

The opinion in support of the decision being entered today is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOSHIHIDE ITO
And SHIRO HARA

Appeal No. 2007-0168
Application No. 10/127,927
Technology Center 1700

Decided: June 13, 2007

Before CHUNG K. PAK, CHARLES F. WARREN and LINDA M. GAUDETTE, *Administrative Patent Judges*.

PAK, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

This case is not ripe for review and is, therefore, remanded to the Examiner for appropriate action. 37 C.F.R. §41.50(a)(1) (2006); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

The grounds for remand are two-fold:

- 1) The Examiner does not provide a clear statement of rejection in at least one of the rejections set forth in the Answer; and
- 2) The machine translations of the foreign prior art references referred to in the statements of rejection are insufficiently accurate to properly consider for appeal.

I. The Examiner's statement of rejection is not clear

The statement of the ground of rejection based on DE 19816671 (hereinafter DE '671), JP 10286689 (hereinafter JP '689), United States Patent 6,179,935 (hereinafter US '935), JP 10034376 (hereinafter JP '376), and United States Patent 6,421,942 (hereinafter US '942) is the source of confusion here (Answer 6). In the Final Rejection mailed November 2, 2004, the Examiner rejected claims 15, 18, 19, 21, 23-25, 27-29, 31-33, and 35 (hereinafter "claims") under 35 U.S.C. § 103 as being unpatentable over admissions in the paragraph bridging pages 2-3 of the instant specification in view of [DE '671] ([JP '689]; abstract (57, melting temperature)), [JP '376] . . . or [US '942]

Final Rejection 4.

In their Appeal Brief, the Appellants contend:

[Claims] are patentable over [DE '671], [JP '689], [JP '376] and [US '942].

Br. 22.

In the Examiner's Answer, the Examiner, for the first time, states:

[Claims] are rejected under 35 U.S.C. § 103 as being unpatentable over prior art admission in paragraph bridging pages 2-3 of the instant specification in view of [DE '671] ([JP '689]; abstract (57, melting temperature) with English equivalent [US '935] . . . [JP '376] . . . or [US '942].

Answer 6.

The Examiner's statement of this ground of rejection in the Answer is problematic in two ways. First, as is apparent from a comparison with the Final Rejection, US '935 is introduced for the first time in prosecution of the present application in the Examiner's statement of rejection in the Answer.

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Yet, the Examiner has not identified the rejection as a new ground of rejection in the Answer and given the Appellants an opportunity to address this new prior art reference. *See* 37 C.F.R. § 41.39(a)(2); MPEP § 1207.03 (8th ed., Rev. 5, August 2006).

Second, the Examiner’s use of the word “with” in the Answer makes it unclear what exactly the rejection discussed above constitutes. That is, it is not clear whether U.S. ‘935 is relied upon by the Examiner as an additional reference or as an English translation of DE ‘671. We point out that in either event, U.S. ‘935 is a new, separate document.

Furthermore, in the Final Rejection and Answer, the Examiner treats the German and Japanese prior art references as though they might be equivalent:

[DE ‘671] ([JP ‘689]; abstract (57 melting temperature))
Final Rejection 4. However, in their Brief, the Appellants treat the two patents as separate references when addressing the Examiner’s rejection. *See* Br. 22. Moreover, while the statement of rejection discussed above appears to refer only to the abstract of the JP ‘689 patent as a substitute for DE ‘671, the Examiner cites information from the Abstract of DE ‘671 in the table in the Answer, to the exclusion of JP’689 (Answer 8). The Examiner also does this in the body of the Answer:

However, [DE ‘671] (abstract), [JP ‘376] (abstract) . . . disclose(s) the Pb-free Sn-Ag-Cu solder alloy contains Ni in the analogous metallurgical art.

Answer 7.

II. The machine translations of the foreign prior art relied upon by the Examiner are insufficiently clear and require accurate translation.

The computer translation of the foreign prior art relied upon by the Examiner makes it difficult to ascertain the precise teachings therein. The

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difficulty is underscored in the first ground of rejection in the Answer, wherein the Examiner cites the abstract of JP 08132279 (hereinafter JP ‘279) which reads:

Solder alloy consists of: 1-15% weight % of Zn and balance of Sn.
Solder alloy pref. Consists of: 1-15 weight % of Zn, 3 weight% or less of Cu, 5 weight% or less of at least one of Ag, In, Sb, Ni, Fe, and Bi, and balance of Sn.

Answer 5; *see also* Final Rejection 3.

This content is inconsistent with the language in the “machine translation” of JP ‘279 prepared by the Japan Patent Office (hereinafter machine translation) which reads:

[F]urthermore, the copper of this invention and the solder for the heat exchangers made from a copper alloy – Cu – in addition, the inside of Ag, In, Sb, nickel, Fe, and Bi – at least one or more sorts—less than [5wt%] you may contain. [

Machine translation at [0008].

A portion of the machine translation is also difficult to understand as well:

Ag, In, Sb, nickel, Fe, and Bi raise the reinforcement of solder material, respectively, and since In and Bi are effective in raise wetting flare nature, arbitration can be made to contain them further.

Machine translation at [0008].

To determine the propriety of the Examiner’s grounds of rejection set forth in the Answer, we need to understand all of the specific teachings of the prior art references, as well as any inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom. *See In re Fritch*, 972 F.2d 1260, 1264-65, 23 USPQ2d 1780, 1782-83 (Fed. Cir. 1992); *In re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). This, of course, requires accurate translations of the foreign prior art references, including JP ‘279, relied upon by the Examiner.

ORDER

Accordingly, it is ORDERED that the Examiner take appropriate action consistent with current practice and procedure to (1) supply accurate translations of all the foreign prior art references relied upon in the grounds of rejection set forth in the Answer, and (2) clarify the statement of the grounds of rejection as discussed above, including identifying the second ground of rejection as a new ground of rejection if US ‘935 is included in any respect in the statement of this ground in response to this Order.

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments..

This Remand is made for the purpose of directing the Examiner to further consider the grounds of rejection. Accordingly, if the Examiner submits a Supplemental Answer to the Board in response to this Remand, “[A]ppellant must within two months from the date of the [S]upplemental [E]xaminer’s [A]nswer exercise one of” the two options set forth in 37 C.F.R. § 41.50(a)(2) (2006), “in order to avoid *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding,” as provided in this rule.

REMANDED

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