

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GIOVANNO A. VADO and DOMENICO MANCA

Appeal No. 1998-3006
Application No. 08/586,977¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, 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 to 7 and 9 to 11, which are all of the claims pending in this application.²

¹ Application for patent filed January 16, 1996.

² Claim 1 was amended subsequent to the final rejection (Paper No. 9, mailed February 19, 1997).

Appeal No. 1998-3006
Application No. 08/586,977

We AFFIRM.

BACKGROUND

The appellants' invention relates to a device for "weighing" (i.e., heaving up) ropes or lines such as those attached to anchors. A copy of claims 1 and 9 appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Haines	3,635,441	Jan. 18,
1972		

Claims 1 to 7 and 9 to 11 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.³

³ In the final rejection, claims 1 to 7 and 9 to 11 were rejected on this basis. In the answer (Paper No. 18, mailed March 17, 1998), only claims 1 to 3, 5, 6 and 9 to 11 were rejected on this basis. Since the examiner (answer, p. 4) found one ground of indefiniteness in each of the independent claims on appeal (i.e., claims 1 and 9) and the appellants responded to each ground of indefiniteness on pages 6-8 of the brief (Paper No. 17, filed August 19, 1997), we consider it appropriate to treat claims 1 to 7 and 9 to 11 as being
(continued...)

Claims 1 to 4, 7, 9 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Haines.⁴

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 for the examiner's complete reasoning in support of the rejections, and to the appellants' brief 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 reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

³(...continued)
rejected under the second paragraph of 35 U.S.C. § 112.

⁴ The rejection of claims 5, 6 and 10 under 35 U.S.C. § 102(b) was withdrawn by the examiner (answer, pp. 2-4).

The indefiniteness issues

We sustain the rejection of claims 1 to 7 and 9 to 11 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976). In addition, patentability is not the only consideration requiring the claim language to be definite under 35 U.S.C. 112, second paragraph. In In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the court held that with respect to the second paragraph of § 112, the inquiry is "to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity." In In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970), the court specifically related the matter of infringement to the issue of indefiniteness, stating as follows:

All provisions of the statute must be complied with in order to obtain a patent. The requirement stated in the second paragraph of section 112 existed long before the present statute came into force. Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. Compare *United Carbon Co. v. Binney Co.*, 317 U.S. 228, 55 USPQ 381 (1942), *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F.2d 36, 158 USPQ 565 (6th Cir. 1968).

It therefore is evident that the definiteness of a claim is not only important for a consideration of patentability, but also for a consideration of infringement.

The preamble of a claim may be a consideration in determining infringement, as well as the issue of patentability where the preamble gives life and meaning to the claim.⁵ Thus, the preamble language may not be ignored in determining the question of whether a claim is definite under the second paragraph of § 112. See *Ex parte Kristensen*, 10 USPQ2d 1701, 1703 (Bd. Pat. App. & Int. 1989).

⁵ See, e.g., *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 221 USPQ 669 (Fed. Cir. 1984).

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, p. 4) that

[w]ith respect to claim 1, line 2, "such as lines and ropes" is an improper recitation because it recites a narrower limitation within a broader limitation in the form of an example and should be deleted, i.e., [sic, i.e.,] the broader limitation is "elongated members" and the narrower limitation is "such as lines and ropes.["

With respect to claim 9, lines 1-2, what constitutes "or the like"?

With respect to claim 1, the appellants argue (brief, p. 6) that "in nautical language, the term "line" is commonly used to describe what one would call a "rope" when ashore" and that the examiner "has cited no authority for the proposition that ropes are not lines."

In our view, the appellants have misunderstood the examiner's basis for the rejection of claim 1 as being indefinite. The examiner did not reject claim 1 on the basis that "ropes are not lines." The examiner's basis was that the phrase "such as ropes and lines" following the recitation

"elongated members" in claim 1 rendered the claim indefinite. We agree with the examiner. In our opinion, the phrase "elongated members such as ropes and lines" is indefinite since the metes and bounds thereof would not be known with a reasonable degree of precision and particularity. In that regard, it is not clear if the phrase "elongated members such as ropes and lines" covers

(1) all elongated members, (2) just ropes and lines, or (3) ropes, lines and some other elongated members which for some unexplained reason are like a rope or a line. Accord Ex parte Steigerwald, 131 USPQ 74, 75 (Bd. App. 1961) and Ex parte Hall, 83 USPQ 38, 39 (Bd. App. 1948). See also, Ex parte Wu, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Int. 1989).

With respect to claim 9, the appellants argue (brief, pp. 7-8) that the phrase "or the like" is recited in a statement of intended use and "should not be subjected to the same scrutiny as structural elements of the claimed invention." In addition, the appellants state that the phrase "nautical line or the like" would be understood to mean nautical line and

"other elongated members such as non-nautical ropes, cables, etc."

We agree with the examiner that the phrase "or the like" in claim 9 is indefinite. Contrary to the appellants' argument, the preamble language may not be ignored in determining the question of whether a claim is definite under the second paragraph of § 112. See Ex parte Kristensen, supra. Additionally, in the present case, it is clear that the preamble recitation of "or the like" introduces an uncertainty into claim 9 to preclude one skilled in the art from determining the metes and bounds of the claimed subject matter. Compare Ex parte Kristensen, supra. Accordingly, we must conclude that claim 9 does not define the invention with the precision and particularity required by In re Moore, supra, and In re Hammack, supra.

For the reasons stated above, the decision of the examiner to reject claims 1 to 7 and 9 to 11 under 35 U.S.C. § 112, second paragraph, is affirmed.

The anticipation issues

We will not sustain the rejection of claims 1 to 4, 7, 9 and 11 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

In this case, we agree with the appellants that claims 1 to 4, 7, 9 and 11 are not anticipated by Haines since limitations of claims 1 and 9 (the independent claims on appeal) are not found in Haines as set forth below.

The examiner's basis for the rejection of claims 1 and 9 (answer, pp. 4-5) was that Haines taught the following claimed elements: a hub (Haines' hub 42); a motive wheel (Haines' disc 39); a driven wheel (Haines' disc 41); driving means or motor (Haines' motor 23); a thrust ring (Haines' dislike plate 45);

and position adjustment means or deflector (Haines' bores 64 and 66, disc 65, bolt 67, nut 68, and rollers 75 and 76).

Claim 1 recites "said motive wheel being located between said thrust ring and said driven wheel." This limitation is not found in Haines as applied by the examiner. In that regard, as clearly shown in Figure 2 of Haines, the motive wheel (Haines' disc 39) is not located between the thrust ring (Haines' disclike plate 45) and the driven wheel (Haines' disc 41).

Claim 9 recites "a plurality of axially movable pins . . . to rigidly connect the thrust ring to the driven wheel." This limitation is not found in Haines as applied by the examiner. In that regard, as clearly shown in Figure 2 of Haines, the thrust ring (Haines' disclike plate 45) is welded to the driven wheel (Haines' disc 41) via portion 46.⁶ Thus, Haines' bolts 51 and 57 (i.e., pins) do not rigidly connect

⁶ see column 2, lines 39-43, of Haines.

the thrust ring (Haines' disclike plate 45) to the driven wheel (Haines' disc 41).

In addition, as clearly shown in Figure 2 of Haines, the position adjustment means or deflector (Haines' bores 64 and 66, disc 65, bolt 67, nut 68, and rollers 75 and 76) does not **engage**⁷ the thrust ring (Haines' disclike plate 45) as recited in claims 1 and 9.

Since all the limitations of the claims under appeal are not found in Haines for the reasons set forth above, the decision of the examiner to reject claims 1 to 4, 7, 9 and 11 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 and 9 to 11 under 35 U.S.C. § 112, second paragraph, is affirmed and the decision of the examiner to

⁷ Webster's Third New International Dictionary, (1971) defines engage as used in this instance to mean "to come into contact or interlock with."

reject claims 1 to 4, 7, 9 and 11 under 35 U.S.C. § 102(b) is reversed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

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

AFFIRMED

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPEAL NO. 1998-3006 - JUDGE NASE
APPLICATION NO. 08/586,977

APJ NASE

APJ STAAB

APJ CRAWFORD

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

DRAFT TYPED: 06 May 99

FINAL TYPED: