

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN H. MALIK, JOHN J. MIKULA and ROBERT A. JULIEN

Appeal No. 97-0677
Application No. 08/312,710¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge and
McQUADE and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, which are all of the claims pending in this application. In the examiner's answer, the examiner allowed claim 4 and objected to claim 3 as depending from a rejected claim. Accordingly, claims 1 and 2 remain on appeal.

¹ Application for patent filed September 27, 1994.

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We AFFIRM-IN-PART and enter a new rejection pursuant to 37
CFR § 1.196(b) and a recommendation pursuant to 37 CFR
§1.196(d).

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BACKGROUND

The appellants' invention relates to a one-piece blow-molded plastic drum. Claims 1 and 2, as they appear in the appendix to the appellants' brief, are attached to this decision.

The prior art references of record relied upon by the examiner as evidence of obviousness under 35 U.S.C. § 103 are:

Ames	4,489,847	Dec.
25, 1984		
Pyzytulla	5,018,642	May
28, 1991		

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Pyzytulla in view of Ames.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the § 103 rejection, we make reference to the examiner's answer (Paper No. 13, mailed September 18, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants'

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brief (Paper No. 12, filed July 29, 1996) and reply brief (Paper No. 14, filed November 25, 1996) 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.

CLAIM 1

We will not sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103 as being unpatentable over Pyzytulla in view of Ames.

On page 4 of the answer, the examiner determined that

[i]t would have been obvious to one of ordinary skill in the art to have employed the close proximity tangential plane teaching of Ames (847) in the construction of the device of Pyzytulla (642).

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On pages 5-6 of the brief, the appellants argue that

the outer surface of the body portion of Pyzytulla's drum is not positioned in a tangential plane in close proximity to a tangential plane along the outer surface of the handling ring. . . . [and that] one skilled in the art considering the teachings of Ames '847 in combination with Pyzytulla '642 . . . would not decrease the energy absorbing capability of Pyzytulla's "crumple zone" by moving the transition ring radially inwardly.

Thus, the appellants argue that the limitation that the "body portion outside² surface is positioned in a tangential plane in close proximity to a tangential plane along said handling ring outer surface" is not taught by Pyzytulla and that the combined teachings of Pyzytulla and Ames would not have suggested this limitation.

It is an essential prerequisite that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 103 begins with

² We read the terminology "outside surface" as referring back to the previously recited "outer cylindrical surface" of the body portion. Accordingly, we suggest that claim 1, as well as claim 4 which contains the same language, be amended to change "outside" to --outer-- for better antecedent basis.

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a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Our review of independent claim 1 reveals that we are unable to derive a proper understanding of the scope and content thereof. Specifically, the terminology "so that said body portion outside surface is positioned in a tangential plane in close proximity to a tangential plane along said handling ring outer surface" in independent claim 1 raises a definiteness issue under 35 U.S.C. § 112, second paragraph.

The terminology "in close proximity" is a term of degree. When a word of degree is used, such as the terminology "in close proximity" in claim 1, it is necessary to determine whether the specification provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial

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Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 573-74 (Fed. Cir. 1984).

Admittedly, the fact that some claim language, such as the term of degree mentioned supra, may not be precise, does not automatically render the claim indefinite and hence invalid under the second paragraph of § 112. Seattle Box, supra. Nevertheless, the need to cover what might constitute insignificant variations of an invention does not amount to a license to resort to the unbridled use of such terms without appropriate constraints to guard against the potential use of such terms as the proverbial nose of wax.³

In Seattle Box, the court set forth the following requirements for terms of degree:

When a word of degree is used the district court must determine whether the patent's specification provides some standard for measuring that degree. The trial court must decide, that is, whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.

³ See White v. Dunbar, 119 US 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 4 USPQ2d 1136, 1139 (Fed. Cir. 1987).

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In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985), the court added:

If the claims, read in light of the specifications [sic], reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.

Indeed, the fundamental purpose of a patent claim is to define the scope of protection⁴ 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 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).

⁴ See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

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In the present case, we have reviewed the appellants' disclosure to help us determine the meaning of the above-noted terminology from claim 1. That review has revealed that the appellants' have used the terminology "in close proximity" on pages 4, 9 and 16 of the specification, in the abstract and in claims 1 and 4. Page 9 of the specification provides that Figure 2 shows the tangential plane E of the outside surface 12a of the body portion 12 in close proximity to the tangential plane E' of the outer surface 22a of the handling ring 20. Pages 9-10 of the specification provide that Figure 3 shows the tangential plane of the outer surface 22a of the handling ring 20 of a prior art drum extends a substantial distance outwardly from the tangential plane along the outside surface of the body portion 12 of the prior art drum. However, these portions of the disclosure do not provide explicit guidelines defining the terminology "in close proximity" (claim 1). Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the terminology "in close proximity" as used in claim 1 that would enable one skilled in the art to ascertain what is meant by "in close proximity." For example, one cannot ascertain if the body portion outer surface of Pyzytulla's drum

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is positioned in a tangential plane "in close proximity" to the tangential plane along the handling ring outer surface. Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of 35 U.S.C. § 112. See In re Hammack, supra.

Since the appellants' specification fails to set forth an adequate definition as to what is meant by the terminology "in close proximity" recited in claim 1, the appellants have failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

New ground of rejection

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

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained above.

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As set forth previously, our review of the specification leads us to conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "in close proximity" in claim 1.

Examiner's rejection of claim 1 under 35 U.S.C. § 103

We emphasize again here that claim 1 contains unclear language which renders the subject matter thereof indefinite for the reasons stated supra as part of our new rejection under 35 U.S.C. § 112, second paragraph. We find that it is not possible to apply the prior art to claim 1 in deciding the question of obviousness under 35 U.S.C. § 103 without resorting to speculation and conjecture as to the meaning of the questioned limitation in claim 1. This being the case, we are therefor constrained to reverse the examiner's rejection of claim 1 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). This reversal of the examiner's rejection is based only on the technical grounds relating to the indefiniteness of this claim.

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CLAIM 2

We will sustain the examiner's rejection of claim 2 under 35 U.S.C. § 103 as being unpatentable over Pyzytulla in view of Ames, noting simply that the appellants' argument that the limitation that the "body portion outside surface is positioned in a tangential plane in close proximity to a tangential plane along said handling ring outer surface" is not taught by Pyzytulla and that the combined teachings of Pyzytulla and Ames would not have suggested this limitation is not germane to claim 2 since such a limitation is not recited in this claim and that the appellants have not otherwise contested the correctness of this rejection.

RECOMMENDED NEW REJECTION UNDER 37 CFR § 1.196(d)

Under the provisions of 37 CFR § 1.196(d), this panel of the Board remands the application to the examiner and recommends the following new rejection of allowed claim 4 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the invention, for the reasons explained below.

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As set forth previously with respect to claim 1, our review of the specification leads us to conclude that one of ordinary skill in the art would not be able to understand the metes and bounds of the terminology "in close proximity" recited in claims 1 and 4. Since the appellants' specification fails to set forth an adequate definition as to what is meant by the terminology "in close proximity" recited in claim 4, the appellants have failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

Additionally, the terminology "said inside surfaces" recited in the last line of claim 4 lacks antecedent basis in the claim since the claim does not recite any element having an inside surface. Since claim 4 lacks antecedent basis for "said inside surfaces," the appellants have failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112.

CONCLUSION

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To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 103 is reversed; the decision of the examiner to reject claim 2 under 35 U.S.C. § 103 is affirmed; a new rejection of claim 1 under 35 U.S.C. § 112, second paragraph, has been made pursuant to our authority under 37 CFR § 1.196(b); and remand with a recommendation for a new rejection of allowed claim 4 under 35 U.S.C. § 112, second paragraph, is made under the provisions of 37 CFR § 1.196(d).

A period of two months is set in which the appellants may submit to the Primary Examiner an appropriate amendment, or a showing of facts or reasons, or both, in order to avoid the ground of rejection set forth in the statement of the Board of Patent Appeals and Interferences under the provisions of 37 CFR § 1.196(d) and/or prosecute further before the Primary Examiner by way of amendment or showing of facts, or both, not previously of record with respect to the new rejection under 37 CFR § 1.196(b) if the appellants so elect.

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Upon conclusion of the proceedings before the Primary Examiner on remand, this case should be returned to the Board by the Primary Examiner so that the Board may either adopt its decision as final or render a new decision on all of the claims on appeal, as it may deem appropriate. Such return for this purpose is unnecessary if the application is abandoned as the result of an unanswered Office action, allowed or again appealed.

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

AFFIRMED-IN-PART; 37 CFR § 1.196(b); 37 CFR § 1.196(d)

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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SAMUEL G. LAYTON JR.
BELL SELTZER PARK & GIBSON
P. O. DRAWER 34009
CHARLOTTE, NC 28234

APPENDIX

1. A one-piece blow-molded closed plastic drum comprising:

a generally cylindrical body portion defining an outer cylindrical surface;

a bottom integrally-molded with a lower end of said cylindrical body portion;

a head portion integrally-molded with an upper end of said cylindrical body portion and defining a top and a transition area extending around and connected at a lower end to an upper end of said body portion and connected at an upper end to said top;

a handling ring integrally-molded with said drum and having a leg member extending upwardly from generally said upper end of said transition area and a grippable member extending generally outwardly from an upper end of said leg member to define an outer circumferential surface on said handling ring; and

said transition area having an outside curved surface below the connection to said leg member of said handling ring and of a predetermined radius so that said body portion outside surface is positioned in a tangential plane in close proximity to a tangential plane along said handling ring outer surface.

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2. A one-piece blow-molded closed plastic drum comprising: a generally cylindrical body portion defining an outer cylindrical surface and an inside surface;

a bottom integrally-molded with a lower end of said cylindrical body portion;

a head portion integrally-molded with an upper end of said cylindrical body portion and defining a top having an inside surface and a transition area extending around and connected at a lower end to an upper end of said body portion and connected at an upper end to said top;

a handling ring integrally-molded with said drum and having a leg member extending upwardly from generally said upper end of said transition area and a grippable member extending generally outwardly from an upper end of said leg member to define an outer circumferential surface on said handling ring; and

said transition area having an inside curved surface below the connection to said leg member of said handling ring and with at least one predetermined radius so that no acute angles are formed between said inside surfaces of said top, said transition area and said body portion.

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APJ NASE

APJ McQUADE

APJ McCANDLISH

DECISION: **AFFIRMED-IN-PART;**
37 CFR § 1.196(b);
37 CFR § 1.196(d)

Prepared By: Delores A. Lowe

DRAFT TYPED: 04 Nov 97

FINAL TYPED: