

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 DIRK DANTZ, WILFRIED VON AMMON,
DIRK ZEMKE, and FRANZ SEGIETH

Appeal 2006-0993
Application 10/351,739
Technology Center 1700

Decided: November 3, 2006

Before PAK, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

A review of the record presently before us leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner, via the Office of a Director of the involved Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

As a first matter, we remand the Application to the Examiner for action with regard to the Information Disclosure Statement (IDS) mailed August 9, 2006. This IDS was filed after docketing of the appeal and has not yet been reviewed by the Examiner.

As a second matter, we remand the Application to the Examiner for review of the statement made in the Answer at page 5 (Answer § (10), ¶ 1). In this paragraph, the Examiner states that the Appellants' arguments made in the Brief with respect to the rejection under 35 U.S.C. § 103(a) over Aydelott and Tung "have been fully considered and are persuasive. The rejection of claims 1, 3 and 8 has been withdrawn." This statement is unclear in view of the fact that the only rejection of record in the Final Office Action was a rejection of claims 1, 3, and 8 under 35 U.S.C. § 103(a) over Aydelott in view of the Admitted Prior Art or Tung (Final Office Action 2) and this rejection has been restated in the Answer verbatim (Answer 3). Clarification is required.

As a third matter, we remand the Application to the Examiner to properly cite US Patent 6,072,854 in the "Evidence Relied Upon" section of the Answer and in the statement of rejection of claim 3 if the Examiner is to rely upon this reference to reject claim 3. Presently, the Examiner discusses this reference on page 4 of the Answer in relation to the rejection of claim 3, but the reference is not listed as evidence relied upon nor is it recited in a statement of rejection. Where a reference is relied on to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of rejection. *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

CONCLUSION

In summary, we remand this Application to the Examiner for action not inconsistent with the above instructions.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

REMANDED

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BROOKS KUSHMAN PC
1000 TOWN CENTER
TWENTY-SECOND FLOOR
SOUTHFIELD, MI 48075