

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 RICHARD C. JANZIG and DAVID M. DAHM

Appeal No. 2006-1894
Application No. 09/564,248

ON BRIEF

Before HAIRSTON, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

ON REMAND TO THE EXAMINER

We have reviewed the instant appeal and we remand it to the examiner for further explanation of the outstanding rejection of the claims.

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Appellants and the examiner apparently agree that the Prompt United States Patent Application Publication No. 2001/0034733, filed March 2, 2001, is not a viable reference against the instant claims under 35 U.S.C. § 102(e), or under any other section of that statutory provision, because appellants' effective filing date on the instant application is May 12, 2000. We concur in this assessment.

Yet, the examiner's only official rejection of claims 1-62 is under 35 U.S.C. § 102(e) as anticipated by the Prompt, Publication 2001/0034733. Accordingly, this rejection must be reversed.

We do note, however, that the examiner explains that the Prompt Patent Publication claims the benefit of U.S. Provisional Application No. 60/186,814, filed on March 3, 2000. The examiner then asserts that this provisional application supports the subject matter of the Prompt Publication in making the initial rejection, while appellants, of course, deny that the provisional application can support the subject matter of the publication. For example, appellants point out, with regard to independent claim 51, that the provisional application discloses

nothing about establishing a dual Schema file "at a client side terminal" and discloses nothing about displaying a modifiable

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copy of a data source schema from the dual Schema file in a split window format.

In any event, the examiner has failed to point out specifically how the provisional application filed March 3, 2000 is considered to meet the instant claim language.

If the examiner persists and wishes to make a rejection of claims 1-62 under 35 U.S.C. § 102(e) as anticipated by the provisional application of Prompt, filed March 3, 2000, then the examiner is required to specifically and precisely point out the correspondence of the instant claim limitations of each and everyone of claims 1-62 with something described in the provisional application. In making any such rejection, the examiner must also answer appellants' specific arguments anent claim 51, at pages 3-4 of the reply brief, wherein appellant specifically asserts that the provisional application fails to describe: the establishment of a dual Schema file at the client side terminal; the dual Schema file containing an original copy

of a data source schema and a modifiable copy of the data source schema; the .dsx file as ever being a modifiable copy of the data source schema; the display of the modifiable copy of the data source schema from the dual Schema File in a split window format;

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and the modification of one of the values at least in part in response to a user executed point and click operation.

This case is remanded to the examiner for action not inconsistent with this remand order.

It is important to note that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

This application, by virtue of its "Special" status, requires an immediate action. MPEP §708.01.

REVERSED AND REMANDED

KENNETH W. HAIRSTON)
Administrative Patent Judge)

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