

The opinion in support of the order 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* JUSSI VIROLAINEN and PAULI LAINE

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Appeal 2007-0989  
Application 10/359,809  
Technology Center 2800

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Decided: September 13, 2007

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Before LANCE LEONARD BARRY, JAY P. LUCAS, and JOHN A.  
JEFFERY, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-61. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

## II. PRINCIPLES OF LAW

In an *ex parte* appeal, the Board of Patent Appeals and Interferences "is basically a board of review – we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999). Our opinion addresses three reasons for remanding.

## III. EXPLANATION OF REJECTION

"[T]o have meaningful review, we must be able to understand the examiner's rejection. . ." *Gambogi*, 62 USPQ2d at 1211-12. An "examiner's answer is required to include," M.P.E.P. § 1207.02 (8th ed., rev. 4, Oct. 2005<sup>1</sup>), "[f]or each ground of rejection maintained by the examiner . . . an explanation of the ground of rejection." (*Id.*) "In every Office action, each pending claim should be mentioned by number, and its treatment or status given." *Id.* 707.07(i).

Here, the Examiner rejects the sixty-one pending claims under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 6,462,264 ("Elam") and U.S. Patent No. 5,763,805 ("Yamabata"). Although he enumerates numerous disclosures of Elam and Yamabata (Answer 3-6), the Examiner

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<sup>1</sup> We cite to the version of the Manual of Patent Examining Procedure in effect at the time of the Answer. The cited requirements likewise appear in the latest version of the M.P.E.P.

does not indicate to which of the sixty-one claims each of the disclosures corresponds. After stating the aforementioned basis for rejecting claim 1-61, moreover, his explanation thereof omits claim numbers.

"We decline to substitute speculation as to the rejection for the greater certainty [that] should come from the [Examiner] in a more definite [explanation] of the grounds of rejection[]." *Gambogi*, 62 USPQ2d at 1212. More specifically, the Examiner should treat the sixty-one claims by number. Furthermore, he should map each of the disclosures on which he relies to the specific claims numbers.

#### IV. SUMMARY OF CLAIMED SUBJECT MATTER

For "each of the independent claims involved in the appeal," 37 C.F.R. § 41.37(c)(1)(v)(2005),<sup>2</sup> an appeal brief's *Summary of Claimed Subject Matter* "shall refer to the specification by page and line number, and to the drawing[s], if any, by reference characters." *Id.* Such identification is "considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application." M.P.E.P. § 1205.02.

Here, the Appellants admit that claim 1 is independent and "is drawn to a method. . ." (Br. 4.) Of the Appellants' four drawings, Figure 4 depicts the Appellants' method. To wit, the Figure "illustrates a logical flow

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<sup>2</sup> We cite to the version of the Code of Federal Regulations in effect at the time of the Appeal Brief. The cited requirements likewise appear in the latest version of the C.F.R.

diagram in accordance with a method of th[eir] invention." (Specification 7.) Although the limitations of claim 1 presumably correspond in some way to the steps of Figure 4, the Appellants' *Summary of Claimed Subject Matter* (Br. 3-5), omits reference to that Figure at all, let alone by its reference characters.

We decline to speculate about where the subject matter of claim 1 is shown in the drawings when such information should come from the Appellants. More specifically, they should map each of the limitations of this independent claim to the specific reference characters of Figure 4.

## V. EVIDENCE

An Appeal Brief shall include "[a]n appendix containing copies of any evidence submitted pursuant to ' ' 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal. . ." 37 C.F.R. ' 41.37(c)(1)(ix).

Here, the Appellants rely on the following evidence in contesting the Examiner's rejection:

- "Merriam-Webster online dictionary (<http://www.m-w.com/dictionary/selectively>, visited March 21, 2006)" (Br. 11)
- "relevant entries at [www.wikipedia.com. . .](http://www.wikipedia.com. . .)" (Reply Br. 8)

The Appellants, however, provide no copies of the evidence. Likewise, the *Evidence Appendix* of their Appeal Brief (Br. 36) omits mention thereof.

We are unfamiliar with the content of the "Merriam-Webster online dictionary" back on March 21, 2006. Besides likely being unfamiliar with the content of the *Wikipedia* website on whatever date the Appellants visited it, we are also uncertain which parts the Appellants consider "relevant." Accordingly, we decline to speculate about the evidence that the Appellants should provide.

## VI. CONCLUSION

For the aforementioned reasons, we remand the application to the Examiner to clarify his rejection in a Substitute Examiner's Answer, to ensure that the Appellants map each of the limitations of claim 1 to the specific reference characters of Figure 4, to ensure that the Appellants provide copies of the evidence on which they rely, and for any other action not inconsistent with the views expressed herein.<sup>3</sup> The Substitute Answer should be self-contained with respect to all rejections and arguments; no prior answer or Office action should be referenced or incorporated therein. Similarly, any subsequent brief submitted by the Appellants should be self-contained with respect to all arguments. No prior brief should be referenced or incorporated therein.

Because it is being remanded for further action, the application is a "special" application. M.P.E.P. § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of

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<sup>3</sup> For example, U.S. Patent Application Serial No. 10/101,900, which the Specification "incorporate[s] by reference," (Specification 4), has issued as a U.S. Patent. The Appellants may wish to update the Specification.

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any action affecting status of the appeal (e.g., abandonment, issue, reopening prosecution).

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).

**REMANDED**

tdl/gw

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