

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2002-0950
Application No. 09/655,147

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 1, the sole claim pending in this application.

We AFFIRM.

BACKGROUND

The appellant's invention relates to a mailing envelope which presents the appearance of having contents with bulk, even with a one-sheet insert (specification, page 1). Claim 1, the sole claim on appeal, reads as follows:

1. A rectangular shaped sealed mail envelope of cardboard construction material characterized by presenting a miter joint appearance at each of four corners thereof comprising a rectangular rear panel delimiting a selected width between opposite left and right side edges and having top and bottom edges,

left and right flaps respectively wholly joined from a top to a bottom location of one said left and right edge of said rear panel and having operative positions folded upon said rear panel, each said left and right flap having top and bottom inclined edges oriented in a converging relation to each other starting from a said top and bottom location and terminating at a clearance location therefrom,

a bottom panel and top panel respectively joined to said top and bottom edges of said rear panel and having operative positions folded upon and adhesively secured to said left and a¹ said right flap in said underlying operative positions interposed between said rear panel and said top and bottom panels, and² a selected width size delimited between opposite sides of said top and bottom panels of an extent less than said width size³ of said rear panel and also of an extent less than distances between length portions of said left and right flap top and bottom inclined edges so as to leave exposed a beginning length portion of said inclined edges of said opposite top and bottom edges of said left and right flaps,

said top and bottom panels having opposite side inclined edges oriented in a converging relation to each other and aligning in parallel relation to each said exposed beginning length portion of said inclined edges of said left and right flaps and bounding a clearance therebetween, whereby said aligned edges in said parallel relation and said

¹ As only one right flap has been recited in the claim, “a” is inappropriate and should be deleted.

² Insertion of language such as “said top and bottom panels each having” before “a selected width size” would greatly improve the clarity and readability of the claim.

³ The term “width size” lacks strict antecedent basis, in that a width, but not a width size, of the rear panel has been recited in the claim. While this informality does not render the scope of the claim indefinite, correction to maintain consistent terminology should be considered.

clearance therebetween present an appearance of a miter joint at each corner of said sealed mail envelope.

The examiner relied upon the following prior art references of record in rejecting the appealed claim:

Knight	3,015,438	Jan. 2, 1962
Back et al. (Back)	5,487,826	Jan. 30, 1996

The following rejections are before us for review.⁴

Claim 1 stands 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 appellant regards as the invention.

Claim 1 stands rejected under 35 U.S.C. § 103 as being unpatentable over Knight in view of Back.

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. 7) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 6 and 8) 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 claim, to the applied prior art references, and to the

⁴ The issue identified as Issue A on page 4 of the brief relates to petitionable subject matter rather than appealable subject matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. That issue is thus not within the jurisdiction of the Board and will not be reviewed by this panel. In re Mindick, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967).

respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. See In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner offers two bases for the indefiniteness rejection (see page 3 of the answer). The first is that the phrase “terminating at a clearance location therefrom” is unclear because it cannot be determined what “therefrom” refers to and because it is unclear what a “clearance location” is. The second basis is that there is no antecedent basis for “said underlying operative positions.” For the reasons which follow, we share the examiner’s view that these phrases render the scope of the claim indefinite.

Appellant offers an explanation of the terminology “clearance location” on pages 6 and 7 of the brief. According to this explanation, the “clearance location” refers to the fact that the inclined top and bottom edges of the flaps stop short of a theoretical point of intersection of their converging relation (see the drawing on page 6 of the brief). We are not aware of a conventional definition of “clearance location” which connotes the meaning set forth in this explanation and appellant has not presented any evidence that “clearance location” would be so understood by one of ordinary skill in the art. The only mention of the term “clearance” in appellant’s underlying disclosure refers to the clearance 50 between the initial length portions 44 of the edges 42 of the flaps and the

other side 48 (the inclined edges of the top and bottom panels) of the miter joint appearance. Thus, in light of the underlying disclosure, one skilled in the art would look to that “clearance” in attempting to understand what is meant by “clearance location” in claim 1 and would be confused as to what is meant thereby.

Moreover, we also agree with the examiner that it is unclear to what “therefrom” refers in the phrase “terminating at a clearance location therefrom,” especially when viewed in light of appellant’s explanation of “clearance location.” Simply stated, it is unclear whether “therefrom” refers to “each other” (i.e., the top and bottom inclined edges) or to the “top and bottom location.”

Furthermore, the examiner’s position that “said underlying operative positions” lacks antecedent basis is well taken. The claim recites two “operative positions,” those of the left and right flaps and those of the top and bottom panels. As pointed out by the examiner, neither of these “operative positions” has been recited as being “underlying.” As the use of the term “said” indicates that the terminology following “said” refers to previously recited terminology in the claim and “underlying operative positions” have not previously been recited in appellant’s claim, it is impossible to determine with any certainty to what “said underlying operative positions” refers.

The examiner has withdrawn as a basis for the rejection under the second paragraph of 35 U.S.C. § 112 the reason set forth in the last paragraph of the section numbered “4” (see page 3 of the final rejection, Paper No. 4) and, hence, this basis is not before us for review. Nevertheless, we, like the examiner, cannot escape the

observation that the claim strings together a series of limitations so long that it is difficult, if not impossible, for the reader to determine which elements of the claim have the recited features and that, contrary to appellant's comments in the first paragraph on page 9 of the brief, the interests of appellant would be well served if appellant's counsel followed the recommendations made by the examiner.

For the foregoing reasons, we agree with the examiner that the terminology alluded to by the examiner is unclear and renders the scope of the claim indefinite. Thus, we shall sustain the examiner's rejection of claim 1 under the second paragraph of 35 U.S.C. § 112.

The obviousness rejection

We recognize the inconsistency implicit in our holding that claim 1 is indefinite under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention, with a determination as to whether claim 1 is unpatentable under 35 U.S.C. § 103. Normally, when substantial confusion exists as to the interpretation of a claim and no reasonably definite meaning can be ascribed to the terms in a claim, a determination as to patentability under 35 U.S.C. § 103 is not made. See In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). However, in this instance, inasmuch as claim 1 contains another limitation which can be understood and which we have determined is not met by the prior art applied by the examiner, we have reached a determination as to the patentability of claim 1 over the applied prior art to

avoid the inefficiency of piecemeal appellate review. See Ex parte Ionescu, 222 USPQ 537, 540 (Bd. App. 1984).

In particular, claim 1 calls for

said top and bottom panels having opposite side inclined edges oriented in a converging relation to each other and aligning in parallel relation to each said exposed beginning length portion of said inclined edges of said left and right flaps and bounding a clearance therebetween, whereby said aligned edges in said parallel relation and said clearance therebetween present an appearance of a miter joint at each corner of said sealed mail envelope.

This limitation refers to the miter joint appearance 14 at each corner of the envelope provided by the approximately 45 degree angled edges 46 and 52 in parallel relation to each other and bounding “the ***intentionally left*** nominal clearance 50 therebetween” (specification, page 4; emphasis ours). In other words, the clearance between the angled edges 46 and 52 is not merely an incidental clearance resulting from manufacturing tolerances; it is intentionally designed into the envelope to enhance the appearance of the miter joints.

As explained in column 3, lines 50-75, Knight discloses inclined edges (10c, 11c, 14d, 10d, 12d, 14c, 12c, 11d) cut at approximately 45 degree angles to prevent an excess of material at the corners of the envelope A which are adhered together to form the strips 20-23. Specifically, these edges are cut at approximately 45 degree angles so that they are in “substantially abutting contact rather than overlapping with each other.” While this disclosure suggests that there may be some clearance left between adjacent inclined edges (i.e., 10c and 11c, 14d and 10d, 12d and 14c, 12c and 11d,

respectively) as a result of imprecision in cutting the 45 degree angles, it is also apparent that Knight's objective is to have the adjacent edges as close to abutting as possible within manufacturing tolerances. Even accounting for incidental clearances which might result from imprecise cutting of the 45 degree angles, there is no indication in Knight that the adjacent edges will be aligned in parallel relation and have a clearance therebetween as called for in claim 1. Thus, we do not agree with the examiner that Knight meets this limitation.

Even accepting that it would have been obvious to modify Knight's envelope by making it of cardboard and by forming the flaps E and F thereof with straight vertical edges, in view of the teachings of Back, as proposed by the examiner on page 4 of the answer⁵, this would still not overcome the above-noted deficiency of Knight so as to arrive at the claimed invention. Accordingly, we conclude that the applied references are insufficient to establish a prima facie case of obviousness of the subject matter of claim 1 and, consequently, we will not sustain the rejection.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 112, second paragraph, is affirmed and the examiner's decision to reject claim 1 under 35 U.S.C. § 103 is reversed. In that one rejection of the sole claim on appeal is sustained, the examiner's decision is affirmed.

⁵ Appellant does not contest the examiner's position with regard to these modifications.

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

AFFIRMED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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