

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILLES BERGE, JEAN-PIERRE EUSTACHE and JEAN-LOUIS ROUMEGOUX

Appeal No. 1998-0607
Application No. 08/506,857

HEARD: August 16, 2000

Before CALVERT, McQUADE, and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1-5, which are all of the claims pending in this application. The examiner has refused entry of an amendment (Paper No. 10) filed March 12, 1997 after the final rejection (see Paper No. 11). An amendment to the specification (Paper No. 13) filed July 17, 1997 has been entered.

BACKGROUND

The appellants' invention relates to a modular screen washing and wiping apparatus for a windshield of a vehicle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Miller	4,911,545	Mar. 27, 1990
Charles	5,009,459	Apr. 23, 1991 ¹
Eustache et al. (Eustache) (European patent application)	588,708	Mar. 23, 1994 ²

The following rejections stand before us for review.³

(1) Claims 1-5 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 appellants regard as the invention.

¹ While it appears that the Miller and Charles patents, along with the Hou and Kogita patents discussed *infra*, were cited by the examiner in Paper No. 2 (see page 4 and action summary sheet thereof), our review of the application file did not reveal a copy of the citation of references (PTO-892) contained in the file.

² An English language translation of this reference, prepared by the Patent and Trademark Office, is appended hereto.

³ The first issue raised in the appellants' brief (whether the drawings are properly objected to under 37 CFR § 1.83) relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review this issue.

(2) Claims 4 and 5 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter for which the specification does not provide an adequate written description.⁴

(3) Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Miller.

(4) Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Charles.⁵

Reference is made to the brief and reply brief (Paper Nos. 12 and 18) and the answer and supplemental answer (Paper Nos. 15 and 19) for the respective positions of the appellants 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 appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

⁴ While it is not clear from the examiner's statement of the rejection whether it is based upon the enablement or written description requirement of the first paragraph of 35 U.S.C. § 112, the examiner's explanation of the rejection appears to be concerned with enablement. In any event, while the basis of the rejection appears to us to be lack of enablement, our decision addresses both possible bases to determine whether a rejection under 35 U.S.C. § 112, first paragraph, is sustainable. In light of our treatment of this rejection, the appellants are not prejudiced thereby.

⁵ This rejection was entered as a new ground of the rejection in the examiner's answer (Paper No. 15, page 8). While the rejection as stated in the answer referred to Miller as the reference relied upon, it is clear from both the examiner's explanation of the rejection (answer, page 8) and the examiner's supplemental answer (Paper No. 19, page 2) that the rejection is based upon Charles.

Rejection (1)

With respect to claim 1, the examiner's position is that the language "at least one rear view mirror carried on **said plurality** of assembled modules" (emphasis ours) is indefinite. The examiner contends that the claims should be limited to recite the rear view mirror mounted on the wiping means modules, as described in the specification. Further, according to the examiner, it is not known if the appellants are claiming that there is a rear view mirror on each of the modules. With particular regard to claim 4, the examiner points out that "the rear view" should be "the rear view mirror."

The purpose of the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). To that end, the legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). Moreover, in order to satisfy the second paragraph of 35 U.S.C. § 112, a claim must accurately define the invention in the technical sense. See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973).

Turning first to claim 1, the appellants' specification, on page 3, discloses that the invention is directed to a modular apparatus comprising at least two modules, with one of the modules adapted to contain a screen washing liquid and the other module supporting means for wiping the windshield, wherein one of the modules serves to support at least one wing mirror. On pages 5-6, the appellants' specification discloses embodiments of the invention wherein each of the screen wiping modules supports a wing element or mirror (see Figures 2 and 3).

Claim 1 recites a modular screen apparatus comprising a plurality of modules adapted for assembly together and to the vehicle, with one of the modules constituting a windshield washing liquid reservoir and another of the modules carrying a windshield wiping means, and at least one rear view mirror carried on said plurality of assembled modules.⁶ As we see it, this claim merely requires that at least one rear view mirror be carried on at least one of the assembled modules, as a rear view mirror which is carried on any of the assembled modules is carried on the plurality of assembled modules. From our viewpoint, while the claim is broad, in that it encompasses the wing mirror being carried on the windshield washing liquid reservoir module, the windshield wiping means module or an additional module, the metes and bounds of the claim are sufficiently well defined to satisfy the requirements of the second paragraph of 35

⁶ The claim language "the vehicle further including at least one rear view mirror . . ." does not appear to be commensurate in scope with the claim, which does not include the vehicle. We interpret this language not as a positive recitation of the vehicle as part of the claim but merely as requiring that a mirror be carried on the plurality of assembled modules of the modular apparatus. As this issue is not before us on appeal, we leave to the examiner and the appellants consideration of whether "vehicle" in the above-quoted clause should be changed to "apparatus."

U.S.C. § 112. Moreover, we perceive nothing in this limitation of the claim which is inconsistent with the appellants' underlying disclosure, as the examiner's rejection suggests. While the only specific embodiment disclosed in the specification comprises the mirrors carried on the windshield wiping means modules, we also note that definiteness under the second paragraph of 35 U.S.C. § 112 does not require that the claims be written so narrowly that they are limited only to the illustrative structure disclosed in the appellants' specification. Just because a claim is broad does not mean that it is indefinite. See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); In re Miller, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); In re Gardner, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and Ex parte Scherberich, 201 USPQ 397, 398 (Bd. App. 1977).

For the foregoing reasons, we shall not sustain the examiner's rejection of claim 1, or claims 2 and 3 which depend therefrom, as being indefinite under 35 U.S.C. § 112, second paragraph. However, as the appellants concede on page 12 of the brief that the examiner is correct with respect to claim 4, we shall summarily sustain the examiner's rejection of claim 4, as well as claim 5 which depends from claim 4 and thus incorporates the same deficiency.

In addition to the deficiency pointed out by the examiner, we also note that claims 4 and 5 fail to comply with the second paragraph of 35 U.S.C. § 112 for the following reason.

The sixth paragraph of 35 U.S.C. § 112 states:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or

acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Claim 4 recites, *inter alia*, "means articulating the rear view [mirror] on said plurality of assembled modules" and claim 5 includes the further limitation "wherein the means articulating the rear view mirror on said plurality of assembled modules is arranged to enable the mirror to be retracted with respect to said assembled plurality of modules." The "means articulating . . ." is, as we see it, an element in a claim for a combination expressed as a means for performing a specified function without the recital of structure or materials in support thereof. Therefore, in accordance with the sixth paragraph of 35 U.S.C. § 112, this element shall be construed to cover the corresponding structure described in the appellants' specification and equivalents thereof.

Looking to the appellants' specification, the only reference to articulating or retracting the mirrors appears on page 6 and reads as follows:

In the embodiment shown in Figure 3, the wing mirrors 52 are suitably articulated on the wiper modules 20. They may be articulated in such a way as to be retractable, . . .

Figure 3 illustrates the wiper modules 20 having mirrors 52 extending outwardly from a rear edge thereof. The juncture between the mirrors 52 and modules 20, and hence any structure purporting to articulate and/or retract the mirrors, is not shown. In short, while the appellants'

specification broadly discloses articulating the mirrors so as to be retractable, it does not disclose any structure to achieve such articulation.

As our reviewing court stated in In re Dossel, 115 F.3d 942, 946, 42 USPQ2d 1881, 1885 (Fed. Cir. 1997) (quoting In re Donaldson Co., 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994)),

[a]lthough paragraph six statutorily provides that one may use means-plus-function language in a claim, one is still subject to the requirement that a claim "particularly point out and distinctly claim" the invention. Therefore, if one employs means-plus-function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112.

In failing to disclose any structure for articulating the mirrors so as to enable them to be retracted, the appellants have made it impossible for one of ordinary skill in the art to ascertain the metes and bounds of that claim limitation (the corresponding structure described in the specification and its equivalents) and, thus, have in effect failed to particularly point out and distinctly claim the invention. It is not clear, for example, whether the claim limitation may be met by a simple hinge or whether some type of actuating device is also required to move the mirror. Moreover, as evidenced by the prior art to Kogita (U.S. Patent No. 5,337,190), Hou (U.S. Patent No. 5,007,724) and Miller (U.S. Patent No. 4,911,545), for example, various arrangements for retractable mirrors, permitting and effecting different modes of movement, such as linear extension, pivoting or a combination thereof, were known in the art at the time

the appellants' application was filed. Therefore, it would not even have been clear to one skilled in the art what type of movement is intended by "articulating" and "retracted" as used by the appellants.

In order to give the appellants an opportunity to react to the additional rationale articulated above in support of the examiner's rejection of claims 4 and 5 under the second paragraph of 35 U.S.C. § 112, we designate our affirmance of this rejection as a new ground of rejection under 37 CFR § 1.196(b).

Rejection (2)

The examiner's statement of the rejection of claims 4 and 5 under 35 U.S.C. § 112, first paragraph, "as containing subject matter for which the specification does not provide an adequate written description" is ambiguous as to whether the basis thereof is lack of enablement or written description. However, the examiner's explanation of the rejection, in the response to arguments on pages 8-9 of the answer, indicates that the examiner's rejection of the claims is based on a determination that the specification does not describe the invention so as to enable a person skilled in the art to which the invention pertains to make and use the invention (i.e., lack of enablement).

Insofar as the enablement requirement is concerned, the dispositive issue is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without

undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling into question the enablement of the appellants' disclosure, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

In particular, the examiner asserts that the specification does not adequately disclose a means articulating the rear view mirror, as recited in claim 4, or a means for retracting the rear view mirror (answer, page 5). The appellants, on the other hand, argue that means for articulating and retracting mirrors mounted on vehicles were well known in the art at the time of the appellants' invention, as exemplified by the teachings of Kogita, Hou and Miller, and that, accordingly, one of ordinary skill in the art would have been able to practice the claimed invention without undue experimentation (brief, pages 9-11). Kogita discloses an actuator and linkage for pivoting and extending an external mirror mounted on an automotive vehicle (see Figure 1) and Hou discloses a motor 3 and worm 5 for linearly extending and retracting an auxiliary mirror frame 12 out of or into a main mirror frame 11 and a motor 111 for rotating the base 113 of a main mirror rearward and frontward. Miller discloses an extendible mirror (Figures 1-6) which is linearly retracted and extended by means of a piston and cylinder into and out of a well in the front fender of a vehicle. In a second embodiment (Figures 7-14), Miller discloses a mirror mounted in a ball and socket joint for pivotal movement effected by a piston and cylinder unit between a retracted position (Figures 10, 12) within a well in a door panel and an extended position (Figures 8, 11). The examiner concedes (answer, page 9) that

the prior art discloses several different means to make a retractable mirror, but finds the appellants' disclosure deficient, in that it does not indicate which of the many known types of articulation/retraction is employed in the appellants' invention.

In light of the above discussion, we conclude that one of ordinary skill in the art would have known, from the prior art, how to construct a device which articulates and retracts the appellants' rear view mirror, even without the disclosure of a particular embodiment thereof by the appellants. This is true whether "articulating" and "articulating to enable the mirror to be retracted" as used by the appellants require pivoting, pivoting in combination with linear extension or linear extension alone.⁷ In short, the examiner has not met the burden of advancing acceptable reasoning inconsistent with enablement in this instance.

The description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). With respect to the description requirement, the court in Vas-Cath, Inc. v. Mahurkar, 935 F.2d at 1563-64, 19 USPQ2d at 1117 stated:

35 U.S.C. § 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely

⁷ Note our discussion of this issue in our affirmance of the 35 U.S.C. § 112, second paragraph, rejection of claims 4 and 5, *supra*.

explain how to "make and use"; the applicant must also 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**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

In this instance, both the language in original claims 4 and 5 and the disclosure on pages 5 and 6 of the appellants' original specification clearly convey that the appellants were in possession of the invention as recited in claims 4 and 5, including means articulating the mirrors so as to enable them to be retracted.

For the foregoing reasons, we shall not sustain the examiner's rejection of claims 4 and 5 under the first paragraph of 35 U.S.C. § 112.

Rejection (3)

It does not appear to be in dispute that Eustache discloses the subject matter of claim 1 with the exception of a mirror carried on said plurality of assembled modules. To overcome this deficiency, the examiner relies upon the teachings of Miller (see answer, page 7). Miller, as discussed above, discloses two embodiments of retractable mirrors, one of which (Figures 1-6) is retractable and extendible into and out of a well in the front fender of a vehicle and the other of which (Figures 7-14) is pivotable into and out of a well in a door panel of a vehicle. While we agree that Miller would have suggested to one of ordinary skill in the art provision of such a retractable mirror on the Eustache vehicle, the well of either a front fender or a door panel cannot, in our opinion, reasonably be considered a part of "said plurality of assembled modules" as required by the claim. Further, we perceive no suggestion to provide such a

mirror on either of Eustache's modules (the recipient module 100 or wiping module 200) so as to arrive at the claimed invention.

Accordingly, we shall not sustain the examiner's rejection of claim 1, or of claims 2-5 which depend from claim 1, as being unpatentable over Eustache in view of Miller.

Rejection (4)

In making this rejection, the examiner asserts that it would have been obvious to a person skilled in the art to provide a rear view mirror assembly on the modular wiping assembly of Eustache in view of the teaching of Charles (answer, page 8). Charles discloses a wiper system for a raked (swept back so as to reduce the coefficient of drag) windshield wherein the side edges of the windshield form a shallow V, including an upper branch formed along a body door pillar line 18 and a lower branch formed along a hood line 20. The pivot points for the wiper arms 22 are located at or near the juncture of the door pillar edge 18 and hood line edge 20, at the base of the V, so that, as illustrated in Figure 1, the wiper arms are oscillated back and forth far enough to cover substantially the entire surface area of the windshield (column 3, lines 8-34). The vehicle body 10 also has a pair of aerodynamically shaped side mirror housings 26, each mirror housing having a fairing 28 that extends out partially along the length of the hood line 20 and is slotted where it hangs over the surface of the windshield. Thus, the pivot for each wiper arm can be located under a housing 26 and the wiper arm can move through the slotted fairing. Additionally, each wiper arm can be stopped

or "parked" at the lower limit of the wipe pattern, along a respective hood line 20, where it will be masked and covered by a respective fairing, thereby providing both an aesthetic and aerodynamic advantage (column 3, line 37, to column 4, line 4).

While it may be true that Charles would have suggested modifying Eustache so as to provide a raked windshield as taught by Charles to reduce drag and provide slotted mirror housings overhanging the side edge of the windshield to mask and cover the wiper arms, we fail to perceive any teaching, suggestion or incentive in the applied references which would have motivated an artisan to provide the mirror housings so as to be carried on one or more of the modules (100, 200) of Eustache, as opposed to, for example, the tops of the front fenders adjacent the hood line. We appreciate Charles' disclosure of the relative proximity of the wiper arms and the mirror housings, but such an arrangement in no way requires that the mirror housings be carried on the wiping means module 200 or on a module adapted for assembly with the wiping means module and recipient or reservoir module 100. From our perspective, the only suggestion for putting the selected pieces from the references together in the manner proposed by the examiner is found in the luxury of hindsight accorded one who first viewed the appellants' disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Therefore, we shall not sustain the examiner's rejection of claim 1, or claims 2 and 3 which depend therefrom, as being unpatentable over Eustache in view of Charles.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5 under 35 U.S.C. § 112, second paragraph, is affirmed as to claims 4 and 5 but reversed as to claims 1-3. The examiner's decision to reject claims 4 and 5 under 35 U.S.C. § 112, first paragraph, claims 1-5 under 35 U.S.C. § 103 as being unpatentable over Eustache in view of Miller and claims 1-3 as being unpatentable over Eustache in view of Charles is reversed. We have designated our affirmance of the rejection of claims 4 and 5 under 35 U.S.C. § 112, second paragraph, as a new ground of rejection pursuant to 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 appellants, 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).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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