

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKASHI HORAI,
SYUJI TSUKAMOTO, NARUTOSHI FUKUZAWA,
and HIROYUKI ARIOKA

Appeal 2008-0014
Application 10/640,246
Technology Center 1700

Decided: October 25, 2007

Before CHUNG K. PAK, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

We remand the application to the examiner for consideration and explanation of issues raised by the record. 37 C.F.R. §41.50(a)(1) (2007); Manual of Patent Examining Procedure (MPEP) § 1211 (8th ed., Rev. 5, August 2006).

In the ground of rejection of the appealed claims under 35 U.S.C.

§ 103(a) as unpatentable over Takazawa, the Examiner contends that one of ordinary skill in this art would have modified the mixture of two compounds in Takazawa's Example 10 with respect to the amount of the second compound based on other disclosure in the reference, in order to meet certain limitations in independent claim 1 and the other appealed claims. Answer 3-4 and 5-9. Appellants' contentions are based on other disclosures than Example 10 of Takazawa as well. Br. 11-21; Reply Br. in entirety.

Thus, our consideration of the issues raised by the Examiner and Appellants requires consideration of Takazawa as a whole. Indeed, it is well settled that a reference stands for all of the specific teachings thereof as well as the 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), presuming skill on the part of this person. *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

The difficulty we encounter in considering Takazawa is that the document the Examiner relies upon and is thus considered by Appellants, is a "computer" translation of Takazawa prepared by the Japanese Patent Office which is obviously an incomplete and inaccurate translation. Indeed, the document contains the caveat that the translation "may not reflect the original precisely" and other disclaimers under "Notices." Takazawa translation 1. We have not found any other translation of this reference in the electronic files of the USPTO for this Application.

Our consideration of the issues presented in this appeal requires a clear and accurate translation of the original Japanese patent document to Takazawa in order to determine all of the specific teachings thereof as well as the inferences one of ordinary skill in this art would have reasonably been expected to draw therefrom.

Accordingly, the examiner is required to take appropriate action consistent with current examining practice and procedure to obtain an authoritative translation of the original Japanese reference to Takazawa, P2001-150815A, enter the translation into the electronic records of the USPTO, and consider the issues in this appeal in light of the actual disclosure in the original Japanese patent document provided by the authoritative translation, with a view toward placing this application in condition for decision on appeal with respect to the issue presented.

If, in response to our remand, the Examiner submits a supplemental answer to the Board which further considers the ground of rejection of the appealed claims under 35 U.S.C. § 103(a) as unpatentable over Takazawa as authoritatively translated, “appellant must within two months from the date of the supplemental examiner’s answer exercise one of” the two options set forth in 37 C.F.R. §41.50(a)(2) (2007), “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.

Appeal 2008-0014
Application 10/640,246

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.

REMANDED

tc/lS

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191