

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. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. BEGGINS

Appeal No. 2001-1284
Application No. 08/792,765

ON BRIEF

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

DECISION ON APPEAL

Claims 1 to 29 are pending and were rejected in the final rejection (Paper No. 24, mailed March 24, 2000).¹ No claim has been canceled. The appellant has limited the appeal to claims 1 to 23, 28 and 29 (brief, p. 1). Accordingly, the appeal as to claims 24 to 27 is dismissed.

We AFFIRM-IN-PART.

¹ Claim 1 was amended subsequent to the final rejection.

BACKGROUND

The appellant's invention relates to a two-part telescopic lightweight portable bottle cooler apparatus (specification, p. 1). 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:

Buddrus	3,120,319	Feb. 4, 1964
Cooper	4,456,134	June 26, 1984
Augur	4,811,858	Mar. 14, 1989

Claims 1 to 17, 20 to 22, 28 and 29 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 appellant regards as the invention.²

² The examiner included claims 24 to 27 in the statement of this rejection (answer, p. 3), however, claims 24 to 27 are not under appeal as noted on page 1 of this decision.

Claims 1 to 3, 5 to 17 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur.³

Claims 1 to 3, 5 to 23, 28 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur and Buddrus.⁴

Claims 1, 6, 11, 20 to 22 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Cooper in view of Augur and Buddrus.⁵

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 29, mailed September 29, 2000) for the examiner's complete reasoning in

³ The examiner included claims 24 to 26 in the statement of this rejection (answer, p. 4), however, claims 24 to 26 are not under appeal as noted on page 1 of this decision.

⁴ The examiner included claims 24 to 27 in the statement of this rejection (answer, p. 5), however, claims 24 to 27 are not under appeal as noted on page 1 of this decision.

⁵ The examiner included claims 24 to 26 in the statement of this rejection (answer, p. 6), however, claims 24 to 26 are not under appeal as noted on page 1 of this decision.

support of the rejections, and to the brief (Paper No. 28, filed July 24, 2000) and reply brief (Paper No. 30, filed November 27, 2000) 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. 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 17 and 20 to 22 under 35 U.S.C. § 112, second paragraph. We sustain the rejection of claims 28 and 29 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. Thus, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

The first basis for this rejection was that it was unclear with regard to claims 1 to 17, 20 to 22 and 28 as to whether the appellant was claiming the combination of the cooler apparatus and the bottle or the subcombination of the cooler apparatus. We do not agree with this basis for this rejection for the reasons set forth in the brief (pp. 10-11). In that regard, it is our view that those skilled in the art would understand claims 1 to 17, 20 to 22 and 28 to be clearly directed to the cooler apparatus, not the combination of the cooler apparatus and bottle.

The second basis for this rejection was that the term "quick plunge" as used in claims 28 and 29 is unclear. We agree.

The term "quick plunge" is a term of degree. When a word of degree is used, 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.⁶

In Seattle Box, the court set forth the following requirements for terms of degree:

[w]hen 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

⁶ 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).

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:

[i]f 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, the fundamental purpose of a patent claim is to define the scope of protection⁷ 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).

⁷ See In re Vamco Machine & Tool, Inc., 752 F.2d 1564, 224 USPQ 617 (Fed. Cir. 1985).

In the present case, we have reviewed the appellant's disclosure to help us determine the meaning of "quick plunge." That review has revealed that the appellant's specification states: (1) at page 2, lines 12-26, that the threads are "relatively steeply arched," (2) at page 2, lines 27-31, that the quick plunge feature "preferably provides complete insertion with a minimum of turning of the upper enclosure," and (3) at page 4, lines 24-31, that "the 'steepness' of the threads 33, 35 are preferably selected such that minimal turning of the upper enclosure 13 is required to secure the upper enclosure 13 with the lower enclosure 15, thus providing a deep plunge, quick insertion feature." Additionally, the appellant's Figures 1 and 3-5 show threads 33, 35 on enclosures 13, 15.

However, these portions of the disclosure do not provide explicit guidelines defining the terminology "quick plunge." Furthermore, there are no guidelines that would be implicit to one skilled in the art defining the term "quick plunge" that would enable one skilled in the art to ascertain what is meant by "quick plunge." For example, one cannot ascertain if the threads 18, 26 of Cooper provide "quick plunge" of upper shell 22 into lower cup 12. Absent such guidelines, we are of the opinion that a skilled person 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.

The appellant's argument (brief, p. 11) that "the term 'quick plunge' is sufficiently defined by the preceding claim language" is unpersuasive since the preceding claim language does not provide sufficient guidelines that would enable one skilled in the art to ascertain what is meant by "quick plunge."

For the reasons set forth above, the decision of the examiner to reject claims 1 to 17, 20 to 22, 28 and 29 under 35 U.S.C. § 112, second paragraph, is affirmed with respect to claims 28 and 29 and reversed with respect to claims 1 to 17 and 20 to 22.

The obviousness rejections

We will not sustain the rejection of claims 1 to 3, 5 to 23, 28 and 29 under 35 U.S.C. § 103.

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 all the rejections under 35 U.S.C. § 103, the examiner determined (answer, pp. 4-6) that Cooper does not disclose his apparatus being made from insulating foam and that in view of either Augur's cooler apparatus made of insulating foam or Buddrus' cooler apparatus made of insulating foam it would have been obvious at the time the invention was made to a person of ordinary skill in the art to make Cooper's apparatus from insulating foam.

The appellant argues throughout the briefs that the applied prior art would not have suggested making Cooper's apparatus from insulating foam. We agree. In our view, the only suggestion for making Cooper's apparatus from insulating foam stems from

hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d at 1553, 220 USPQ at 313).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d

1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, we fail to find sufficient motivation in the applied prior art for a person of ordinary skill in the art at the time the invention was made to have modified Cooper's apparatus (i.e., lower cup 12 and upper shell 22) to be made of an insulating foam material having sufficient strength so as to permit Cooper's device to still function (i.e., to collapse the container 36). It follows that we cannot sustain the examiner's rejections of claims 1 to 3, 5 to 23, 28 and 29 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 17, 20 to 22, 28 and 29 under 35 U.S.C. § 112, second paragraph, is affirmed with respect to claims 28 and 29 and reversed with respect to claims 1 to 17 and 20 to 22; and the decision of the examiner to reject claims 1 to 3, 5 to 23, 28 and 29 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

JEFFREY V. NASE)	
Administrative Patent Judge)	
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MURRIEL E. CRAWFORD)	APPEALS
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