

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** HIROJI TANI  
and  
TEPPEI KUBOTA

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Appeal No. 1998-2668  
Application No. 08/601,258

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ON BRIEF

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Before KIMLIN, WALTZ, and LIEBERMAN, **Administrative Patent Judges.**

WALTZ, **Administrative Patent Judge.**

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1 through 17, which are all of the claims pending in this application.

According to appellants, the invention is directed to a method for adjusting the temperature coefficient of resistance

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(TCR) of a temperature-measuring resistive element (Brief, page 1). Claim 1 is illustrative of the subject matter on appeal and a copy of this claim is reproduced below:

1. A method of adjusting a temperature coefficient of resistance of a temperature-measuring resistive element having an electrically insulating base and a platinum film formed on the base, the method comprising the steps of:

forming a platinum film by sintering an organic platinum compound located on the base; and

controlling at least one of a thickness of the platinum film and a temperature at which the platinum film is heat-treated after formation of the platinum film so as to adjust the temperature coefficient of resistance of the platinum film.

Claims 1 through 17 stand rejected under 35 U.S.C. § 112, ¶2, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards [sic] as the invention." (Answer, sentence bridging pages 3-4). We reverse this rejection and *remand* this application to the examiner for reasons stated below.

#### **OPINION**

A. *The Rejection under 35 U.S.C. § 112, ¶2*

The examiner states that all of the claims recite sintering a metal compound or organic metal compound (Answer, page 4). The examiner finds that "[t]he term 'sinter' means to make into a sinter which is a bonded mass of metal particles shaped and

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partially fused by pressure and heating below the melting point.”  
(*Id.*). The examiner questions how appellants sinter an organic  
metal compound or metal compound (*id.*).

With respect to claims 1, 2 and 7-13, the examiner states  
that there are no guidelines given by appellants for controlling  
the time of heating and/or the thickness of the metal film and/or  
the temperature (*id.*). Therefore the examiner considers these  
claims indefinite in addition to the reason noted above.

Appellants argue that all that is required by the second  
paragraph of section 112 is that the scope of the subject matter  
embraced by the claim is clear (Brief, page 2). Appellants  
submit that their arguments have always been consistent with what  
they regard as their invention and the two steps claimed are what  
appellants consider to be their invention (Brief, page 4).  
Appellants argue that, while the claims may be broad, this does  
not affect the clarity of what is being claimed (*id.*). In  
response to the examiner's statements regarding the absence of  
guidelines for “controlling” the parameters of temperature, time  
of heating, and thickness of the film, appellants argue that 35  
U.S.C. § 112, ¶6, specifically permits applicants to forego such  
detail in the claims (Brief, sentence bridging pages 4-5).

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"The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. [Citations omitted]." *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). It is well settled that the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). In our view, the examiner has not met the initial burden of establishing that one of ordinary skill in the art would not have been apprised of the scope of the claims. Accordingly, we cannot sustain the examiner's rejection.

The examiner has not presented any convincing reasoning or evidence that the term "sinter" is indefinite as recited in the claims on appeal. The examiner actually presents a common definition of "sinter" on page 4 of the Answer. In *ex parte* prosecution, the examiner must apply the broadest reasonable meaning of the words in the claim as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment is afforded by the written description contained in appellants' specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Appellants disclose that the resistive element is formed by applying an organic platinum

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resinate paste to the insulating base and then sintering the organic platinum resinate paste to form a platinum film (specification, page 3, ll. 15-21). Appellants teach that "sintering" is accomplished by "firing" the organic platinum resinate paste at a temperature of about 600 to 900°C. (specification, page 4, ll. 14-15; page 5, ll. 19-21). Accordingly, the meaning of the term "sinter" would have been clear to one of ordinary skill in the art.

We agree with appellants that 35 U.S.C. § 112, ¶6, allows claim language expressing a step for performing a specified function without the recital of "structure, material, or acts in support thereof . . . ." (35 U.S.C. § 112, ¶6 (1975)). Therefore the examiner's rejection of claims 1, 2 and 7-13 "because no guidelines are given for [controlling] any of these parameters" (Answer, page 4) cannot be sustained.<sup>1</sup> No structure or acts need be recited in the claims when the claim language recites a step plus function under the sixth paragraph of 35

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<sup>1</sup>In this part of the rejection, the examiner uses the phrases "invitation to experiment" and "no guidelines are given." These phrases are more applicable in a rejection for lack of enablement under the first paragraph of 35 U.S.C. § 112. See *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). However, the only rejection of record in this appeal which we review is under the second paragraph of 35 U.S.C. § 112.

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U.S.C. § 112. The examiner has again failed to meet the initial burden of establishing why one of ordinary skill in the art would not have been apprised of the scope of these claims.

For the foregoing reasons, the examiner's rejection of claims 1-17 under 35 U.S.C. § 112, ¶2, is reversed.

*B. Remand to the Examiner*

Appellants submitted an English translation of a German Office Action and four German references (without translations) under the heading "**SUBMISSION**" in Paper No. 12 dated Aug. 18, 1997. There is no indication in the record that the examiner has considered this paper. The examiner has not initialed the accompanying "Applicant's Art Citation."

Upon return of this application to the jurisdiction of the examiner, the examiner should consider Paper No. 12 in accordance with 37 CFR § 1.97 and the *MPEP*, 7th ed., § 609, Rev. 1, Feb. 2000. If these references are considered by the examiner, and in view of the relevance of the references as set forth in the translation of the German Office Action, the examiner should procure translations of these four references and consider the patentability of the claims in view of these translations. It appears, from the translation of the German Office Action, that at least DE 43 00 084 A1 discloses controlling the temperature

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and duration of heating to adjust the TCR of a platinum film of a temperature-measuring resistive element.

Accordingly, this application is *remanded* to the examiner for review and consideration of the foregoing matters.

*C. Summary*

The examiner's rejection of claims 1-17 under the second paragraph of 35 U.S.C. § 112 is reversed. This application is remanded to the examiner for appropriate action as discussed above.

The decision of the examiner is reversed.

**REVERSED & REMANDED**

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
PAUL LIEBERMAN	)	
Administrative Patent Judge	)	

TAW:hh

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