

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte HUTTON W. THELLER

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Appeal No. 97-2451  
Application No. 08/260,635<sup>1</sup>

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ON BRIEF

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Before COHEN, MEISTER, and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 and 2. Claims 9, 10 and 16 have been allowed. Claims 3 to 8 and 13 to 15 have been objected to as depending from a non-allowed claim. Claims 11 and 12 have been canceled.

We REVERSE and enter a new rejection pursuant to 37 CFR § 1.196(b).

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<sup>1</sup> Application for patent filed June 16, 1994. According to the appellant, the application is a continuation of Application No. 07/980,853, filed November 24, 1992, now U.S. Patent No. 5,331,858.

BACKGROUND

The appellant's invention relates to a hot tach tester. A copy of claims 1 and 2 appears in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

DTC Hot Tach Tester Operation Instructions	Prior to 11/1991
Topwave DTC Hot Tach Tester Brochure	Prior to 11/1991

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over DTC Hot Tach Tester Operation Instructions in view of Topwave DTC Hot Tach Tester Brochure.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 14, mailed November 1, 1996) and the supplemental examiner's answer (Paper No. 16, mailed January 14, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 13, filed October 7, 1996) and reply

brief (Paper No. 15, filed December 16, 1996) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing a rejection based upon prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Our review of independent claim 1 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, the terminology "cooling said seal during said delamination to a temperature substantially below the initial temperature of said seal upon removal from said heat sealing location" and "applying a pulling force to said pulling portions . . . to rapidly remove the heat seal segment from the heat seal location" in independent claim 1 raise definiteness issues under 35 U.S.C. § 112, second paragraph.<sup>2</sup>

The terminologies "substantially below" and "rapidly remove" are terms of degree. When a word of degree is used, such as the terminologies "substantially below" and "rapidly remove" in claim 1, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

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<sup>2</sup> The appellant argues (brief, pp. 13-15 and 24-25) that the applied prior art does not teach or suggest the claimed substantial cooling period. The examiner determined (answer, p. 4) that the claimed substantial cooling period was inherently met by exposing the sample (i.e., strip) to ambient conditions upon removal of the sample from the heat sealing location.

Admittedly, the fact that some claim language, such as the terms of degree mentioned supra, may not be precise, does not automatically render the claim indefinite and hence invalid under the second paragraph of § 112. Seattle Box, supra. Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled use of such terms without appropriate constraints to guard against the potential use of such terms as the proverbial nose of wax.<sup>3</sup>

In Seattle Box, the court set forth the following requirements for terms of degree:

When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), the court added:

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<sup>3</sup> See White v. Dunbar, 119 US 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 4 USPQ2d 1136, 1139 (Fed. Cir. 1987).

If the claims, read in light of the specifications [sic], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

Indeed, the fundamental purpose of a patent claim is to define the scope of protection<sup>4</sup> and hence what the claim precludes others from doing. All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, we have reviewed the appellant's disclosure to help us determine the meaning of the above-noted terminologies from claim 1. That review has revealed that the appellant used the terminology "substantially below" only in original claim 1. In addition, pages 7 and 10 of the

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<sup>4</sup> See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

specification provide that the air conducting apparatus 60 provide a constant stream of conditioned ambient air, preferably at a flow rate of one liter per second or greater. The review has also revealed that the appellant used the terminology "rapidly remove" only on page 3 of the specification. Page 3 of the specification provides that the ends of the strip are rapidly moved apart, desirably at a rate above 20 cm/second, to rapidly remove the sealed portion of the strip from the heat seal dies. However, it would be inappropriate, in view of the claim differentiation doctrine (the doctrine of claim differentiation states the presumption that "the difference between claims is significant." Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017, 1023, 4 USPQ2d 1283, 1288 (Fed. Cir. 1987)), to interpret "rapidly remove" to mean a speed of at least 20 cm/second since dependent claim 14 adds that limitation to claim 1. Accordingly, it is our view that the disclosure does not provide explicit guidelines defining the terminologies "substantially below" and "rapidly remove" (claim 1). Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the terminologies "substantially below" and "rapidly remove" as used in claim 1 that would enable one skilled in the art to ascertain what is meant by

"substantially below" and "rapidly remove." For example, one cannot ascertain if the temperature drop of the seal caused by exposure to ambient conditions during delamination as in the applied prior art constitutes "cooling said seal during said delamination to a temperature substantially below the initial temperature of said seal upon removal from said heat sealing location." Additionally, one cannot ascertain if applying the same pulling force to the pulling portions to remove the heat seal segment from the heat seal location and then to progressively delaminate the seal as in the applied prior art constitutes "applying a pulling force to said pulling portions . . . to rapidly remove the heat seal segment from the heat seal location." Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, supra.

Since the appellant's specification fails to set forth an adequate definition as to what is meant by the terminologies "substantially below" and "rapidly remove" recited in claim 1,

the appellant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

**New ground of rejection**

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.<sup>5</sup>

Claims 1 to 8 and 13 to 16 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention.

As set forth previously, our review of the specification leads us to conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminologies "substantially below" and "rapidly remove" in independent claim 1. Likewise, one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "substantially below" in independent claim 16. Additionally, we conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "substantially higher" in dependent claim 13 since

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<sup>5</sup> 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)) permits the Board to reject any pending claim including allowed and objected to claims.

the appellant's specification fails to set forth an adequate definition as to what is meant by that terminology.

**Examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103**

We emphasize again here that claim 1 contains unclear language which renders the subject matter thereof indefinite for the reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. We find that it is not possible to apply the prior art to claim 1 in deciding the question of obviousness under 35 U.S.C. § 103 without resorting to speculation and conjecture as to the meaning of the questioned limitations in claim 1. This being the case, we are therefore constrained to reverse the examiner's rejection of claim 1 and claim 2 which depends therefrom under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). This reversal of the examiner's rejection is based only on the technical grounds relating to the indefiniteness of the claims.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 2 under 35 U.S.C. § 103 is reversed and a new rejection of

claims 1 to 8 and 13 to 16 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

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. 53131, 53197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

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 (§ 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 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. . . .

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

REVERSED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JAMES M. MEISTER	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPEAL NO. 97-2451 - JUDGE NASE  
APPLICATION NO. 08/260,635

APJ NASE

APJ COHEN

APJ MEISTER

DECISION: **REVERSED;**  
**37 CFR § 1.196(b)**

Prepared By: Delores A. Lowe

**DRAFT TYPED:** 09 Jun 98

**FINAL TYPED:**