

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL L. RUDD and JERLYN R. CULP

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Appeal 2007-3775  
Application 09/952,997  
Technology Center 2100

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Decided: June 25, 2008

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Before JAMES D. THOMAS, LANCE LEONARD BARRY, ST. JOHN COURtenay, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-11, 23, and 24. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

## II. PROCEDURES

"Prior art . . . often includes . . . foreign patent documents which may not be in the English language." MPEP § 706.02 (8th ed., rev. 6, Sep. 20007). "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the examiner is relying upon in support of the rejection." *Id.* "Examiners may request written translations at any point in the examination process . . . but are encouraged to use . . . language reference resources as much as possible in the early phases of examination." *Id.* § 901.05(d).

## III. ANALYSIS

Here, the Examiner rejects claims 1-11, 23, and 24 under 35 U.S.C. § 103(a) as obvious over Japanese Patent No. JP10283288 ("Hidetoshi") and Japanese Patent No. JP11102332 ("Mitsunobu"). In explaining the rejection, he cites to translations of Hidetoshi and Mitsunobu. Generated by machine, the translations warn that they "may contain errors" (Hidetoshi machine translation, p. 1) and contain the following disclaimer: "The JPO, the NCIPI, and those who drafted this document in the original language are not responsible for the result of the translation." (Mitsunobu machine translation, p. 1.)

Our review of the machine translations have uncovered numerous problems therewith. In the translations, "[u]ntranslatable words are replaced with asterisks (\*\*\*)�." (Hidetoshi machine translation, p. 1.) The machine translation of many of the specific paragraphs on which the Examiner relies include such untranslatable words. For example, the machine translation of Hidetoshi's paragraph 26 includes three instances of untranslatable words.

Furthermore, the machine translations "appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors." MPEP § 706.03(d). Major parts of the machine translations are unintelligible to us. Examples follow.

- In order to solve this technical problem [the Internet terminal equipment of this invention] The input section which inputs directions of a user, and the modem which changes data format from the analog from digital one, or an analog like digital one, The circuit interface section which \*\*\*\*\* analog data through PSTN, The speed test section which measures the transmission speed of the analog data \*\*\*\*\* (ed) through the circuit interface section, The coding section which compresses and restores digital data and makes size of a transmitting file small, The accumulation section which saves a transmitting file and a reception file, control of the whole system, and control of the communications protocol were performed, and when the transmission speed of the data measured by the speed test section at the time of a communication start is below a threshold, it has the composition which has the control section which directs compression and restoration of transmit data in the coding section. (Hidetoshi machine translation, ¶ [0022].)

- [then, the user of Internet terminal equipment 101 ] The information on various form written by URL is accessed, An E-mail can be exchanged through the server which understands an POP protocol (S104). After acquiring the IP address of the server corresponding to directed URL or the e-mail address from the server called DNS (S105), a connection is required of a server (S106). [ a control section 110 ] if a connection with the server corresponding to URL or the e-mail address directed at Step 104 is established (S107) When it judges whether the data transmission rate of the modem 103 measured by the speed test section 105 is smaller than a threshold (S108) and judges with it being smaller than a threshold It sets up to encode the coding section 106 and the file which transmits to 125 (S109), and communication of data is required (S110). Next, the coding section 106 of Internet terminal equipment 101 and the coding section 125 of the Internet repeating installation 121, respectively After encoding the file which transmits (S111), data communication is performed through the circuit interface section 101 and 122 (S112), and the file which received is decrypted (S 113). (Hidetoshi machine translation, ¶ [0043].)
- "Moreover, take in data from a computer network, change into a picture signal, display on a screen, and it sets to the information-display equipment which an E-mail is created and can be transmitted." (Mitsunobu machine translation, ¶ [0009].)
- A means to take in image data from other than said computer network, It is characterized by having a means to display on the screen for reducing the image data which the memory which memorizes the image data which this means took in, and this memory memorized to a predetermined size, and creating an E-mail, and a means to transmit the image data which said memory memorized when transmitting this E-mail. (*Id.*)

- This E-mail creation screen of *having* the destination column, the title column, the CC (carbon copy) column, and the contents column is the same as the E-mail creation screen of *only* the conventional text, and the image display field 47 which newly displays the picture captured from the digital camera is formed. (*Id.* ¶ 0029 (emphases added).)
- If a user decides the number added to the picture to capture and specifies by a soft keyboard 47a here, while image data will be taken in automatically and RAM33 will memorize temporarily It is displayed on the image display field 48 of an E-mail creation screen ( drawing 7 ) by the Image Processing Division section 39 and image memory 40 grade. (*Id.* ¶ [0030].)
- "[W]hen the reception destination of the transmitted E-mail is a thing excellent in display functions . . ." (*Id.* ¶ [0032].)

#### IV. CONCLUSION

In an *ex parte* appeal, the Board of Patent Appeals and Interferences "is basically a board of review — we review . . . rejections made by patent examiners." *Ex parte Gambogi*, 62 USPQ2d 1209, 1211 (BPAI 2001). Here, after considering the record, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

#### V. ORDER

We remand the application to the Examiner to "consult the translators in the Translations Branch of the Scientific and Technical Information Center (STIC)" MPEP § 901.05(d) to obtain written translations of Hidetoshi and Mitsunobu into English.

Appeal 2007-3775  
Application 09/952,997

"Because it is being remanded for further action, the application is a 'special' application. MPEP § 708.01(D). Accordingly, it requires immediate action. Furthermore, the Board should be informed promptly of any action affecting status of the appeal (e.g., abandonment, issue, or reopening prosecution)." *Ex parte Feldman*, No. 2007-2390, 2008 WL 460205, at \*2 (BPAI 2008).

REMANDED

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