

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KYEONG-SUN YUN

Appeal No. 2004-0096
Application No. 09/785,273

ON BRIEF

Before FRANKFORT, STAAB and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2 and 3, which are all of the claims pending in this application. Claim 3 was amended subsequent to the final rejection (see Paper Nos. 9 and 12).

We REVERSE and enter new grounds of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellant's invention relates to a water pail equipped with an air passageway in the outlet thereof to pass through external air so that the contents contained in the pail are smoothly exhausted out (specification, page 1). According to appellant, the invention is an improvement over prior art containers provided with a separate hole spaced from the outlet (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art reference in rejecting the appealed claims:

Reap	1,676,711	Jul. 10, 1928
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Claims 2 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Reap.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 13) for the examiner's complete reasoning in support of the rejection and to the brief (Paper No. 11) 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, to the applied Reap patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Before addressing the patentability of claims 2 and 3 under 35 U.S.C. § 102, it is essential that we understand the scope and content thereof. A basic and important rule of claim construction is that the language of the claim defines the scope of the protected invention. Yale Lock Mfg. Co. v. Greenleaf, 117 U.S. 554, 559 (1886) ("The scope of letters patent must be limited to the invention covered by the claim, and while the claim may be illustrated it cannot be enlarged by language used in other parts of the specification."); Autogiro Co. of Am. v. United States, 384 F.2d 391, 396, 155 USPQ 697, 701 (Ct. Cl. 1967) ("Courts can neither broaden nor narrow the claims to give the patentee something different than what he has set forth [in the claim]."). See also Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 419 (1908); Cimiotti Unhairing Co. v. American Fur Ref. Co., 198 U.S. 399, 410 (1905). Accordingly, "resort must be had in the first instance to the words of the claim" and words "will be given their ordinary and accustomed meaning, unless it appears that the inventor used them differently." Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 759, 221 USPQ 473, 477 (Fed. Cir. 1984). Second, it is equally "fundamental that claims are to be construed in the light of the specifications and both are to be read with a view to ascertaining the invention." United States v. Adams, 383 U.S. 39, 49, 148 USPQ 479, 482 (1966).

With these principles in mind, we turn to the language of claims 2 and 3 on appeal. Claim 2 requires, inter alia, "a detachable air passageway member which

includes a bisection member which is dimensioned to fit and detachably adhere to an inside surface of an outlet of a fluid container” and claim 3 recites a bisection member which is “dimensioned to fit and detachably adhere to an inside surface of an outlet of a fluid container” wherein the bisection member “has a width dimension of said outlet such that the edges of the bisection member frictionally engage said outlet to adhere said bisection member to the outlet.” Inasmuch as the sole dispute in this appeal is focused on the interpretation of the term “detachable,” as used in appellant’s claims, it is essential that we understand what is meant by detachable adherence within the context of appellant’s invention. When understood according to their ordinary and customary usage, the terms “detachable”¹ and “adhere”² would seem to be inconsistent with one another so as to render the phrase “detachably adhere” oxymoronic in nature. We thus turn to appellant’s specification in an attempt to determine what is meant by this phrase.

Appellant’s specification (page 3) informs us that the bisection member 31 is “adhered” to divide the inside outlet 10, that an air guide member 32 is “adhered” to both sides of the lower bisection parts of the outlet and “adhered” to form predetermined air passageway 40 and that the air guide member 32 is provided to be “adhered” along the inner surface of the outlet 10 and is provided not to be stuck at the

¹ The term “detach” is defined as “to unfasten or separate and remove; disconnect; disengage” (Webster’s New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988)).

² To stick fast; stay attached. Id.

inside surface of the side of the water pail 20. This detailed description of the invention mentions nothing about the air passageway or bisection member being “detachable” or “detachably adhered” to the outlet. Nevertheless, page 4 of appellant’s specification cites as one of the advantages of appellant’s invention that, “since the air passageway is detachably formed, it is possible to facilitate cleaning thereof.” Accordingly, it is not apparent from this written description how the air passageway or bisection member is secured on the container or whether or to what degree such securement is detachable and appellant’s drawing Figures 2a, 2b, 3 and 4 do nothing to clarify this point.³ While the summary of the invention on page 2 of appellant’s brief states that the bisection member 31 “bisects the outlet and has a width equal to a dimension of the outlet such that the edges of the bisection member frictionally engage the outlet to adhere the bisection member to the outlet” and claim 3, which was not an original claim, contains a similar recitation, Figure 2b in appellant’s application appears to illustrate the bisection member 31 having a width which is less than the diameter of the outlet and edges which meet the inner surface of the outlet 10 at points which are not diametrically opposed, thereby implying that frictional engagement of the bisection member with the outlet is not the means of adherence of the bisection member and air passageway to the container.

³ We also note that the reference numerals 31 and 32 appear to be reversed in Figure 4.

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim 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. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

In light of the above, we must reach the conclusion that one of ordinary skill in the art would not be able to determine what is meant by the terminology “detachable” and “detachably adhere” in claim 2 so as to ascertain the scope thereof as required by 35 U.S.C. § 112, second paragraph. Likewise, especially in view of the illustration of the bisection member in appellant’s Figure 2b, one of ordinary skill in the art would be unable to ascertain what dimensions of the bisection member are required to meet the functions of detachable adherence and frictional engagement recited in claim 3. For the foregoing reasons, we enter a new ground of rejection of claims 2 and 3 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.

Further, pursuant to our authority under 37 CFR § 1.196(b), we also reject claims 2 and 3 under the first paragraph of 35 U.S.C. § 112 because the specification does not provide adequate disclosure of the invention so as to enable one of ordinary skill in the

art to make and/or use the same. For the reasons discussed above, one of ordinary skill in the art would not be able to determine from appellant's underlying disclosure how the bisection member and air passageway are secured to the container so as to be "detachably adhered."

Additionally, also pursuant to our authority under 37 CFR § 1.196(b), claim 3 is rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed. As discussed above, appellant's specification and drawings as originally filed provide no hint that the edges of the bisection member frictionally engage the outlet as recited in claim 3.

We shall not sustain the examiner's 35 U.S.C. § 102 rejection of claims 2 and 3 as being anticipated by Reap. For the reasons expressed above, these claims are indefinite. Therefore, the prior art rejection must fall because it is necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). In particular, as discussed above, the meaning of the terminology "detachably adhered" and the dimensional limitation required to meet this recitation in claim 3, which is the sole issue in dispute with regard to this rejection, is not clear in light of appellant's underlying disclosure. It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2 and 3 under 35 U.S.C. § 102(b) is reversed and new rejections of claims 2 and 3 under the first and second paragraphs of 35 U.S.C. § 112 are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 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. . . .

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 1.1969(b)

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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