

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KATSUMI KITANAKA

Appeal No. 1998-0046
Application No. 08/357,320¹

HEARD: NOVEMBER 1, 1999

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6, 9 and 10, which are all of the claims pending in this application.²

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

¹ Application for patent filed December 16, 1994.

² Claims 7 and 8 were canceled in Paper No. 10.

BACKGROUND

The appellant's invention relates to an endless chain cutter. A copy of the claims under appeal appears in the appendix to the appellant's brief.³

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

Protzeller	2,594,991	Apr. 29, 1952
Reagle	2,636,291	Apr. 28, 1953
Hayward	AU 540,966	Dec. 13, 1984
(Australian patent document)		

The following rejections are before us for review.

1. Claims 1-5 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Protzeller.
2. Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Reagle.
3. Claims 6 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over either Protzeller or Reagle in view of Hayward.

³ The copy of claim 5 in the appellant's brief is an incorrect reproduction of claim 5 of record in the application in that "outward" should be "outwards."

Reference is made to the brief (Paper No. 14) and reply brief (Paper No. 16) and the answer (Paper No. 15) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

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 the examiner's rejections 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). Accordingly, we will initially direct our attention to appellant's claim 1 to derive an understanding of the scope and content thereof.

Claim 1 recites an endless chain extending between two upper and lower sprockets spaced along an axis and cutter elements mounted on the chain, at least some of the cutter elements "comprising cutting edges which extend *substantially parallel* to said axis" (emphasis added).

The term "substantially" is a term of degree. When a word of degree is used, such as the term "substantially" 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).

Admittedly, the fact that some claim language, such as the term of degree mentioned supra, may not be precise, does not automatically render the claim indefinite under the second paragraph of § 112. 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 the present case, we have reviewed the appellant's disclosure to help us determine the meaning of the above-noted terminology from claim 1. That review has revealed that the appellant's specification does not use the terms "cutting edges" or "parallel" or "substantially parallel" and, thus, provides absolutely no guidance as to the meaning of "substantially parallel."

The appellant's drawings, which are not engineering drawings dimensioned and drawn to scale, provide no further clarification with regard to this claim terminology. Figures 2a, 2b and 2c, which are described (specification, page 4) as a front, plan and side view, respectively, of one example of a cutter element, illustrate the cutter bits (4) in some detail. The cutter bits (4) of Figure 2a do not appear to us to comprise any edge extending parallel to the run of the endless

chain (1), which we interpret to be parallel to the recited "axis." Figure 2c illustrates cutter bits (4) having front faces which may or may not be parallel to the run of the chain. Figures 1 and 6 illustrate cutter bits (4) having curved front faces, rather than canted front faces as illustrated in Figure 2a. Additionally, as shown in Figure 6, it appears that the cutting face of the cutter bits (4) of the appellant's invention are the upper faces, which appear to be perpendicular to the run of the chain.

As should be evident from the above discussion, these portions of the disclosure do not provide explicit guidelines defining the terminology "substantially parallel" (claim 1). Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the term "substantially" as used in the terminology "substantially parallel" that would enable one skilled in the art to ascertain what is meant by "substantially." For example, one cannot ascertain if the inclined face (64) of Protzeller's excavating element is "substantially parallel" to the run of the chain therein, as now claimed. 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 disclosure fails to set forth an adequate definition as to what is meant by the terminology "substantially parallel" in claim 1, and claims 2 through 6, 9 and 10 which depend therefrom, 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.

Our findings, discussed above, in reviewing the appellant's disclosure have led us to review the appellant's original disclosure, including the original claims⁴, to determine whether the appellant's disclosure, as originally filed, provided adequate support for the "substantially parallel" limitation in compliance with the written description requirement of the first paragraph of § 112.

⁴ Our review of the original claims reveals that the "substantially parallel" limitation was not present in any of the original claims of the application.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the applicant does not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991).

In view of our findings discussed above, our review of the appellant's original disclosure, including the original drawings and claims, leads us to conclude that it would not have conveyed with reasonable clarity to those skilled in the

art that, as of the filing date of the application, the invention was directed to a cutter having cutter elements comprising "cutting edges which extend substantially parallel to said axis."

For the foregoing reasons, the appellant's original disclosure does not provide support for the invention as now claimed.

Considering now the rejections of claims 1 through 6, 9 and 10 under 35 U.S.C. §§ 102(b) and 103, we have carefully considered the subject matter defined by these claims.

However,

for reasons stated supra, no reasonably definite meaning can be ascribed to certain language appearing in the claims. As the court in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter 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. Specifically, as discussed above, this would require speculation as to the meaning of "substantially parallel" as used in the claims (note brief, pages 4 and 6). Since a rejection based on prior art cannot be based on speculations and assumptions, see In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, pro forma, the examiner's rejections of claims 1 through 6, 9 and 10 under 35 U.S.C. §§ 102(b) and 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the rejections under 35 U.S.C. §§ 102(b) and 103.

NEW GROUNDS OF REJECTION

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection:

Claims 1 through 6, 9 and 10 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above and incorporated herein.

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 terminology "substantially parallel" in independent claim 1. Claims 2 through 6, 9 and 10 depend from claim 1 and are likewise indefinite.

Claims 1 through 6, 9 and 10 stand rejected under 35 U.S.C. § 112, first paragraph, as the disclosure, as originally filed, does not provide support for the invention as is now claimed.

As discussed above and incorporated herein, the appellant's original disclosure does not provide support for the limitation that at least some of the cutting elements comprise "cutting edges which extend substantially parallel to said axis."

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 5 and 10 under 35 U.S.C. § 102(b), claims 1 and 4 under 35 U.S.C. § 102(b) and claims 6 and 9 under 35 U.S.C. § 103 is reversed. New grounds of rejection of claims

1 through 6, 9 and 10 under the first and second paragraphs of 35 U.S.C. § 112 are added pursuant to 37 CFR § 1.196(b).

This decision contains new grounds 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 grounds 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. . . .

REVERSED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 1998-0046
Application No. 08/357,320

Page 14

JAMES E. LEDBETTER, ESQ.
STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
1615 L STREET NW, SUITE 850
P.O. BOX 34387
WASHINGTON , DC 20043-4387

JDB/ki