

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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 FRANK G. DRUECKE,  
JAMES J. TANNER and  
RICHARD H. BELL

---

Appeal No. 2002-0815  
Application No. 08/902,171

---

ON BRIEF

---

Before KIMLIN, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

#### **DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-11.

Claims 1-4 are representative of the subject matter on appeal, and are set forth below, wherein the text in **bold** is for emphasis:

1. A weather-protective outer garment comprising a laminated fabric of a polyolefin nonwoven fabric discontinuously bonded to a foraminous polyolefin film with an adhesive, said laminated fabric oriented such that the polyolefin film side of the fabric is the outward-facing surface of the garment, said garment having one or more discontinuously ultrasonically bonded

seams **which are not reinforced with an additional strip of material** and in which the polyolefin film side of two laminated fabric edges are melted together, said seam(s) having a strength of about 2000 grams or greater per inch of seam width, and said laminated fabric having a basis weight of about 80 grams or less per square meter, a hydrohead of about 50 centimeters or greater, and a breathability of about 1000 grams or greater per square meter per 24 hours.

2. The garment of Claim 1 **wherein the wholesale price, expressed as 1997 U.S. dollars, is about 20 dollars or less.**

3. The garment of Claim 1 wherein the wholesale price, expressed as 1997 U.S. dollars, is about 10 dollars or less.

4. The garment of claim 1 wherein the wholesale price, expressed as 1997 U.S. dollars, is from about 2 to about 8 dollars.

Claims 1-11 stand rejected under 35 U.S.C. § 112, first paragraph (written description), as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 2-4 stand rejected under 35 U.S.C. § 112, second paragraph.

I. The 35 U.S.C. § 112, first paragraph, rejection (written description)

We first present the applicable case law in connection with a 35 U.S.C. § 112, first paragraph rejection, specifically, lack of written descriptive support, discussed below.

Appeal No. 2002-0185  
Application 08/902,171

In In re Kaslow, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983), the Federal Circuit affirmed the Board's decision, and quoted the Board's statement of the law with approval:

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

In re Kaslow, 707 F.2d at 1375, 217 USPQ at 1096  
(citation omitted).

Also, an ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. The disclosure need only reasonably convey to one of ordinary skill in the art that the inventors had possession of the subject matter in question. See In re Edwards, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978).

Here, the examiner states that the phrase "which are not reinforced with an additional strip of material", of claim 1, is new matter because this negative limitation, i.e., concept of exclusion, is not expressly supported by the specification.

Appellants argue that their figures show the bonded seam structure is not reinforced with an additional strip of material. (brief, page 3).

Upon our review of the specification, although there is no express language such as "which are not reinforced with an additional strip of material", we agree with appellants that the figures show that their invention includes a bonded seam structure that is not reinforced with an additional strip of material even if the figures depict a preferred embodiment, as

queried by the examiner. Also, as noted above, an ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Id. Hence, we determine that an adequate written description exists to support the phrase "which are not reinforced with an additional strip of material".

We therefore **reverse** this rejection.

II. The rejection under 35 U.S.C. § 112, second paragraph

The examiner has rejected claims 2-4 because they are based upon a fluctuating currency value, for example, the U.S. dollar as valued in 1997 (answer, page 3).

We find that dependent claims 2-4 are improper in view of the fact that these claims do not further limit independent claim 1 because they do not further limit the structure or material of the garment defined by claim 1, an article of manufacture within the meaning of 35 U.S.C. § 101. In this context, we agree with the examiner's rejection of claims under 35 U.S.C. § 112, second paragraph.

We therefore **affirm** this rejection.

III. CONCLUSION

The rejection under 35 U.S.C. § 112, first paragraph (written description) is **reversed**.

The rejection under 35 U.S.C. § 112, second paragraph is **affirmed**.

Appeal No. 2002-0185  
Application 08/902,171

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**

Edward C. Kimlin )  
Administrative Patent Judge )  
 ) BOARD OF PATENT  
 ) APPEALS AND  
 ) INTERFERENCES  
Beverly A. Pawlikowski )  
Administrative Patent Judge )

BAP/cam

Appeal No. 2002-0185  
Application 08/902,171

KRATZ, Administrative Patent Judge, concurring.

I concur with the majority's disposition of the examiner's stated rejections as maintained on appeal. However, I write separately to express different reasons for sustaining the examiner's decision rejecting claims 2-4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

The relevant inquiry under 35 U.S.C. § 112, second paragraph, is whether the claim language, as it would have been interpreted by one of ordinary skill in the art in light of appellants' specification and the prior art, sets out and circumscribes a particular area with a reasonable degree of precision and particularity. See In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The fundamental purpose of a patent claim is to define the scope of protection<sup>1</sup> and hence what the claim precludes others from doing. All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public

---

<sup>1</sup>See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 625 n.5 (Fed. Cir. 1985).

Appeal No. 2002-0815  
Application 08/902,171

must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

In the present case, the claimed terminology respecting the wholesale price as set forth in claims 2-4 is not a reasonably predictable physical property of the claimed garment. Rather, as basically found by the examiner at page 4 of the answer, a wholesale price can be determined by a variety of methods based on a number of disconnected business decisions and unexpected eventualities leaving the scope of what claims 2-4 cover unclear. Piggybacking such indeterminate pricing methodologies onto an article of manufacture, as in claims 2-4, results in an improper aggregation of disconnected economic/business considerations with the claimed article of manufacture itself and is in violation of the requirements and

Appeal No. 2002-0815  
Application 08/902,171

underlying purpose of the second paragraph of 35 U.S.C. § 112.  
Accordingly, I concur with the majority's decision for the  
reasons set forth above.

PETER F. KRATZ ) BOARD OF PATENT  
Administrative Patent Judge ) APPEALS  
) AND  
) INTERFERENCES

Gregory E. Croft

Appeal No. 2002-0815  
Application 08/902,171

Kimberly Clark Worldwide Inc.  
401 North Lake Street  
Neenah, WI 54956