

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 KIM KWEE NG, pro se*

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Appeal No. 2006-0802  
Application 10/151,141

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ON BRIEF

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Before GARRIS, WARREN and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

*REMAND TO THE EXAMINER*

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 CFR §41.50(a)(1) (2005); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 3, August 2005).

The record shows that the following grounds of rejection were of record in the final action mailed December 4, 2003 (final action), and maintained by the Examiner on appeal in the examiner's answer mailed October 5, 2005 (answer):

claims 11 through 15, 19 through 21, 23 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention (final action, pages 2-3; answer, page 4);

claims 10 through 15 under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Ross (final action, pages 3-4; answer, page 5);

claims 16, 17, 22 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Ross as applied to claims 10 through 15<sup>1</sup> above and further in view of Kozak et al. (Kozak) or Burlando (final action, pages 4-5; answer, pages 5-6);

claims 10 through 15 and 18 through 21 under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Corbitt (final action, pages 5-6; answer, pages 6-7); and

claims 16, 17, 22 through 25 under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Corbitt as applied to claims 10 through 15 and 18-21 above and further in view of Kozak or Burlando (final action, pages 6-7; answer, pages 7-8).

In the brief filed August 23, 2004, the Appellant states under “Status of claims” that “Claims 10-25 are rejected” and that “[t]he appellant is appealing Claim 10, Claim 18 and Claim 22” (page 1), and further states only the following “Issues:”

- (i) Claim 10 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Ross (page 4);
- (ii) Claim 18 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Corbitt (page 5, 12-14 and 24-25); and
- (iii) Claim 22 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kiecker in view of Burlando (pages 5-6).

Further in the brief, under “Grouping of Claims,” the Appellant states that each of independent claims 10, 18 and 22 are “rejected under 35 U.S.C. § 103(a),” and includes under each statement the claims dependent on the independent claim and whether the dependent claims are “rejected under 35 U.S.C. § 112, second paragraph,” and/or “rejected under 35 U.S.C. § 103(a)” without particulars, noting that “[t]he dependent claims are added to the list as per instructions from the Examiner in the Office communication dated 8/6/2004” (page 6). The Appellant then states “[t]he claims in the group do not stand or fall together. Claim 18 is separately patentable from the group comprising 10 and 22” (page 6).

Still further in the brief, under “Arguments,” the Appellant states that “[t]he applicant has elected to appeal Claims 10, 18 and 22” and presents arguments only with respect to claim 10 with respect to the combined teachings of Kiecker and Ross (pages 7-10 and 23-24), claim 18 with respect to the combined teachings of Kiecker and Corbitt (pages 12-14 and 24-25), and

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<sup>1</sup> We consider the examiner’s stated claim range of “1-15” as “10-15” which reflects claims 10 through 25 of record as of the final action and the filing of the brief.

claim 22 with respect to the combined teachings of Kiecker and Burlando (pages 5-6, 15-19 and 26).

With respect to the remaining contents of the brief, we point out here that appeal is taken from the action of the primary examiner twice rejecting claims of record. 35 U.S.C. § 134(a) (2002); 37 CFR § 1.191(a)(1) (2004); MPEP §1205 (8th ed., Rev. 2, May 2004); see also 37 CFR § 41.31(a)(1) (September 2004); MPEP §1204 (8th ed., Rev. 3, August 2005). Thus, claims proposed by an Applicant in unentered amendments are not before the Board on appeal, and the matter of the non-entry of the amendments is petitionable and not appealable. See MPEP §§ 706.01, 714.13, II. Entry Not A Matter Of Right, and 1201 (8th ed., Rev. 2, May 2004; 8th ed., Rev. 3, August 2005).

In the answer (pages 2-3), the Examiner does not address the Appellant's statement under "Status of Claims," "Grouping of Claims," and "Arguments" that he is only "appealing Claims 10, 18 and 22," even in view of the statements with respect to the dependent claims set forth under "Grouping of Claims" at the direction of the Examiner.

If the Appellant indeed intends to limit the appeal to independent claims 10, 18 and 22, that is, to withdraw the appeal with respect to dependent claims 11 through 17, 19 through 21 and 23 through 25, the appeal will be dismissed as to claims 11 through 17, 19 through 21 and 23 through 25 with the consequent loss of these claims to the Appellant. See MPEP §1215.03 (8th ed., Rev. 2, May 2004; 8th ed., Rev. 3, August 2005).

The Examiner further does not address the Appellant's statement of the "Issues" which does not include the second ground of rejection of claim 10 under 35 U.S.C. § 103(a) or the correct grounds of rejection of claim 22 under the same statutory provision, noting only that the ground of rejection of certain dependent claims under 35 U.S.C. § 112, second paragraph, was not accounted for (answer, page 2). See 37 CFR § 1.192(c)(6) (2004); MPEP §1206 (8th ed., Rev. 2, May 2004); see also 37 CFR § 41.37(c)(1)(vi) (September 2004); MPEP §1205.02 (8th ed., Rev. 3, August 2005). The Examiner further considers the dependent claims to be grouped with the independent claims even though the Appellant does not so group the claims under "Grouping of Claims." See 37 CFR § 1.192(c)(7) (2004); MPEP §1206 (8th ed., Rev. 2, May 2004); see also 37 CFR § 41.37(c)(1)(vii) (September 2004); MPEP §1205.02 (8th ed., Rev. 3, August 2005). The examiner further does not address that the second ground of rejection

of claim 10 under 35 U.S.C. § 103(a), the correct grounds of rejection of claim 22 under 35 U.S.C. § 103(a) and the ground of rejection of dependent claims under 35 U.S.C. § 112, second paragraph, have not been briefed. See 37 CFR § 1.192(c)(8) (2004); MPEP §1206 (8th ed., Rev. 2, May 2004); see also 37 CFR § 41.37(c)(1)(vii) (September 2004); MPEP §1205.02 (8th ed., Rev. 3, August 2005).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to notify the Appellant that the brief filed August 23, 2004, is not compliant as we have discussed above as provided in 37 CFR § 1.192(d) (2004); see also 37 CFR § 41.37(d) (September 2004), in order that Appellant's intentions with respect to the grounds of rejection, the dependent claims and the arguments to be considered are clear as provided in the rules, with a view toward placing this application in condition for decision on appeal with respect to the issues presented.

This remand is *not* made for the purpose of directing the examiner to further consider the grounds of rejection. Accordingly, 37 CFR § 41.50(a)(2) (2005) does not apply.

We hereby remand this application to the examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This application, by virtue of its “special” status, requires immediate action. It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal in this case. *See MPEP § 708.01(D)* (8th ed., Rev. 3, August 2005).

*Remanded*

BRADLEY R. GARRIS	)
Administrative Patent Judge	)
	) BOARD OF PATENT
	) APPEALS AND
	) INTERFERENCES
CHARLES F. WARREN	)
Administrative Patent Judge	)

Kratz, *Administrative Patent Judge*, concurring

I concur with the majority=s Decision to Remand this application to the Examiner. However, unlike the majority, I would suggest that the examiner prepare a notification that omits any reference to 37 CFR § 1.192(d). This is so because it is my opinion the format provisions of 37 CFR § 1.192 (c), with which such a notification is primarily concerned, would not be applicable when a Brief is filed by an Appellant (Applicant) who is not represented by a registered practitioner, as the record reflects to be the case here.

I write separately to further emphasize, in my opinion, that the Examiner should take appropriate action to secure written clarification from Appellant as to the particular rejected claims included in this appeal by Appellant. In this regard, I would urge the Examiner to notify Appellant of the apparent inconsistency in the Brief filed August 23, 2004 concerning the appeal status (and the consequences of such status) of rejected claims 11 through 17, 19 through 21, and 23 through 25. The inconsistency is evident from a review of the Brief and in light of the majority=s Remand Decision Opinion. I would suggest that the Examiner should require a clear accounting of the rejected claims that are the subject of this appeal from Appellant in order to resolve any ambiguity in the previously submitted Appeal papers as to the claims on appeal.

I would also have suggested that the Examiner should remind/notify Appellant as to the provisions of our Federal Regulations respecting appeals, especially 37 CFR § 1.192 (a), as in effect at the time of the filing of Appellant's Brief, especially in light of any substantive deficiencies in the Brief in addressing any rejections of appealed claims. In this regard, I would have urged the Examiner to explain to Appellant that arguments and authorities that Appellant intends to rely on must be furnished in the Briefs. I would suggest that the Examiner inform Appellant that all outstanding rejections of each and every appealed claim that Appellant clearly makes a subject of this appeal should be addressed in the Briefs. I would urge the Examiner to notify Appellant of any such deficiency in the previously filed Briefs and urge Appellant to point out and fully explain any perceived errors in each rejection maintained by the Examiner while referring to each rejection and each reference relied upon by the examiner.

In light of the above, I concur with the majority=s decision to REMAND this application to the jurisdiction of the examiner for appropriate action to clarify the appeal record so as to

Appeal No. 2006-0802  
Application 10/151,141

render this application ready for Decision on the appeal issues developed by the Examiner and Appellant.

PETER F. KRATZ  
Administrative Patent Judge

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 ) APPEALS AND  
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Appeal No. 2006-0802  
Application 10/151,141

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