

NOTE: This order is nonprecedential.

United States Court of Appeals for the Federal Circuit

In re: NCH CORPORATION,
Appellant

2022-1166

Appeal from the United States Patent and Trademark Office, Patent Trial and Appeal Board in No. 14/681,777.

ON MOTION

Before LOURIE, TARANTO, and HUGHES, *Circuit Judges*.

PER CURIAM.

O R D E R

The Director of the United States Patent and Trademark Office moves to waive the requirements of Federal Circuit Rule 27(f) and to remand for further proceedings. NCH Corporation opposes remand.

NCH appeals from the Patent Trial and Appeal Board's affirmance of the examiner's rejections of claims in NCH's patent application for lack of written description under 35 U.S.C. § 112(a) and/or as obvious under 35 U.S.C. § 103(a). In its opening appeal brief, NCH argues that the Board failed to address arguments and declaration evidence that NCH provided in its opening brief to the Board

to rebut those rejections, which the Board incorrectly deemed as presented for the first time in NCH's reply brief.

The Director now acknowledges that the Board mistakenly believed the arguments to be newly presented in NCH's reply brief, and "[t]hus, the Board's analysis is incomplete at this time." Mot. at 2. The Director therefore moves to remand for the Board to address NCH's arguments and declaration evidence in the first instance. It is within this court's discretion to remand to allow the agency to reconsider its previous position. *See SKF USA Inc. v. United States*, 254 F.3d 1022, 1029 (Fed. Cir. 2001). We agree that remand is proper and could preserve party and judicial resources, and therefore grant the motion.

Accordingly,

IT IS ORDERED THAT:

(1) The motion is granted. The appeal is remanded to the Board to address NCH's arguments and supporting evidence and to issue a revised decision. On remand, NCH should be given an opportunity to raise arguments and evidence it believes the Board failed to consider properly.

(2) Each side shall bear its own costs.

FOR THE COURT

May 26, 2022

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner

Clerk of Court

ISSUED AS A MANDATE: May 26, 2022