, 2007, affirming a rejection of appealed claims 1, 3-7, and 9-16.

We DISMISS the appeal as to independent claim 7 and the claims dependent thereon. We also REMAND the appeal to the merits panel for consideration and decision on the patentability on the merits of independent claims 1 and 15 and the claims dependent thereon.

The invention described in Appellant's Specification relates to polyisocyanurate insulation foams made by reacting an isocyanate and reactants which include a polyol. (Spec.2:6-10). Reaction of an isocyanate and a polyol can lead to production of polyurethane. However, when excess isocyanate is present and a trimerization catalyst is used, a polyisocyanurate (as opposed to polyurethane) is obtained. (Spec. 4:10-12 and 7:11-16). Appellant's claimed invention is limited to a method for producing polyisocyanurate insulation foams, as opposed to polyurethane insulation foams.

In its Decision, the merits panel affirmed the rejection of independent claim 7, the broadest claim on appeal. Since Appellant did not present under specific subheadings [37 C.F.R. § 41.37(c)(1)(vii)] specific arguments for any other claims, the merits panel applied that result to all of the appealed claims. (Dec. 5, n. 5).

In the Request for Rehearing, Appellant contends that the Examiner and the merits panel were, or should have been, aware that Appellant inadvertently failed to cancel claim 7. (Req. for Reh. 2). Also, Appellant contends that the issues posed by the limitations in claims 1 and 15 that are

not included in claim 7 were fully briefed in the Appeal Brief, Examiner's Answer and Reply Brief. (*Id.* at 2). Thus, Appellant argues, in the interest of judicial economy, the Board should rehear and decide the appeal in respect to claims 1 and 15. (*Id.* at 3).

ISSUE

A first issue is whether the Board should dismiss the appeal as to claim 7.

A second issue is whether the Board should rehear the appeal and decide patentability on the merits of claims 1 and 15 and the claims dependent thereon despite the Appellant's failure, in this case, to comply with the applicable rule.

FINDINGS OF FACT

1. Independent claim 7 recites:

A method for producing polyisocyanurate insulation foams, the method comprising:

contacting an isocyanate-reactive compound with an isocyanate compound in the presence of a blowing agent that includes both isopentane and n-pentane in the substantial absence of cyclopentane, where the isopentane is present in a weight fraction that is greater than the weight fraction of the n-pentane.

2. Independent claim 1 recites:

A method for producing polyisocyanurate insulation foams, the method comprising:

contacting an A-side stream of reactants that includes an isocyanate with a B-side stream of reactants that include a polyol and a blowing agent, where the blowing agent includes isopentane and n-pentane in a substantial absence of cyclopentane, *where said polyol and said blowing agent are*

combined under a pressure in excess of about 80 psi and a temperature in an excess of about 10°C, and where the blowing agent includes an isopentane to n-pentane weight ratio of 2.7:1 to 1:1.

(emphasis added).

3. Independent claim 15 recites:

A method for producing polyisocyanurate insulation foams, the method comprising:

contacting an A-side stream of reactants that includes an isocyanate with a B-side stream of reactants that include a polyol and a blowing agent, where the blowing agent includes isopentane and n-pentane in a substantial absence of cyclopentane, where the weight ratio of the isopentane to n-pentane is *[sic]* from 2.7:1 to 1:1, and *where said polyol and said blowing agent are combined under a pressure in excess of about 80 psi and a temperature in an excess of about 10°C.*

(emphasis added).

4. As indicated, claims 1 and 15 include limitations relating to pressure and temperature that are not included in claim 7.

5. In the Appeal Brief, filed May 19, 2006, Appellant stated:

Claims 1, 3-7, and 9-16 are pending, all stand rejected under 35 U.S.C. § 103, and all are appealed. . . . Inasmuch as Appellant had inadvertently failed to amend claim 7 in a manner consistent with claims 1 and 15, Appellant offers to cancel claim 7, as well as the claims dependent thereon, upon favorable consideration of claims 1 and 15.

(App. Br. 2).

6. Appellant has never formally withdrawn independent claim 7 and the claims dependent thereon by canceling those claims.

7. In the Appeal Brief, Appellant did not argue the patentability of any of the claims separately but did argue that pressure and temperature limitations distinguish the claimed invention over the prior art. (App. Br. 6-8).

8. In the Examiner's Answer, entered August 8, 2006, the Examiner addressed the issue of the patentability of claims containing pressure and temperature limitations. (Ex. Ans. *passim*).

9. In the Reply Brief, filed October 10, 2006, Appellant repeated verbatim the statement made in the Appeal Brief as quoted above (Finding of Fact ("FF") 5) concerning the inadvertent failure to amend claim 7, and offer to cancel 7 and the claims dependent thereon. (Reply Br. 4).

10. In the Reply Brief, on the merits, Appellant contended that the Examiner's combination of a secondary reference that discloses specific process parameters, i.e., pressure and temperature limitations, with the primary references that do not disclose such parameters is improper. (Reply Br. 9-10).

11. In the Reply Brief, Appellant further stated that "[I]t should have been clear to the Examiner that Appellant's arguments [in the Appeal Brief] were directed toward claims 1 and 15." (Reply Br. 12).

12. At the Oral Hearing, held June 6, 2007, Appellant's counsel reiterated that "I did, in the brief, say that we would cancel that claim [7], as long as we address the other issues." (Hearing Transcript 17).

13. In the Decision on Appeal, entered June 27, 2007, the merits panel observed that "Appellant's offer to cancel claim 7 and the claims dependent thereon did not remove these claims from appeal." (Dec. 5, n. 4).

14. In the Decision on Appeal, the merits panel also stated that:

[W]e note that Appellant argues the conditions under which the blowing agent is formed. However, this

limitation does not occur in claim 7. Therefore, a discussion of the conditions for formation of the blowing agent is not necessary to our decision.

(Dec. 5, n. 5).

15. Similarly, in the Decision on Appeal, the panel further noted that:

Appellant argues the [pressure and temperature] conditions under which the polyol and blowing agent preblend is created . . . However, Appellant's arguments regarding the conditions for formation of the polyol and blowing agent preblend are not limited to the scope of claim 7.

(Dec. 8).

16. In the Request for Rehearing, filed August 27, 2007, Appellant acknowledged that:

[B]ecause the pertinent limitations of claims 1 and 15 were not considered [in the Decision on Appeal], *the entirety of the Appellant's arguments were not considered because all arguments hinged on the relevant limitations within claims 1 and 15 (not claim 7)*. Indeed, Appellant fully briefed – in both the initial Brief and Reply Brief – the issues relating to the relevance of these particular claim limitations.

(Req. for Reh'g. 2)(emphasis added).

APPLICABLE REGULATIONS

In respect to the cancellation of claims during an appeal, 37 C.F.R. § 41.33(b)(1) provides:

Amendments filed on or after the date of filing a brief pursuant to § 41.37 may be admitted:

- (1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding . . .

37 C.F.R. § 41.37(c) requires that in order to present a particular claim for individual consideration on appeal, the appellant must submit a separate argument under a separate subheading as to that claim. Specifically, 37 C.F.R. § 41.37(c)(1)(vii) states:

Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately.

Requests for rehearing are controlled by 41 C.F.R. § 41.52(a)(1), including the requirement that:

The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board.

RELEVANT JUDICIAL AUTHORITY

In a case of first impression involving a possible misunderstanding of a procedural issue, the Federal Circuit, in *Key Pharmaceuticals v. Hercon Labs. Corp.*, 161 F.3d 709, 715-16 (Fed. Cir. 1998) observed:

It is the case, though, that we have not found any prior opinion of this court that has had occasion to publicly condemn this behavior [of asserting a position which the trial court adopts at the request of appellant and then complaining about it on appeal]. . . In an abundance of fairness, then, and to preclude any argument by Hercon that it was not on notice, we choose instead to independently review the correctness of the trial court's claim construction.

(footnote omitted). *See also Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1374 (Fed. Cir. 1999).

ANALYSIS

Status of Claim 7

In the Appeal Brief and Reply Brief, “Appellant offer[ed] to cancel claim 7, as well as the claims dependent thereon, upon favorable consideration of claims 1 and 15.” (FF 5, 9). Facially, all Appellant offered was to cancel claim 7 and the claims dependent thereon conditioned upon “favorable consideration of claims 1 and 15.” Appellant did not cancel claim 7 and claims dependent thereon.

At the Oral Hearing, Appellant appeared to moderate this position, stating “I did, in the brief, say that we would cancel that claim [7], as long as we address the other issues.” (FF 12). Nevertheless, the offer remained conditional on “address[ing] the other issues.”

As a matter of policy, based on a need for efficient handling of the ex parte appeal and inter partes interference dockets, the Board of Patent Appeals and Interferences (“Board”) does not enter into contingent arrangements in which the withdrawal or dismissal of a claim is conditioned upon commitments to or restrictions on future Board action. (*See Dawson v. Dallavalle*, Interference 105,223), <http://des.uspto.gov/Foia/ReterivePdf?system=BPAI&fINm=fd105569-09-18-2007-1>, p. 4-5 (BPAI Sep. 18, 2007) (concession of priority in interference cannot be conditioned on limitation on future action by USPTO). Thus, an Appellant in an ex parte appeal may not seek to have a claim withdrawn or dismissed from an appeal based on a condition that the Board take or refrain from taking action on one or more other claims. If an Appellant wants an appeal withdrawn or dismissed as to a particular claim,

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the proper course of action is to file an amendment canceling the claim. (*See* 37 C.F.R. § 41.33(b)(1)).

In the present appeal, the merits panel was under no obligation to dismiss the appeal as to claim 7, which remained pending in the application despite Appellant's contingent offer in the Appeal Brief and Reply Brief, and at the Oral Hearing to cancel the claim conditioned upon favorable consideration of claims 1 and 15. Even as late as filing the Appeal Brief, Appellant could have submitted an amendment as permitted by 37 C.F.R. § 41.33(b)(1) canceling claim 7 and the claims dependent thereon. Furthermore, Appellant did not request a withdrawal or dismissal of claim 7 and the dependent claims.

Appellant's Request for Rehearing does not dispute that the Examiner did not err in rejecting claim 7 and the claims dependent thereon. The Decision on Appeal affirmed the Examiner's rejection of claim 7 on the merits. Furthermore, the Request for Rehearing does not argue that the merits panel "misapprehended or overlooked" any points in connection with its affirmance of the rejection of claim 7. (*See* 37 C.F.R. § 41.52(a)(1)). Thus, the appeal is finally decided as to claim 7 and the claims dependent thereon.

Consideration of Claims 1 and 15

In view of the finality of the appeal as to claim 7, the only procedural issue remaining to be resolved is whether the Board should consider and decide separately the patentability of claims 1 and 15.

As we have discussed above, Appellant did not file an amendment to cancel claim 7 and the dependent claims nor did the Appellant request a

withdrawal or dismissal of claim 7 and the dependent claims. Further, as noted, Appellant did not separately specifically argue any claim and the panel thus correctly selected claim 7, the broadest claim, for deciding the appeal. (*See*, 37 C.F.R. § 41.37(c)(1)(vii)).

However, notwithstanding the technical correctness of the procedure followed by the merits panel, it was at all times during the appeal known by all of the participants, including the Examiner and the merits panel, that Appellant was not arguing the patentability of claim 7 but was including it in the group of appealed claims and relying on the pressure and temperature limitations of claims 1 and 15 to establish the patentability of those claims. (FF 7, 8, 10, 11, 14, 15, and 16). Most significantly, both Appellant and the Examiner fully briefed the patentability of claims containing those limitations. (FF 7, 8, and 10).

Therefore, lacking informative Board precedent and out of an abundance of fairness, the appeal will be remanded to the merits panel for considering and deciding, in the first instance, the patentability of claims 1 and 15 and the claims dependent thereon, as requested in the Request for Rehearing. In reaching this result, the Board exercises its discretion by electing to follow the practice followed by the Federal Circuit in *Key Pharmaceuticals*, 161 F.3d at 715-16. In a previous situation also involving a possible misunderstanding of procedural matter, the Board elected to follow the abundance of fairness policy announced by the Federal Circuit. (*See Quadrant Drug Delivery Ltd. v. Nektar Therapeutics*, 76 USPQ2d 1518, 1523 (BPAI 2005) (In an interference, permission granted to take testimony outside the United States)).

As discussed above, the dismissal of the appeal as to claim 7 and the claims dependent thereon is not conditioned on the consideration, favorable or otherwise, of claims 1 and 15. Rather, such dismissal is the result of the Appellant making it abundantly clear that he no longer seeks a patent on claim 7 and claims dependent thereon. In essence, the appeal is moot as to claim 7 and the claims dependent thereon.

In taking the action we take today, we wish to make clear that publication of this opinion is intended to put appellants on notice of the ineffectiveness of a conditional withdrawal of a claim. With this notice, appellants should not expect the Board in the future to exercise discretion to permit them from avoiding the consequence of such an approach. Adherence to the requirements of the rules is essential if the Board is to efficiently handle the increasing docket of ex parte appeals it is currently receiving.

DECISION

The appeal is (1) dismissed as to claim 7 and the claims dependent thereon, and (2) returned to the merits panel for consideration and decision on the patentability on the merits of claims 1 and 15 and the claims dependent thereon and for such further action as the merits panel may deem appropriate.

DISMISSED-IN-PART and REMANDED-IN PART

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