

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MAKOTO NAMIKAWA, YOSHIO TERADA,
JIROU NUKAGA, and EIJI TOYODA

Appeal 2007-4314
Application 10/297,184
Technology Center 1700

Decided: February 29, 2008

Before PETER F. KRATZ, CATHERINE Q. TIMM, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This appeal was taken pursuant to 35 U.S.C. § 134 from the final rejection of claims 3, 9-11, 14, 15, 19-24, 29-32, 37-45, and 50-52.

Our review of the application leads us to conclude that this appeal is not in condition for a decision at this time. Therefore, we remand the application to the Examiner to consider the following issues and to take appropriate action.

The Examiner in the Answer contends that “the adhesion performance parameters of the cleaning layer (which can include acrylic adhesives) would be either expressly or inherently disclosed, or at most an obvious modification to one of ordinary skill . . .” (Answer 5, ll. 2-6).

In response to the Examiner’s Answer, Appellants filed a Reply Brief on March 09, 2007. The Examiner noted that the Reply Brief had been entered and considered and forwarded the application to the Board. See Paper mailed May 18, 2007. Our review of the record reveals that the Examiner has not indicated whether the evidence (JP-A-2003-253225, JP-A-2001-4920, and the web page of OSAKA ORGANIC CHEMICAL INDUSTRY LTD)¹ furnished by Appellants with the Reply Brief for rebuttal to the Examiner’s rejection of independent claims 1, 9, 30, and 43 and the claims which depend therefrom was entered or not.

Current patent practice and procedure indicates that the Reply Brief should not include any new or non-admitted or evidence. The Examiner’s indication that the Reply Brief has been entered does not indicate the status of the additional evidence. 37 C.F.R. § 41.41 states:

(a)

(1) Appellant may file a reply brief to an examiner's answer within two months from the date of the examiner's answer.

(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

¹ A copy of each document along with a partial English translation of the alleged pertinent portion of the documents was supplied with the Reply Brief.

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.

The present record is unclear as to whether the Examiner has in-fact considered the additional evidence submitted by Appellants with the Reply Brief. The Examiner should clarify the present record by indicating (1) whether or not the Reply Brief is in compliance with 37 C.F.R. § 41.41; (2) whether or not additional evidence submitted with the Reply Brief has been entered and considered; (3) if the evidence has been entered, if appropriate, provide a statement addressing the sufficiency of the evidence; and (4) if it is determined that the Reply Brief is not in compliance with 37 C.F.R. § 41.41, appropriately notify the Appellants.

Accordingly, we remand the application to the Examiner, via the Office of the Director of the Technology Center, to consider the following issues and to take action not inconsistent with the views expressed herein.

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This remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) is made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) applies if a Supplemental Examiner's Answer is written in response to this remand by the Board.

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

PL Initials
sld

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