

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HISANORI NASU, YOSHITAKA NAKAMURA,
HITOSHI FUJIMIYA and KENJI YAMAMOTO

Appeal No. 1999-0329
Application No. 08/212,818

ON BRIEF

Before WINTERS, ADAMS, and GRIMES, Administrative Patent Judges.

ADAMS, Administrative Patent Judge.

VACATUR and REMAND TO THE EXAMINER

On consideration of the record we find this case is not in condition for a decision on appeal. For the reasons that follow, we vacate¹ the pending rejections under 35 U.S.C. § 103 and remand the application to the examiner to consider the following issues and to take appropriate action.

¹ Lest there be any misunderstanding, the term "vacate" in this context means to set aside or to void. When the Board vacates an examiner's rejection, the rejection is set aside and no longer exists.

1. Improper Examiner's Answer.

The examiner sets forth two separate rejections on page 4 of the Examiner's Answer. The examiner then states (Examiner's Answer, page 4) "[t]hese rejections are set forth in prior Office Actions, Paper Nos. 13, 4." Manifestly, this is improper.

In relevant part, the Manual of Patent Examining Procedure (MPEP) § 1208 (6th ed., July 1996), states "[a]n examiner's answer should not refer, either directly or indirectly, to more than one prior Office action."

2. The rejections set forth in the Examiner's Answer are new to this record.

Page 2 of the Final Office Action presents two grounds of rejection:

1. Claims 1-5, 7-8, [and] 16-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Tsuda et al. and Rose et al. 4,936,974 and Rose, Jr. 5,180,479 in view of Kobayashi et al.
2. Claim[s] 6, [and] 9-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Rose, Jr. 5,180,479 and Rose et al. 4,936,974.

We emphasize the use of the word "and" in each rejection, clearly suggesting that the references are to be combined with each other. In contrast, the Examiner's Answer presents the following two grounds of rejection:

1. Claims 1-5, 7-8, [and] 16-26 are rejected under 35 U.S.C. § 103 as being unpatentable over Tsuda et al. or Rose et al. 4,936,974 or Rose, Jr. 5,180,479 in view of Kobayashi et al.
2. Claim[s] 6, [and] 9-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Rose, Jr. 5,180,479 or Rose et al. 4,936,974.

We emphasize the examiner's use of the word "or", thereby transforming the rejections from the application of prior art as a combination, to the application of prior art in the alternative.

The record is silent with regard to why the rejections were transformed in this manner. Therefore, it is unclear what "grounds of rejection" the examiner is presenting for our review.

3. Additional evidence relied upon to support the rejections:

Notwithstanding the confusion, set forth supra, in responding to appellants' arguments the examiner relies on two references that are not part of the underlying rejection. First, in response to appellants' arguments regarding the first ground of rejection, the examiner relies on "Zhu et al. 5,069,766, col. 1 to col. 2, line 9." See Examiner's Answer, page 7. Then in response to appellants' arguments regarding the second ground of rejection, the examiner relies on the "teaching of Kobayashi...." See Examiner's Answer, page 10. Note however, that the second ground of rejection does not list the Kobayashi reference as relied upon.

In this regard, we remind the examiner that "[w]here a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference statement of the rejection." In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

As set forth in Gechter v. Davidson, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1033 (Fed. Cir. 1997), “For an appellate court to fulfill its role of judicial review it must have a clear understanding of the grounds for the decision being reviewed,” which requires that “[n]ecessary findings must be expressed with sufficient particularity to enable [the] court without resort to speculation, to understand the reasoning of the board, and to determine whether it applied the law correctly and whether the evidence supported the underlying and ultimate fact-findings.” Like the Court of Appeals in Gechter, this board requires a clear understanding of the grounds for the decision being reviewed. In this case, we find it difficult to understand the examiner’s reasoning and whether the evidence upon which she relies supports the underlying fact-findings for the rejections under 35 U.S.C. § 103. Given the substantial degree of confusion regarding the statement of the rejections and the references relied upon in support of the rejection, we vacate the outstanding rejections and remand the application to the examiner to clarify the record.

We, however, are not authorizing a Supplemental Examiner’s Answer under the provisions of 37 CFR § 1.193(b)(1). Any further communication from the examiner that contains a rejection of the claims should provide appellants with a full and fair opportunity to respond.

Appeal No. 1999-0329
Application No. 08/212,818

This application, by virtue of its "special" status, requires an immediate action. MPEP § 708.01 (7th ed., rev. 1, February 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case.

VACATED and REMANDED

SHERMAN D. WINTERS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
DONALD E. ADAMS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
ERIC GRIMES)	
Administrative Patent Judge)	

Appeal No. 1999-0329
Application No. 08/212,818

FAY, SHARPE, BEALL, FAGAN,
MINNICH & McKEE
104 EAST HUME AVENUE
ALEXANDRIA, VA 22301

DEA/jlb