

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LOUIS F. GENATOSSIO

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Appeal No. 98-2069  
Application No. 29/052,369<sup>1</sup>

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HEARD: August 5, 1998

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Before HAIRSTON, STAAB, 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 the single design claim pending in this design application.

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<sup>1</sup> Filed March 28, 1996 (Attorney Docket No. 02103/301001).

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We AFFIRM.

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BACKGROUND

Louis F. Genatossio (appellant) appeals from the rejection of the following design claim:

The ornamental design for audio signal processing unit substantially as shown and described.

On March 28, 1996, the appellant filed this design application with a claim to: The ornamental design for audio signal processing substantially as shown and described. On November 20, 1996, the examiner's first Office action (Paper No. 2) was mailed. In that action, the examiner rejected the claim as being indefinite under 35 U.S.C. § 112, second paragraph, because the use of the term "substantially" therein. On February 25, 1997, the appellant filed a response (Paper No. 3) requesting withdrawal of the 35 U.S.C. § 112, second paragraph, rejection. Additionally, the appellant amended the claim to read as follows: The ornamental design for audio signal processing unit substantially as shown and described. On May 21, 1997, the examiner's final Office action (Paper No. 4) was mailed. No references were relied upon by the examiner in rejecting the claim, the sole

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rejection of the design claim being based on the second paragraph of 35 U.S.C. § 112.

The examiner's statement of the rejection is as follows:

The claim is 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 applicant regards as the invention.

The claim is indefinite because of the use of the term "substantially" therein. Cancellation of said term will overcome the rejection. *Ex parte Sussman*, 8 USPQ2d 1443 (BPAI 1988), *Ex parte Pappas*, 23 USPQ2d 1636 (BPAI 1992) and 37 CFR 1.153. [first Office action, page 2]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the § 112 rejection, we make reference to the examiner's answer (Paper No. 9, mailed January 15, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 8, filed October 31, 1997) and reply brief (Paper No. 10, filed March 20, 1998) for the appellant's arguments thereagainst.

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's drawings, specification and claim and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we

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will sustain the examiner's rejection of the claim 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 primarily whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. If the scope of the invention sought to be patented cannot be determined from the language of the claims

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with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. That is, the examiner must provide a reasonable explanation as to why the scope of protection provided by the claim is not adequately set forth with a reasonable degree of certainty. Assuming that sufficient reason for such doubt exists, a rejection for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention will be proper on that basis.

Once the examiner has established a reasonable basis to question the clarity of the claimed invention, the burden falls on the applicant to present persuasive arguments, supported by suitable proofs where necessary, that the designer of ordinary skill in the art would be able to

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ascertain the scope of the invention sought to be patented using the disclosure as a guide.

Thus, the dispositive issue in this appeal is whether the appellant's disclosure, considering the ordinary skill of the designer in the art as of the date of the appellant's application, would have aided a person of such skill in determining the scope of the appellant's claim. The threshold step in resolving this issue as set forth supra is to determine whether a reasonable basis exists to question whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity.

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

The claim terminology found objectionable by the examiner, i.e., "substantially," is a term of degree, inherently imprecise as to its exact meaning. When a word of degree is used, such as the term "substantially" in the claim,

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it is necessary to determine whether the disclosure provides some standard for measuring that degree. See Seattle Box Company, Inc. v. Industrial 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 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.<sup>2</sup>

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

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<sup>2</sup> See White v. Dunbar, 119 U.S. 47, 51-52 (1886) and Townsend Engineering Co. v. HiTec Co. Ltd., 829 F.2d 1086, 1089-91, 4 USPQ2d 1136, 1139-40 (Fed. Cir. 1987).

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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.

In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985)(quoting from Georgia-Pacific Corp. v. United States Plywood Corp., 258 F.2d 124, 136, 118 USPQ 122, 132 (2d Cir.), cert. denied, 358 U.S. 884, 119 USPQ 501 (1958)), 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, one fundamental purpose of a claim is to define the scope of protection<sup>3</sup> 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 a claim of a

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<sup>3</sup> See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

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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).

Another fundamental purpose of a claim is to define the scope of the claim. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with 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).

We appreciate that Seattle Box, Shatterproof Glass and the other cases cited above involved utility applications rather than design applications. Nevertheless, we think that the court's underlying rationale applies regardless of whether the claim in question appears in a utility application or a design application. See Ex parte Pappas, 23 USPQ2d 1636, 1638

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(Bd. Pat. App. & Int. 1992) (merits panel of Board cites cases involving utility applications in support of new § 112, second paragraph, rejection of appealed design claim containing the phrase "or similar structure").

In the present instance, the appellant's disclosure consists of seven drawing figures illustrating a single embodiment of an ornamental design for an audio signal processing unit, and a specification containing a brief narrative description of the actual article embodying the design and a description of the relationship of the drawing figures to one another. In the present case, we find no standard or guideline whatsoever in the appellant's disclosure to aid the designer of ordinary skill who designs audio signal processing units in determining to what extent a particular ornamental design for an audio signal processing unit may depart from that which is disclosed by the appellant and yet be regarded as "substantially as shown and described."

Furthermore, it is our determination that there are no guidelines that would be implicit to the designer defining the

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term "substantially" as used in the claim under appeal that would enable the designer of ordinary skill in the art to ascertain what is meant by "substantially." There is little evidence of record that the term "substantially" in a design claim is a well accepted term having a meaning that is well known to the designer of ordinary skill. The mere fact that some design patents have included the term "substantially" in the claim is of little value for the reasons expressed infra.

We believe that the designer of ordinary skill who designs audio signal processing units would be unable to determine to what extent a particular ornamental design for an audio signal processing unit may depart from that which is disclosed by the appellant and yet be regarded as "substantially as shown and described." Absent such guidelines, we are of the opinion that the designer of ordinary skill 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.

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In light of the foregoing, we conclude that the examiner did have a reasonable basis to question whether the claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity. Thus, the burden shifted to the appellant to present persuasive arguments, supported by suitable proofs where necessary, that the designer of ordinary skill in the art would be able to ascertain the scope of the invention sought to be patented using the disclosure as a guide. This the appellant has not done for the reasons set forth infra. Accordingly, we sustain the standing 35 U.S.C. § 112, second paragraph, rejection of the appealed design claim.

Alternatively, we note the requirement of 37 CFR § 1.153(a) that the claim of a design patent "shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described." The PTO's rulemaking power, 35 U.S.C. § 6(a), authorizes the Commissioner to "establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." Our

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reviewing court has long held that such regulations<sup>4</sup> have the force and effect of law when not inconsistent with the statutes. See Norton v. Curtiss, 433 F.2d 779, 791, 167 USPQ 532, 542 (CCPA 1970); Piel v. Falkner, 426 F.2d 412, 165 USPQ 708 (CCPA 1970); In re Rubinfeld, 270 F.2d 391, 123 USPQ 210 (CCPA 1959), cert. denied, 362 U.S. 903, 124 USPQ 535 (1960); Vandenberg v. Reynolds, 268 F.2d 744, 746, 122 USPQ 381, 382 (CCPA 1959). We are unable to find any clear conflict between 37 CFR § 1.153(a) and the applicable statutes. Title 35, section 171 of the United States Code provides that "The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided." While 35 U.S.C. § 112 states that "The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," that provision does not necessarily mean that every design

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<sup>4</sup> This rulemaking authority is directed only to the conduct of proceedings in the PTO, it does not grant the Commissioner the authority to issue substantive rules. See Animal Legal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

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applicant shall, as a matter of right, be entitled to present a claim in whatever form the applicant desires. Accordingly, we find that the requirement of 37 CFR § 1.153(a) that the claim of a design patent "shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described" is not inconsistent with the statutes.

The requirement that the claim of a design patent "shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described" became effective on March 1, 1949 upon the original promulgation of Rule 153, now 37 CFR § 1.153(a). The claim format the appellant has chosen to use here does not comply with the formal requirement of the rule because of the presence of the word "substantially" in the claim.<sup>5</sup> It is our opinion that

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<sup>5</sup> In Ex parte Sussman, 8 USPQ2d 1443 (Bd. Pat. App. & Int. 1988), a case relied upon by the examiner, a merits panel of this Board, when faced with similar claim format, (1) noted in a footnote that the inclusion of the word "substantially" in the claim rendered it improper under the rule, and (2) interpreted the claim as if the offending word was not present. In the instant case, it is not immediately clear why the examiner did not object to the claim format the appellants

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this promulgation of Rule 153 was the PTO's interpretation of how a design applicant must comply with the statutory requirement to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.<sup>6</sup> It has been consistently held for many years that it is the appearance of a design as a whole which is controlling in determining questions of patentability and infringement. See Rubinfeld 270 F.2d at 395, 123 USPQ at 214 and cases cited therein. Additionally, as stated by the court in In re Mann, 861 F.2d 1581, 1582, 8 USPQ2d 2030, 2031 (Fed. Cir. 1988), "[a] design claim has almost no scope. The claim at bar, as in all design cases, is limited to what is shown in the application drawings." Under such circumstances, we believe that the inclusion of the word "substantially" in a design claim creates uncertainty as to the actual scope of the design

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have chosen to employ for failing to comply with the "formal terms" claim format required by 37 CFR § 1.153(a).

<sup>6</sup> Under R. S. 4888, as amended, 35 U.S.C. § 33 (1949), it was required that the inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." This provision was carried forward into § 112, Title 35, U. S. C. (1952) with slight modification of the language. See In re Schechter, 205 F.2d 185, 187, 98 USPQ 144, 147 (CCPA 1953).

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claim. This being the case, the appellant's insistence to include the word "substantially" in their design claim in an apparent attempt to circumvent the requirement of 37 CFR § 1.153(a) regarding the formal terms of a design claim only serves to foster confusion as to what the claim is intended to cover. This provides an additional reason for sustaining the standing 35 U.S.C. § 112, second paragraph, rejection of the appealed design claim.

We have, of course, considered all of the appellant's arguments. However, we are not persuaded that the examiner erred in rejecting the claim.

On page 3 of the brief and page 2 of the reply brief, the appellant cites Dobson v. Hartford Carpet Co., 114 U.S. 439, 446 (1885) for the proposition that the use of the word "substantially" in a design claim does not render the claim indefinite under the second paragraph of 35 U.S.C. § 112. Contrary to that which the appellant would apparently have us believe, the Supreme Court in Dobson did not establish some sort of per se rule to the effect that the use of

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"substantially" is acceptable language in a design claim in all cases. Rather, the court held that "the patent is valid, at least for purposes of this case" since the bill was taken pro confesso, 114 U.S. at 446. While the Supreme Court then went on to state that "[a]side from this, we see no good objection to the form of the claim," such comment is dicta especially since Dobson never objected to the use of "substantially" in a design claim.<sup>7</sup>

On pages 4-6 of the brief, the appellants state that

[t]here follows other decisions demonstrating that the inclusion of the word "substantially" in claims to an ornamental design does not interfere with courts or litigants in determining that the design patent claim with "substantially" "particularly points out and distinctly claims what . . . [the inventor] regards as his invention." 35 U.S.C. § 112.

In re Geiger, 165 U.S.P.Q. 572, 573 (C.C.P.A. 1970)  
("The claim on appeal is of the form prescribed in design patent applications, reciting: The ornamental design for an automobile substantially as shown and described.")  
(Footnote omitted.).

In re Fee, 158 U.S.P.Q. 277, 278 (C.C.P.A. 1968)  
("The ornamental design for a lawn sprinkler substantially as shown and described.").

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<sup>7</sup> We have reviewed both the brief for appellants and the brief for appellee to the Supreme Court. The issue of whether or not the use of "substantially" is acceptable language in a design claim was not mentioned in either brief.

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In re Levy, 135 U.S.P.Q. 447 (C.C.P.A. 1962) ("The single claim refers to the drawing and claims the ink cartridge 'substantially as shown.'").

In re Rubinfeld, 123 U.S.P.Q. 210, 214 (C.C.P.A. 1959) ("A single claim to 'the ornamental design for a floor waxer substantially as shown' would afford exactly the same degree of protection to appellant in the instant case as would the claims involved in this appeal [also including 'substantially']. Id. 211.").

Super Prod. Corp. v. Metal France Aquariuzza Co., 117 U.S.P.Q. 17, 20 (D.N.J. 1958) ("The claim of the patent hereinabove described as 'I claim: The ornamental design for an aquarium filter, substantially as shown.'").

R. Wallace & Sons Mfg. Co. v. Ellmore Silver Co., 85 U.S.P.Q. 479 (D. Conn. 1950) ("Its single claim is 'The ornamental design for a spoon or other article of flatware, substantially as shown.'").

Smith v. Dental Prod. Co., 60 U.S.P.Q. 260, 272 (7th Cir. 1944), cert. denied, 322 U.S. 743 (1944) ("The patentee claims: 'The ornamental design for an ampule substantially as shown.'").

Viehmann et al. v. D.F.H. Novelty Furniture Co., 41 U.S.P.Q. 468, 469 (E.D.N.Y. 1939) ("The ornamental design for a kitchen table or the like, substantially as shown and described.").

We have reviewed the eight cases cited above by the appellant but do not find any to be controlling for the following reasons. The issue decided in Geiger was whether the appellants in their design application were claiming the "same invention" claimed in their design patent. The Court in Geiger did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite

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under the second paragraph of 35 U.S.C. § 112.<sup>8</sup> The issues decided in Fee were whether the appellants' design claim was properly rejected under double patenting and that the application lacks a sufficient disclosure. The Court in Fee did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The issue decided in Levy was whether the appellant's design claim was obvious over the prior art. The Court in Levy did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The issues decided in Rubinfield were whether the appellant could present multiple embodiments and multiple claims in a design application. The Court in Rubinfield did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The issues decided in Super Products were whether the appellants' design

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<sup>8</sup> We note that the Court's dicta that the claim on appeal is of the form prescribed in design patent applications is not controlling and is inaccurate since Rule 153(a) did not permit the use of the word "substantially" in a design claim.

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patent was valid over three prior patents and whether the patent was infringed. The Court in Super Products did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The issues decided in Wallace were whether the appellants' design patent was valid over the prior art and whether the patent was infringed. The Court in Wallace did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The design issue decided in Smith was that the appellants' design patent was invalid for lack of invention. The Court in Smith did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. The issue decided in Viehmann was whether the appellants' design patent was valid over the prior art. The Court in Viehmann did not decide the issue of whether the use of "substantially" in a design claim renders the claim indefinite under the second paragraph of 35 U.S.C. § 112. Thus, the eight cases cited by the appellant are not controlling and do not support the appellant's position

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because none of them addresses the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C.

§ 112, second paragraph, that an inventor must particularly point out and distinctly claim what he regards as his invention.<sup>9</sup>

On page 8 of the brief, the appellant criticizes the examiner's reliance on Ex parte Sussman, 8 USPQ2d 1443 (Bd. Pat. App. & Int. 1988) in support of the rejection. According to the appellant, the footnote of Sussman relied upon by the examiner is dicta and inconsistent with "the settled law of the Supreme Court of the United States, the predecessor court of the Federal Circuit Court of Appeals and other courts that the use of 'substantially' is proper in the single claim to an ornamental design in a design patent." As is apparent from

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<sup>9</sup> In fact, our research has not uncovered any final court or Board decision in which the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C. § 112, second paragraph, was decided. This includes the cases cited by the examiner to support the rejection. Thus, there is no binding precedent for this panel of the Board to follow. See Ex parte Holt, 19 USPQ2d 1211, 1214 (Bd. Pat. App. & Int. 1991).

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our discussion above, our conclusion that the examiner did not err in rejecting the appealed claim under 35 U.S.C. § 112, second paragraph, does not depend on the Sussman decision.

On pages 6-8 of the brief and pages 3-4 of the reply brief, the appellant specifically calls to our attention numerous design patents<sup>10</sup> and utility patents that issued with the word "substantially" appearing in the claim, for the purpose of showing that the appellant's use of the word "substantially" is consistent with settled practice in the PTO. We recognize that design patents and utility patents

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<sup>10</sup> Our research indicates that Manual of Patent Examining Procedure (MPEP) § 1504.04 "Considerations Under 35 U.S.C. 112" was revised in January of 1995 when original Edition 6 of the MPEP was published. That revision of the MPEP amended § 1504.04, in pertinent part, to read as follows:

Defects in [design] claim language give rise to a rejection of the claim under the second paragraph of

35 U.S.C. 112[.] Typical examples include:

1. Use of phrases in the claim such as "substantially as shown," "or similar article," "or the like," or equivalent terminology.

This circumstance may serve to partially explain the numerous design patents which have issued in the past with the word "substantially" appearing in the claim and why the examiner has rejected the appellants' claim.

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have issued with the word "substantially" appearing in the claim. However, the appellant has not cited any authority which holds that the issuance of a patent has any significant precedential value. In evaluating compliance with 35 U.S.C. §§ 112 and 171, each design application must be evaluated on the record developed in the Patent and Trademark Office (PTO). See In re Gyurik, 596 F. 2d 1012, 1018 n.15, 201 USPQ 552, 558 n.15 (CCPA 1979) and In re Phillips, 315 F. 2d 943, 137 USPQ 369 (CCPA 1963). To the extent any error has been made in the rejection or issuance of claims in a particular application, the PTO and its examiners are not bound to repeat that error in subsequent applications. Accord, In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) ("The fact that the PTO may have failed to adhere to a statutory mandate over an extended period of time does not justify its continuing to do so."); In re Cooper, 254 F.2d 611, 617, 117 USPQ 396, 401 (CCPA), cert. denied, 358 U.S. 840, 119 USPQ 501 (1958) (decision in a trademark application in accordance with law is not governed by possibly erroneous past decisions of the Patent Office); In re Zahn, 617 F.2d 261, 267, 204 USPQ 988, 995 (CCPA 1980) ("[W]e are not saying the issuance of one

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patent is a precedent of much moment."); Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992) (prior issuance of patents for designs referred to as icons has no significant precedential value in evaluating compliance with 35 U.S.C. § 171). Compliance with §§ 112 and 171 requires analysis of the statutes and interpretation of case law. Mere reference to possibly contrary decisions of an examiner in other applications, applications in which the issue raised here was not even addressed, are not helpful in this analysis. Furthermore, it is debatable whether or not this data establishes that for which it is cited. In any event, the appellant does not contend, and it is not apparent to us, that these design patents and utility patents constitute evidence establishing that a designer of ordinary skill in the relevant art would understand the metes and bounds of the appellant's design claim when read in light of the appellant's specification.

On page 6 of the brief and pages 1-2 of the reply brief, the appellant cites Gorham Mfg. Co. v. White, 81 U.S. (14 Wall) 511, 528 (1872) for the proposition that "the settled

law established by the Supreme Court has been infringement occurs when 'two designs are substantially the same.'" The appellant argues that since "substantially" was used by the Supreme Court in defining design patent infringement, surely it is proper for the appellant to use "substantially" in claiming the subject matter they regard as the invention. We are unpersuaded by this argument.<sup>11</sup> It is not apparent to us how the presence of the word "substantially" in the Gorham test for infringement<sup>12</sup> of a design patent mandates that it is proper, within the meaning of 35 U.S.C. § 112, second

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<sup>11</sup> This argument would be equivalent to an argument that "substantially" in a utility claim would never be indefinite since the term "substantially" is used by the courts in applying the doctrine of equivalents in an infringement suit. A finding of infringement under the doctrine of equivalents requires proof of insubstantial differences between the claimed and accused products. A patentee may prove this insubstantial change by showing that the accused device performs substantially the same function, in substantially the same way, to produce substantially the same result as the claimed invention. See Hilton Davis Chem. Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1516-21, 35 USPQ2d 1641, 1644-47 (Fed. Cir. 1995) (en banc), rev'd on other grounds, 117 S. Ct. 1040, 41 USPQ2d 1865 (1997) and Graver Tank & Mfg. Co. v. Linde Air Prods. Co., 339 U.S. 605, 608, 85 USPQ 328, 330 (1950).

<sup>12</sup> We note that in an infringement action, both parties may present evidence on the issue of whether the two designs are substantially the same.

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paragraph, for the appellant's design claim to include the word "substantially" in the absence of some standard or guideline in the specification apprising the designer of ordinary skill just what that term encompasses. If we were to accept the appellant's argument, infringement in designs would occur not only when a competing design is substantially the same as a patented design, but also when a competing design is substantially the same as an undisclosed and indeterminate variation of a patented design.

Furthermore, we are not persuaded by the position that the presence of "substantially" in the present design claim merely makes explicit what is implicit in every design claim for the purpose of defining the boundaries of protection in infringement. While the word "substantially" is used in the test for infringement of a design patent, it is not obvious to us how this implicitly enlarges the scope of the claim in determining whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103. As stated in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970), "[a]ll words in a claim must be considered in judging the

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patentability of that claim against the prior art." Thus, we view the scope of the appellant's design claim "The ornamental design for audio signal processing unit substantially as shown and described" to be of a different scope than the following claim: "The ornamental design for audio signal processing unit as shown and described." It is our inability to determine the actual extent of this difference in scope that renders the appellant's design claim indefinite under 35 U.S.C.

§ 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

#### CONCLUSION

To summarize, the decision of the examiner to reject the claim under 35 U.S.C. § 112, second paragraph is affirmed.

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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

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 98-2069  
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APPEAL NO. 98-2069 - JUDGE NASE  
APPLICATION NO. 29/052,369

APJ NASE

APJ STAAB

APJ HAIRSTON

DECISION: **AFFIRMED**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 05 Aug 98

**FINAL TYPED:**

**3 MEMBER CONF.**

**HEARD: 05 Aug 98**