

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL RICHARD HENNING,
MICHAEL LOCKHART,
ROGER LYNN REYNOLDS,
SUSAN LYNN RITENOUR BARKER,
and KRISTEN WILSON SELLERS

Appeal 2007-3679
Application 10/117,655
Technology Center 1700

Decided: January 30, 2008

Before CHUNG K. PAK, CHARLES F. WARREN, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

REMAND TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action. See 37 C.F.R. § 41.50(a)(1).

The subject matter on appeal is directed to “methods and apparatus for pulling reduced-diameter [fiber-optic] couplers” (Spec. 1, ll. 1-5). Further details of the appealed subject matter are recited in representative claims 1 and 8 reproduced below:

1. Apparatus for pulling a fiber optical coupler to achieve a reduced diameter fused region, comprising;
first and second stages operative to hold the fibers on either side of the fused region, with at least one of the stages being moveable relative to the other;
a furnace positioned relative to the fused region;
a tensometer to determine the tension of the fibers between the stages; and
a controller operative to monitor the tension on the fibers and increase the distance between the stages when the tension falls to a predetermined threshold.

8. A method of pulling a fiber optical coupler to achieve a reduced diameter fused region, comprising the steps of:
suspending a fiber optical coupler having a fused region between first and second stages;
heating the fused region with a furnace;
monitoring the tension on the fibers; and
pulling the fibers when the tension on the fibers reaches a predetermined threshold.

According to the Examiner's statement of rejection at page 4 of the Answer, "[c]laims 1-7 are rejected under 35 U.S.C. [§] 103(a) as obvious over Bjornlie et al., US Patent No. 4,765,816 in view of Naka et al., US Patent No. 6,002,472 or Smith, US Patent No. 5,079,433 or Shine et al., JP 4-349137..." However, in the body of this § 103 rejection, the Examiner specifically refers to "claims 1-14" and discusses obviousness of the subject matter claimed. (Ans. 4-5). Consequently, it is not clear what claims are actually rejected under 35 U.S.C. § 103(a).

At page 5 of the Answer, the Examiner also states that:

Claims 8-14 are rejected under 35 U.S.C. [§] 102(b) as being anticipated by Bjornlie et al., cited above, further evidenced by Smith, cited above.

....

Claims 8-14 are rejected under 35 U.S.C. [§] 102(b) as anticipated by or, in the alternative, under 35 U.S.C. [§] 103(a) as obvious over Harding, GB 2179339 A.

The Examiner's Final Office Action dated December 23, 2005 reveals that:

Claims 1-14 are rejected under 35 U.S.C. [§] 103(a). This rejection is set forth in the prior Office action mailed on October 17, 2005.

...

Claims 8-14 are rejected under 35 U.S.C. [§] 102(b). This rejection is set forth in the prior Office action mailed on October 17, 2005.

Claims 1-14 are rejected under 35 U.S.C. [§] 102/103(a). This rejection is set forth in the prior Office action mailed on October 17, 2005.

According to the electronic record (eDAN 2.2.1), the only prior Non-Final Office Action of record was mailed on June 1, 2005, rather than October 17, 2005. This Non-Final Office Action employs the same statements of rejections set forth in the Answer (p. 3-5). In other words, the statements of the rejections set forth in the Non-Final Office Action, like those of the Answer, are not consistent with the statements of rejections set forth in the Final Office Action. Moreover, the statement of the § 103 rejection in the Non-Final Office Action, like that of the Answer, is not consistent with the body of the rejection. While the Examiner's statement of the § 103 rejection, for example, is directed to claims 1 through 7, the body of the same is directed to claims 1 through 14. Consequently, this recorded prosecution history causes even greater confusion as to what claims are, in fact, rejected under 35 U.S.C. § 103 and 35 U.S.C. § 102(b)/103(a).

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ORDER

Upon return of this Application to the Examiner's jurisdiction, we ORDER the Examiner to clarify the claims rejected in the statements of rejections under 35 U.S.C. § 103(a) and under 35 U.S.C. § 102(b)/103(a) via a Supplemental Answer. See 37 C.F.R. § 41.50(a)(2). The Examiner's statements of rejections must be consistent with the body of the same to avoid any confusion.

Accordingly, we Remand this Application to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) to take appropriate corrective action.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REMAND

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