

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHRISTINE LECLAIR CORRIVEAU, GWENDOLYN JEANNE GRAFF,
DANIEL J. ZYCK, and ALBERT H. CHAPDELAINE

Appeal No. 2006-0356
Application No. 10/228,742

ON BRIEF

Before CAROFF, KIMLIN, and WARREN, Administrative Patent Judges.
CAROFF, Administrative Patent Judge.

DECISION ON APPEAL

Appellants' appeal from the examiner's final rejection of claims 1-92, all of the claims pending in appellants' application.

The appealed claims are directed to a rolled edible thin film product and a method of making that product. The rolled edible thin film may be placed in a container, and may be designed to be segmented by a consumer into a plurality of pieces. Claim 1 is representative:

1. A rolled edible thin film product comprising:
a container housing a rolled edible thin film; and
the rolled edible thin film comprising a body comprising a film-former substrate designed to adhere to at least a portion of an oral cavity of a consumer and dissolve in less than 20 seconds in the oral cavity, the body designed to be segmented by a consumer into a plurality of pieces that can be separately placed in the oral cavity of the consumer.

After having carefully reviewed the examiner's answer and the appellants' brief, we find that the issues presented are not ripe for a decision on the merits for the following reasons:

First, we note that the examiner has rejected all of the appealed claims under 35 U.S.C. § 103(a) for obviousness based upon a combination of four references: Leung et al., Ream et al., Zerbe et al., and Stewart.

It is our view that appellants did not have sufficient notice that Zerbe et al. and Stewart would be relied upon by the examiner on appeal since those two references were not included in the statement of rejection in the final rejection; and the examiner should have indicated that the rejection being applied in the answer is a new ground of rejection.

Second, we find that the reasons given by the examiner for combining all four references are unclear and confusing.

The examiner should clearly state which specific features in each reference are being relied upon, point out how those features relate to elements recited in appellants' claims, and clearly explain why a person of ordinary skill in the art would have found it obvious to combine the features disclosed in the references.

In this regard, in rejecting the claims the examiner should distinguish more clearly between claims which include “container” and “segment” limitations, such as claim 1; and those that do not, such as claims 19 (no container), 36 (no container), 53 (no container or segments), 71 (no segments), 83 (no segments), 85 (no container or segments), 87 (no container or segments), and 90 (no container or segments).

Third we note that in the “Evidence Relied Upon” section of the answer, the examiner has failed to include Leung et al. and Ream et al., which should be included since they are two of the four references relied upon by the examiner in rejecting the claims.

Fourth, on page 3 of the answer the examiner has identified Ream et al. by two different patent numbers. The examiner should make sure the references are identified by their correct patent numbers.

Fifth, the examiner has addressed some, but not all, of the claims separately argued by appellants in their brief. In this regard, we note that claims 72-78 have been separately discussed in the brief, but not separately addressed in the answer.

In view of the foregoing, we remand the application to the examiner, and require that the examiner take appropriate action consistent with current examining practice to resolve all of the deficiencies noted above.

This application, by virtue of its “special status”, requires immediate action on the part of the examiner. See MPEP § 708.01 (8TH ed., Rev. 4, Feb. 2005). It is important

that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

This remand is made for the purpose of directing the examiner to further consider the ground of rejection. Accordingly, if the examiner submits a supplemental answer to the Board in response to this remand, "appellant must within two months from the date of the supplemental examiner's answer exercise one of" the two options set forth in 37 CFR § 1.41.50(a)(2) (2005), "in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding," as provided in this rule.

REMANDED

MARC L. CAROFF)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
EDWARD C. KIMLIN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES F. WARREN)	
Administrative Patent Judge)	

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