

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL M. POTTER

Appeal No. 96-0004
Application No. 08/147,759¹

HEARD: May 7, 1999

Before JOHN D. SMITH, PAK, and WALTZ, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-14, 16-35 and 37-43. Appellant has withdrawn the appeal as to claims 1-14 and 16-22. Accordingly, remaining for our consideration is the appeal of the rejection of claims 23-35 and 37-43.

¹ Application for patent filed November 5, 1993.

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The subject matter on appeal is directed to irregularly shaped glass fibers suitable for insulation. The claimed glass fibers are defined by certain physical properties of first and second glass compositions from which the fibers are composed.

Claim 23 is representative and is reproduced below:

23. Irregularly-shaped glass fibers suitable for insulation comprising separate first and second oxide glass compositions having:

- a. nonidentical coefficients of thermal expansion, the nonidentical coefficients of thermal expansion having a difference greater than about 2.0 ppm/°C,
- b. log₃ viscosity temperatures within the range of from about 1850 to about 2050°F (1010 to 1121°C),
- c. liquidus temperatures of at least 50°F(28°C) below that of the log₃ viscosity temperatures, and
- d. chemical durabilities of less than about 4.0%.

Claims 23-33 stand rejected under 35 U.S.C. § 112, second paragraph, as indefinite. All appealed claims stand rejected under 35 U.S.C. § 112, first paragraph, "written description requirement". We reverse.

In a situation as the present one, wherein claims are rejected under both the first and second paragraphs of 35 U.S.C. § 112, the definiteness of the claims are addressed

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prior to the analysis of whether the claimed subject matter is based on an adequate written description in the originally filed specification. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Thus, as the examiner reasons in his answer at page 5, since "the claims are unclear as to what the invention is... how can it be adequately described". However, for the reasons set forth in appellant's briefs, we agree that the claims have not been properly rejected under either paragraph of 35 U.S.C. § 112.

With respect to the question as to whether appealed claims 23-33 are indefinite under the second paragraph of 35 U.S.C.

§ 112, the examiner points out that these claims define the invention in terms of physical properties without reference to specific glass compositions. We agree with appellant that the language referring to the physical properties in the rejected claims is reasonably precise and sufficiently definite to provide a "clear-cut indication of the scope of subject matter embraced" by the rejected claims. In re Swinehart, 439 F.2d 210, 214, 169 USPQ 226, 229 (CCPA 1971). This ground of rejection is, accordingly, reversed.

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We also agree with appellant for the reasons set forth in the brief at pages 4-7 that the appealed claims are based on an adequate written description of the invention in the originally filed specification. Accordingly, we also reverse the stated rejection of the appealed claims under the first paragraph of 35 U.S.C. § 112.

The decision of the examiner is reversed.

REVERSED

JOHN D. SMITH)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CHUNG K. PAK)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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THOMAS A. WALTZ)	
Administrative Patent Judge)	

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APJ JOHN D. SMITH

APJ PAK

APJ WALTZ

DECISION: REVERSED
Send Reference(s): Yes No
or Translation (s)
Panel Change: Yes No
Index Sheet-2901 Rejection(s): _____

Prepared: February 24, 2000

Draft Final

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OB/HD GAU

PALM / ACTS 2 / BOOK
DISK (FOIA) / REPORT