

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. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ICHIRO OGAWA and ISAO NAKAJO

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Appeal No. 2002-1481  
Application No. 09/005,836

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HEARD: FEBRUARY 13, 2003

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

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 through 6, as amended subsequent to the final rejection. These claims constitute all of the claims in the application.

Appellants' invention pertains to an electromagnetic shield for use with a circuit board having circuit devices. A basic understanding of the invention can be derived from a reading of exemplary claims 1 and 4, respective copies of which appear in the CLAIMS APPENDIX to the main brief (Paper No. 18).

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As evidence of obviousness, the examiner has applied the documents listed below:

Pressler et al (Pressler)	5,550,713	Aug. 27, 1996
Persson et al (Persson)	5,672,844	Sep. 30, 1997

The following rejection is before us for review.

Claims 1 through 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pressler in view of Persson.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 19), while the complete statement of appellants' argument can be found in the main and reply briefs (Paper Nos. 18 and 21).

#### OPINION

We cannot resolve the obviousness issue on its merits since the claims on appeal are indefinite under 35 U.S.C. § 112, second paragraph, as more fully explained below. In a case such as the present one, where claims contain unclear language which renders

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them indefinite, an evaluation thereof relative to prior art is inappropriate. See In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) and In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Since an obviousness rejection cannot be based on speculation and conjecture as to what is being claimed, we are constrained to reverse the examiner's rejection under 35 U.S.C. § 103(a). This reversal is procedural in nature and not founded upon the merits of the obviousness rejection. Thus, it is quite important to recognize that we take no position as to the pertinence of the prior art relied on by the examiner since this prior art clearly cannot be applied until it can be determined what in fact is being claimed.

Under the provisions of 37 CFR § 1.196(b), we introduce the following new rejection.

Claims 1 through 6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Independent claim 1 sets forth an electromagnetic shield for use with a circuit board having circuit devices comprising, inter alia, a first conductive coating where the coating extends from a

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top of the rib structure to a section surrounded by the rib structure, with the conductive pattern being in absolute contact with the top of the rib structure. Independent claim 4 recites an electrical apparatus having a circuit board with circuit devices, said apparatus comprising, inter alia, a conductive coating for coating from a top of rib structure to a section surrounded by said rib structure, where a conductive pattern is in absolute contact with the top of the rib structure.

From the language of each of these claims, and in accord with the underlying disclosure, it is clear that the top of the rib structure is coated. However, inconsistent with the above, each of these independent claims requires that a conductive pattern be in absolute contact with "the top" of the rib structure; a relationship that is apparently impossible by virtue of the aforementioned coating on the top of the rib structure. It is also not clear what the word "contact" denotes in the context used, i.e., electrical contact, mechanical contact, or both electrical and mechanical contact. Additionally, even read in light of appellant's overall disclosure, we are at a loss to understand the meaning of the modifying word "absolute" relative to the already discussed "contact". Lastly, the claims specify

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that the rib structure surrounds an enclosure section of conductive coating which effects a shield for surrounding a source of unwanted electromagnetic radiation. The word "surround" is broadly defined as enclosing on all sides.<sup>1</sup> The noted language is not understood since the rib structure does not appear to be configured to surround (enclose) the source of unwanted electromagnetic radiation on all sides (Fig. 2). The above language renders the claims indefinite in meaning under 35 U.S.C. § 112, second paragraph, since the metes and bounds thereof cannot be ascertained.

In summary, this panel of the board has procedurally reversed the obviousness rejection on appeal, and has entered a new rejection in accordance with our authority under 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. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

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<sup>1</sup> Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979.

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§ 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)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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