

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte EVERETT A. WESTERMAN  
and PHILLIP E. ROLL

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Appeal No. 1998-0531  
Application 08/464,489<sup>1</sup>

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ON BRIEF

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Before FRANKFORT, STAAB and GONZALES, Administrative Patent Judges.

STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 11, 12 and 25-28. As a result of further

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<sup>1</sup> Application for patent filed June 5, 1995. According to the appellants, the application is a division of Application 08/018,466, filed February 16, 1993, now Patent No. 5,442,156, issued August 15, 1995; which is a continuation of Application 07/682,637, filed April 9, 1991, abandoned.

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prosecution subsequent to the final rejection, the examiner has withdrawn the final rejection of claims 11, 12 and 25-27 and allowed said claims, leaving for our consideration only the final rejection of claim 28. Claim 24, the only other claim pending in the application, has previously been allowed.<sup>2</sup>

Appellants' invention pertains to a heating apparatus for applying heat to a repair site on a composite structure for curing the repair. Claim 28 defines the appealed subject matter as follows:

28. A heating apparatus for heating a repair site on a composite structure to a substantially uniform temperature of at least about 300°F, comprising:<sup>3</sup>

(a) a pliable, sealed bladder having a surface in contact with the repair site and an outer surface;

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<sup>2</sup>Pursuant to appellants' request for a copy of claim 27, we enclose as an attachment to this opinion a copy of page 4 of appellants' amendment submitted March 8, 1996 (Paper No. 6), wherein claim 27 was added as a new claim.

<sup>3</sup>In that claim 28 calls for, *inter alia*, a sealed bladder having a surface in contact with the repair site and an outer surface, a electrical heater *within the bladder*, and insulation *on the outer surface of the bladder*, it does not appear to read on any of the embodiments currently illustrated in appellants' drawings. If true, it would be appropriate to provide a drawing figure illustrating the embodiment of claim 28 in order to comply with 37 CFR § 1.83(a).



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The central issue in this appeal is the weight to be accorded the preamble recitation in claim 28 that the claimed heating apparatus is "for heating a repair site on a composite structure to a substantially uniform temperature of at least about 300EF." The examiner contends that "[t]he recitation of heating to 'at least about 300EF' [is] not [to be] given patentable weight since it is found in the preamble of the claim" (second answer, page 5). Appellants argue on page 2 of the second reply brief (Paper No. 15) that claim 28 "positively defines an operating temperature for the apparatus of at least about 300EF," that "[t]he claim must be read as a whole and no part of the claim can be ignored or disregarded," and that Feldman's heating appliance for attachment around the appendage of a patient "simply is not the structure that Applicant describes and claims in claim 28."

Whether a preamble or introductory clause of a claim constitutes a limitation on a claim is a matter to be determined by the facts of each case in view of the claimed

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examiner's discretion, such as objections to the drawings, are not subject to our review. Rather, such matters may be resolved by petition to the Commissioner under 37 CFR § 1.181.

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invention as a whole. *In re Stencel*, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987); *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 480-81 (CCPA 1951). As explained by the Court in *Bell Communications Research Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995):

. . . [T]he general principle, as well-settled as any in our patent law precedent, [is] that a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.

In the present instance, we consider that the preamble recitation "for heating a repair site . . . to a substantially uniform temperature of at least about 300EF" must be taken into account, at least insofar as it sets forth a capability for the claimed apparatus. That is, we read claim 28 as requiring that a device which literally meets the terms of the body of the claim must also be at least capable of functioning in the manner called for in the preamble in order to fall within the scope of the claim. Accordingly, the examiner's position that the preamble recitation in question "[is] not

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[to be] given patentable weight since it is found in the preamble of the claim" is inappropriate.

Concerning functional language of the type found in the preamble of claim 28 and the weight it is to be given, we point to the statement by the Court in *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ 1429, 1432 (Fed. Cir. 1997) that

[a] patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971) ("[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims."). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk. As our predecessor court stated in *Swinehart*, 439 F.2d at 213, 169 USPQ at 228:

where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981); *In re Ludtke*, 441 F.2d 660, 663-64, 169 USPQ 563, 565-67 (CCPA 1971).

Feldman, the examiner's evidence of anticipation,

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pertains to an apparatus for applying heat to an injured body area to relieve pain arising from, for example, rib injuries, vertebrae discomfort, shoulder and upper back conditions, thigh or knee problems, or tennis elbow (column 2, lines 6-10). With reference to Figure 3, the apparatus includes a belt 10 for wrapping around the injured body part, a pair of sheets 22 sealed at the edges to form an envelope, a quantity of electrically nonconductive and inert fluid 24 in the envelope, and a resistance heating element 23 located in the envelope. In use, the belt is wrapped about the injured body part to bring the envelope into contact

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therewith and current is applied to the element 23 to heat the apparatus, and thus the injury site. As explained at column 3, lines 37-41, "[t]he sheets forming the envelope are preferably formed from a plasticized, flexible, polymeric film having . . . good resistance to heat in the temperature range of interest, *normally between about 95EF (35EC) to 160EF (71EC)*" (emphasis added).

The examiner's position that the Feldman apparatus anticipates claim 28 is not well taken. First, Feldman is not disclosed as being a heating apparatus for heating a site to a substantially uniform temperature of at least about 300EF. Second, given the fact that Feldman is for use in heating body parts, and that the film from which the envelope is made has good resistance to heat in the temperature range of between about 95EF to 160EF, it is simply not reasonable to presume that Feldman's apparatus is capable of heating a site to which it may be applied to a temperature of at least about 300EF. Third, the examiner has provided no evidence or technical reasoning that would suggest that Feldman's apparatus is capable of functioning in the manner called for in the

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preamble of the claim. This being the case, we

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will not sustain the standing rejection of claim 28 as being  
anticipated by Feldman.

The decision of the examiner is reversed.

*REVERSED*

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CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	APPEALS AND
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	)	INTERFERENCES
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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