

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

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* BONNIE M. PEMBERTON,  
and FRANK A. WOLFE

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Appeal No. 2000-2202  
Application No. 08/810,049

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ON BRIEF

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Before PAK, JEFFREY T. SMITH and PAWLIKOWSKI, *Administrative Patent Judges*.  
JEFFREY T. SMITH, *Administrative Patent Judge*.

***DECISION ON APPEAL***

Appellants appeal the Examiner's final rejection of claims 20-22, 24, 27 and 30.<sup>1</sup>

Because the issues are not ripe for appeal, we remand.

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<sup>1</sup> Claims 13-14 and 16 to 18 are pending in the present application and have been indicated as containing allowable subject matter by the Examiner. (Answer, p. 2).

### ***OPINION***

The Examiner relied on an Italian patent 590,156, identified as Avery Adhesive, published on March 25, 1959 as evidence of obviousness. The Examiner states “Avery Adhesive shows the construction of individual double sided adhesive tapes, 11, on a continuous backing release layer, 20, with individual release sheets, 10, overlying the individual tapes (See Figs. 1, 3).” (Answer, p. 4). The Examiner has not referred to the text of the reference used to reach these determinations. It appears the Examiner has not considered an English language translation of this document.<sup>2</sup> A translation of this document has now been obtained by the Board. The Examiner is required to consider the translation of Italian patent 590,156 to determine if more or all of the limitations of the claims on appeal are disclosed therein.

The Board of Patent Appeals and Interferences is a board of review and not a vehicle for initial examination. See 35 U.S.C. § 6(b)(2000). The burden is on the Examiner to set forth a *prima facie* case of obviousness. *See In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). Findings of fact and conclusions of law

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<sup>2</sup> We note that the Examiner should have obtained a complete translation of the reference during prosecution, and not relied solely on the figures. It is now mandatory for such a translation to be provided prior to forwarding the appeal to the Board. See, e.g. the April 29, 2002 memo from Deputy Commissioner Kunin.

must be made in accordance with the Administrative Procedure Act, 5 U.S.C. 706 (A), (E) (1994). *See Zurko v. Dickinson*, 527 U.S. 150, 158, 119 S.Ct. 1816, 1821, 50 USPQ2d 1930, 1934 (1999). Findings of fact relied upon in making the obviousness rejection must be supported by substantial evidence within the record. *See In re Gartside*, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1775 (Fed. Cir. 2000).

In light of the above facts, we feel it is premature to decide this appeal. More fact finding needs to be completed on the record by the Examiner in view of the full English language translation. Particularly, the Examiner is required to point out on a limitation-by-limitation basis which portions of the cited references correspond to the limitations recited in the claims. It is important that ambiguous or obscure bases for decision do not stand as barriers to a determination of patentability.

### ***CONCLUSION***

In summary, the instant application is remanded to the Examiner to consider the aforementioned issues and to act accordingly.

This application, by virtue of its "special" status requires an immediate action. *MPEP* § 708.01(d) (7th ed., Rev. 1, Feb. 2000). It is important that the Board be informed promptly of any action affecting the appeal in this case (e.g., abandonment, issue, reopening prosecution).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REMAND

CHUNG K. PAK  
*Administrative Patent Judge*

JEFFREY T. SMITH  
*Administrative Patent Judge*

BEVERLY A. PAWLIKOWSKI  
*Administrative Patent Judge*

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