

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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HANS OETIKER

Appeal No. 2001-0737
Application No. 08/766,212

HEARD: July 11, 2001

Before ABRAMS, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 35, 53 to 55, 62 to 73 and 80 to 95. Claims 74 to 79 and 96-106 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 36 to 52 and 56 to 61 have been canceled.

We REVERSE.

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BACKGROUND

The appellant's invention relates to a balancing arrangement (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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| Oetiker 1981 (Oetiker '012) | 4,299,012 | Nov. 10, |
| Oetiker 1985 (Oetiker '004) | 4,492,004 | Jan. 8, |

Claims 1 to 35, 53 to 55, 62 to 73 and 80 to 95 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claim 62 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Oetiker '012.

Claim 62 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Oetiker '004.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 19, mailed December 30, 1999) and the answer (Paper No. 27, mailed October 10, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 26, filed July 28, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 35, 53 to 55, 62 to 73 and 80 to 95 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.

Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

With this as background, we analyze the specific reasons set forth by the examiner (final rejection, pp. 3-5) for the rejection under 35 U.S.C. § 112, second paragraph.

The first reason is that it is unclear whether claim 1 and its dependent claims call for a balancing arrangement *per se*, or a combination of a balancing arrangement and a rotating member. We agree with the appellant (brief, pp. 12-13) that claim 1 is clearly drawn to a balancing arrangement *per se*, not the combination of a balancing arrangement and a rotating member.

The second reason is that it is unclear whether claim 62 and its dependent claims call for a clamp structure *per se*, or a combination of a clamp structure and a counterweight (see e.g., claim 86). We agree with the appellant (brief, pp. 13-14) that claim 62 is clearly drawn to a clamp structure *per se*, not the combination of a clamp structure and a counterweight. Likewise, claim 86 is clearly drawn to the combination of a clamp structure and a counterweight.

The third reason is that a variety of confusing terms are used in claims 73, 75 and 78.¹ We agree with the appellant (brief, pp. 14-15) that the terms used in claim 73 are not confusing. In fact, the examiner has not set forth why the terms used in claim 73 are confusing and/or indefinite.

The fourth reason is that a variety of terms (cited by the examiner on page 4 of the final rejection) using the suffix "-like" were indefinite. In our view, those terms using the suffix "-like" are definite, as required by the second paragraph of 35 U.S.C. § 112, since they define the metes and bounds of the claimed

¹ Claims 75 and 78 are not subject to this rejection and have been withdrawn from consideration.

invention with a reasonable degree of precision and particularity. The American Heritage Dictionary, Second College Edition, (1982) defines the suffix "-like" as meaning "resembling or characteristic of." Thus, for example, the term "groove-like" means resembling a groove. The examiner has not explained why the metes and bounds thereof would not be understood with a reasonable degree of precision and particularity.

The fifth reason is that the terms "about," "generally," "approximately," and "substantially" were indefinite. We agree with the appellant (brief, pp. 16-23) that the above-noted terms as used in the claims under appeal are definite as required by the second paragraph of 35 U.S.C. § 112.

The last reason is that it was unclear what structure performed the function of the "means for imparting elastic stretchability to said clamping band means" recited in claim 80. The appellant on page 23 of the brief noted the structure that performed the above-noted function recited in claim 80 thus complying with the requirement that a claim "particularly point out and distinctly claim" the invention.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 35, 53 to 55, 62 to 73 and 80 to 95 under 35 U.S.C. § 112, second paragraph, is reversed.

The anticipation rejections

We will not sustain the rejections of claim 62 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In this case we agree with the appellant (brief, pp. 23-26) that claim 62 is not anticipated by either Oetiker '012 or Oetiker '004.² In that regard, both Oetiker '012 and Oetiker

² As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the USPTO is not exempt from following the statutory mandate of 35 U.S.C. § 112,

(continued...)

'004 fail to disclose the claimed "means to enable securing of said counterweight to said clamping band means." Likewise, both Oetiker '012 and Oetiker '004 fail to disclose the claimed "means in said clamping band means to increase the holding ability of the clamp structure and therewith increase the weight of the counterweight means which can be reliably secured to the part."

Since all the limitations of claim 62 are not found in either Oetiker '012 or Oetiker '004, the decision of the

²(...continued)
paragraph 6, which reads:
An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

The holding in Donaldson sets a limit on how broadly the USPTO may construe means-plus-function language under the rubric of "reasonable interpretation." Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination.

examiner to reject claim 62 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 35, 53 to 55, 62 to 73 and 80 to 95 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claim 62 under 35 U.S.C. § 102(b) is reversed.

REVERSED

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| NEAL E. ABRAMS |) | |
| Administrative Patent Judge |) | |
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| |) | BOARD OF PATENT |
| JOHN P. McQUADE |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| JEFFREY V. NASE |) | |
| Administrative Patent Judge |) | |

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JENINE GILLIS

APPEAL NO. 2001-0737 - JUDGE NASE
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APJ NASE

APJ ABRAMS

APJ McQUADE

DECISION: **REVERSED**

PREPARED: Mar 27, 2002

OB/HD

PALM

ACTS 2

DISK (FOIA)

REPORT

HEARD: July 11, 2001