

The opinion in support of the remand being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANK C. GOVER, FRANK E. LEVINE,
BRET R. OLSZEWSKI, CHARLES P. ROTH,
EDWARD H. WELBON, and CHARLES WRIGHT

Appeal No. 1999-0288
Application 08/538,071

ON BRIEF

Before THOMAS, HAIRSTON, and LEVY, Administrative Patent Judges.
LEVY, Administrative Patent Judge.

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner for consideration of our findings and to take appropriate action.

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DISCUSSION

We begin with the relevant procedural history. Appellants filed an appeal brief on February 2, 1998 (Paper No. 15). On March 31, 1998, the examiner's answer was mailed (Paper No. 16). Appellants submitted a reply brief to the examiner's answer on June 1, 1998 (Paper No. 20). In response, on July 17, 1998, the examiner filed a supplemental examiner's answer to rebut the arguments presented in the reply brief (Paper No. 21).

Prior to December 1, 1997, the examiner was permitted to provide a supplemental examiner's answer on appeal. However, 37 CFR § 1.193(b)(1) as amended, effective December 1, 1997, sets forth that:

(1) Appellant may file a reply brief The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose. (underlining added).

Because the brief, examiner's answer, reply brief and the supplemental examiner's answer are all subsequent to the December 1, 1997 change in 37 CFR § 1.193, the amended rule in effect at the time of the filing of the brief clearly applies to the supplemental examiner's answer.

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The examiner could have chosen to acknowledge receipt of the reply brief, enter the reply brief, and forward the application to the Board for decision on appeal. Instead, the examiner has chosen to rebut the arguments presented in the reply brief. Under 37 CFR 1.193(b)(1), the examiner lacks authority to sua sponte, enter a supplemental examiner's answer as a response to a reply brief. Government agencies and its officials are bound to follow the agency's regulations. Fort Stewart Schools v. Federal Labor Relations Auth., 495 U.S. 641, 654, 109 L. Ed. 2d 659, 110 S. Ct. 2043 (1990) ("It is a familiar rule of administrative law that an agency must abide by its own regulations."); Schroeder v. West, 212 F.3d 1265, 1270 (Fed. Cir. 2000); Saddler v. Department of the Army, 68 F.3d 1357, 1358 (Fed. Cir. 1995) (agency "must abide by its own regulation"). Thus, we find the supplemental examiner's answer to have been entered without authority.

Accordingly, because the examiner has chosen to rebut the arguments presented in the reply brief, we remand the case to the examiner to reopen prosecution, as required by 37 CFR § 1.193(b)(1), or to take other appropriate action.

In addition, as guidance for further action on this application in view of the remand, we note that 37 CFR § 1.193(b)(2) sets forth that:

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(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

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SUMMARY

This application is remanded to the examiner for appropriate action consistent with our findings, supra. This application, by virtue of its "special" status, requires an immediate action.

Manual of Patent Examining Procedure (MPEP)

§ 708.01(D) (8th Ed., August 2001). It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal of this case.

REMANDED

JAMES D. THOMAS)	
Administrative Patent Judge)	
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KENNETH W. HAIRSTON)	BOARD OF APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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STUART S. LEVY)	
Administrative Patent Judge)	

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