

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ATSO FORSTEN
and
TIMO LIUKKONEN

Appeal No. 1999-2143
Application No. 08/734,866

ON BRIEF

Before KIMLIN, WALTZ, and DELMENDO, Administrative Patent Judges.
DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1 through 10, the only claims pending in the subject application.¹

¹ In response to the final Office action of November 20, 1997, the appellants submitted on February 23, 1998 a paper captioned "RESPONSE AFTER FINAL" proposing an amendment to claim 1. (Papers 6 and 7.) The examiner indicated in the advisory action of March 2, 1998 that the amendment will be entered upon the filing of a notice of appeal and an appeal brief. (Paper 8.)

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The subject matter on appeal relates to a method for implementing a process for monitoring a solder paste printing process in the setting and soldering of a circuit board. (Substitute appeal brief, page 3.) Further details of this appealed subject matter are recited in illustrative claim 1, which is reproduced below from the amendment filed August 28, 1997 as further amended on February 23, 1998:²

1. A method for implementing a process for monitoring the solder paste printing process in the setting and soldering of a circuit board, in which paste printing process solder paste (5) is spread on a circuit board (4) at the solder pads (7) of surface mounted devices or corresponding connecting pins, characterized in that for evaluating the quality of the paste printing process at least one paste test pattern (9; 10; 18) is arranged on the circuit board (4; 13), which test pattern is constituted by a number of test elements (91, 92, 93, 94; 111, 112, 113, 114; 121, 122, 123, 124), the shapes of which correspond to geometrical plane figures on the surface of the circuit board, which test elements have varying degrees of difficulty in view of the printing process, and wherein the spatial relationship between test elements is such that the distance between one test element and another is different and each of said test elements has different width and the distance between

² Although the examiner states in the answer (page 2) that the copy of the appealed claims as found in the appendix to the appellants' substitute brief is correct, we observe that this is not the case. Specifically, claim 1 as reproduced in the appendix to the substitute brief does not incorporate the change made in the amendment under 37 CFR § 1.116 filed February 23, 1998, which the examiner entered.

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consecutive elements is smaller as the width of each said test element becomes larger.

The examiner relies upon the following prior art references as evidence of unpatentability:

Tanabe (JP '188) (published JP patent application)	3-244188	Oct. 30, 1991
Shigeyama et al. (JP '005) (published JP patent application)	4-212005	Aug. 03, 1992

Claims 1 through 8 on appeal stand rejected under 35 U.S.C. § 103 as unpatentable over JP '188. (Examiner's answer, pp. 3-4.) Also, appealed claims 9 and 10 stand rejected under 35 U.S.C. § 103 as unpatentable over JP '188 in view of JP '005. (Id. at pp. 4-5.)³

We reverse the aforementioned rejections. In addition, we remand this application to the examiner for further action not inconsistent with the opinion set forth below.

Prior to addressing the merits, we observe that the examiner has applied JP '188 and JP '005 against the claims on appeal. However, it appears that the examiner has relied only on the English

³ The examiner has withdrawn the rejection under 35 U.S.C. § 102(b) as set forth in the final Office action of November 20, 1997. (Interview Summary dated August 6, 1998, paper 13.) Similarly, the examiner has withdrawn the rejection under 35 U.S.C. § 112. (Examiner's answer, page 5.)

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language abstracts for these Japanese applications.⁴ See, e.g., the examiner's citation of the "abstract" of JP '188 on page 3 of the answer. In this regard, it appears that neither the appellants nor the examiner made any effort to obtain and fully consider complete English language translations of the references, as would be expected in any appeal in which the relied upon references are not in the English language. Despite the lack of such effort, the answer refers to JP '188 and JP '005 as the evidence relied upon to reject the claims on appeal. This is not appropriate. Similarly, we find that the appellants' sweeping characterizations of JP '188 and JP '005 are not accompanied by any indication that the complete references were considered and evaluated.

Given that the examiner's consideration of the prior art appears to have been limited to the English language abstracts, the answer should have referred to the published abstracts rather than the underlying Japanese patent documents.⁵ Also, the answer should

⁴ These abstracts are: (1) Patent Abstracts of Japan, The Patent Office, Japanese Government, Vol. 16, No. 31, Jan. 27, 1992, for JP '188 and (2) Patent Abstracts of Japan, The Patent Office, Japanese Government, Vol. 555, Nov. 25, 1992 for JP '005.

⁵ See In re Portola Packaging, 110 F.3d 786, 790, 42 USPQ2d 1295, 1299 (Fed. Cir. 1997).

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have identified the publication dates for the abstracts, not the publication dates for the underlying patent applications. Because the appellants' and the examiner's considerations of JP '188 and JP '005 appear to be limited to the English language abstracts, we also limit our discussion to the abstracts.

We now turn to the merits of the examiner's rejections. Referring to the English language abstract, the examiner states that JP '188, the principal reference, "teaches a method where the printing process of soldering paste is controlled by test 'dummy' patterns." (Examiner's answer, page 3.) The examiner, however, acknowledges that JP '188 "fails to teach that the test 'dummy' patterns are formed at different distances from each other," as required by the appealed claims. (Id.) Nevertheless, the examiner alleges:

[T]he Examiner has taken the position that it would have been within the skill of a practitioner in the art to have varied the distances between the test "dummy" patterns with the reasonable expectation of achieving similar results. The distances between the test "dummy" patterns as well as the shape, size, etc. are all "result effective" variable[s] which are manipulated by a practitioner in the art depending upon the desired end product produced. It has been well settled that the mere "optimization" of "result effective" variables is deemed as an obvious modification of the prior art. . . [Id. at pp. 3-4.]

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We cannot agree with the examiner. The examiner has not identified any evidence in the relied upon abstracts establishing that the distance between the test "dummy" patterns was known to one of ordinary skill in the art to be a result effective variable. In our view, the absence of such evidence is fatal to the examiner's rejection. In re Antonie, 559 F.2d 618, 620, 195 USPQ 6, 8 (CCPA 1977).

We therefore reverse the examiner's rejection of claims 1 through 8 under 35 U.S.C. § 103 as unpatentable over JP '188 and claims 9 and 10 under 35 U.S.C. § 103 as unpatentable over JP '188 in view of JP '005.

The decision of the examiner is reversed.

We remand the subject application to the examiner for consideration of the entire English language translations of JP '188 and JP '005, copies of which are attached to this decision. The examiner should consider these translations in their entirety and, if warranted, apply either or both of these references by themselves or in combination with other references in rejections as may be appropriate.

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This application, by virtue of its "special" status, requires an immediate action. See MPEP § 708.01(D) (7th ed., Rev. 1, Feb. 2000).

REVERSED AND REMANDED

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