PRECEDENTIAL OPINION

Pursuant to Board of Patent Appeals and Interferences Standard Operating Procedure 2, the opinion below has been designated a precedential opinion.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ABID GHUMAN, MICHAEL CZARNECKI, BRIAN GENORD, CHRISTOPHER JENT, DANIEL QUINN, JOHN ROBERTSON, and DAVID SWEET

Appeal 2008-1175
Application 10/709,045
Technology Center 3700

Decided: May 1, 2008

Before MICHAEL R. FLEMING, *Chief Administrative Patent Judge*, and FRED E. McKELVEY, *Senior Administrative Patent Judge*, and MURRIEL E. CRAWFORD, LINDA E. HORNER, and MICHAEL W. O'NEILL, *Administrative Patent Judges*.

PER CURIAM.

REMAND ORDER

STATEMENT OF THE CASE

(1) Appellants and jurisdiction

Abid Ghuman, Michael Czarnecki, Brian Genord, Christopher Jent, Daniel Quinn, John Robertson, and Davis Sweet (Appellants) appeal from a final rejection mailed on July 26, 2006. 35 U.S.C. § 134(a) (2002).

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

(2) Filing date and real party in interest

The application on appeal was filed on April 8, 2004.

The real party in interest is Ford Global Technologies, LLC, a wholly owned subsidiary of Ford Motor Company. Appeal Brief, page 1.

(3) Claims and arguments on appeal

The Examiner entered a Final Office Action (final rejection) which was mailed on July 26, 2006.

Claims 1-20 are pending in the application.

Claim 1 is an independent claim.

Claims 2-4 depend directly or indirectly from claim 1.

Claims 5-11 also depend directly or indirectly from claim 1.

Claim 12 is an independent claim.

Claims 13-20 depend directly or indirectly from claim 12.

Claims 1-4 were finally rejected under 35 U.S.C. § 102(b) as being anticipated by Sekine, U.S. Patent 5,127,569, issued July 7, 1992.

Claims 5-20 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Sekine alone or in combination with other prior art of record.

The Final Office Action dated July 26, 2006 states: "[a] shortened statutory period for reply is set to expire 3 months or thirty (30) days, whichever is longer, from the mailing date of this communication."

The Final Office Action further states: "[f]ailure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED."

A Notice of Appeal was timely filed. Notice of Appeal under 37 C.F.R. § 41.31, filed October 27, 2006.

According to the Notice of Appeal, "[a]pplicant hereby appeals to the Board of Patent Appeals and Interferences from the [F]inal Office Action dated July 26, 2006 for the above-identified patent application."

An Appeal Brief was timely filed. Appeal Brief under 37 C.F.R. § 41.37, filed December 21, 2006.

The Appeal Brief states (page 2):

> Claims 1-20 are pending in this application. Claims 1-20 have been rejected. Claims 1-4 are the subject of this appeal.

In the body of the Appeal Brief, Appellants limit the discussion and argument to claims 1-4.

Appellants do not argue the separate patentability of claims 2-4 apart from claim 1.

Appellants do not discuss the Examiner's rejection of claims 5-20. However, Appellants have not submitted an amendment canceling claims 5-20.

In due course, the Examiner entered an Examiner's Answer. Examiner's Answer, mailed April 11, 2007.

The Examiner, like the Appellants, limits his discussion to claims 1-4.

A Reply Brief was timely filed. Reply Brief under 37 C.F.R. § 41.41, filed June 6, 2007.

The Reply Brief limits its discussion to claim 1.

DISCUSSION

An applicant seeking administrative review of a final rejection must file a notice of appeal. 35 U.S.C. § 134(a); 37 C.F.R. § 41.31(a) (2007).

In the case before us, Appellants filed a notice of appeal "to the Board of Patent Appeals and Interferences from the Final Office Action dated July 26, 2006 for the above-identified patent application." The Notice of Appeal in this case did not state whether all, or less than all, of the rejected claims are appealed.

In the Appeal Brief, Appellants did not expressly state that claims 5-20 are withdrawn from the appeal. Instead, Appellants expressly stated that only claims 1-4 are the subject of "this appeal." In addition, Appellants have not submitted an amendment canceling claims 5-20. In an appeal brief, an applicant can withdraw an appeal as to some of the rejected claims. An applicant can withdraw claims by an expressed or implied

statement. In the case before us, Appellants did not provide an express statement of withdrawal of claims 5 through 20, but instead limited the appeal to claims 1 through 4. Appellants have not appealed claims 5 through 20 and have not challenged the Examiner's rejection of these claims. Thus, we treat these claims as withdrawn from the appeal.

If upon filing an appeal brief, the applicant limits the claims to be considered on appeal, then it is the practice of the Patent and Trademark Office to treat the claims not pursued in the appeal brief as having been withdrawn from the appeal. *Manual of Patent Examining Procedure*, § 1215.03 (8th ed. Rev. 6, Sept. 2007) states:

> A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application … and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from the application by direction of the examiner at the time of the withdrawal of the appeal as to those claims. Examiner[s] may use the following form paragraph to cancel the claims that are withdrawn from the appeal at the time of the withdrawal:
>
> > The withdrawal of the appeal as to claims [5-20 in this case] operates as an authorization to cancel those claims from the application. See MPEP § 1215.03. Accordingly, these claims [5-20 in this case] are canceled.

Consistent with the principles set out in MPEP § 1215.03, when an applicant no longer wishes to pursue in the appeal brief rejected claims

which were appealed in the notice of appeal, the applicant should file an amendment canceling any claim which the applicant no longer wishes to pursue. *See* 37 C.F.R. § 41.33(b)(1) (2007) and *Ex parte Letts*, http://www.uspto.gov/web/offices/dcom/bpai/prec/rh071392_erratum.pdf, slip op. at 8-9 (Bd. Pat. App. & Int. Jan. 31, 2008) (precedential) ("[i]f an Appellant wants an appeal withdrawn or dismissed as to a particular claim, the proper course of action is to file an amendment canceling the claim.")

DECISION

The application on appeal is remanded to the Examiner so that the Examiner may enter a paper canceling claims 5-20. MPEP § 1215.03.

Upon entry of the paper, the application should be returned to the Board for consideration of the appeal on its merits as to remaining claims 1-4.

REMANDED

EWH

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