

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(2) is not binding precedent of the Board.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. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HERMANN-JOSEF FOX
and MANFRED LASSMANN

Appeal No. 95-2502
Application 07/763,625¹

HEARD: Jun. 9, 1999

Before McCANDLISH, Senior Administrative Judge, COHEN and
GONZALES, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final
rejection of claims 1, 4 through 11 and 14 through 22. No
other claims are pending in the application.

¹ Application for patent filed September 23, 1991.

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Appellants' invention relates to a method (claims 1, 4 through 9, 21 and 22) and to an apparatus (claims 10, 11 and 14 through 20) for determining a variation in control data of an automatic piecing operation for an automatic thread-producing spinner. The data produced in appellants' invention includes measurements of the diameter of a monitored length of thread containing the piecer, deviations of the measured thread diameter from a given thread diameter and the locations of those deviations relative to the piecer.

A copy of the appealed claims 1, 4 through 11 and 14 through 21 is appended to appellants' brief.² A copy of appealed claim 22 is found on page 2 of the examiner's answer.

In rejecting the appealed claims, the examiner relies upon the following reference:

Raasch et al. (Raasch)	4,825,632	May 2, 1989
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Claims 1, 4 through 11 and 14 through 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raasch, and claims 4 through 9 and 20 additionally stand rejected under 35

² In the preamble of claim 1, we have interpreted the recitation of "improving the piecer" to refer to a future piecer, not a piecer that has already been formed.

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U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention. Reference is made to the examiner's answer for details of these rejections.³

We cannot sustain the examiner's rejection of the appealed claims under § 102(b). In all of the independent claims (namely method claims 1 and 21 and apparatus claim 10), the processing data for improving future piecing operations includes not only the deviation of the thread diameter from a given diameter, but also the locations of the deviations relative to the piecer. Claim 1, for example, recites the step of evaluating and counting the locations of the deviations with respect to the piecer, while claim 21 recites that the measured data includes the location of each deviation relative to the piecer. In apparatus claim 10, the issued

³ According to the examiner's statement on page 6 of the answer, the final rejection of the appealed claims under 35 U.S.C. § 102(b) as being anticipated by the Lassmann patent has been withdrawn. The rejection of claims 1, 14, 21 and 22 under the second paragraph of § 112 has not been carried forward to the answer and therefore is presumed to be withdrawn. See Ex parte Emm, 118 USPQ 180, 181 (Bd. App. 1957).

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results include the location of at least one of the deviations with respect to the piecer.

In Raasch's automatic spinner, the processing data for the piecing operation admittedly includes the deviation of thread diameter from a given diameter along a thread length including the piecer. However, this reference fails to expressly or inherently disclose the feature of determining the locations of those deviations. For this reason alone, the Raasch patent is not a proper anticipatory reference for the subject matter of the appealed claims. Compare Kloster Speedsteel AB v. Crucible Inc., 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) (The absence from the reference of any element of a claim negates anticipation of that claim by the applied reference). We must therefore reverse the § 102(b) rejection of appealed claims 1, 4 through 11 and 14 through 22.

We also must reverse the rejection of dependent claim 20 under the second paragraph of § 112. When the limitation pertaining to the "preprogrammed expert system" is read in light of the specification as required in In re Hammack, 427 F.2d 1384, 1391, 166 USPQ 209, 215 (CCPA 1970), it is clear

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that the claimed system includes the data bank and the knowledge base described on pages 32-34 of the specification. Claim 20 therefore defines the metes and bounds of the invention with a reasonable degree of precision to satisfy the test for definiteness in In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

With regard to dependent claims 4 through 9, the examiner's reasons set forth on pages 3 and 5 of the answer for rejecting these claims under the second paragraph of § 112 are unclear. In part, the examiner seems to be concerned with the fact that these claims are not limited to the order in which certain method steps are performed. Such an omission does not necessarily render the claims indefinite. Instead, such an omission here merely deals with the breadth of the claims. Breadth, however, is not to be confused with indefiniteness. In re Miller, 441 F.2d 689, 691, 169 USPQ 597, 600 (CCPA 1971). We nevertheless consider claims 4 through 9 to be indefinite for reasons that follow.

It is unclear whether appellants intended the processing step of claim 4 to merely recite further details of the

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processing step in claim 1 or whether appellants intended the processing step of claim 4 to be separate and distinct from the processing step of claim 1. If the claim language is read literally, the processing step of claim 4 is defined as if it is separate and distinct from the processing step of claim 1. Appellants' specification, however, suggests that only a single processing step is involved with regard to the data obtained in the counting step. Likewise, it is unclear whether appellants intended the processing step of claim 5 to merely recite further details of the processing step in claims 1 or 4 or whether appellants intended the processing step of claim 5 to be separate and distinct from the processing steps in claims 1 and 4.

It also is unclear whether appellants intended the evaluating steps of claims 6 and 7 to be separate and distinct from the evaluating step of claim 1 or whether appellants intended the evaluating steps of claims 6 and 7 to merely recite further details of the evaluating step in claim 1. It also is unclear whether appellants intended the remaining steps in claim 6 and the steps in claim 8 to be part of or independent from the processing step recited in claim 1 or

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claim 4. In addition, it is unclear whether appellants intended the remaining steps in claim 7 (i.e., the steps apart from the evaluating step) and the steps recited in claim 9 to be part of or independent from the processing step in claims 1, 4 or 5.

For the foregoing reasons, claims 4 through 9 do not define the metes and bounds of the invention with a reasonable degree of precision as required in In re Venezia, 530 F.2d at 958, 189 USPQ at 151. Accordingly, we will sustain the rejection of claims 4 through 9 under the second paragraph of § 112.

In summary, the examiner's decision to reject claims 1, 4 through 11 and 14 through 22 under § 102(b) and to reject claim 20 under § 112, second paragraph, is reversed, and the examiner's decision to reject claims 4 through 9 under § 112, second paragraph, is affirmed. Since our reasons supporting the rejection of claims 4 through 9 under § 112, second paragraph, appear to differ from the examiner's reasons, we herewith designate our affirmance of the rejection of claims 4 through 9 under the second paragraph of § 112 as a new ground of rejection under the provisions of 37 CFR § 1.196(b).

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In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of

the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the

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application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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

AFFIRMED-IN-PART
37 CFR § 1.196(b)

	Harrison E. McCandlish, Senior)	
	Administrative Patent Judge)	
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)	
	Irwin Charles Cohen)	BOARD OF
PATENT	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
	John F. Gonzales)	
	Administrative Patent Judge)	

tdc

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