

Ex parte Quist, Appeal 2008-001183 (BPAI 6/2/2010)(Precedential per curiam, expanded panel)

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The BPAI published a new precedential opinion on 6/21/2010. Ex parte Quist, Appeal 2008-001183 (BPAI 6/2/2010)(Precedential per curiam, expanded panel).

See <http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd08001183.pdf>

This is a decision of an expanded panel on a request for rehearing of a decision of an original appeals panel affirming a rejection under 35 USC 103.

On the merits, the expanded panel concluded that the appellants was arguing a claim construction narrower than the actual claim scope. The method claim at issue recited "comprising" the step of "cutting a carrier board". The expanded panel and the original appeals panel both concluded that the foregoing claim recitation of "carrier board" included both uncoated and coated wood board, not just uncoated wood board. The appellant's arguments presumed that "carrier board" meant only uncoated wood board.

However, the relevant point of law for which this decision was apparently made precedential is the procedure by which an appeals panel must review when the appellant challenges the examiner's weighing of evidence of secondary considerations. On this issue, the expanded panel held that:

On Board review, if the appellant raises the issue as to whether the examiner's conclusion of obviousness was in error, based in part on the proffered evidence of secondary considerations, the panel must consider if the examiner erred in determining patentability, based upon the totality of the record. In such instances, the Board panel must consider anew all the relevant evidence of obviousness, both for and against, in view of the argument on the issue. One such instance requiring a reweighing is seen in the present appeal – if the Appellants argue that the Examiner erred in determining that the weight of the evidence supports a conclusion of obviousness, the Board must review that conclusion of obviousness anew to see if the preponderance of relevant evidence properly before the Office supports that conclusion.

Given the foregoing, it is advisable on appeal, in cases in which evidence for patentability exists, to expressly assert that the examiner failed to properly weigh the evidence, and to note that the procedure for weighing the evidence upon appeal is specified in Quist.

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