

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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Appeal No. 2001-0600  
Application No. 08/584,776

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ORDER REMANDING TO EXAMINER

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On page 3 of the Examiner's Answer mailed January 21, 1998 (Paper No. 16), the examiner listed the following references as "(9) Prior Art of Record":

3,956,270	Rambach	5-1976
4,327,999	Koller	5-1982
4,329,144	Eugster	5-1982
4,460,375	Sommer	7-1984
4,536,569	Hashimoto	8-1985

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It should be noted that the Optiz et al., Buhler et al. II and Veb I or II references discussed on page 6 of the Answer as "(11) Grounds of Rejection" are not included as "(9) Prior Art of Record."

Section 1208 of the Manual of Patent Examining Procedure (MPEP) (6th Ed., Rev. 3, July 1997) states:

REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

. . . .

(9) References of Record. A listing of the references of record relied on, and in the case of nonpatent references, the relevant page or pages.

Clarification is required concerning the pertinence of the Optiz et al., Buhler et al. II, and Veb I or II references. See MPEP § 1211. If appropriate, compliance with MPEP § 1208(A)(9) is also required.

Accordingly, it is

ORDERED that the application is remanded to the Examiner:

1. for clarification under MPEP § 1211 concerning the pertinence of the Optiz et al., Buhler et al. II, and Veb I or II

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references discussed on page 6 of the Examiner's Answer (Paper No. 17)

2. for compliance with MPEP § 1208(a)(9), if appropriate, by issuing a Supplemental Examiner's Answer which includes the Optiz et al., Buhler et al. II, and Veb I or II references as "Prior Art of Record"; and

3. for such further action as may be appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the status of the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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