

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WARREN S. BROOKS et al.

Appeal No. 1999-2089
Application No. 08/517,181¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

¹ Application for patent filed August 21, 1995.

Appeal No. 1999-2089
Application No. 08/517,181

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 7, as amended subsequent to the final rejection.² These claims constitute all of the claims pending in this application.

We REVERSE.

² While the examiner has approved entry of the amendment after final rejection (Paper No. 8, filed July 13, 1998), we note that this amendment has not been clerically entered.

BACKGROUND

The appellants' invention relates to a semiconductor wafer lifter basket assembly. A copy of the claims under appeal 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:

Ball	1,016,386	Feb.
6, 1912		

Claims 1 to 7 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.

Claims 1 to 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Ball.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 12,

mailed November 6, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed October 8, 1998) and reply brief (Paper No. 13, filed December 10, 1998) 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.

The indefiniteness rejection

We will not sustain the rejection of claims 1 to 7 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 whether the claims meet the threshold requirements of clarity and precision (i.e., they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity), not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second

paragraph, is appropriate. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

We have reviewed both the specific objections and arguments (answer, pp. 3 and 4) raised by the examiner in the rejection under 35 U.S.C. § 112, second paragraph, and the arguments thereagainst advanced by the appellants (brief, pp. 6-9 and reply brief, pp. 2-3) that the rejection is not warranted. After

review of the claims under appeal, we find ourselves in agreement with the appellants' position in this matter. Specifically, we have reviewed claim 1 and fail to find any basis for the examiner's determination that claim 1 is indefinite (e.g., omits recitation of essential elements, steps, or necessary structural cooperation between the elements) for the reasons set forth by the appellants. Furthermore, we note that the mere breadth of a claim does not

in and of itself make a claim indefinite.³ In any event, it is our view that claim 1 does set forth a cooperative relationship of the elements recited. In view of the above, we conclude that claim 1 does define the metes and bounds of the claimed invention with a reasonable degree of precision and particularity.

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

The obviousness rejection

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 7 under 35 U.S.C. § 103.

³ Breadth of a claim is not to be equated with indefiniteness. See In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this case, we agree with the appellants' argument that Ball does not suggest the invention as set forth in claim 1 (the only independent claim on appeal). Specifically, we agree with the appellants' position (reply brief, p. 5) that the elevator cage of Ball does not teach or suggest the recited "wafer lifter basket" due to the definition of that phrase set forth in the specification at page 5, lines 24-25. That is, the elevator cage of Ball is not a mechanism that holds, carries or otherwise transports a semiconductor wafer **during** processing. Moreover, we agree with the appellants'

view (brief, pp. 11-12; reply brief, pp. 5-6) that Ball's "means for releasable coupling" the elevator cage 6 to the draw wing 45 has not been established to be an equivalent to the structure disclosed by the appellants which correspond to the claimed means. See In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994) (the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6).

For the reasons stated above, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claims 1 to 7 under 35 U.S.C. § 103 is reversed.

REVERSED

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

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APPEAL NO. 1999-2089 - JUDGE NASE
APPLICATION NO. 08/517,181

APJ NASE

APJ STAAB

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 16 Nov 99

FINAL TYPED: