

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 45

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAYOSHI KAKUTANI

Appeal No. 96-2651
Application 08/201,479¹

HEARD: MAY 7, 1998

Before STONER, Chief Administrative Judge,
COHEN and ABRAMS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

ON REQUEST FOR REHEARING

This is in response to a "REQUEST FOR REHEARING"
(hereafter "request") of our decision dated May 28, 1998,
wherein this panel of the board reversed the examiner's

¹ Application for patent filed February 23, 1994.
According to appellant, the application is a continuation of
Application 07/915,419, filed July 17, 1992, now abandoned.

Appeal No. 96-2651
Application 08/201,479

rejection of claims 1, 7, and 8 under 35 U.S.C. § 102(b) as being anticipated by Fletcher, reversed the examiner's rejection of claims 1, 4, 7, 8, and 22 under 35 U.S.C. § 103 as being unpatentable over Röhner, Fletcher, and Worg, and reversed the examiner's rejection of claims 11 through 14 and 17 through 19 under 35 U.S.C. § 103 as being unpatentable over Röhner, Fletcher, Worg, and Martinez. Additionally, we introduced "NEW GROUNDS OF REJECTION" as follows:

a new rejection of claims 1 and 7 under 35 U.S.C. § 103 as being unpatentable over Worg; and

a new rejection of claims 2 through 4, 8, and 22 under 35 U.S.C. § 103 as being unpatentable over Worg in view of Röhner.

On pages 14 and 15 of our decision, appellant was expressly informed that "one" of two options set forth in the decision (page 15) must be exercised with respect to the new grounds of rejection to avoid termination of proceedings as to the rejected claims.

In the request, appellant includes a "Supplemental Declaration under 37 CFR § 1.132" and indicates that, in the event the Board does not reverse its decision, it is requested

Appeal No. 96-2651
Application 08/201,479

that the application be remanded to the examiner for consideration of the additional facts presented in the supplemental declaration regarding commercial success.

Appellant's request lacks express conformity with the mandatory election of one of the two options set forth in the decision.

Nevertheless, and particularly in light of appellant's submission of a Supplemental Declaration with additional facts regarding commercial success, we consider appellant's request, inclusive of argument contesting the new rejections (request, pages 2 through 4), as an election of option (1) to have the matter of the new rejections reconsidered by the examiner.

In conclusion, as indicated above, we understand the overall content of the request as an election of option (1) of 37 CFR 1.196(b). Accordingly, the request for rehearing before this panel of the board is DENIED, and the application is REMANDED to the examiner for consideration of the content of the request.

DENIED and REMANDED

BRUCE H. STONER, JR.)
Chief Administrative Patent Judge)

Appeal No. 96-2651
Application 08/201,479

| | | |
|--------|-----------------------------|-----------------|
| |) | |
| |) | |
| |) | |
| PATENT | IRWIN CHARLES COHEN |) BOARD OF |
| | Administrative Patent Judge |) APPEALS AND |
| | |) INTERFERENCES |
| | |) |
| | NEAL E. ABRAMS |) |
| | Administrative Patent Judge |) |

Appeal No. 96-2651
Application 08/201,479

Darby & Darby
805 Third Avenue
New York, NY 10022

ICC/ki