

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABRAHAM J. DOMB,
MANOJ MANIAR,
and ANDREW S.T. HAFFER

Appeal No. 96-1948
Application 07/995,952

REMAND

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

WILLIAM F. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our review of the record in this application leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and take appropriate action.

Prior Art Rejection

1. Dunn Reference Relied Upon

Appellants filed the Appeal Brief in this application on the premise that the Dunn reference relied upon by the examiner was U.S. Patent No. 4,841,968. See the paragraph bridging pages 2-3 and pages 7-11 of the Appeal Brief. However, the examiner identifies the Dunn reference relied upon in the prior art rejection as U.S. Patent No. 4,522,804. See page 3 of the Examiner's Answer.

Upon return of the application, the examiner should clarify which Dunn reference is relied upon in the rejection under 35 U.S.C. § 103.

2. Statement of the Rejection Under 35 U.S.C. § 103

Apart from the question as to which Dunn reference the examiner relies upon, the statement of the rejection on pages 4-6 of the Examiner's Answer is not clear. The examiner has not referred to any individual claim on appeal. Nor has he specifically set forth how the relied upon references are combined or applied under 35 U.S.C. § 103.

As set forth in the Manual of Patent Examining Procedure (MPEP) § 706.02(j) (6th ed., Rev. 3, July 1997),

the examiner should set forth in the Office action (1) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (2) the difference or

differences in the claim over the applied reference(s), (3) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (4) an explanation why such proposed modification would have been obvious to one of ordinary skill in the art at the time the invention was made.

Upon return of the application and after clarification of which Dunn reference is relied upon, we recommend that the examiner review the statement of the rejection and redraft it using the model set forth in MPEP § 706.02(j). In so doing, the examiner should consider each claim on appeal individually. For example, claim 1 on appeal is directed to a polymer blend which does not include a pharmaceutically active agent. Claim 10 is directed to a process for preparing blends of miscible polymers and also does not involve the presence or use of a pharmaceutically active agent. Since the statement of the rejection does not separately address claim 10 on appeal, it is not apparent how the references, either individually or in combination, teach or suggest the steps required by claim 10 on appeal.

3. Scope of Search

As set forth above, some of the claims on appeal do not require the presence or use of a pharmaceutically active agent. However, it appears that the examiner has limited his search of the prior art on the basis that all of the claims on appeal require a pharmaceutically active agent. The "SEARCHED" portion of the administrative file wrapper does not indicate that the examiner has searched classes such as class 525

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which appear to be relevant in determining the patentability of polymer blends per se. Furthermore, the "SEARCH NOTES" section of the administrative file wrapper indicates that the examiner has not performed a search using the APS system or the computerized data bases available to the examiners.

Upon return of the application, the examiner should review each of the claims on appeal and ensure that a complete prior art search has been performed.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The examiner has rejected the claims on appeal under this section of the statute in that "[t]he phrase [sic, phrases] 'different thermal properties' and 'mutual solvent' [are] vague and indefinite because it [sic] is [sic] relative." In making this rejection, it appears that the examiner has not used the correct legal standard. As set forth in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), claims must not be read in a vacuum. Rather, the claims must be read in light of the supporting specification and the relevant prior art as they would have been read by one skilled in the art. The statement of the rejection appearing at page 3 of the Examiner's Answer indicates that the examiner has read the claims in a vacuum since the examiner does not refer to the supporting specification or the prior art references attached to the Appeal Brief. These references are relevant since they are concerned with the technology of polymer blends.

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Upon return of the application, the examiner should reconsider the rejection under 35 U.S.C. § 112, second paragraph, taking into account the correct legal standard. If the rejection is maintained, the examiner should restate the rejection and indicate in a specific manner why one skilled in the art can not reasonably ascertain the scope of the claims on appeal taking into account the supporting specification and relevant prior art.

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

REMANDED

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Administrative Patent Judge)	
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