

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(2) is not binding precedent of the Board.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. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN A. CARLSON

Appeal No. 97-2785
Application No. 08/173,698 ¹

HEARD: Feb. 04, 1998

Before McCANDLISH, Senior Administrative Patent Judge, and
COHEN and STAAB, 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 reissue claims 5 through 8 in this application

¹ Application filed December 20, 1993 for Reissue of U.S.
Patent No. 5,104,156, issued April 14, 1992, based on
Application No. 07/599,654, filed October 18, 1990.

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for reissuing appellant's Patent No. 5,104,156 ². The original patent claims 1 through 4, which are the only other claims in the application, have been allowed.

The invention disclosed in appellant's '156 patent relates to a remote control assembly 10 having a flexible, motion transmitting core element 12 extending through a flexible conduit 14. The core element 12 may be utilized as a push/pull cable for such components as a steering member or throttle member in a marine craft or other vehicle. In order to detachably secure the flexible conduit 14 to a support structure 20, the control assembly 10 includes a female housing 28 and a male coupler end fitting 22. The female housing 28 is fixed to the support structure 20. The male coupler end fitting 22 is attached to an end of the flexible conduit 14 and is releasably locked in the female housing 28 by a locking element such as a spring biased locking ring 32 (Figure 2) or a retractable locking bolt 112 (Figure 3) to thereby couple the flexible conduit 14 to the

²A copy of the claims 5-8 as appended to appellants brief is attached to this decision.

female housing 28. ³ According to claim 1, the only independent claim in the original patent, the male coupler body is formed with a truncated surface means (29) which slopes upwardly at a constantly changing slope.

Urging that the original patent claims 1 through 4 were too narrow because of the limitation pertaining to the truncated surface means, appellant introduced claims 5 through 8. Claims 5 through 7 broaden the limitation pertaining to the truncated surface, and claim 8 deletes this limitation all

³ In each of the rejected independent reissue claims added in this reissue application, the body of the claim is inconsistent with the preamble of the claim in that the body recites the combination of the flexible conduit (14) and elements of the male fitting assembly whereas the preamble is directed to the male fitting assembly per se. In each of these claims, we have interpreted the preamble as defining a structure which includes the elements recited in the body to establish consistency between the preamble and the body of the claim. It is noted that each of these independent reissue claims incorrectly recites that the male coupler fitting assembly is identified by the reference numeral 10. In contrast, the descriptive portion of the specification applies the reference numeral 10 to designate the remote motion-transmitting control assembly. With particular regard to claims 6 and 8, we have interpreted the recitation of "opposite sides" of the flexible conduit to mean the opposite ends of the conduit. With further regard to claims 6 and 8, we have interpreted the recitation of "either side" of the cylindrical body portion to mean either end of the body portion.

together.

In the examiner's answer, claims 5 through 8 "are rejected under 35 USC [sic, U.S.C.] 251 as being drawn to new matter or if inappropriate claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention"

(answer, pages 2-3).⁴ Claim 8 additionally stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

The basis for the rejections under § 251 and § 112, first paragraph, appears to be the same, namely that the broadened reissue claims 5 through 8 are unsupported by appellant's original disclosure. According to the examiner,

[n]owhere in the original disclosure is there a basis for the invention being practiced without "a constantly changing slope". No part of the

⁴ The "new matter" rejection under § 251 "is tantamount to a rejection on the basis that the claimed subject matter has not been described in the manner required by 35 USC [sic, U.S.C.] 112, first paragraph." In re Salem, 553 F.2d 676, 681, 193 USPQ 513, 517-519 (CCPA 1977).

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patent is seen to teach nor is it seen to lie within the scope of the patent claims to have a slope which does not constantly change. [answer, page 6].

The rejections of the appealed claims under § 251 and § 112, first paragraph are not sustainable. The critical inquiry in these rejections of the broadened reissue claims is whether the original disclosure indicates or suggests that the omitted or broadened limitation "was essential or critical to either the operation or patentability of the invention." In re Peters, 723 F.2d 891, 893, 221 USPQ 952, 953 (Fed. Cir. 1983).

In the present case, the examiner has not established that the limitation pertaining to the truncated surface means as defined in patent claim 1 was either critical or essential to either the operation or the patentability of the invention. In fact, mere cursory inspection of the embodiment shown in Figure 2 of the patent drawings reveals that because the truncated surface 29 is spaced from the locking ring 32 except at a point immediately adjacent to the relief surface 26, it may be of any configuration so long as it does not interfere with the movement of the locking ring to its illustrated locking position.

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Thus, in the present case, the broadened reissue claims 5 through 8 merely omit or broaden an unnecessary limitation as was the case in Peters. Accordingly, we cannot sustain the rejections of appealed claims 5 through 8 under § 251 and § 112, first paragraph.

With regard to the rejection of claim 8 under the second paragraph of § 112, the examiner's difficulty with the claim language centers on the recitation of the "means for coacting between a female housing, said space and relief to retain said male coupler and flexible conduit in said female housing." Typically, the term "between" is used to refer to some element or structure interacting with or lying intermediate two physical objects.

In the present case, however, the term "between" is used to define the relationship of the coacting means with respect to two objects (namely, the female housing and the relief) and a space. In the first place, it is not clear how a structure such as the coacting means can coact with a space for any purpose, let alone the claimed purpose. Furthermore, it is not clear from the claim language whether the coacting means is intended to coact between the female housing, on the one hand,

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and the relief and the space, on the other hand, or whether the coacting means is intended to coact between the female housing and the space, on the one hand, and the relief, on the other hand. This claim language is therefore indefinite because it fails to define the metes and bounds of the invention with a reasonable degree of precision. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). We will therefore sustain the rejection of claim 8 under the second paragraph of § 112.

In summary, we have reversed the examiner's rejections of claims 5 through 8 under § 251 and § 112, first paragraph, and we have affirmed the examiner's rejection of claim 8 under § 112, second paragraph.

The examiner's decision rejecting the appealed claims is affirmed in part.

AFFIRMED-IN-PART

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	
IRWIN CHARLES COHEN)	BOARD OF PATENT
)	APPEALS AND

