The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte CHRISTOPHER J. MILLEY

_____

Appeal No. 2002-1103
Application No. 09/580,413

_____

ON BRIEF

_____

Before GARRIS, DELMENDO, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO EXAMINER

The above identified application is hereby remanded to the examiner for action consistent with our comments below.

This remand is occasioned by a lack of clarity and the file record concerning the issue of claim grouping and argument. Specifically, on page 5 of the brief, the appellant states that "[t]he claims do not stand and fall together". Consistent with

this statement, the appellant presented separate arguments regarding independent claims 1 and 78 on pages 10-13 of the brief as well as separate arguments regarding three distinct groupings of specifically identified dependent claims on page 14 of the brief. In direct conflict with the foregoing circumstances, the examiner on page 2 of the answer stated that the appealed claims "stand or fall together" on the clearly erroneous grounds that "appellants brief does not include a statement that this grouping of claims does [sic: do] not stand or fall together and reasons in support thereof". Further, in her "*Response to Argument*" section of the answer, the examiner failed to address the appellant's aforementioned arguments on page 14 of the brief regarding certain dependent claims. As a response to the examiner's statement on page 2 of the answer, the appellant filed a reply brief explaining whey this statement is erroneous and "[i]n an effort to clarify the grouping of claims for this Appeal", setting forth a total of 43 separate groupings of specifically identified claims. Additionally, the appellant presented in his reply brief arguments regarding the appealed claims (which may or may not correspond to the previously mentioned 43 separate claim groupings) including arguments

regarding certain dependent claims in the paragraph bridging pages 20 and 21 of the reply brief which the appellant acknowledged had not been presented in the principal brief. There, a communication mailed paper 10, 20002 as paper no. 13, the examiner stated "[t]he Reply Brief has been received and entered and considered"; however, the examiner provided no other comment regarding the reply brief.

Under the circumstances recounted above, it is apparent that the subject appeal contains issues concerning claimed grouping and argument which the examiner inappropriately has not addressed. Therefore, in order to properly and effectively pursue this appeal, the examiner must respond to this remand by filing a Supplemental Examiner's Answer which clarifies the file record in the following respects.[1] First, the examiner must specifically express whether she agrees with the 43 separate claim groupings presented by the appellant on pages 3-5 of the reply brief, and, if not, why not. Additionally, in this Supplemental Answer, the examiner must respond to each and every one of the arguments advanced by the appellant including those

[1] We hereby expressly authorize the examiner to provide a Supplemental Examiner's Answer pursuant to 37 CFR 1.193(b)(1) (2002). See the Manual of Patent Examining Procedure (MPEP) Section 1211 (Eighth edition, August 2001).

directed to specific claims which have been separately grouped by the appellant. Finally, in preparing the Supplemental Answer, the examiner must hold and an appeal conference pursuant to MPEP Section 1208 and must follow the guidelines for preparing a § 103 rejection and for responding to an applicant's rebuttal arguments as set forth in MPEP Sections 2141-2145.

This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D).

It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMANDED

BRADLEY R. GARRIS Administrative Patent Judge	)	
ROMULO H. DELMENDO Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)	

vsh

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