

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN B. WOLK,  
JAMES G. BENTSEN,  
RALPH R. ROBERTS,  
JOHN S. STARAL AND  
YINGBO LIN

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Appeal No. 2006-1510  
Application No. 10/414,066

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ON BRIEF

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Before WARREN, KRATZ and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

Upon a careful review of the record in this appeal, we determine that this application is not in condition for a decision at this time. Accordingly, pursuant to our authority under 37 CFR § 41.50(a)(1)(effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), we remand this application to the jurisdiction of the examiner for action consistent with our remarks below.

In the answer, the examiner maintains a § 103(a) rejection of appealed claims 1, 4, 5, 13, 17, 18, 24, 25, 28-30, and 35-40 over Mori (U.S. Patent No. 5,281,489) in view of Hosokawa (JP 2-001-097949) and Burroughes (GB 2348316). In so doing, the examiner does not make of record and refer to a complete and accurate verified full English language translation of the Japanese language patent document relied upon. Rather, the record includes a computer (machine) translation of the text of the Japanese document. At the top of page 1 of the Hosokawa Japanese document translation, a disclaimer as to the accuracy of the translation is presented with the further liability disclaimer that the "Japan Patent Office is not responsible for any damage caused by the use of this translation." A review of the translation reveals that many sentences and phrases employed therein employ incorrect terms, such as the apparent misuse of the word "law" in numbered paragraph 107 of the computer translation. Also, we note the "\*\*\*" used in the translation to indicate untranslated words. In this regard, appellants argue that Hosokawa is not combinable as alleged by the examiner and refer to numbered paragraph 138 of the computer translation at page 5 of the reply brief. That referred to paragraph employs the symbol for untranslated words.

While the ultimate question of obviousness under 35 U.S.C. § 103 is one of law, the question can only be answered after the requisite factual findings have been made. Such factual findings can not be made from an unreliable translation. Obtaining and considering an accurate, and verified English language translation of the full text of the relied upon foreign language document is necessary in furnishing reliable evidence of the factual basis for making the ultimate determination of patentability.

Accordingly, this application is remanded to the examiner for the purpose of securing a complete and accurate verified English language translation of the relied upon Japanese document and clarifying the examiner's rejection in light of the English language translation of the relied upon Japanese document that is secured and ultimately made of record. A copy of the translated document should be forwarded to appellants. The examiner should fully explain how the relied upon publication is being applied by referring to the verified accurate English language translation that is obtained by page and line (or numbered paragraph) in any rejection maintained in a supplemental examiner's answer that may be ultimately prepared in response to this remand.

Moreover, should the examiner issue a supplemental answer, the examiner should fully respond to the arguments presented in the reply brief.

CONCLUSION

For the reasons outlined above, this application is remanded to the jurisdiction of the examiner. Pursuant to the provisions of 37 CFR § 41.50(a)(2) (effective Sept. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sept. 7, 2004)), appellants are required to timely respond to any supplemental examiner's answer that may be issued in response to this remand. As stated in this rule, appellants must exercise one of the two following two options to avoid sua sponte dismissal of the appeal as to the claims involved in the remand: (i) request that prosecution be reopened before the examiner by filing a reply under Rule 111 with or without amendment or evidence or (ii) request that the appeal be maintained by filing a reply brief as provided in 37 CFR § 41.41.

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01 (D)(8th ed., Rev. 3, Aug. 2005).

REMANDED

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
PETER F. KRATZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JEFFREY T. SMITH	)	
Administrative Patent Judge	)	

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