

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC L. AMES
and
HENRY H. MAGENHEIM

Appeal No. 95-4047
Application 07/931,206¹

ON BRIEF

Before PAK, OWENS and SPIEGEL, *Administrative Patent Judges*.
OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's final rejection of claims 1-5, which are all of the claims in the application.

THE INVENTION

Appellants' claimed invention is directed toward a

¹ Application for patent filed August 17, 1992.

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temporary replacement motor vehicle window, comprised of two sheets of flexible transparent film which are attached such that they form an envelope which will fit snugly over the frame of a vehicle door. Claim 1 is illustrative and reads as follows:

1. A temporary replacement window comprising:

two sheets of a flexible transparent film pre-cut to a pattern that is shaped to snugly fit over a broken window frame on an automobile or motor vehicle;

and means of attaching the two sheets of a flexible transparent film, along a portion of their edges, so that together the two sheets form an envelope which will fit snugly over the frame of a vehicle door having the broken window.

THE REFERENCES

Vargas	4,889,754	Dec. 26, 1989
Schrumer et al. (Schrumer)	5,044,776	Sep. 3, 1991

Miles Kimball Co. Catalog (Miles Kimball), page 58 (Dec. 1990).

THE REJECTIONS

Claims 1-5 stand rejected under 35 U.S.C. § 103 as being unpatentable over Vargas or Miles, each taken with Schrumer. These claims also stand rejected under 35 U.S.C. § 112, first and second paragraphs, on the grounds that the claimed invention is not described in such full, clear, concise and

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exact terms as to enable a person of ordinary skill in the art to make and use the invention, and/or that the claims fail to particularly point out and distinctly claim the subject matter which appellants regard as the invention.

OPINION

We have carefully considered all of the arguments advanced by appellants and the examiner and agree with appellants that the aforementioned rejection under 35 U.S.C. § 103 is not well founded. Accordingly, we do not sustain this rejection. Nor do we sustain the rejection under 35 U.S.C. § 112, first paragraph. We sustain the rejection under 35 U.S.C. § 112, second paragraph, only as to claims 4 and 5.

Rejection under 35 U.S.C. § 103

Vargas discloses a temporary window comprised of at least two layers of transparent polymeric film held together by a thin layer of transparent adhesive (col. 1, lines 44-48). At least one of the outer layers is perforated or precut such that strips or sections of that layer can be peeled off, thereby exposing adhesive which is used to bond the temporary window to a window frame such as that of an automobile (col.

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1, lines 48-58; col. 2, lines 20-24).

Miles Kimball (page 58) discloses two protective windshield covers. One is a sunshield which reflects heat and is held in place by four built-in magnets. The other is a black winter cover which attaches with self-stick gripper tape. The covers

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can be anchored by closing the ends in the car doors.

Schramer discloses a resealable, plastic, foil, paper or laminate bag for containing items such as potato chips, dog food, and lawn care products (col. 2, lines 38-43). The bag has on its side one or more pressure-sensitive adhesive strips covered by a release liner having perforated cuts such that sections of the release liner can be individually removed to expose new areas of the adhesive, thereby providing multiple securing sites for closing and sealing the bag (col. 1, lines 6-16; col. 2, lines and 15-23; col. 5, lines 17-34; col. 6, lines 40-51). The multiple closing sites permit the void volume in the bag to be decreased as the product volume decreases (col. 2, lines 49-53).

The examiner argues that Schramer's teaching of enclosing or folding plastic covers to form a sheath or bag-like feature would have fairly suggested, to one of ordinary skill in the art, modifying the Vargas or Miles Kimball articles such that they are in the form of an envelope (supplemental answer, pages 6-7). The examiner provides no reasoning in support of this conclusion.

Appellants argue that the examiner's rejection relies upon

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impermissible hindsight (amended brief, pages 20-23). We agree. It is clear that the motivation relied upon by the examiner for

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making a temporary replacement window in the form of an envelope comes solely from the description of appellants' invention in their specification. Thus, the examiner used impermissible hindsight when rejecting the claims. See *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983); *In re Rothermel*, 276 F.2d 393, 396, 125 USPQ 328, 331 (CCPA 1960). Accordingly, we reverse the rejection under 35 U.S.C. § 103.

Rejection under 35 U.S.C. § 112, first paragraph

The examiner makes no argument as to why appellants' specification does not describe the claimed invention such that an enabling disclosure is provided, and no reason is apparent. Consequently, we reverse the rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 112, second paragraph

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

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of precision and particularity. See *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner argues that "a portion" in appellants' claim 1 is speculative and that the claim does not set forth the metes and bounds of the invention because it does not specify the portion at which the sheets are attached (supplemental answer, page 3). The term "a portion" broadly encompasses any portion, but the fact that the term is broad does not mean that it is indefinite. See *In re Gardner*, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) ("Breadth is not indefiniteness."); *In re Borkowski*, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970). The examiner has not explained, and it is not apparent, why "a portion" in appellants' claim 1, when interpreted by one of ordinary skill in the art in view of appellants' specification, would not have set out and circumscribed a particular area with a reasonable degree of precision and particularity. We therefore reverse the rejection of claim 1 under 35 U.S.C. § 112, second paragraph.

Regarding claim 4, the examiner argues that "transparent grades" and "film grade" are nebulous (supplemental answer,

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page 3). Regarding "transparent grades", the examiner argues that it is unclear whether the term means that the polyolefins are transparent (*see id.*). It is clear that "transparent" in the

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term "transparent grades of polyolefins" means that the polyolefins are transparent. The examiner provides no explanation as to why the term "film grade" is indefinite, and none is apparent.

However, "acrylics such a film grade polymethylmethacrylate" in claim 4 is indefinite because it is not clear whether this term encompasses acrylics generally or only those which have some unspecified similarity to polymethylmethacrylate. Also, "related copolymers" in the expression "acrylics such a film grade polymethylmethacrylate and related copolymers" is indefinite because it is not clear, in view of appellants' disclosure, how the copolymers are related, e.g., with respect to composition, physical properties, etc. For these reasons, we sustain the rejection under 35 U.S.C. § 112, second paragraph, of claim 4 and claim 5 which depends therefrom.

DECISION

The rejections of claims 1-5 under 35 U.S.C. § 103 as being unpatentable over Vargas or Miles, each taken with Schramer, and under 35 U.S.C. § 112, first paragraph, are

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reversed. The rejection of claims 1-3 under 35 U.S.C. § 112,
second paragraph,

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is reversed. The rejection of claims 4 and 5 under 35 U.S.C.
§ 112, second paragraph, is affirmed.

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

AFFIRMED-IN-PART

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
TERRY J. OWENS))
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
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CAROL A. SPIEGEL)	
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