

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LYNN FORESTER,
NEIL H. HENDRICKS
and DONG-KYU CHOI

Appeal No. 2001-0777
Application No. 08/652,893

ON BRIEF

Before OWENS, KRATZ and MOORE, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

REMAND TO THE EXAMINER

From a review of the record of this application, this appeal is not ripe for decision at this time. Accordingly, this application is being remanded to the examiner for appropriate action.

This appeal was taken from the examiner's final rejection of claims 14-17, 19-26 and 46-49. No other claims remain pending in the application.

Appellants' invention relates to a method for annealing substrates coated via chemical vapor deposition with electron beam radiation, a product film and a product microelectronic device.

The prior art references of record listed by the examiner at page 3 of the answer are:

Umemura	4,713,258	Dec. 15, 1987
Yamaguchi et al. (Yamaguchi)	4,983,540	Jan. 08, 1991
Livesay	5,003,178	Mar. 26, 1991

"Japanese patent abstract of 58-151517, by Yoshii, 7-1985."

The examiner rejects appealed claims 14-17, 19-21, 23-26 and 46-49 under 35 U.S.C. § 103 as being unpatentable over Japanese patent abstract 58-151517 in view of Yamaguchi and Livesay (answer, pages 4-7). In rejecting claim 22 under 35 U.S.C. § 103, the examiner additionally relies on Umemura (answer, page 7).

Appellants address the examiner's rejections in the brief (see, e.g., pages 4, 5 and 8) referring to the Japanese abstract 58-151517, as being relied upon by the examiner in the rejections applied by the examiner in the answer. We note that the examiner did not make reference to the underlying Japanese patent document (unexamined Japanese Patent Application No. 60-043814 published on March 08, 1985) to which the relied upon abstract pertains as

evidence being relied upon in rejecting the claims in the final rejection or answer.

In response to a Remand and in a communication (Paper No. 28) mailed August 21, 2002, the examiner maintains that it is the "Japanese reference JP 60-43814 A" that has been applied by the examiner against appellants' claimed invention. However, as explained above, a review of the rejections set forth in the answer reveals that a Japanese abstract, not the underlying Japanese patent document, was set forth as part of the evidence relied upon by the examiner in rejecting the claims.

Thus, there are inconsistent signals in this record concerning the issues before us including whether the "Japanese reference JP 60-43814 A" and English language translation thereof referred to in Paper No. 28 were intended to be relied upon by the examiner as evidence in addition to the other properly referred to evidence in each of the § 103 rejections set forth in the answer. We decline to speculate as to what evidence the examiner ultimately intended to rely on in rejecting the appealed claims.

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. In this regard,

obtaining and considering the full text of any document, instead of relying on an English language abstract provides a more complete factual basis for making the ultimate determination of patentability. Here, it is not apparent why the examiner and appellants have spent considerable resources in apparently determining and arguing the patentability of the subject matter on appeal without obtaining and specifically referring to a complete English language translation of the underlying Japanese patent document.

Thus, this appeal involves issues that have not been fully developed by both appellants and the examiner. The examiner should review all of the reference evidence and the claimed invention anew in light of the arguments of record, as well as any evidence that was furnished by appellants, which the examiner has entered. In so doing, the examiner should reconsider if a prior art rejection of the claimed subject matter continues to be warranted. If so, the examiner should list all of the relied upon evidence that is necessary to support such a rejection in the statement of the rejection as is consistent with current

examining practices and procedures.¹

Under the circumstances recounted above, the record before us is not in a condition which permits a proper disposition of the subject appeal. We are constrained, therefore, to remand this application for clarification of the file record with respect to the issues previously discussed.

In this regard, we note that any new ground of rejection entered in the present record requires reopening of *ex parte* prosecution. See 37 CFR § 1.193(a)(2) (1997).

Consequently, the subject application is being returned to the jurisdiction of the examiner for taking appropriate action consistent with current examining practices and procedures to effect the record clarification discussed above.

¹ Evidence upon which the examiner intends to rely should be included in the listed evidence that is being relied upon in any such rejection. This is so since evidence not listed in the statement of the rejection will not be considered by this panel of Board as part of the evidence being relied upon by the examiner.

This application, by virtue of its "special" status requires an immediate action. Manual of Patent Examining Procedure § 708.01 (8th ed., August 2001). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

TERRY J. OWENS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JAMES T. MOORE)	
Administrative Patent Judge)	

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