

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANTHONY FIALA, THOMAS D. SMITH and
THOMAS D. SMITH JR.

Appeal No. 98-0024
Application 08/467,306¹

ON BRIEF

Before CALVERT, COHEN and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 10 to 25. Claims 4 to 9, the other claims remaining in the application, stand withdraw from consideration under 37 CFR § 1.142(b) as being directed to nonelected inventions.

¹Application for patent filed June 6, 1995.

Claim 10 is illustrative of the subject matter in issue:

10) An insulation for pipe in tubular integral form and comprising:

- a) a flexible and resilient water-tight and vapor-tight outer tube having what was formerly two longitudinal edges which were fused into a unitary continuous said outer tube;
- b) an insulating tube inside of said outer tube;
- c) said insulating tube comprising two half tubes for encircling said pipe;
- d) a moisture barrier tube inside of said insulating tube to define a recess for receiving said pipe;
- e) said moisture barrier tube comprising two half tubes for encircling said pipe; and
- f) said outer tube being sufficiently flexible upon being longitudinally divided along a line to have said two longitudinal edges and which two longitudinal edges can be rotated with respect to each other with said outer tube still being unitary.

Claims 10 to 25 stand finally rejected for failure to comply with the second paragraph of 35 USC § 112.

The examiner considers part (f) of claims 10 and 18² to be indefinite because in part (a) of these claims, it is recited

²Claim 18, the other independent claim on appeal, recites the pipe insulation in combination with the pipe. Part (f) of claim 18 is identical to part (f) of claim 10.

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that the outer tube's former two longitudinal edges are "fused into a unitary continuous said outer tube", while part (f) of these claims recites that the outer tube is "longitudinally divided along a line to have said two longitudinal edges".

According to the examiner (answer, page 7):

step [sic: part] (f) is describing features of the outer tube which are known prior to the sealing of the longitudinal edges but are not actual features of the outer tube once it is in its final sealed state as set forth by step [sic: part] (a). Therefore, appellant [sic] has created an indefinite situation where two states of the outer layer are occurring in the same claim and the metes and bounds of the claim cannot be determined when it is not known in what form appellant [sic] is intending to claim the apparatus.

The test for compliance with the second paragraph of § 112 is stated in In re Merat, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975), as:

whether the claim language when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct.

In the present case, while the language of part (f) might be

more clearly expressed,³ we do not consider that one of ordinary skill would find the bounds of the claimed subject matter to be indistinct.

The part of the specification which is relevant to part (f) is found on page 8, lines 8 to 15:

It is called to the attention of the reader that the high-density polyethylene [outer circular member] 22 is split only once at the top of Figure 4 and at 31. The high-density polyethylene is not split at the bottom of Figure 4.

The result is a flexible insulation kit 40, see Figure 2, which can be spread apart around the solid high-density polyethylene at the bottom 60 of Figure 4. In other words, the high-density polyethylene at the bottom of Figure 4 functions as a hinge around which the two halves of the insulation can be rotated and moved.

In our view, one of ordinary skill in the art, reading part (f) in light of this disclosure, would not consider that the claims recite the outer tube in both its fused and longitudinally divided states, but rather that the claims are drawn to a combination including a fused outer tube, with part

³For example, if "upon being . . . to have" were changed to -- that, prior to --, and "and which" were changed to -- being fused, said --.

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(f) simply referring, as appellants state on page 11 of their brief, "to a physical characteristic of the outer tube and not to a state of assembly."

The examiner further argues on pages 7 to 8 of the answer:

Section (f) may indeed be describing a physical attribute of the outer layer but does so in a way that is describing the attribute when the outer layer is in a different form from its final state which is indefinite.

We do not agree. The fact that an element in a claim is defined by a property or characteristic which it has when in a different form from the form in which it is claimed does not inherently render the claim indefinite. Cf. In re Miller, 441 F.2d 689, 691, 169 USPQ 597, 599 (CCPA 1971) (claim to powder which recited unsintered flex strength, a property of preforms made from the powder rather than of the powder itself, was not indefinite). Here, although part (f) sets forth a characteristic of the outer tube which it has when in a different form than recited in part (a), there is compliance with the second paragraph of § 112 since the bounds of the claimed subject matter are distinct, as discussed above.

In the final rejection, the examiner also found claims

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14, 16, 22 and 24 to be indefinite because they refer to an ASTM standard,⁴ reasoning that "these factors could change in time and not be a specific limitation anymore" (final rejection, page 3). This rejection is repeated on page 4 of the examiner's answer, but is not discussed in detail on pages 6 to 8.

In any event, we do not consider that the reference to the ASTM standard renders these claims indefinite. The ASTM standard referred to in the claims is the one in existence when the application was filed. Such standards are published annually, and if later amended, the previous standard would still be available. See the discussion of the ASTM in Gore & Assocs. Inc. v. Int'l. Medical Prosthetics Research Assocs. Inc., 16 USPQ2d 1241, 1244-45 (D. Ariz. 1990). Thus one of ordinary skill could readily determine the bounds of claims 14, 16, 22 and 24. In this regard, we note that it is not uncommon to recite ASTM standards or methods in claims. See, e.g., In re Saether, 492 F.2d 849, 851, 181 USPQ 36, 38 (CCPA

⁴These claims each recite "said flexible outer tube being high-density polyethylene qualified as type III, category 5, class C, selected from Grades P23 and P24 as per ASTM D1248."

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1974), and In re Chapman, 357 F.2d 418, 148 USPQ 711 (CCPA
1966).

Accordingly, the rejection of claims 10 to 25 will not be
sustained.

Conclusion

The examiner's decision to reject claims 10 to 25 is
reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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Thomas W. Secrest
P.O. Box 1303
151 N. Market Blvd.
Chehalis, WA 98532