

Art Unit: 2192

**RESPONSE TO ORDER RETURNING
UNDOCKETED APPEAL TO EXAMINER**

1. This action is in response to the Order from the Deputy Chief Appeals Administrator mailed December 23, 2008, requiring the examiner to cancel claims 19-37.
2. The withdrawal of the appeal as to claims 19-37 operates as an authorization to cancel these claims from the application. See MPEP § 1215.03. Accordingly, these claims are canceled.
3. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.

/Eric B. Kiss/
Eric B. Kiss
Primary Examiner, Art Unit 2192

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: CURTIS W. HEISEY, RAVINDRA V. GOKHALE, and
KATHY A. KAMINSKI

Application No. 10/016,597
Technology Center 2100

Mailed: December 23, 2008

Before KRISTA ZELE *Deputy Chief Appeals Administrator*
ZELE, *Deputy Chief Appeals Administrator*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 26, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

APPEAL BRIEF, APPEALED CLAIMS

Appellants have not appealed all rejected claims. Specifically, a review of the Grounds of Rejection on the record finds that rejections are outstanding for the following pending claims: 1-37. The rejected claims that have not been appealed and/or argued for appeal are claims 19-37.

DISCUSSION

The Board of Appeals and Interferences (Board), in *Ex parte Ghuman*, <http://www.uspto.gov/web/offices/dcom/bpai/prec/rm081175.pdf> (BPAI May 14, 2008) (precedential), held that in appeals where rejected claims are expressly withdrawn, or are implicitly withdrawn by not presenting arguments in support of patentability, the Board will remand (or return) the application to the Examiner with instructions to cancel the expressly or implicitly withdrawn claims. *See also Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8th ed. Rev. 6, Sept 2007).

CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) enter a paper canceling claims 19-37; and
- 2) upon entry of the paper, to return the application to the Board for the consideration of appealed claims;
- 3) for such further action as may be appropriate.

Application No. 10/016,597

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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REPLY BRIEF NOT CONSIDERED

1. The reply brief filed on July 3, 2007, has not been considered because it is not in compliance with 37 CFR 41.41(a). The reply brief included new or non-admitted affidavit or other evidence. (See Reply Brief (07/03/2007) at p. 5, last paragraph, continuing onto p. 6.)



Eric B. Kiss