

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PIERRE DOUBLET, YVES DOUESNEAU and JEAN-PAUL MENEZ

Appeal No. 1999-2433
Application No. 08/862,361

HEARD: January 25, 2001

Before COHEN, FRANKFORT and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17 through 28, 30 through 35 and 37 through 39, which are all of the claims currently pending in this application. Claims 1 through 16, 29 and 36 have been canceled.

Appellants' invention relates to a sheet of security

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paper which includes localized areas with reduced thickness and opacity, particularly a paper for banknotes (see claims 17 through 22, 30 through 32, 35, 37, 38 and 39). In addition, appellants' invention relates to a process for manufacturing a sheet of paper which includes at least one area or region having reduced thickness relative to the thickness of the rest of the sheet (claims 23 through 27, 33 and 34) and to a sheet of paper obtained by means of the process of claim 23 on appeal (claim 28). Independent claims 23 and 37 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims¹ are:

Jones	54,835	May 15, 1866
Howes	987,678	Mar. 21,

¹Our understanding of the foreign language document to Vernois relied upon by the examiner is based on a translation of that document prepared for the U.S. Patent and Trademark Office. For appellants' convenience, a copy of that translation is attached to this decision.

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1911	Vernois et al. (Vernois)	EP 0 091,341	Oct.
12, 1983			
	Melling et al. (Melling)	EP 0 319 157	Jun. 07,
1989			
	Thomas et al. (Thomas)	EP 0 388 090	Sep. 19, 1990

Claims 35 and 37 through 39 stand rejected under 35

U.S.C.

§ 103(a) as being unpatentable over Thomas or Melling in view of Howes.

Claims 17, 18, 32, 35, 37 and 39 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Thomas.

Claims 17, 18, 20, 23 through 28, 30 through 32, 34 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Melling.

Claims 21 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Melling in view of Jones.

Claims 19, 21, 22 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Thomas or Melling in view of Vernois.

Rather than attempt to reiterate the examiner's full

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commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the examiner's answer (Paper No. 26, mailed March 24, 1999) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 25, filed December 14, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the examiner's rejections based on prior art, it is essential that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellants' independent claim 37 on appeal in an

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attempt to derive an understanding of the scope and content thereof.

Claim 37 defines a sheet of security paper which includes at least one area of reduced opacity of a size of at least 0.4 cm²

and having "an average uniform opacity less than the opacity of the rest of the sheet" wherein the sheet is a two-ply sheet including one ply which comprises at least one area whose thickness is nil and wherein the two plies are directly joined together. Our problem comes in understanding exactly what the language "average uniform opacity" is intended to mean. While

appellants' specification (e.g., page 5) uses this terminology, we are given no definition as to exactly what appellants' mean by this language. Appellants' make numerous arguments on appeal (e.g., brief, pages 4, 6, 7, 8 and 9) that the prior art applied by the examiner does not have the required "average uniform opacity" required in claim 37 on appeal and thus in the claims which depend therefrom. By

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definition², an "average" is an arithmetical mean obtained by dividing the sum of two or more quantities by the number of quantities, or a number or value that typifies a set of values of which it is a function, as a median or mode. When used as an adjective, the term "average," for example, as in average speed, normally connotes a numerical average.

While appellants' brief uses the terminology "constant reduced opacity" (page 6) and "uniform reduced opacity" (page 7), we see no basis in the original disclosure to understand the language of claim 37 on appeal to be so limited. In this regard, we note that the samples of a security paper that were handed out at the oral hearing held on January 25, 2001, stated by

appellants' counsel to be made in accordance with the present invention, clearly did not have a uniform opacity across the area or region of reduced thickness and opacity provided therein when such paper was viewed by being held up to a light source in the hearing room. Accordingly, it is our view that

² Webster's New World Dictionary, Second College Edition, Prentice Hall press, 1986.

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claim 37 and claims 17 through 22, 30 through 32, 35, 38 and 39 which depend therefrom run afoul of the requirements of 35 U.S.C. § 112, second paragraph, which specifies that the claims presented must particularly point out and distinctly claim the subject matter which applicants regard as their invention.

Given the foregoing, under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 17 through 22, 30 through 32, 35 and 37 through 39:

Claims 17 through 22, 30 through 32, 35 and 37 through 39 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention. As a further point, we also note that claim 19 which specifies that the sheet according to claim 37 is

"one-ply" is indefinite since it is entirely inconsistent with the "two-ply sheet" defined in claim 37. In claim 21, the

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reference to "the tracing paper technique" is ambiguous and indefinite. What tracing paper technique? Regarding claim 38, we note that there is no "ply whose thickness is nil," but only a ply that includes at least one area whose thickness is nil.

As a further point, we also observe that there is a minor inconsistency in independent claim 23 on appeal. The recitation regarding "the thickness (e_1) of the rest of the sheet" in claim 23 should actually refer to ---the thickness (e_t) of the rest of the sheet---, as is made clear in the specification, at page 7. We likewise note that the equation on the top of page 8 of the specification relating to Figure 2 appears to be in error.

Turning to the examiner's rejections of appealed claims 17 through 22, 30 through 32, 35 and 37 through 39 under 35 U.S.C.

§ 102 and/or 35 U.S.C. § 103, we emphasize again that these claims contain language which renders the subject matter thereof indefinite. Accordingly, we find that it is not reasonably possible to apply the prior art relied upon by the

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examiner to these claims in deciding the question of
anticipation under 35

U.S.C. § 102 or obviousness under § 103 without resorting to
considerable speculation and conjecture as to the meaning of
the questioned limitation regarding the "average uniform
opacity" in independent claim 37 and in dependent claim 17,
particularly since appellants' specification provides no
guidance as to exactly what this terminology is to mean. This
being the case, we are constrained to reverse the examiner's
rejections of appealed claims 17 through 22, 30 through 32, 35
and 37 through 39 in light of the holding in In re Steele,...
134 USPQ 292 (CCPA 1962). We hasten to add that this reversal
of the examiner's rejections is not based on the merits of the
rejections, but on technical grounds relating to the
indefiniteness of the appealed claims.

Our action above leaves for our consideration in this
appeal the rejection of claims 23 through 28 and 34 under 35
U.S.C.

§ 103 based on Melling, and of claim 33 under 35 U.S.C. § 103

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based on Melling in view of Jones and also on Melling or Thomas in view of Vernois.

Independent claim 23 defines a process for manufacturing a sheet of paper which includes at least one region having reduced

thickness relative to the thickness of the rest of the sheet. The only difference pointed to by the examiner (answer, page 5) between the process of claim 23 on appeal and that in Melling is the recitation in claim 23 regarding the thickness of the reduced thickness region. In the examiner's opinion, such difference would have been obvious

since the claimed area depends on the design of the security and the desired strength (area of reduced thickness having reduced strength as compared with the overall sheet) and the desired degree of reduced opacity or increased transparency or translucency.

In the paragraph bridging pages 9 and 10 of the brief, appellants argue that Melling does not teach or suggest the particular process set forth in claim 23. We agree. While we find a teaching in Melling of a sheet having at least one region of reduced thickness having a thickness as recited in

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claim 23 on appeal (Melling, page 3, lines 45-56, i.e., the embodiment wherein there are holes in both fiber layers but at different locations), we find that the examiner has pointed to nothing in

Melling relating to the other process steps of appellants' claim 23. Thus, the examiner has provided no factual basis as to exactly how Melling teaches or suggests a first layer of paper formed on wire of a first wet end of a paper-making machine, a

second layer of paper formed on wire of a second wet end of a paper-making machine, one of the two layers of paper having at least some local regions of less thickness, with the two layers being joined directly together and dried. Given the lack of a factual basis to support the examiner's rejection, we must refuse to sustain the rejection of independent claim 37 under 35 U.S.C. § 103 based on Melling. It follows that the examiner's rejection of dependent claims 24 through 27 and 34, and product-by-process claim 28 based on Melling will also not be sustained.

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Finding nothing in Jones or Vernois which would provide for the deficiencies of Melling as noted above, we must also refuse to sustain the examiner's rejections of dependent claim 33 under 35 U.S.C. § 103 on the basis of Melling combined with either Jones or Vernois. As for the rejection of dependent claim 33 under 35 U.S.C. § 103 on the basis of Thomas and Vernois, we note that the examiner has pointed to nothing in Thomas or Vernois that teaches or suggests the process steps of independent claim 23 on appeal as we have noted above. This is particularly significant since the security paper pointed to by the examiner in Figure 7 of Thomas is a single ply paper with a reduced thickness area (3) and not a two-ply paper like that formed by the process of appellants' claim 23 on appeal. Lacking the noted limitations of independent claim 23, it follows that the examiner's rejection of dependent claim 33 under 35 U.S.C. § 103 on the basis of Thomas in view of Vernois will therefore not be sustained.

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In summary, the examiner's rejections of claims 17 through 28, 30 through 35 and 37 through 39 as set forth in the examiner's answer (pages 3-5) have been reversed. A new rejection of claims 17 through 22, 30 through 32, 35 and 37 through 39 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 CFR § 1.196(b).

In addition to the foregoing, we REMAND this application to the examiner to determine if additional prior art considered along with Melling, Thomas and Howes would render obvious appellants' method as set forth in independent claim 23 and the claims which depend therefrom, and also to consider product-by-

process claim 28 in that same regard. For example, the examiner may wish to consider EP 0059056 mentioned on page 3 of Melling relating to a cylinder mold papermaking machine. In addition, if

appellants' claim 37 to the sheet of security paper itself were to be adequately clarified and made definite, the

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examiner should consider appropriate rejections of that claim also, clearly treating all of the limitations of the claimed subject matter.

The decision of the examiner is reversed.

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. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark 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 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. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b) and REMANDED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

cef/vsh

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RICHARD E. FICHTER
BACON & THOMAS
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

APPENDIX A
CLAIMS 23, 28 AND 37

23. A process for manufacturing a sheet of paper which includes at least one region having reduced thickness relative to the thickness of the rest of the sheet, characterized in that:
a first layer of paper (3) is formed on a wire of a first wet end of a paper-making machine, a second layer of paper (5) is formed on a wire of a second wet end of a paper-making machine, one of the two layers of paper having at least some local regions (8) of less thickness, so that the thickness (e_2) of the two layers of paper in said regions is up to 80% relative to the thickness (e_1) of the rest of the sheet,
the two layers are joined directly together and dried.

28. The sheet obtained by means of the process according to Claim 23.

37. A sheet of security paper which includes at least one area of reduced opacity (3,20) of at least 0.4 cm² having an average uniform opacity less than the opacity of the rest of the sheet wherein the sheet is a two-ply sheet (16,17) including one ply (17) which comprises at least one area whose thickness is nil and wherein the two plies are directly joined together.