

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 TOBIN J. MARKS and JONATHAN G.C. VEINOT

Appeal 2006-2978
Application 10/299,239
Technology Center 1700

Decided: April 30, 2007

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

A review of the present record before us leads us to conclude that this case is not in condition for a decision on appeal. We remand the application to the Examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §§ 41.35(b) and 41.50(a)(1) (2006).

In particular, we remand this application to the Examiner to clarify the record as to the status of all of the pending claims and as to the rejections being maintained by the Examiner.

Procedural History

In the Final Rejection mailed June 2, 2004, the Examiner presented:

(1) a rejection of claims 14, 16-20, 22, 25-29, 31, and 33 under 35 U.S.C. § 102(b) as unpatentable over Knight (US 5,678,863);

(2) a rejection of claims 21, 23, and 32 under 35 U.S.C. § 103(a) as unpatentable over Knight (US 5,678,863) in view of Dobrusskin (GB 2,282,145);

(3) a rejection of claims 14, 15, 24, and 34 under 35 U.S.C. § 103(a) as unpatentable over Revol (US 5,629,055) in view of Tissue (Electromagnetic Spectrum); and

(4) a rejection of claim 34 under 35 U.S.C. § 102(e) as unpatentable over Hanelt (US 5,827,449).

(5) a statement indicating that the rejection of claims 15 and 24 over Knight in view of Hanelt US 5, 827, 449 has been withdrawn.

In the Examiner's Answer mailed June 28, 2006, the Examiner indicated that the rejection of claims 14, 15, 24, and 34 over Revol in view of Tissue and the separate rejection of claim 23 had been withdrawn. The Examiner further indicated that Appellants' Brief had omitted claim 24 from the 35 U.S.C. § 102(b) rejection over Knight (Answer 3).

Prior to the statement of the rejection in the Examiner's Answer, the subject matter of claims 15 and 24 had not been rejected under 35 U.S.C.

§ 102(b) as anticipated by Knight. A review of the Office Actions preceding the Examiner's Answer indicates that the Examiner believes that the subject matter of claims 15 and 24 was obvious over Knight in view of a second reference. The statement of the §102 rejection appearing in the Final Rejection from which the Appellants have taken this appeal does not include a discussion of claims 15 and 24.¹ As such, it appears that the Examiner is providing a new basis of rejection for claims 15 and 24.² The Appellants indicated in the principal Brief that the subject matter of claims 15 and 24 was to be separately treated (Br. 4). However, the Appellants have not indicated in the Reply Brief that the subject matter of claims 15 and 24 should be separately treated.

The Examiner should clarify the record as to whether or not the subject matter of claims 15 and 24 is newly rejected. The Examiner should take appropriate action consistent with current examining practice and procedure to notify Appellants of the proper status of the rejected claims.

The Examiner should provide Appellants with the opportunity to clarify the present record and to present separate arguments for subject matter of claims 15 and 24 if appropriate.

¹ The Examiner has relied on the statement of the §102 rejection appearing in the Office Action mailed December 23, 2003. The §102 rejection appearing in this Office Action did not include a discussion of claims 15 and 24.

² The Examiner's discussion of claims 15 and 24 in the Answer does not appear to address the concerns previously raised in the prior Office Actions. To support a rejection under §102, the Examiner must indicate where the claimed features are expressly described or are inherently present in the cited reference. In the present case, the Examiner must explain why the features previously considered obvious are now anticipated by the cited reference.

ORDER

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to rectify the above-noted matters.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center involved, for appropriate action in view of the above comments.

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.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

REMANDED

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