UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BRAD M. MONCLA, MATTHEW J. KALINOWSKI, DAVE SPETH, CHARLES DIEHL, DALE SCHMIDT, KEVIN D. MAAK and RONALD WEVERS

Appeal 2009-006448
Application 10/925,693
Technology Center 1700

Decided: June 22, 2010

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, JAMES T. MOORE and ALLEN R. MACDONALD, *Vice-Chief Administrative Patent Judges*, MICHAEL P. COLAIANNI, BEVERLY A. FRANKLIN, LINDA M. GAUDETTE, and KAREN M. HASTINGS, *Administrative Patent Judges.*

GAUDETTE, *Administrative Patent Judge.*

DECISION ON APPEAL

The application on appeal is before the Board on remand from the U.S. Court of Appeals for the Federal Circuit. *In re Moncla*, Appeal 2010-1126 (Fed. Cir. May 6, 2010, Order). The Board panel which originally heard the appeal consisted of Judges Franklin, Gaudette, and Hastings.

Chief Judge Fleming, acting on behalf of the Director, has designated an expanded panel to decide the appeal on remand.

BACKGROUND

In an Office Action mailed Nov. 21, 2006, the Examiner finally rejected all pending claims as follows: claims 9, 10, 12, 32, 35, 57-62 and 64-72 under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a), and claims 9, 10, 12, 32, 33, 35, 57-62 and 64-72 (provisionally) on the ground of non-statutory obviousness-type double-patenting over claims 1-42 of later-filed, co-pending Application Serial No. 11/068,573. Appellants appealed to the Board pursuant to 37 C.F.R. § 41.31(a), requesting review of all three grounds of rejection. (Appeal Brief, filed Apr. 20, 2007, 14.)

The original Board panel entered a final Decision (mailed Sep. 23, 2009 (hereinafter "prior Decision")) reversing the rejections under 35 U.S.C. §§ 102(b) and 103(a), and affirming the provisional, obviousness-type double-patenting rejection. The overall decision of the original Board panel was thus an affirmance of the Examiner's decision rejecting all pending claims. *See* 37 C.F.R. § 41.77. Appellants appealed to the Federal Circuit pursuant to 35 U.S.C. §§ 141 and 142, requesting reversal of the Board's decision to affirm the provisional, obviousness-type double-patenting rejection. (Brief of Appellants, filed Feb. 16, 2010, 12.)

After the filing of Appellants' Brief in Appeal 2010-1126, the Director and Appellants determined it would be in the best interest of the parties and the Federal Circuit to remand the case back to the USPTO and, accordingly, filed a "Joint Motion for Remand." The Federal Circuit granted the motion (*see supra* Order), and the appeal is now before this expanded panel.

ORDER

The prior Decision by the Board reversed the Examiner's rejections under 35 U.S.C. § 102 and § 103. The only remaining rejection is a provisional non-statutory double patenting rejection. We conclude that in this circumstance it was premature for the original Board panel to address the Examiner's provisional rejection of the claims.

Therefore, it is ORDERED:

1. The decision of the original Board panel affirming the provisional rejection of claims 9, 10, 12, 32, 33, 35, 57-62 and 64-72 on the ground of non-statutory obviousness-type double-patenting over claims 1-42 of later-filed, co-pending Application Serial No. 11/068,573 is vacated.

2. The overall decision of the original Board panel affirming the Examiner's decision to reject all of the pending claims is vacated.

3. We enter a new Decision in which:

a. The decision of the original Board panel reversing the rejections under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103(a) remains unchanged; and

b. We do not reach the Examiner's provisional rejection of claims 9, 10, 12, 32, 33, 35, 57-62 and 64-72 on the ground of non-statutory obviousness-type double-patenting.

REVERSED

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