

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GARY R. WUNDERLICH and LARRY D. WIERSCHKE

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Appeal No. 1999-2812  
Application No. 08/724,049

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection (Paper No. 12, mailed April 14, 1998) of claims 16 to 28. Claims 14 and 15 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. Claims 1 to 13 have been canceled.

We AFFIRM.

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Application No. 08/724,049

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BACKGROUND

The appellants' invention relates to a method and apparatus for transverse cutting of multi-ply web material and, more particularly, to a continuous motion saw (specification, p. 1). A copy of claims 17 to 23 and 25 to 28 under appeal is set forth in the appendix to the appellants' brief (Paper No. 21, filed January 19, 1999). A copy of claims 16 and 24 under appeal is set forth in the appendix to the examiner's answer (Paper No. 22, mailed March 26, 1999).

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

Molins 1927	1,630,132	May 24,
Spencer 1981	RE 30,598	May 5,

Claims 16 to 28 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.

Claims 16 to 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Spencer in view of Molins.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections,<sup>1</sup> we make reference to the answer for the examiner's complete reasoning in support of the rejections, and to the brief and reply brief (Paper No. 23, filed May 24, 1999) for the appellants' arguments thereagainst.

#### 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.

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<sup>1</sup> The rejection of claims 16 to 28 under the judicially created doctrine of double patenting set forth in the final rejection was withdrawn by the examiner in the answer (p. 10).

**The indefiniteness rejection**

We sustain the rejection of claims 16 to 28 under 35 U.S.C. § 112, second paragraph.

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 cannot 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 appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

Furthermore, the 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 analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal (answer, p. 4).

I. The examiner found the following phrases to lack clear antecedent basis: "said first and second bars" and "said third and fourth bar means." Additionally, the examiner found that those phrases were not clearly understood. The examiner inquired if the "first and second bars" and the "third and fourth bar means" were referring to the previously recited "first and second bar means" and the "third and fourth bars" and if so, the examiner stated that consistent terminology for the same features should be maintained throughout the claims.

We agree with the examiner that the lack of clear antecedent basis for the above-identified terms renders claims 16 to 28 indefinite under the second paragraph of 35 U.S.C. § 112. In that regard, it is our view that the metes and bounds of the claimed invention cannot be determined with a reasonable degree of precision and particularity since it is unclear if the appellants are claiming (1) "first and second bar means" or "first and second bars," and (2) "third and fourth bars" or "third and fourth bar means." Additionally, we note that the use of the term "means" may invoke the provisions of the sixth paragraph of 35 U.S.C. § 112 to determine the scope and meaning of a claimed element.

For the reasons set forth above, the appellants' argument regarding this specific rejection (brief, pp. 7-8) is unpersuasive. In addition, we note that the refusal by the examiner to enter the appellants' amendment after final rejection

relates to a petitionable matter and not to an appealable matter. See In re Schneider, 481 F.2d 1350, 1356-57, 179 USPQ 46, 51 (CCPA 1973) and In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). See also Manual of Patent Examining Procedure (MPEP) (7th Ed., July 1998) § 1002(c), item 3(b) and § 1201.

**II.** The examiner found the following phrases to lack clear antecedent basis: "the centers" in claim 16 and "the offset" in claim 18.

We agree with the appellants' argument (brief, p. 8) that the lack of a positive antecedent for "the centers" in claim 16 and "the offset" in claim 18 does not render the claims indefinite.

**III.** The examiner found that claim 21 was vague and indefinite in that it is not clear what the claim encompasses. Specifically, the examiner asked

What is the phrase "said step of rotating the second bar being accomplished by the rotation of the first, *second*, and third bars" (emphasis added)?

We agree with the examiner that claim 21 is indefinite under the second paragraph of 35 U.S.C. § 112. In that regard, it is our view that the metes and bounds of claim 21 cannot be determined with a reasonable degree of precision and particularity since the step of rotating the second bar is accomplished not by the rotation of the first, *second*, and third bars as set forth in the claim but by rotation of the first, third, and *fourth* bars as set forth in the specification (emphasis added).

**IV.** The examiner found that claim 22 was vague and indefinite in that it is not clear what the claim encompasses. The examiner specifically asked "What is the claim referring to?"

We agree with the appellants' argument (brief, p. 10) that claim 22 adds no further indefiniteness. In that regard,

claim 22 is further defining the step of connecting drive means to the first bar recited in parent claim 21.

V. The examiner found that the phrase "would logs" in claim 25 was vague and indefinite. The examiner inquired if the phrase should read -- wound logs --.

In response to this rejection, the appellants noted that the examiner was correct that the claimed contained a typographical error in the "would" should be "wound."

It is our view that this clear typographical error does not constitute indefiniteness under 35 U.S.C. § 112, second paragraph, since the correction thereto would have been understood by one skilled in the art.

*Summary*

For the reasons set forth above, the decision of the examiner to reject claims 16 to 28 under 35 U.S.C. § 112, second paragraph, is affirmed.

**The obviousness rejection**

We will not sustain the rejection of claims 16 to 28 under 35 U.S.C. § 103.<sup>2</sup>

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

Claim 16 reads as follows:

A method of operating an orbital saw to transversely sever superposed elongated web plies into shorter length products comprising the steps of  
advancing, along a linear path, said superposed elongated web plies having a cross sectional area of at least about 3.5 square inches (2200 m<sup>2</sup>),

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<sup>2</sup> Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 103 is not made. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). However, in this instance, we consider it to be desirable to avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537 (Bd. App. 1984).

providing a 4-bar linkage including first and second bar means extending generally parallel to each other, each of said first and second bars having a pair of ends, and third and fourth bars,

connecting said first and second bars adjacent the ends thereof with said third and fourth bars, to provide at least one degree of pivotal freedom of said third and fourth bars relative to said first and second bars,

rotatably mounting a disc blade on each of said third and fourth bar means with each of said third and fourth bars being equipped with means for rotating said disc blades,

rotating said first bar about a first axis to orbit said blades with the orbit of said blades intersecting said linear path and with the centers of said disc blades being at least 30" (750 mm) apart while skewing said first axis at a minor acute angle to said linear path, and

rotating said second bar about a second axis different from said first axis to compensate for said skewing and to orient said disc blades perpendicular to said web plies in said linear path when severing said web plies.

After considering the combined teachings of the applied prior art (i.e., Spencer and Molins), we reach the conclusion that it would not have been obvious at the time the invention was made to a person having ordinary skill in the art to have arrived at the claimed invention. Specifically, it is our opinion that the combined teachings of the applied prior art would not have suggested rotating the second bar about a

second axis different from the first axis about which the first bar rotates. In our view, when the teachings of the applied prior art are combined together in the manner set forth by the examiner (answer, p. 5, lines 3-10), the first and second bars would be rotating about the same axis. In our view, the only suggestion for further modifying Spencer in the manner proposed by the examiner to meet the above-noted limitation (answer, p. 5, lines 11-18) stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 16 to 28.

CONCLUSION

To summarize, the decision of the examiner to reject claims 16 to 28 under 35 U.S.C. § 112, second paragraph, is affirmed and the decision of the examiner to reject claims 16 to 28 under 35 U.S.C. § 103 is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

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

AFFIRMED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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APPLICATION NO. 08/724,049

APJ NASE

APJ CALVERT

APJ ABRAMS

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** Feb 23, 2000

**FINAL TYPED:**