

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** BERND ECK, DIETER BAUMANN,  
JORG HEILEK and KLAUS JOACHIM

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Appeal No. 2006-1023  
Application No. 10/275, 859

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ON BRIEF<sup>1</sup>

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

**REMAND TO THE EXAMINER**

This case is not ripe for meaningful review and is therefore,  
remanded to the Examiner for appropriate action consistent with the  
views expressed below.

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<sup>1</sup> The hearing for this application scheduled for May 9, 2005, has been postponed because

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On page 6 of the Answer dated August 8, 2005, the Examiner rejects the subject matter of claim 6 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-12 of Application No. 10/181,919 ('919 application).<sup>2, 3</sup> On July 26, 2002, an amendment was filed in the '919 application, canceling claims 1-12. On February 8, 2005, Application No. 10/181,919 issued as US Patent 6,852,881. The Examiner has failed to indicate that the double patenting rejection was applicable to the claims that remained in the '919 application after the July 26, 2002 amendment or that the rejection was applicable to the claims of the issued patent. Thus, the basis of the rejection of the subject matter of claim 6 under double patenting is unclear.

We also note that in the remaining obviousness-type double patenting rejections presented in Answer that the Examiner has failed to detail the specifics of these rejections.

The Board is required by the Federal Circuit to analyze the claims on a limitation-by-limitation basis, with specific fact finding for each contested limitation and satisfactory explanations for such findings. *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997). The

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the issues are not ripe for review.

2 The Examiner's reasoning for the rejection appears in the Final Rejection mailed April 19, 2005.

3 The Appellants in the Brief, filed May 27, 2005, and the Reply Brief, filed September 26, 2005,

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Examiner must meet an equivalent standard, because the Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000).

Further, the Examiner should provide a discussion of the arguments presented by Appellants in the Briefs to the extent that the arguments remain applicable. In light of the above facts, we feel it is premature to decide this appeal. The Appellants should be given an opportunity to respond on the record. Particularly, the Examiner is required to point out on a limitation by limitation basis which claims of the cited references correspond to the limitations recited in the rejected claim. It is important that ambiguous or obscure bases for decision do not stand as barriers to a determination of patentability.

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provides arguments regarding the obviousness-type double patenting of claim 6 over claims 1-12 of Application No. 10/181,919. (Brief, pp. 9-10; Reply Brief, pp. 3-4).

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This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (2004) is made for further consideration of a rejection. Accordingly, 37 CFR § 41.50(a)(2) applies if a supplemental Examiner's Answer is written in response to this remand by the Board.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR ' 1.136(a)(1)(iv)( 2004).

**REMANDED**

PETER F. KRATZ	)	
<b>Administrative Patent Judge</b>	)	
	)	
	)	
	)	
	)	<b>BOARD OF PATENT</b>
CATHERINE TIMM	)	<b>APPEALS</b>
<b>Administrative Patent Judge</b>	)	<b>AND</b>
	)	<b>INTERFERENCES</b>
	)	
	)	
	)	
JEFFREY T. SMITH	)	
<b>Administrative Patent Judge</b>	)	

JTS/sld

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