

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 KANTA KUMAR and
CHESTER A. BACON, JR.

Appeal 2006-3344
Application 10/202,150
Technology Center 1700

Decided: April 5, 2007

Before THOMAS A. WALTZ, PETER F. KRATZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This appeal involves claims 1, 3-6, 9, 11-19, and 23. We remand the application to the jurisdiction of 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 November 16, 2005, the Examiner presented:

(1) a rejection of claims 1, 4-6, 11, 12, 15, 16, 18, 19, and 23 under 35 U.S.C. § 103(a) as unpatentable over Getter (WO 00/12301) in view of Paeglis (US 4,737,213);

(2) a rejection of claims 3, 9, and 17 under 35 U.S.C. § 103(a) as unpatentable over Getter (WO 00/12301) in view of Paeglis (US 4,737,213) and further in view of 3M Scotchlite Reflective Material-High Gloss Series 6200 Product Bulletin (3M);

(3) a rejection of claims 13 and 14 under 35 U.S.C. § 103(a) as unpatentable over Getter (WO 00/12301) in view of Paeglis (US 4,737,213) and further in view of Rega (US 6,054, 208).

On the first page of the Brief filed on March 13, 2006, Appellants indicate that appeal is being taken from the Examiner's final rejection of claims 1, 3-6, 9, 11-19, and 23. However, the Appeal Brief only presents arguments against the Examiner's § 103(a) rejection of claims 1, 4-6, 11, 12, 15, 16, 18, 19, and 23, albeit the claims appendix includes claims 3, 9, 13, 14, and 17 and all of claims 1, 3-6, 9, 11-19, and 23 are listed as being rejected in the "STATUS OF THE CLAIMS" section of the Brief (Br. 2).

In the Answer mailed May 16, 2006, the Examiner agrees with the rejected status of the claims as presented by Appellants in the Brief. The

Examiner repeats all of the aforementioned 35 U.S.C. § 103(a) rejections in the Answer.

BASIS FOR REMAND

37 C.F.R. § 41.37(c)(1)(vi) and (vii) (2005) 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)(vi) 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 C.F.R. § 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).

Here, the Examiner should afford Appellants an opportunity to clarify the record as to whether or not the separate rejections of claims 3, 9, 13, 14, and 17 under 35 U.S.C. § 103(a), as set forth in the Final Rejection, are being appealed or whether Appellants are, in effect, waiving their right to pursue these rejected claims in this application (appeal withdrawn as to these claims). The Examiner should take appropriate action consistent with current examining practice and procedure to notify Appellants of the deficiency in the Brief with respect to the lack of argument therein

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respecting the grounds of rejection of appealed claims 3, 9, 13, 14, and 17 under 35 U.S.C. § 103(a), which grounds of rejection are being maintained by the Examiner.

The Examiner should provide Appellants with the opportunity to clarify the present record and cure the Brief with regard to same in order to avoid withdrawal of the appeal and its consequences with respect to all of the affected appealed claims, with a view toward placing this application in condition for decision on appeal, with respect to the issues presented.

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

REMANDED

sld/lr

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