

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* WENGUANG MA and KURT FEICHTINGER

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Appeal 2008-1717  
Application 10/183,841  
Technology Center 1700

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Decided: March 19, 2008

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Before EDWARD C. KIMLIN, PETER F. KRATZ, and  
CATHERINE Q. TIMM, *Administrative Patent Judges*.

KRATZ, *Administrative Patent Judge*.

**ORDER REMANDING TO THE EXAMINER**

This is an appeal from the Examiner's final rejection of claims 17, 19, 20, 24-27, and 51-53, the only claims that remain pending in this application. We have jurisdiction pursuant to 35 U.S.C. §§ 6 and 134.

A principal issue raised in this appeal is whether or not Soda (U.S. Pat. No. 3,270, 572), the primary reference relied upon by the Examiner in each of the obviousness rejections presented for review by Appellants, discloses or suggests a structural skin bonded to a block of core material as part of a structural sandwich composite, as is allegedly required by the appealed claims.

However, the record is unclear as to whether the Examiner has in fact considered and entered evidence (Andrew Marshall's "Composite Basics" (ISBN # 0-9664540-0-6) and U.S. Pat. No. 5,916,672), which evidence is argued and relied upon by Appellants in the Reply Brief filed September 25, 2006 as directly bearing on this contested issue (Reply Br. 5-9). While the Examiner's Communication mailed October 06, 2006 identifies the Reply Brief as having been entered and considered, the Examiner does not address or otherwise communicate the entry status of the above-identified evidence relied upon by Appellants therein. In this regard, we observe that 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 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.

Here, neither the Evidence Appendix of the Brief nor the Reply Brief Evidence Appendix presents a statement by Appellants “setting forth where in the record, that evidence was entered in the record by the examiner” and/or is accompanied by a copy of the cited evidence, as is required.<sup>1</sup> 37 C.F.R. § 41.37(c)(ix). Indeed, the Evidence Appendix to the Brief and the Evidence Appendix to the Reply Brief each state “None.” Also, the record reflects that the Examiner has not furnished that missing information in the Answer and/or otherwise specifically addressed the merits of Appellants’ arguments relying on such evidence to the extent that evidence is of record. On the other hand, and to the extent that the Examiner has determined to deny entry of that evidence in the record, the Examiner has not furnished Applicants with an appropriate Notification of such non-entry of the evidence pursuant to 37 C.F.R. § 41.41 (b).

We decline to speculate as to the entry status of the above-identified evidence. Thus, our review of the record of this application reveals that this appeal is not in condition for a decision at this time.

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<sup>1</sup> We recognize that Appellants indicate that the above-noted evidence, as relied upon in the Reply Brief, is identified in the subject Specification (Reply Br. 5 and 6). However, the mere reference to this evidence in the Specification, even if and when accompanied by a broadly worded incorporation by reference statement as is the case for the U.S. Patent, is not enough of itself to make all of the evidence referred to in the Reply Brief of record for purposes of this appeal.

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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 the additional evidence discussed in the Reply Brief has been entered and considered; (3) if the evidence has been entered, if appropriate, provide a reasoned statement addressing the sufficiency of the evidence in light of the stated rejections and Appellants' reliance thereon in opposition to the stated rejection; 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 foregoing issues and to take action not inconsistent with the views expressed herein.

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 Initial:  
sld

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