

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD GREEN and JAMES V. SNIPES

Appeal No. 97-0734
Application No. 08/058,592¹

ON BRIEF

Before COHEN, MEISTER, 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 23, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed May 7, 1993.

BACKGROUND

The appellants' invention relates to an orthopedic casting tape. An understanding of the invention can be derived from a reading of exemplary claims 1 and 18, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Siciliano	3,077,758	Feb.
19, 1963		
McMurray	4,745,912	May 24,
1988		

Claims 7 and 9 stand rejected 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 appellants regard as the invention.

Claims 1 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over McMurray in view of Siciliano.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 21, mailed June 18, 1996) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 20, filed February 26, 1996) and reply brief (Paper No. 22, filed August 22, 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.

Initially we note that the examiner's objection to the drawings (final rejection², p. 2) relates to a petitionable

² Paper No. 8, mailed October 3, 1994.

matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellants on pages 11-12 of the brief.

The indefiniteness issue

We will not sustain the rejection of claims 7 and 9 under 35 U.S.C. § 112, second paragraph.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims 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. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner determined (answer, pp. 3-4) that

[t]he further limitation recited in claim 7, individual thinner wales, is inconsistent with the independent claim 1 limitation of grouped thinner wales. Likewise, the further limitation recited in Claim 9, individual

alternating wales, is inconsistent with the limitations in independent claim 1 of a group of alternating wales.

The appellants argue (brief, p. 11) that claims 7 and 9 are not inconsistent with parent claim 1. We agree. In that regard, we do not agree with the examiner that claim 1 requires grouped (i.e., contiguous) thinner wales or for that matter that claim 1 requires grouped (i.e., contiguous) thicker wales. In our opinion, claims 7 and 9 reasonably apprise those of skill in the art of their scope. Accordingly, claims 7 and 9 are definite under 35 U.S.C. § 112, second paragraph.

For the reasons set forth above, the decision of the examiner to reject claims 7 and 9 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness issue

We will not sustain the rejection of claims 1 through 23 under 35 U.S.C. § 103.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id.

In this case, it is our determination that the combined teachings of McMurray and Siciliano do not contain any disclosure or suggestion supporting the modification of McMurray proposed by the examiner. In fact, the advantage of utilizing alternating thicker and thinner wales is not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

Moreover, we agree with the appellants' argument (brief, pp. 4-6) that Siciliano does not teach alternating thick and thin wales. It is our view that the examiner's belief that Siciliano does teach alternating thick and thin wales is based

upon sheer speculation. However, the examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

For the reasons set forth above, the decision of the examiner to reject claims 1 through 23 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 7 and 9 under 35 U.S.C. § 112, second paragraph, is

reversed and the decision of the examiner to reject claims 1
through 23 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 97-0734 - JUDGE NASE
APPLICATION NO. 08/058,592

APJ NASE

APJ MEISTER

APJ COHEN

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 05 Jan 99

FINAL TYPED: