

**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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* W. KYLE ANDERSON

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Appeal No. 97-0904  
Application 08/105,699<sup>1</sup>

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ON BRIEF

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Before CALVERT, LYDDANE and PATE, *Administrative Patent Judges*.  
PATE, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the final rejection of claims 45 and 46. The other claims in the application stand as follows: claims 25-27, 30, 31 and 33-42 have been indicated by the examiner as allowable. Claims 22-24, 28, 29, 32, 43 and 44 have been cancelled. Claims 1-21 have been indicated by the examiner

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<sup>1</sup> Application for patent filed August 11, 1993.

as directed to allowable subject matter and stand as objected to for depending upon a rejected claim.

The appealed subject matter is directed to a mounting arrangement for a capacitor. With reference to Figure 3, a capacitor 22 has end projections 32 and 40 which provide electrical connection for the capacitor. A supporting means 56 having end projection engaging inserts 72 and 114 is provided to connect the capacitor to the electrical conducting bus 64.

The following claims are further illustrative of the claimed subject matter:

45. An electrical apparatus, comprising:

an electrical component including at least one projection therefrom, the projection providing electrical connection for the electrical component; and

a supporting means, the supporting means having an apertured means for receiving the projection and establishing the electrical connection therewith, the apertured means being arranged to accommodate movement of the projection during utilization of the electrical component without discontinuity of the electrical connection.

46. The electrical apparatus of claim 45 wherein the electrical component includes a plurality of projections therefrom, wherein the supporting means includes a plurality of apertured means, and wherein the supporting means includes a stabilizing means for maintaining the apertured means in a predetermined spacial relationship during movement of the electrical component.



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Therefore, the rejection of claim 45 will be sustained. With respect to claim 46, we enter a new rejection under 35 U.S.C. § 112, second paragraph.

We are in agreement with the examiner's finding that Kennedy discloses an electrical component, integrated circuit 22, which includes at least one projection 21 extending therefrom, the projection 21 providing electrical contact for the electrical component. Kennedy further discloses a supporting means 16 having apertured means including square aperture 19 and spring contact 12. Furthermore, we agree with the examiner that the inwardly bowed sections of socket contacts 11 are shown in conductive communication with electrical lead 21 and small up or down movements of electrical lead 21 do not result in the bowed portion losing contact with the lead 21. Therefore, in our view, Kennedy inherently shows the apertured means is arranged to accommodate movement of the projection during utilization of the electrical component without discontinuity of the electrical connection.

We further note neither the appellant nor the examiner has raised any means-plus-function issues with respect to the construction of the means terms in claims 45 and 46 *vis á vis* 35 U.S.C. § 112, sixth paragraph.

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The test for anticipation is whether:

a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention.

*In re RCA Corp. v Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed, 468 U.S. 1228 (1984). As noted above, Kennedy discloses expressly or under the principles of inherency each and every element of claim 45, and the rejection of claim 45 is hereby sustained.

Pursuant to 37 CFR 1.196(b), we make the following new rejection: claim 46 is 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, in that the meaning of the claim limitation of "maintaining the apertured means in a predetermined spacial relationship" is not clear. It is unclear whether the apertured means is to be maintained in a predetermined spacial relationship with another apertured means or with some other component of the claimed invention.

In view of this situation, it is our opinion that no definite meaning can be ascribed to the limitation of "maintaining the apertured means in a predetermined spacial relationship" in claim 46. When this is true of the terms in a

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claim, the subject matter of the claim cannot be held to be anticipated, but rather the claim becomes indefinite. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since the rejection under 35 U.S.C. § 102 cannot be based upon speculation and assumptions, we are constrained to reverse the examiner's rejection of claim 46. See *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that a reversal of the rejection under § 102 is not a reversal on the merits of the rejection, but rather a procedural reversal predicated upon the indefiniteness of the claimed subject matter.

#### *SUMMARY*

The rejection of claim 45 under 35 U.S.C. § 102 has been sustained, and of claim 46 has been reversed.

A rejection of claim 46 pursuant to 37 CFR 1.196(b) under 35 U.S.C. § 112, second paragraph, has been entered by the Board.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based

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upon the same record must be filed within one month from the date hereof (37 CFR 1.197).

With respect to the new rejection under 37 CFR 1.196(b), should appellant elect the *alternate* option under that rule to prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision. In the event appellant elects this alternate option, 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 us for final action on the affirmed rejection, including any timely request for reconsideration 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, 1.196(b)*

IAN A. CALVERT	)	
Administrative Patent Judge)	)	
	)	
	)	
WILLIAM E. LYDDANE	)	BOARD OF PATENT
Administrative Patent Judge)	)	APPEALS AND
	)	INTERFERENCES
	)	
WILLIAM F. PATE, III	)	
Administrative Patent Judge)	)	

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