

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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

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Ex parte MICHAEL ZOECKLER and TARCISIO SANTORO

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Appeal No. 2006-0722  
Application No. 09/971,469

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ON BRIEF

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Before FRANKFORT, McQUADE and BAHR, Administrative Patent Judges.  
FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 41.50(a)(1) for appropriate action with regard to the items listed below.

In light of this remand, the oral hearing scheduled for 1:00 PM on March 21, 2006 was vacated.

In the present appeal, claims 1, 5, 6, 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson (U.S. Patent No. 2,502,117). In addition, claims 1 through 6 and 8 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Walsh (U.S. Patent No. 5,794,812). Claims 2, 4 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Anderson in view of Mitchard (U.S. Patent No. 4,946,540) or Anderson in view of Walsh taken further in view of Mitchard. Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Anderson in view of Goldsborough (U.S. Patent No. 5,163,891) or Anderson in view of Walsh taken further in view of Goldsborough.

On August 30, 2004 appellants filed a reply brief. The reply brief included several pages of arguments and comments concerning the examiner's position as set forth in the answer and specifically urged that the rejections based on Anderson alone and Anderson in view of Walsh were improper. In response to the reply brief, the examiner sent out a notice (mailed October 5, 2004) informing appellants that the reply brief had been "received." Noting the ambiguity of such a notification, the

assigned Board panel remanded the application to the examiner to provide a clear indication as to whether the reply brief was actually entered and considered. It was also expressly indicated that the examiner should provide a response on the record to the arguments advanced by appellants in the reply brief. See the remand mailed September 13, 2005.

On September 23, 2005 the examiner mailed a paper indicating that the reply brief had been "entered and considered," but declined to provide a meaningful response on the record to the arguments set forth in the reply brief, contending that such arguments were not new issues and had been dealt with on pages 6 and 7 of the answer.

We again REMAND this application to the examiner. Assuming our earlier remand did not make the point clearly enough, what we want and expect from the examiner is a specific response on the record to the various arguments raised in the reply brief filed August 30, 2004. More particularly, we expect the examiner to point out where in Anderson there is any teaching or suggestion of the method steps set forth in claim 1 on appeal and, even more specifically, where there is a teaching or suggestion for the

modification of Anderson urged by the examiner. As noted in the reply brief, the examiner's observation in the answer (pages 3-4) that Anderson's apparatus is "capable of cutting both sheets and would do so if the adjustable slot cutters were not properly aligned with the pre-cut slots in the carton sheets" amounts to nothing more than an allegation that Anderson could perform the function recited in appellants' method claims.

Nor do we find any meaningful information on pages 6 and 7 of the answer to support the examiner's conclusion of obviousness, or which reasonably provides response to appellants' arguments. The examiner's use of "canned" form paragraphs citing platitudes like those on pages 6 and 7 of the answer are no substitute for a reasoned analysis of the facts and of the teachings or suggestions to be fairly derived from the applied references by one of ordinary skill in the art which would have led to the particular modification of Anderson urged by the examiner.

Assuming that a supplemental examiner's answer clarifying the issues discussed above will be written in response to this remand, it follows that appellants may exercise one of the options set forth in 37 CFR § 41.50(a)(2).

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 3, August 2005.

REMANDED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
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	)	
	)	BOARD OF PATENT
JOHN P. McQUADE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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Steve M. McLary, Esq.  
Graphic Packaging International, Inc.  
814 Livingston Court  
Marietta, GA 30067

CEF/ki

