

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(2) is not binding precedent of the Board.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. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREW J. AIKENS
and FRITZ F. EBNER

Appeal No. 1997-1431
Application 08/323,976¹

ON BRIEF

Before JERRY SMITH, FLEMING and BARRY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed October 17, 1994.

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This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 5-17, which constitute all the claims remaining in the application.

The disclosed invention pertains to a method and apparatus for recording various transactions on an electronic network by a plurality of users and for billing these transactions to the various users.

Representative claim 5 is reproduced as follows:

5. A printing machine billing system for a printing machine electrically interconnected over a network to a plurality of electronic workstations, each of the workstations having user interfaces, the printing machine having a plurality of modes of operation, each mode operable to effect recurring events, the printing machine including apparatus for generating a weighted total of said events by assigning weighting factors to each event, the apparatus comprising counting means for generating an output related to said events, weighting means for generating a plurality of weighting factors, the weighting factors being a function of the events, and a totalizer responsive to the counting means, the weighting factors, and the mode of operation to determine a billing charge, the network including means to verify an access code and account number from a workstation whereby the billing charge of the totalizer is charged to said account number.

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The examiner relies on no references in the answer.

Claims 5-17 stand rejected under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which appellants regard as their invention.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the arguments in support of the rejection advanced by the examiner. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record

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before us, that claims 5-17 particularly point out the invention in a manner which complies with 35 U.S.C. § 112. Accordingly, we reverse.

The pertinent parts of the examiner's rejection read as follows:

Claims 5-17 are 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 applicant regards as the invention.

Claims 5-17 are inoperative and therefore lack utility for the recited purpose of the disclosed and claimed invention, since

- 1) a printing operation never takes place in claims 5, 6 & 14 the cost of the printing operation can not be billed to an account.
- 2) the actual cost of the printing job that is associated with a particular account in claims 6 & 11 is never determined, it would be improper to bill the entire usage of the machine to a particular account.
- 3) the claims fail to accomplish what is recited in the preamble.

...

The subject matter of claims 5-10, in regard to the recited details, lacks antecedent basis within the specification as required by 37 CFR § 1.75(d 1)[answer, page 3].

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It can be seen from the above rejection that while it is ostensibly made under the second paragraph of 35 U.S.C. § 112, it includes questions of accuracy, inoperativeness, utility, business propriety and support within the specification. Although many of these issues are more properly challenged under a different section of the statute, for example, 35 U.S.C. § 101 or 35 U.S.C. § 112, first paragraph, only a rejection under the second paragraph of 35 U.S.C. § 112 is before us.

The examiner does not really address the scope of the invention recited in the claims or whether the artisan would understand the scope of the claimed invention when considered in light of the disclosure. Instead, the examiner has apparently established a per se rule that any feature of a claim which is deemed to lack clear support in the specification under 37 CFR § 1.75(d)(1) automatically fails to particularly point out the invention as required by the second paragraph of 35 U.S.C. § 112. We are unable to find indefiniteness in the claims before us, and we find no merit in the examiner's amalgamation of issues lumped together as a rejection under the second paragraph of

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35 U.S.C. § 112.

The examiner objects to the recitation in claim 5 that the printing machine has "a plurality of modes of operation, each mode operable to effect recurring events." According to the examiner, there is only a single mode of operation or the printer is idle, neither of which satisfies the quoted language of the claim [answer, page 4]. We fail to understand why the examiner deems the performing of a printing task that is to be billed as the only mode of operation. Claim 5 recites a printing machine having a plurality of modes of operation. The disclosed printing machine operates to perform several tasks besides simply a printing task that is billed. There is no basis for the examiner to conclude that there are not a plurality of operable modes which effect recurring events.

The examiner then addresses the recitation in claim 5 of weighting factors and concludes that the specification is silent as to how the weighting scheme is actually applied to the determination of a bill for a particular print job [answer, pages 4-5]. We fail to understand what the examiner's observation has to do with indefiniteness under 35

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U.S.C. § 112. The claimed weighting factors are not indefinite, they are simply broadly recited. Any weighting factors would fall within the scope of the claim.

The examiner makes several other points in which the rejection under the second paragraph of 35 U.S.C. § 112 is justified based on a perceived lack of compliance with 37 CFR

§ 1.75(d)(1). As we noted above, we do not understand the examiner's objections under 37 CFR § 1.75(d)(1), and we do not understand the examiner's determination that lack of compliance with this rule automatically justifies a rejection under the second paragraph of 35 U.S.C. § 112.

The examiner states that "it is the examiner's position that the claimed invention does not actually provide an invention which would be useful to a skilled artisan to determine the billing charges for a printing operation" [answer, page 7]. Not only do we not understand this stated position, but we fail to see what this position has to do with the claimed invention being indefinite. We respond in the

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same manner to the examiner's position that the instant claims lack utility for the purpose recited in the preamble of the claims.

For a consideration of a rejection made under the second paragraph of 35 U.S.C. § 112, the general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co., v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

We have read the specification and considered the appealed claims in light of the specification, and we have no difficulty understanding the metes and bounds of the claimed invention. Therefore, the rejection of claims 5-17 under the second paragraph of 35 U.S.C. § 112 is not sustained.

The decision of the examiner rejecting claims 5-17 is

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reversed.

REVERSED

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)	
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