

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opinion in support of the remand being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN COREY WREN

Appeal No. 2006-0678
Application 09/504,374

ON BRIEF

Before OWENS, LEVY, and NAPPI Administrative Patent Judges.
LEVY, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

DISCUSSION

From our review of the record, we find that the examiner's answer (page 3) lists the prior art relied upon as being Shavit, Filepp and the Official Guide to the Prodigy Service. On pages 3 and 4 of the answer, the examiner states that:

The following ground(s) of rejection are applicable to the appealed claims:

Claim 66 is rejected under 35 U.S.C. 102(b).

Claims 12-22, 34-39, 41, 47-50, 52-65 and 67-88, rejected under 35 U.S.C. 103.

These rejections are set forth in a prior Office Action, mailed on 30 October 2003.

Turning to the file record, we find no office action that was mailed on October 30, 2003. Rather, we find that prior Office action was the final rejection which was mailed on November 10, 2003¹. Turning to the November 10, 2003 final rejection, we find (pages 9-26) that the grounds of rejection under 35 U.S.C. § 102 and 35 U.S.C. § 103(a) applied against the claims listed by the examiner to be as follows:

¹ We presume that the final rejection mailed November 10, 2003 was the prior office action referred to by the examiner.

1. **Claim 66 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shavit et al. (US Patent 4,799,156).**
2. **Claims 12, 47, 48, 52, 64 and 66** and their dependent claims, drawn to an apparatus, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* et al. (US Patent 5,347,632).
3. **Claims 34-41, drawn to a system, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* et al. (US Patent 5,347,632)/*Filepp*.**
4. **Alternatively, Claims 12-18, 20-22, 34-39, 41, 47-50, 52-59, 60-65, 70, 81 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* et al. (US Patent 5,347,632) in view of John Viescas, Official Guide to the Prodigy Service, Microsoft Press, 1991, ISBN 1-55615-374-0, Ch, 6, pages 210, 217, 220 and 227.**
5. **Claims 16, 50 and 56,** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by an unknown author, Services: AT&T Provides Compass, Communications International., London, July 1993, vol. 20, issue 7, 2 pages/ATT Services.
6. **Claims 67 and 78** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by an unknown author, Prodigy Services Add Offerings, Wall Street Journal (Eastern edition), New York, N.Y. Mar 18, 1991, Proquest ID 27808985. The article was accessed from the Internet on 20 October 2003/*Offerings*.
7. **Claims 68 and 79** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by Williams, Bob, Blanc, Maureen, Horn, Sabrina, Perkins, Alyce entitled *Verity Announces TOPIC Real-Time and Strategic Alliance With Dow Jones & Co.*, Business Wire. New York: Apr. 23, 1990, Sec. 1. Pg. 1, ProQuest ID: 6395601/*Verity*.
8. **Claims 69 and 80** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by Don Oldenburg, Making the Right Connection, The Washington Post

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(pre-1997 Fulltext). Washington, D.C.: Jan. 29, 1993, pg. b.05/*Right Connection*.

9. **Claims 71 and 82** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by Bob Bruce, entitled *Home-Based Banking Slowly Catching*, Boulder County Business report, Boulder, CO, Oct 1989; Vol. 8;Iss.9; Sec. 1, pg. 6; ProQuest ID: 7285253/*Home-Based Banking*.

10. **Claims 72, 73, 83 and 84** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by an anonymous author, *New Competitor for Prodigy*, Catalog Age, New Canaan: Aug 1991, Vol. 8, Iss. 8; p. 38, accessed via Proquest on 20 October 2003/*New Competitor for Prodigy*.

11. **Claims 74 and 85** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by Michael Pollick, *Online Services Get on Track*, The Sun, Baltimore, August 11, 1991, p.1/*Online Services* and further in view of an article by Michael Banks, *How to Determine Which Personal Online Service is Right For You*, Medford: Mar/Apr 1993, Vol. 10, Iss. 2; pg. 20, ProQuest ID:98658/*Right For You*.

12. **Claims 75, 76, 86 and 87** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of *Software Publishing Corp. Unveils New Support Warranty Policy*, Len Filppu, Business Wire, New York, 26 August 1993/*Support Policy*.

13. **Claims 77 and 88** are rejected under 35 U.S.C. 103(a) as being unpatentable over *Filepp* in view of an article by Karen M. Cheseby, Kenneth T. Berents, Paul T. Sweeney, *What the Analysts Say*, The Washington Post, Washington, D.C.: Aug. 23, 1993. Pg. F.33. ProQuest ID: 72181259/*Pricing Strategy*.

At the outset, we note that the listing of references (answer, page 3) is inconsistent with the references listed in the statements of the rejection. We also note that in the final rejection, the examiner additionally rejected claims under 35

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U.S.C. § 112, first paragraph, 35 U.S.C. § 112, second paragraph, as well as under the Judicially created doctrine of Obviousness-type double patenting. In the answer (page 2) the examiner withdrew the rejections under 35 U.S.C. § 112. However, because the rejection based upon obviousness-type double patenting was neither repeated nor referred to in the examiner's answer, we presume that this rejection has been withdrawn by the examiner. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

Turning to appellant's brief, appellant provides (brief, pages 3 and 4) a statement of the issues regarding the claims rejected under 35 U.S.C. § 102 and 35 U.S.C. § 103(a), as follows:

Whether claim 66 is anticipated by Shavit et al under 35 U.S.C. 102?

Whether claims 12, 34-41, 47, 48, 52, 64 and 66 are unpatentable under 35 U.S.C. 103(a) over Filepp et al.

Whether Claims 12-18, 20-22, 34-39, 41, 47-50, 52-59, 60-65, 70 and 81 are unpatentable under 35 U.S.C. 103(a) over Filepp in view of John Viescas, Official Guide to the Prodigy Service, Microsoft Press?

Whether Claims 16, 50 and 56 are unpatentable under 35 U.S.C. 103 over Filepp in view of Services, AT&T Provides Compass?

Whether Claims 67 and 78 are unpatentable under 35 U.S.C. 103 over Filepp in view of an article; Prodigy Services Add Offerings, Wall Street Journal?

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Whether Claims 68 and 79 are unpatentable under 35 U.S.C. 103 over Filepp in view of an article; Verity Announces TOPIC Real Time and Strategic Alliance With Dow Jones & Co.?

From the listing of the issues by appellant, we find that appellant only lists the first six of the thirteen rejections set forth in the examiner's final rejection dated November 10, 2003.

Turning back to the examiner's answer, we find that the examiner has not addressed this discrepancy. Similarly, from our review of the reply brief, we find (reply brief, pages 3 and 4) that appellant repeats the same list of issues from the brief, without commenting on the discrepancy between the listing of issues in the brief and the statement of the rejection in the examiner's answer (pages 3 and 4) which refers back to the final rejection.

From all of the above, we are unable to determine which rejections and which references are before us for decision on appeal. Accordingly, we remand this case to the examiner for clarification of this matter.

SUMMARY

In light of the above, the examiner and appellant should take appropriate action with respect to the issues raised. We do not remand this case lightly, and are cognizant of the fact that

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this application has been pending at the USPTO for a relatively long length of time. However, a correct copy of the applied prior art and a correct copy of the rejections applied against the claims must be ascertained in order for us to decide this appeal.

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure (MPEP) § 708.01(D) (8th Ed., Rev. 4, October, 2005). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal of this case.

REMANDED

TERRY J. OWENS)	
	Administrative Patent Judge)
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	STUART S. LEVY) BOARD OF APPEALS
	Administrative Patent Judge) AND
)) INTERFERENCES
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	ROBERT E. NAPPI)
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SSL/cam

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