

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MASAHIKO KATO

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Appeal No. 1999-2454  
Application No. 08/656,106<sup>1</sup>

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ON BRIEF<sup>2</sup>

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2, 6 to 13 and 17 to 19. Claims 3 to 5 and 14 to 16 have been withdrawn from consideration under 37

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<sup>1</sup> Application for patent filed May 31, 1996.

<sup>2</sup> We note that the appellant has requested an oral hearing (part of Paper No. 13, filed February 8, 1999), but under the circumstances a hearing is not considered necessary. See 37 CFR § 1.194(c), last sentence.

Appeal No. 1999-2454  
Application No. 08/656,106

CFR § 1.142(b) as being drawn to a nonelected invention. No  
claim has been canceled.

We REVERSE.

BACKGROUND

The appellant's invention relates to an engine induction system and more particularly to an improved fuel supply arrangement for supplying the fuel to the injectors of a multi-cylinder engine (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1, 2, 6 to 13 and 17 to 19 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.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the second Office action (Paper No. 6, mailed October 2, 1997) and the answer (Paper No. 11, mailed January 12, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 10, filed September 22, 1998) and reply brief (Paper No.

Appeal No. 1999-2454  
Application No. 08/656,106

Page 4

13, filed February 8, 1999) for the appellant's arguments  
thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C.

§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented can be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is inappropriate.

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

With this as background, we turn to the rejection under

35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal. Specifically, the examiner stated (second Office action, page 2) that

the examiner has read claim 1 several times and cannot see how the relationship between the injectors and the rails is defined enough to examine the claim limitations. For example, it sounds like each injector might be sequentially operated, or the injectors might be sequential only relative to one another. It is similarly vague how the plural conduits are attached to the injectors. It is possible that each injector could be connected to plural conduits.

Claim 1 reads as follows:

An engine induction system comprised of a plurality of fuel injectors, means for operating said fuel injectors for spraying fuel therefrom in sequence, and means for delivering fuel from a source to said fuel injectors comprised of at least two separate fuel supply conduits, each conduit being related to said fuel injectors so that fuel is not supplied by any conduit to two fuel injectors that inject adjacent to or simultaneous with each other.

We find ourselves in agreement with the position of the appellant (brief, pages 4-6, and reply brief, pages 1-2) that the claims under appeal are definite, as required by the second paragraph of 35 U.S.C. § 112, when read in light of the

disclosure.<sup>3</sup> In our view, claim 1 defines the metes and bounds thereof with a reasonable degree of precision and particularity. That is all that is required by the second paragraph of 35 U.S.C. § 112. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). Furthermore, we note that while claim 1 may be a very broad claim<sup>4</sup>, breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

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<sup>3</sup> The appellant states (reply brief, paragraph bridging pages 1-2) that claim 1 covers four fuel injectors numbered 1, 2, 3, 4 wherein injectors 1, 2 inject simultaneously and injectors 3, 4 inject simultaneously but sequentially to the injection of injectors 1, 2. However, in our view, such an operation of those injectors would not be consistent with the claimed limitation of "each conduit being related to said fuel injectors so that fuel is not supplied by any conduit to two fuel injectors that inject adjacent to or simultaneous with each other" if the fuel for all four injectors were supplied by only two fuel supply conduits. For example, if one fuel conduit supplied fuel to injectors 1, 2, and the other fuel conduit supplied fuel to injectors 3, 4, then the "not simultaneous" aspect of the above-noted limitation would not be met. Likewise, if one fuel conduit supplied fuel to injectors 1, 3, and the other fuel conduit supplied fuel to injectors 2, 4, then the "not adjacent to" aspect of the above-noted limitation would not be met.

<sup>4</sup> It appears to us that claim 1 is readable on an engine having two fuel injectors operated in sequence where each of the two fuel injectors has its own separate fuel supply conduit.

For the reasons set forth above, the decision of the examiner to reject claims 1, 2, 6 to 13 and 17 to 19 under 35 U.S.C. § 112, second paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 2, 6 to 13 and 17 to 19 under 35 U.S.C. § 112, second paragraph, is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
IRWIN CHARLES COHEN	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 1999-2454  
Application No. 08/656,106

Page 11

ERNEST A. BEUTLER  
KNOBBE MARTENS OLSON AND BEAR  
620 NEWPORT CENTER DRIVE  
SIXTEENTH FLOOR  
NEWPORT BEACH, CA 92660-8016

APPEAL NO. 1999-2454 - JUDGE NASE  
APPLICATION NO. 08/656,106

APJ NASE

APJ CALVERT

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 18 Jan 00

**FINAL TYPED:**