

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** MICHAEL F. COWAN

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Appeal No. 97-4182  
Application 08/429,150<sup>1</sup>

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ON BRIEF

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Before MEISTER, MCQUADE and NASE, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

**DECISION ON APPEAL**

Michael F. Cowan (the appellant) appeals from the final rejection of claims 1 and 2, the only claims present in the application.

We AFFIRM-IN-PART.

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<sup>1</sup> Application for patent filed April 26, 1995.

Appeal No. 97-4182  
Application 08/429,150

The appellant's invention pertains to a lightweight vertical wall tent. Independent claim 1 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the substitute brief.

The references relied on by the examiner are:

Hibbert	3,800,814	April 2, 1974
Nuttall (British Patent)	462,552	Mar. 11, 1937

Claims 1 and 2 stand 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.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over the British patent in view of Hibbert.

The examiner's rejections are explained on pages 2-4 of the final rejection. The arguments of the appellant and the examiner in support of their respective positions may be found on pages 1-7 of the substitute brief and pages 4-6 of the answer.

#### **OPINION**

As a preliminary matter, we base our understanding of the appealed subject matter upon the following interpretation of the terminology appearing in the claims. In line 38 of claim 1 (as

Appeal No. 97-4182  
Application 08/429,150

it appears in the appendix to the substitute brief) we interpret "a fabric canopy" to be -- the fabric canopy -- since this canopy was previously set forth in line 3.

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will sustain the rejection of claim 2 under 35 U.S.C. § 112, second paragraph. We will not, however, sustain the rejections of claim 1 under 35 U.S.C. § 112, second paragraph, or claims 1 and 2 under 35 U.S.C. § 103.

Initially we note that the substitute brief raises questions as to the propriety of the examiner's refusal to enter the substitute specification filed on April 12, 1996 (Paper No. 3). We must point out, however, that under 35 U.S.C. § 134 and 37 CFR § 1.191, appeals to the Board of Patent Appeals and Interferences are taken from the decision of the primary examiner to reject claims. We exercise no general supervisory power over the examining corps and decisions of primary examiners to enter or deny entry of papers is not subject to our review. **See Manual of Patent Examining Procedure** (MPEP) §§ 1002.02(c) and 1201 (6th ed., Rev. 3, Jul. 1997); **In re Mindick**, 371 F.2d 892, 894,

Appeal No. 97-4182  
Application 08/429,150

152 USPQ 566, 568 (CCPA 1967) and *In re Deters*, 515 F.2d 1152, 1156, 185 USPQ 644, 648 (CCPA 1975). Thus, the relief sought by the appellant would have properly been presented by a petition to the Commissioner under 37 CFR § 1.181.

Considering now the rejection of claim 1 under 35 U.S.C. § 112, second paragraph, it is the examiner's position that:

The claim(s) are narrative in form and replete with indefinite and functional or operational language. The structure which goes to make up the device is merely inferentially claimed, or has not been clearly and positively specified.

The preamble of the claims appears to direct to a wall tent, whereas the body of the claims set forth the method of erecting it. It is unclear what [applicant] is claiming.

In addition, it is unclear whether applicant is claiming a rain fly by itself or in combination with a fabric canopy.

Moreover, the phrases "the correct length" on line, "the correct position of a diagonal anchor" on line 16 of claim 1, "the correct position of a lateral anchor" on line 15, "the positions of all eight anchors and the preset lengths of all eight guy ropes being a function of, and calculated from, the dimensions of the erect fly" on lines 10-11 of claim 1, "the correct preset length" on lines 19 and 21 of claim 1 are indefinite as being vague in their meaning. [Final rejection, pages 2 and 3.]

We will not support the examiner's position. The legal standard for indefiniteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re*

Appeal No. 97-4182  
Application 08/429,150

**Warmerdam**, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). As explained by the court in **In re Steppan**, 394 F.2d 1013, 1019, 156 USPQ 143, 148 (CCPA 1967):

The problem, in essence, is thus one of determining who shall decide how best to state what the invention **is**. By statute, 35 U.S.C. 112, Congress has placed no limitations on **how** an applicant claims **his invention**, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.

In short, there is only one basic ground for rejecting a claim under the second paragraph of § 112, namely, the language employed does not set out and circumscribe a particular area sought to be covered with a reasonable degree of precision and certainty. **See, e.g., In re Moore**, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

With specific regard to the examiner's contention that the claims are narrative in form and replete with functional language, the court in **In re Swinehart**, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971) stated:

there is no support, either in the actual holdings of our prior cases or in the statute, for the proposition, put forward here, that "functional" language, in and of itself, renders a claim improper [under 35 U.S.C. § 112, second paragraph].

See also **In re Hallman**, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981):

Appeal No. 97-4182  
Application 08/429,150

"It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than what it is."

As to the examiner's concern that recitations regarding the method of erecting the tent have been recited, a product-by-process claim does not inherently conflict with the second paragraph of § 112 (*In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972)) and product claims may be drafted to include process steps to wholly or partially define the claimed product (*Hallman*, 655 F.2d at 215, 210 USPQ at 611)).

As to the examiner's contention that it is unclear whether a rain fly is being claimed by itself or in combination with a fabric canopy, we believe it is readily apparent that the "lightweight vertical wall tent" defined in claim 1 comprises both a rain fly and a fabric canopy that are in their fully erected state (see, e.g., lines 1-4 and lines 36-42).

With respect to the examiner's concern over the recitations of "correct" lengths and positions, we must point out that, not only does claim 1 expressly set forth what the "correct" lengths and positions are, these limitations are clearly defined on pages 8 and 9 of the specification.

Appeal No. 97-4182  
Application 08/429,150

In view of the foregoing, we will not sustain the rejection of claim 1 under 35 U.S.C. § 112, second paragraph,.

We reach a different conclusion, however, with respect to claim 2 inasmuch as this claim is totally inconsistent with claim 1 from which it depends. That is claim 1, as we have noted above, clearly sets forth the combination of a rain fly and a canopy in their erected state, with the canopy being set forth as being guyed to or supported by the fly. On the other hand, claim 2 (which depends from claim 1) in an apparent contradistinction sets forth a fly that is either (1) used with or without a canopy underneath or (2) attached or unattached to the canopy, thus resulting in an inexplicable inconsistency that renders this claim indefinite. That is, it raises the question of whether (1) a fly *per se* (e.g., as illustrated in Fig. 1) is being claimed, (2) a fly *per se* in its erected state (e.g., as illustrated in Fig. 2) is being claimed or (3) a fly in an erected state in conjunction with a canopy underneath (e.g., as set forth in parent claim 1 and depicted in Fig. 3) is being claimed. Since we are of the opinion that claim 2 does not reasonably apprise those of skill in the art of its scope, we will sustain the examiner's rejection of this claim under 35 U.S.C. § 112, second paragraph.

Appeal No. 97-4182  
Application 08/429,150

Turning to the rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over the British patent in view of Hibbert, it is the examiner's position that:

[The] British publication shows a rain fly 4 having 2 guy ropes (14) attached to each corner and ground anchor as shown in fig. 1, poles (6) support the ridge end of the fly. [The] British publication does not show a canopy supported by the rain fly. However, Hibbert teaches attaching a canopy (20) to the rain fly (22) to form a tent structure. Therefore, it would have been obvious to one skilled in the art to provide [the] British publication '552 with a canopy supported by the rain fly as taught by Hibbert to form a tent structure. [Final rejection, page 4.]

The examiner's position is not sustainable. Claim 1 expressly requires that the erected fly form a structure "entirely supporting and sheltering a fabric canopy that is suspended beneath it" (lines 37 and 38). Even if we were to agree with the examiner that the awning 22 of Hibbert can be considered to be a "fly," there is absolutely nothing in the combined teachings of the British patent and Hibbert which would suggest an arrangement wherein an erected fly forms a structure that entirely supports the canopy. In the British patent there is no canopy whatsoever. In Hibbert the canopy is entirely supported by end frame members 15, with the canopy and end frame members in turn supporting the awning 22. This being the case,

Appeal No. 97-4182  
Application 08/429,150

we will not sustain the rejection of claim 1 under 35 U.S.C. § 103 based on the combined teachings of the British patent and Hibbert.

Considering last the rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over the British patent in view of Hibbert, for the reasons set forth above with respect to the rejection of this claim under the second paragraph of § 112, we are of the opinion that no reasonably definite meaning can be ascribed to certain language appearing in this claim. In comparing the subject matter defined by claim 2 with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection on prior art cannot be based on speculations and assumptions (*see In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), we are constrained to reverse the examiner's rejection of claim 2 under 35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the § 103 rejection.

The rejection of claim 1 under 35 U.S.C. § 112, second paragraph, is reversed.

Appeal No. 97-4182  
Application 08/429,150

The rejection of claim 2 under 35 U.S.C. § 112, second paragraph, is affirmed.

The rejection of claims 1 and 2 under 35 U.S.C. § 103 is reversed.

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***

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JOHN P. MCQUADE	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
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JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 97-4182  
Application 08/429,150

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