

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARY E. EWASYSHYN,
BARRY I. CAPLAN,
ANNE-MARIE BONNEAU
and
MICHEL H. KLEIN

Appeal No. 95-2436
Application 07/773,949¹

ON BRIEF

Before STONER, Chief Administrative Patent Judge, WINTERS and
WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

¹ Application for patent filed November 25, 1991.

Appeal No. 95-2436
Application 07/773,949

Claims 1 through 8, 16 and 17 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Morgan, Pedersen, Ray `87, Ray `88, Walsh and Montelaro. We reverse.

DISCUSSION

In arguing the rejection under 35 U.S.C. § 103 on pages 11-17 of the appeal brief, appellants rely upon a declaration filed under 37 CFR § 1.132 by co-appellant Dr. Michel Klein. See page 12 of the appeal brief. Therein appellants argue that the evidence provided by Dr. Klein's declaration "has been ignored by the examiner."

In reviewing the examiner's answer (Paper No. 16, January 4, 1994), we find the examiner only discusses Dr. Klein's declaration at page 5 where the examiner states "[i]t is further noted that the declaration filed under 37 CFR § 1.132 of 9/8/92 is unpersuasive." No further explanation or analysis of the declaration appears in the answer.

As set forth in 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).

Here, upon being presented with Dr. Klein's declaration, the examiner needed to take a step back and reassess the entire merits of the rejection under 35 U.S.C. § 103.

This was not done. Instead, we have only the examiner's conclusion that the declaration is unpersuasive. The examiner's curt dismissal of Dr. Klein's declaration was improper and constitutes legal error. By statute, this board functions as a board of review, not a de novo examination tribunal. 35 U.S.C. § 7(b)("[t]he [board] shall . . . review adverse decisions of examiners upon applications for patents . . ."). Here, the examiner has not presented a position which is amenable to a meaningful review. Rather than speculate as to reasons why the examiner found the declaration to be "unpersuasive", we will simply reverse the rejection as the examiner did not meet her initial burden of providing reasons of unpatentability. In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

The decision of the examiner is reversed.

REVERSED

BRUCE H. STONER, JR., Chief))
Administrative Patent Judge))
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SHERMAN D. WINTERS)) BOARD OF PATENT
Administrative Patent Judge)) APPEALS AND
) INTERFERENCES
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WILLIAM F. SMITH)
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