

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 YOSHITOMO MASUDA, GAKU YAKUSHIJI,
TAKAO OHUCHI and HAJIME KITANO

Appeal No. 2006-1580
Application 10/112,743

ON BRIEF

Before WARREN, TIMM and JEFFREY T. SMITH, *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 examiner rejected appealed claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Yasuda et al. (Yasuda) in the final action mailed October 1, 2004 (page 4), and maintained this ground of rejection in the answer mailed December 15, 2005 (pages 4-5).

Appellants state in the brief that the present appeal includes appealed claim 4 (page 4), but do not include the above ground of rejection under 35 U.S.C. § 103(a) with the ground of rejection of claims 1, 4 and 8 through 11 under 35 U.S.C. § 102(b) as anticipated by Yasuda

under “Grounds of Rejection To Be Reviewed On Appeal” (brief, page 7; reply brief, page 3) and do not specifically argue the ground of rejection under 35 U.S.C. § 103(a).

The examiner erroneously states that appellants’ “statement of the grounds of rejection is correct” (answer, page 2), and does not otherwise point out the deficiency in the brief with respect to the ground of rejection of appealed claim 4. The examiner further erroneously states that all of the appealed claims “stand or fall together,” citing “37 CFR § 1.192(c)(7),” which rule, of course, was superseded by 37 CFR § 41.37(c)(1)(vii) (September 2004) by the time the brief was filed.

37 CFR § 41.37(c)(1)(vi) and (vii) (September 2004) provide that the appeal brief must set forth a “statement of each ground of rejection presented for review” and “[t]he contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vii) of this section,” respectively. *See also* MPEP § 1205.02 (8th ed., Rev. 3, August 2005; 1200-14 – 1200-15). Where appellants do not present a ground of rejection for review in the brief, the appeal is considered to be withdrawn with respect to that ground and the “withdrawal is treated as an authorization to cancel the withdrawn claims.” MPEP §§ 1214.05 and 1215.03 (8th ed., Rev. 3, August 2005).

37 CFR § 41.37(d) (September 2004) provides that appellants will be notified of any deficiency in the brief under the rules and provided with the opportunity to correct the deficiency. *See* MPEP § 1205.03 (8th ed., Rev. 3, August 2005).

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to notify appellants of the deficiency in the brief with respect to the ground of rejection of appealed claim 4 under 35 U.S.C. § 103(a) that we have discussed above and provide appellants with the opportunity to cure the same in order to avoid withdrawal of the appeal and its consequences with respect to this claim, 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 a ground of rejection.

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

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| CHARLES F. WARREN |) | |
| Administrative Patent Judge |) | |
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| CATHERINE TIMM |) | BOARD OF PATENT |
| Administrative Patent Judge |) | APPEALS AND |
| |) | INTERFERENCES |
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| |) | |
| JEFFREY T. SMITH |) | |
| Administrative Patent Judge |) | |

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