

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EIZO KAWATO

Appeal 2007-2995
Application 10/998,567
Technology Center 2800

Decided: October 30, 2007

Before JOHN C. MARTIN, HOWARD B. BLANKENSHIP,
and JOHN A. JEFFERY, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

ORDER REMANDING TO EXAMINER

Appellant's Brief (filed Aug. 23, 2006) includes an "Evidence Appendix" listing a published U.S. patent application, which is further referenced by Appellant's arguments in the Brief. However, there is no indication in the "Evidence Appendix" where the evidence was entered in the record by the Examiner.

37 C.F.R. § 41.37 (2006) provides in pertinent part (emphasis added):

....

(c)(1)(ix) Evidence appendix. An 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, *along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal.* This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

....

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

Accordingly, this proceeding is remanded to the Examiner to either (1) require that Appellant file an amended brief in compliance with 37 C.F.R. § 41.37 that is without reference to unentered evidence, or (2) indicate entry of the published application submitted as evidence after appeal and provide a supplemental examiner's answer that addresses the evidence and Appellant's arguments in reliance on the evidence.

Current Office policy requires that any supplemental answer be approved and signed by a Technology Center Director or designee. *See Manual of Patent Examining Procedure (MPEP) § 1211.01 (8th ed., Rev. 5, Aug. 2006).*

If a supplemental examiner's answer is written in response to this remand, failure by Appellant to exercise one of the two options specified by 37 CFR § 41.50(a)(2) (2007) will result in *sua sponte* dismissal of the appeal as to all the claims that are rejected.

We also note that Appellant's Reply Brief (filed Nov. 21, 2006) refers to computer simulation waveforms ("Figs. A-L") that were apparently filed with the Reply Brief but were not scanned into the image file wrapper.

37 C.F.R. § 41.41 (2006) provides in pertinent part (emphasis added):

. . . .

(a)(2) *A reply brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.*

(b) *A reply brief that is not in compliance with paragraph (a) of this section will not be considered. Appellant will be notified if a reply brief is not in compliance with paragraph (a) of this section.*

We have thus not considered the present Reply Brief, and will not consider it in the event that the proceeding returns to the Board.

This application, by virtue of its “special” status, requires an immediate action. See MPEP § 708.01. It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

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