

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GEORGE R. PAYNE

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Appeal No. 2002-1717  
Application No. 09/089,153

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ORDER REMANDING TO EXAMINER

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On June 14, 1999, appellant submitted a paper entitled "Amendment" which states on page 7 that "assuming that the examiner meant Schofield as the reference applicant will cancel Claims 4 and 8" and "[a]ccordingly applicant cancels Claims 6 and 7." On July 6, 1999, an Advisory Action was mailed which states that the proposed amendment(s) "will be entered upon filing of a Notice of Appeal and an Appeal Brief." However, the Advisory Action further states that the claims rejected are 1-9. It should be noted that the amendment requesting cancellation of

Appeal No. 2002-1717  
Application 09/089,153

claims 4 and 6-8 has not been physically entered into the record. On March 27, 2000, appellant submitted a Notice of Appeal (Paper No. 10) "from the decision of the Primary Examiner dated 4/13/99 finally rejecting Claim(s) 1-9." Appellant's Appeal Brief filed March 27, 2000 (Paper No. 11) states that "[c]laims 1-9 were rejected under 35 U.S.C. 103 as being unpatentable over Schofield et al. (US5670925) in view of Gauthier (US4373482)" (page 2). The Examiner's Answer mailed August 16, 2000 (Paper No. 13) agreed (page 3). Confusion exists as to whether claims 4 and 6-9 are pending or cancelled. Clarification is required.

Accordingly, it is

ORDERED that the application is remanded to the examiner:

1. for clarification regarding the status of claims 4 and 6-8:

a. If the amendment has been entered, entry of the amendment into the record is required. If the amendment is entered, the Appeal Brief filed March 27, 2000 (Paper No. 11) would be defective because it would no longer contain an accurate "Status of claims," "Status of amendments," "Issues," "Grouping

Appeal No. 2002-1717  
Application 09/089,153

of claims," "Argument," and "Appendix." See 37 CFR § 1.192(c) (1999). Appellant should be notified to submit a new Appeal Brief which corrects the above defects, or the Examiner should issue a supplemental Examiner's Answer which corrects the defects.

2. for notification to appellant in writing of the action taken; 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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