

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 STEVEN D. BURCH and JOHN C. FAGLEY

Appeal No. 2006-1216
Application No. 10/623,674

ON BRIEF

Before PAK, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

On consideration of the record, we determine that the above-identified application is not ready for a decision on appeal under 35 U.S.C. § 134. Accordingly, we remand this application to the examiner for further consideration and action not inconsistent with our opinion below. 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

In the answer mailed September 07, 2005, the Examiner lists two publications in item No. 8 as comprising the evidence being relied upon in rejecting appellants' appealed claims. In item No. 9 of that answer, the examiner states:

The following ground(s) of rejection are applicable to the appealed claims:
Claims 1-12, 15-18, 20-22 and 24-30 are rejected under 35 U.S.C. § 103(a). This rejection is fully set forth in prior Office action, Paper No. 22005.

That statement of rejection is clearly inadequate in that the examiner does not furnish the requisite full explanation of the rejection(s) being relied upon in the answer itself. Here, the examiner has referred to a prior office action in the answer "without fully restating the point relied on in the answer," as is required. See the first full sentence on page 1200-28 of Section 1207.02 of the Manual of Patent Examination Procedure (MPEP), 8th ed., Rev. 3, Aug. 2004. As the above-noted Section of the MPEP makes clear, the examiner should fully set forth and explain each rejection maintained by the examiner in the answer.

A reference to another Paper, especially using an incorrect paper number, is no substitute for the explanation required in the answer itself.

Here, a review of the final rejection mailed February 09, 2005 (presumably the Paper No. 22005 that the examiner refers to

in the answer) reveals fifteen separate rejections under 35 U.S.C. § 103(a) that were maintained by the examiner in that final office action. All of those rejections employ reference evidence other than that listed by the examiner in the answer, Item No. 8. Some of those rejections employ neither of the two references that the examiner lists in numbered item 8 of the answer as the evidence being relied upon.

This lack of clarity in the rejections and evidence relied upon by the examiner in the answer is further attenuated by the examiner's failure to cite Mugerwa in rejecting claims 4, 5, 10, 11, 12, 15, 16, 17, 18 and 20 in the final rejection because those claims depend on claim 1. In this regard, the examiner relies on Grasso et al. (U.S. Patent Application Publication No. US2001/0004500, Bloomfield (U.S. Patent No. 3,982,962) and Mugerwa in a rejection of independent claim 1 in the final rejection, whereas Mugerwa is not cited in the rejections of the above-noted dependent claims.

Here, the examiner has not explained in the final rejection why Mugerwa is necessary for the rejection of independent claim 1, but not those above-noted dependent claims, each of which includes all of the limitations of claim 1. This is particularly significant in that the examiner has not explained

how Grasso and Bloomfield taken without Mugerwa would have suggested a claimed air recycle limitation of claim 1, a claim feature that the examiner allegedly relies on Mugerwa for suggesting. Whether or not that claim limitation is suggested by the applied references, including Mugerwa is clearly an issue in dispute as evinced by appellants' (brief, pages 13 and 15) arguments concerning that limitation of claim 1. Yet Mugerwa is not even applied against several of the dependent claims, which include that air recycle feature, in the final rejection, as noted above.

Upon receipt of this application as a result of this remand, the examiner should take appropriate action to correct the deficiencies identified above.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) 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.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (8th ed., Rev. 2, May 2004). Thus, it is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

Comment [jvn1]: Type address

CHUNG K. PAK)	
Administrative Patent Judge)	
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PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY T. SMITH)	
Administrative Patent Judge)	

PFK/sld

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CARY W. BROOKS
GENERAL MOTORS CORPORATION
LEGAL STAFF, MAIL CODE 482-C23-B21
P.O. BOX 300
DETROIT, MI 48265-3000

Comment [jvn2]: Type address

APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

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DECISION: **ED**

Prepared By:

DRAFT TYPED: 01 Aug 06

FINAL TYPED: