

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 JEAN-PATRICK AZPITARTE

Appeal 2007-0263
Application 09/971,946
Technology Center 2100

Decided: May 3, 2007

Before JAMES D. THOMAS, JOSEPH L. DIXON, and HOWARD B. BLANKENSHIP, *Administrative Patent Judges*.

DIXON, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This is an Order remanding this application to the Examiner. From our initial review of the application and prosecution history, we note a number of items and issues that need to be addressed and clarified by the Examiner prior to our decision on the merits.

First, Appellant has included a proposed amendment to the claims with the Appeal Brief, filed April 25, 2006, which has not been addressed or entered by the Examiner. The Appendix to the Appeal Brief was filed with the amendment to the claims, which is not presently entered. Therefore, the Brief is non-compliant and a new Brief is required.

Second, the Brief is non-compliant with respect to the Summary of the Claimed Invention. MPEP 1205.02 (Eighth Edition, August 2001; Fourth Revision October 2005) sets forth the requirements for the contents of the Brief. Specifically, the Summary of the Claimed invention is as follows:

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. [While reference to page and line number of the specification requires somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.] For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of [37 CFR § 41.37](c)(1)(vii) ..., every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters. See 37 CFR § 41.37(c)(1)(v)

If appellant does not provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), the Office will notify appellant of the defect in the brief and give appellant a time period within which to file an amended brief. See 37 CFR § 41.37(d).

Here, we find that every claim on appeal contains means plus function limitations and many of the claims are separately argued in the Brief, but the Summary of the Claimed Invention does not provide specific correlations of the means limitations to the corresponding structure, acts or materials in the specification as required by 37 CFR § 41.37(c)(1)(v). Rather, the Summary of the Claimed Invention merely includes general citations to portions of the specification. We find this insufficient correlation of the means plus function limitations to permit a meaningful review of the claimed invention. Therefore, Appellant must provide an appropriate Summary of the Claimed Invention as required by 37 CFR § 41.37(c)(1)(v).

Accordingly, it is

ORDERED that the application is returned to the examiner to:

(1) address the merits of the after final amendment dated Apr. 25, 2006 and mail a communication to Appellant. The Examiner should require Appellant to correct the claims appendix to the Appeal brief, if the amendment is not entered.

(2) require a new Appeal Brief in compliance with 37 CFR § 41.37(c)(1)(v) and vacate the Examiner's Answer , if needed, to clarify the record for review; and

(3) take such further action as may be appropriate.

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REMANDED

ELD

Barry L. Kelmachter
BACHMAN & LaPOINTE, P.C.
Suite 1201
900 Chapel Street
New Haven CT 06510-2802