

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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3
4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* HERMANN AUF DER SPRINGE and HANS GOTTSCHLING
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11 Appeal No. 2007-4350
12 Application No. 10/432,790
13 Technology Center 3600
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16 Decided: December 20, 2007
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19 Before: WILLIAM F. PATE, III, HUBERT C. LORIN, and JENNIFER D. BAHR,
20 *Administrative Patent Judges.*

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22 PATE, III, *Administrative Patent Judge.*
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25 ORDER DISMISSING APPEAL
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27 Responsive to an Appeal Brief filed on March 15, 2006, an Examiner's
28 Answer was mailed in the application file on May 10, 2006. The Answer
29 withdrew the standing rejections of claims 1-6 and 11-12 in favor of New
30 Ground(s) of Rejection outlined on pages 3-6 of the Answer. After stating the
31 New Grounds with respect to claims 1-3, 5, 6, and 11-12 and with respect to
32 separately rejected claim 4, the Answer quoted from 37 C.F.R. § 41.39(b) (2007):

33 *[A]ppellant must within two months from the date of the examiner's*
34 *answer exercise one of the following two options to avoid sua sponte*

1 *dismissal of the appeal* as to the claims subject to the new ground of
2 rejection:
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4 (1) *Reopen prosecution*. Request that prosecution be reopened before
5 the primary examiner by filing a reply under §1.111 of this title with
6 or without amendment or submission of affidavits (§§1.130, 1.131 or
7 1.132 of this title) or other evidence. Any amendment or submission
8 of affidavits or other evidence must be relevant to the new ground of
9 rejection. A request that complies with this paragraph will be entered
10 and the application or the patent under ex parte reexamination will be
11 reconsidered by the examiner under the provisions of §1.112 of this
12 title. Any request that prosecution be reopened under this paragraph
13 will be treated as a request to withdraw the appeal.
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15 (2) *Maintain appeal*. Request that the appeal be maintained by filing a
16 reply brief as set forth in §41.41. Such a reply brief must address each
17 new ground of rejection as set forth in §41.37(c)(1)(vii) and should
18 follow the other requirements of a brief as set forth in §41.37(c). A
19 reply brief may not be accompanied by any amendment, affidavit
20 (§§1.130, 1.131 or 1.132 of this title) or other evidence. If a reply
21 brief filed pursuant to this section is accompanied by any amendment,
22 affidavit or other evidence, it shall be treated as a request that
23 prosecution be reopened before the primary examiner under paragraph
24 (b)(1) of this section [emphasis in original and supplied].

1 Appellants have neither requested that prosecution be reopened nor filed a
2 Reply Brief responsive to the New Grounds of Rejection. Furthermore, the New
3 Grounds run to all claims on appeal. Accordingly, by operation of 37 C.F.R. §
4 41.39(b) (2007) the appeal is *sua sponte* DISMISSED.

5 ORDER

6 It is hereby ORDERED that the Appeal in the above-noted Application
7 stands DISMISSED. The Application is returned to the Technology Center for
8 action not inconsistent with this dismissal.

9 No time period for taking any subsequent action in connection with this
10 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

11 DISMISSED

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