

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 JOSEPH KELLY and MIKLOS T. KARA

Appeal 2007-0109
Application 10/741,895
Technology Center 2800

Decided: March 9, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and JEAN R. HOMERE, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

Pursuant to 35 U.S.C. § 134, Appellants have appealed to the Board from the Examiner's Final Rejection of claims 1 through 5 and 7 through 15, the Examiner having objected to claim 6. In accordance with MPEP § 1211 and 37 C.F.R. § 41.50(a)(1), we remand this application to the Examiner.

After considering the record before us, this appeal is not ready for meaningful review. Accordingly, we remand this application to the Examiner to consider the following issues, and to take appropriate action.

In accordance with the discussion at pages 2 and 3 of the Answer, the Examiner has indicated withdrawal of certain grounds of rejection, even though they have not been specified. Presumably, as noted by Appellants at page 8 of the Rely Brief, this applies to the rejections set forth in the Final Rejection. The Answer then proceeds to set forth three new grounds of rejection in-part relying upon newly applied prior art.

First, in contrast to the Final Rejection, the present rejections set forth as new grounds of rejection in the Answer do not include any rejection of claims 3 and 14 on appeal. This is significant since claim 14 is considered or otherwise construed as an independent claim by its recitation of an electronic device according to the method of independent claim 1 on appeal. Thus, since independent claim 1 has been newly rejected on existing prior art, we would expect that independent claim 14 should be rejected in the same manner. This omission and that with respect to claim 3 appear to be inadvertent. In any event, Appellants requested allowance of these claims at page 8 of the Reply Brief. Since the Examiner's subsequent communication

on September 20, 2006 indicating the entry and consideration of the Reply Brief does not respond to this request, the status of claims 3 and 14 on appeal appears to be unclear. In any response to this remand, the Examiner is required to clarify the status of these claims.

More importantly, and of great significant to us, the communication from the Examiner on September 20, 2006 has no additional comments. Inasmuch as the Examiner has set forth new grounds of rejection based in part upon newly applied prior art in the Answer, and the Reply Brief responds accordingly to these new grounds of rejection, this late September communication does not present for our review any responsive remarks by the Examiner to those set forth in the Reply Brief as normally done in the responsive arguments portion of an Answer. Based upon this situation, we consider this appeal to be not ripe for our review. To the extent the present rejections of the claims on appeal are maintained, the Examiner must provide a Supplemental Answer responding to the positions set forth in the Reply Brief for the identified claims argued.

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This application is accordingly remanded to the Examiner for further action consistent with the foregoing.

REMAND

PGC

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