

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER N. BEACHY and
MAITRAYEE BHATTACHARYYA

Appeal No. 94-4377
Application 07/789,738¹

ON BRIEF

Before GRON, ELLIS and OWENS **Administrative Patent Judges**.

ELLIS, **Administrative Patent Judge**.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 24, which are all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. An isolated genome-length transcript promoter from rice tungro bacilliform virus.

¹ Application for patent filed November 8, 1991.

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Claims 1 through 24 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 appellants regard as the invention.²

Having given careful consideration to the entire record which includes, *inter alia*, the appellants' Brief (Paper No. 23) and the examiner's Answer (Paper No. 24), we find ourselves in substantial agreement with the appellants' position. Accordingly, we **reverse** the rejection.

It is well established that claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that the claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); *In re Moore*, 439 F.2d 1232, 1235,

² This is the only rejection presented in the examiner's Answer and, accordingly, it is the only issue which we will address. We direct the appellants' attention to 37 CFR § 1.191(a) which states that appeals may be made to this Board for any claims which have been twice rejected or which have been given a final rejection (§1.113). The issue, raised in the appellants' Brief, of the propriety of the introduction of the full citation of a scientific journal publication into the specification because in the examiner's view, it constitutes the addition of new matter under 35 U.S.C. § 132, does not include the rejection of any of the pending claims.

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169 USPQ 236, 238 (CCPA 1971) ("Definiteness of the language employed 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").

The examiner argues that the claims are vague and indefinite in the recitation of "genome-length." Answer, sentence bridging pp. 2-3. According to the examiner, the referenced phrase does not clearly set forth the boundaries of the promoter. *Id.*, p. 3. We find this position untenable primarily for two reasons.

First, we find that the examiner has improperly taken the phrase "genome length" out of context. As pointed out by the appellants, the referenced phrase is used to modify the term "transcript." Brief, pp. 12-13. In fact, the complete phrase as it appears in the claim is "genome length transcript promoter." The examiner has not provided any reasons on this record as to why the phrase, in its entirety, would not have been understood by those having ordinary skill in the art. *In re Moore, supra.*

More importantly, as pointed out by the appellants, the contested phrase is defined on p. 5 of the specification. Brief, p. 11. It is not clear to us why the examiner has ignored these

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teachings. As noted by the court in *In re Moore*, 439 F.2d at 1235, footnote 2, 169 USPQ at 238, footnote 2,

[i]t is important here to understand that under this analysis claims which on first reading - in a vacuum, if you will - appear indefinite may upon a reading of the specification disclosure or prior art teachings become quite definite.

Here, we know of no reason, and none has been provided by the examiner, as to why one of ordinary skill in the art, upon reading the appellants' specification, would have found the claimed subject matter indefinite. Accordingly, the rejection is reversed.

The decision of the examiner is reversed.

REVERSED

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TEDDY S. GRON)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
JOAN ELLIS)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
TERRY J. OWENS)	
Administrative Patent Judge)	

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