

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH W. LANGAN

Appeal No. 1999-1834
Application No. 08/876,030

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 17 to 34, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a method of making and using a label. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Cahn	2,435,267	Feb. 3, 1948
Soltysiak et al. (Soltysiak)	5,518,762	May 21, 1996
Umeda	JP 5-221438 ¹	Aug. 31, 1993

The following grounds of rejection are set forth in the examiner's answer (Paper No. 9, mailed November 23, 1998):

1. Claims 17, 21, 23 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Soltysiak.

¹ In determining the teachings of Umeda, we will rely on the translation of record provided by the USPTO.

2. Claims 18-20, 22, 25 and 26 stand rejected under 35 U.S.C.

§ 103 as being unpatentable over Cahn in view of Soltysiak.

3. Claims 27-34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Umeda in view of Soltysiak.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 8, filed September 25, 1998) and reply brief (Paper No. 10, filed December 31, 1998) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it

is our conclusion that the evidence adduced by the examiner is insufficient to establish a proper basis for the rejections set forth above. Our reasoning for this determination follows.

Claim 17, the sole independent claim pending in this application, recites a method of making and using a label, including the step of "highly calendering paper stock to form a paper label substrate having first and second faces."

In all the rejections before us in this appeal, the examiner has relied upon Soltysiak as teaching/suggesting this limitation (answer, pp. 4-7). The appellant disagrees (brief, pp. 4-5).

We agree with the examiner that Soltysiak teaches that labels can be made from bond paper and that conventional bond paper is calendered. However, all the claims at issue in this appeal require the paper label substrate to be highly calendered. We have reviewed the teachings of the applied prior art and fail to find therein any teaching or suggestion

to make Soltysiak's label from a paper stock that is highly calendered.

Since all the limitations of claims 17 to 34 are not taught or suggested by the applied prior art for the reasons set forth above, the decision of the examiner to reject claims 17 to 34 is reversed.

REMAND

The term "highly" is a term of degree. When a word of degree is used, such as the term "highly" in claim 17, it is necessary to determine whether the specification 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.²

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 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), 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.

² 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).

Indeed, the fundamental purpose of a patent claim is to define the scope of protection³ 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 the claims of a 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).

We remand this application to the examiner to determine if the disclosure provides either explicit or implicit guidelines defining the terminology "highly calendaring" (claim 17). If such guidelines do not exist, it would appear that a skilled person would not be able to determine the metes

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

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.

If the appellant's disclosure fails to set forth an adequate definition as to what is meant by the terminology "highly calendaring" in claim 17, the examiner should determine if the appellant has failed to particularly point out and distinctly claim the invention as required by the second paragraph of 35 U.S.C. § 112 and if so make the appropriate rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 17 to 34 is reversed. In addition, the application has been remanded to the examiner for further action.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (Seventh Edition, Rev. 1, Feb. 2000).

REVERSED and REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
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