

The opinion in support of the decision being entered today  
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* ROBERT R. KREBS, MICHAEL E. INGRIM,  
ERNEST L. PHELPS, VIRGIL B. CANADY,  
and BILLY JOE BILLECK JR.

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Appeal 2006-3060  
Application 09/683,735  
Technology Center 1700

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Decided: May 31, 2007

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Before PETER F. KRATZ, CATHERINE Q. TIMM, and  
JEFFREY T. SMITH, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

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 for obtaining clarification of the record as to the appeal status of all of the pending claims.

In the second Supplemental Appeal Brief filed on October 14, 2005, Appellants furnish conflicting information with respect to the claims on appeal. In the Status of the Claims section of the second Supplemental Appeal Brief, Appellants note the final rejection of claims 1, 3-15, and 23-40 but state that they “appeal the Examiner’s final rejection of the claims as they relate to claims 1, 3-7, 38, 39 and 40” (Second Supplemental Br. 2). However, in the Summary of the Claimed Subject Matter section of the second Supplemental Appeal Brief, Appellants indicate that “[c]laims 1, 8, 23, 31, 38, 39 and 40 are the only independent claims involved in the present Appeal” (*Id.* 2). Also, in the Claims Appendix to the second Supplemental Appeal Brief, Appellants present all of the rejected claims 1, 3-15, and 23-40 while in the Arguments section of the second Supplemental Appeal Brief, Appellants present arguments addressing the Examiner’s rejections as to claims 1, 3-7, and 38-40 only.

In light of the above, Appellants’ second Supplemental Appeal Brief bears some inconsistencies in describing the rejected claims which Appellants regard as being on appeal here. These inconsistencies are further exacerbated by Appellants’ comments at page 2 of the Appeal Brief filed on November 15, 2004 and page 2 of the Supplemental Appeal Brief filed on December 21, 2004, wherein Appellants seemingly indicate that rejected claims 8-15 and 25-37 are not addressed in the Brief because Appellants contemplate further amendment of same after a Decision on Appeal is reached with respect to the remaining claims. However, a *pro forma* affirmance of the rejection of an unargued rejected claim or a dismissal of the appeal as to an unargued rejected claim generally results from the failure

to argue a rejected claim in an Appeal Brief. *See* MPEP § 1205.02 (8th ed., Rev. 3, August 2005).

37 C.F.R. § 41.31(c) provides, in part, that: “An appeal, when taken, must be taken from the rejection of all claims under rejection which the applicant or owner proposes to contest.” Thus, where Appellants do not present an Examiner’s 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). In this regard, the grounds of rejection presented for review in the second Supplemental Appeal Brief do not match the Examiner’s statement of the grounds of rejection set forth in the Final Rejection and the Examiner’s Answer.

As part of the procedural history of this application, we observe that the Examiner maintained that the Supplemental Appeal Brief filed on December 21, 2004 was defective for failure to comply with several provisions of 37 C.F.R. § 41.37(c) in a Notification of Non-Compliant Appeal Brief mailed September 22, 2005. In the Answer mailed January 03, 2006, the Examiner agreed with Appellants’ “Status of Claims,” “Summary of Claimed Subject Matter,” “Claims Appendix,” and “Grounds of Rejection to be Reviewed on Appeal” set forth in the second Supplemental Appeal Brief. Hence, the Examiner accepted the second Supplemental Appeal Brief as being in compliance with our regulations, notwithstanding the inconsistencies therein noted above. Thus, the multiple Briefs and Answer leave the appeal record in an unclear status for our review.

### BASIS FOR REMAND

37 C.F.R. § 41.37(d) (September 2006) 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). Here, the Examiner is ordered to clarify the appeal record by providing Appellants with a Notification and the opportunity to cure the above-noted inconsistencies in the previously filed Briefs by filing an Amended Brief (a substitute Brief, not a Supplemental Brief, for the three current Briefs on file) with a view toward placing this application in better condition for decision on appeal.

Upon submission of such an Amended Brief, the Examiner should submit a replacement Answer directed thereto.

### ORDER

Accordingly, the Examiner is required to take appropriate action consistent with current examining practice and procedure to rectify the above-noted matters. 37 C.F.R. § 41.50(a)(2) (2005) does not apply.

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 application, by virtue of its “special” status, requires immediate action.

### REMANDED

Appeal 2006-3060  
Application 09/683,735

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