

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written for publication and is not binding precedent of the Board.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 LESEK ZALUSKI, ALICJA ZALUSKA and JONN Q. STROM-OLSEN

Appeal No. 2006-0867
Application No. 10/257,943

ON BRIEF

Before GARRIS, JEFFREY T. SMITH and FRANKLIN, Administrative Patent Judges.
JEFFREY T. SMITH, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon careful review of the record in this appeal, we determine that this application is not in condition for a decision at this time. Accordingly pursuant to our authority under 37 CFR § 41.50(a)(1)(2004), we remand this application to the jurisdiction of the Examiner for an action consistent with our remarks below.

In the answer, the Examiner maintains a 35 U.S.C. § 103(a) rejection of appealed claims 1 to 9, 11 and 24 over Gluckstein, U.S. Patent No. 3,313,598, Liebhafsky, U.S. Patent No. 3,098,769, and Spinner, U.S. Patent No.

4,013,422. In addition to the arguments presented by the Appellants in the Brief, Appellants refer to rebuttal evidence in the form of two non-patent literature documents, as well as a declaration.¹ (See brief, pages 2, 3, 11, 12 and 13). The Examiner provides a brief response to only the declaration evidence on page 6 of the answer. The Examiner has failed to discuss the Appellants' reliance on the article to Kong and the article to Aiello.²

While the burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103(a) resides with the Examiner, the Appellants are entitled to present arguments and evidence (including documents) to rebut any prima facie case established by the Examiner. In order to determine the propriety of the rejection, all arguments and evidence must be fully considered by the Examiner. In the present case, the record is deficient because the Examiner has not addressed the documents relied upon by the Appellants to rebut any prima facie which has been established. The Examiner should fully explain why the documents relied upon by Appellants are not suitable to rebut the stated rejection. Thus, the Examiner should issue a Supplemental Answer fully responding to Appellants' arguments and evidence presented in the Brief.

¹These documents were presented in the response to a non-final amendment submitted by Appellants on February 11, 2004.

²A review of the final rejection reveals that the Examiner has also failed to address the references to Kong and Aiello.

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We also note that Appellants' Brief was submitted on September 29, 2004. Thus, the Appeal Brief should have met the requirements of 37 CFR § 41.37 (effective September 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)). We note that this Brief is defective for at least not including the appropriate evidentiary appendices.

CONCLUSION

For the reasons outlined above, this application is remanded to the jurisdiction of the Examiner. Pursuant to the provisions of 37 CFR § 41.50(a)(2)(2004), Appellants are required to timely respond to any Supplemental Examiner's Answer that may be issued in response to this Remand. As stated in this rule, Appellants must exercise one of the two following options to avoid sua sponte dismissal of the appeal as to the claims involved in the Remand:

(I) Request that prosecution be reopened before the Examiner by filing a Reply Brief under Rule 111 with or without amendment or evidence or

(II) Request that the appeal be maintained by filing a Reply Brief as provided for in 37 CFR § 41.41.

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This application, by virtue of its “special” status, requires immediate action; See
MPEP § 708.01(D)(8th Ed., Rev. 3, Aug. 2005).

REMANDED

BRADLEY R. GARRIS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY T. SMITH)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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BEVERLY A. FRANKLIN)	
Administrative Patent Judge)	

JTS/hh

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