

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte MARCEL POINTEAU, DENIS DARGELOS,  
JEAN-CLAUDE CAZALBOU and JEAN-FRANCOIS BARTEAU

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Appeal No. 2004-0214  
Application No. 09/446,516

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ON BRIEF

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Before HAIRSTON, McQUADE, and NASE, 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 35, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a device and a method for automatic issuing of commercial advantage coupons, when clients go to the check-out(s) of a store, in order to record and pay for articles purchased (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

De Lapa et al. (De Lapa)	5,353,218	Oct. 4, 1994
Deaton et al. (Deaton)	5,638,457	June 10, 1997

Claims 1 to 20 and 34 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 20 and 34 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

Claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 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 Deaton.

Claims 13 and 18 stand rejected under 35 U.S.C. § 103 as obvious over Deaton.

Claims 14, 19 and 33 stand rejected under 35 U.S.C. § 103 as obvious over Deaton in view of De Lapa.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the revised answer (Paper No. 13, mailed July 2, 2003) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10, filed January 27, 2003) and reply brief (Paper No. 14, filed August 29, 2003) 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 references, 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 20 and 34 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, 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 can 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 inappropriate.

Furthermore, appellants may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the Court in In re Swinehart, 439 F.2d 210, 213-14, 169 USPQ 226, 228-29 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

As set forth on page 3 of the revised answer, the sole basis for this rejection is that the phrase "in common for each check-out" as used at line 6 in independent claims 1 and 34 was indefinite.

In our view, the metes and bounds of the phrase "in common for each check-out" can be ascertained with a reasonable degree of precision and particularity. In that regard, as used in claims 1 and 34, the phrase means that each check-out in the store shares one device for automatically issuing commercial advantage coupons.

Accordingly, the phrase is definite and does not violate the second paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 20 and 34 under 35 U.S.C. § 112, second paragraph, is reversed.

### **The written description rejection**

Claims 1 to 20 and 34 stand rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The written description requirement serves "to ensure that the inventor had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him; how the specification accomplishes this is not material." In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). In order to meet the written description requirement, the appellants do not have to utilize any particular form of disclosure to describe the subject matter claimed, but "the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." In re Gosteli, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989). Put another way, "the applicant must . . . convey with reasonable clarity to those skilled

in the art that, as of the filing date sought, he or she was in possession of the invention." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). Finally, "[p]recisely how close the original description must come to comply with the description requirement of section 112 must be determined on a case-by-case basis." Eiselstein v. Frank, 52 F.3d 1035, 1039, 34 USPQ2d 1467, 1470 (Fed. Cir. 1995) (quoting Vas-Cath, 935 F.2d at 1561, 19 USPQ2d at 1116).

As set forth on page 3 of the revised answer, the sole basis for this rejection is that the phrase "each check-out" as used at line 6 in independent claims 1 and 34 was new matter.

Original claim 1 included the phrase "in common for all the check-out(s)." In our view, the editorial change of the phrase "in common for all the check-out(s)" to "in common for each check-out" does not constitute new matter. Accordingly, the phrase does not violate the first paragraph of 35 U.S.C. § 112.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 20 and 34 under 35 U.S.C. § 112, first paragraph, is reversed.

**The prior art rejection of claims 1 to 12, 15 to 17, 20 to 32, 34 and 35**

We will not sustain the rejection of claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Deaton.

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As stated in In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981) (quoting Hansgirk v. Kemmer, 102 F.2d 212, 214, 40 USPQ 665, 667 (CCPA 1939)) (internal citations omitted):

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function, it seems to be well settled that the disclosure should be regarded as sufficient.

Thus, a prior art reference may anticipate when the claim limitation or limitations not expressly found in that reference are nonetheless inherent in it. See In re Oelrich, 666 F.2d at 581, 212 USPQ at 326; Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 630, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Under the principles of inherency, if the prior art necessarily functions in accordance with, or includes, the claimed limitations, it anticipates. See In re King, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). However, inherency is not necessarily coterminous with the knowledge of those of

ordinary skill in the art. See Mehl/Biophile Int'l Corp. v. Milgraum, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305-06 (Fed. Cir. 1999); Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999).

Claims 1, 21, 34 and 35, the only independent claims on appeal, clearly recite that the CRITERIA file as claimed is distinct from the COUPON-TYPE file as claimed. In treating this limitation, the examiner (revised answer, p. 5) admitted that this limitation was not explicitly taught by Deaton. The examiner then presumed that this limitation to be inherent in Deaton since the structure recited in Deaton is substantially identical to that claimed.

In our view, Deaton does not necessarily include a CRITERIA file as claimed which is distinct from a COUPON-TYPE file as claimed. In the regard, the mere fact that Deaton utilizes the same data contained in the claimed CRITERIA and COUPON-TYPE files does not establish that distinct CRITERIA and COUPON-TYPE files must exist. Accordingly, Deaton does not function in accordance with, or include, all the claimed limitations and does not anticipate independent claims 1, 21, 34 and 35 or claims 2 to 12, 15 to 17, 20 and 22 to 32 dependent thereon.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 under 35 U.S.C. § 102(b) is reversed

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

With regard to the rejection of claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 under 35 U.S.C. § 103, we note that the examiner has not presented any evidence suggesting modifying Deaton to have a CRITERIA file as claimed which is distinct from a COUPON-TYPE file as claimed. In fact, the examiner never even alleged that such would have been obvious at the time the invention was made to a person of ordinary

skill in the art. Accordingly, the examiner has not met the initial burden of presenting a case of obviousness.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 under 35 U.S.C. § 103 is reversed.

**The prior art rejection of claims 13, 14, 18, 19 and 33**

We will not sustain the rejection of claims 13 and 18 under 35 U.S.C. § 103 as obvious over Deaton or the rejection of claims 14, 19 and 33 under 35 U.S.C. § 103 as obvious over Deaton in view of De Lapa.

As in the rejection under 35 U.S.C. § 103 of claims 1 to 12, 15 to 17, 20 to 32, 34 and 35, we note that the examiner has not presented any evidence suggesting modifying Deaton to have a CRITERIA file as claimed which is distinct from a COUPON-TYPE file as claimed.<sup>1</sup> Accordingly, the examiner has not met the initial burden of presenting a case of obviousness.

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<sup>1</sup> We have reviewed the patent to De Lapa but find nothing therein which makes up for the deficiency of Deaton discussed above.

For the reasons set forth above, the decision of the examiner to reject claims 13, 14, 18, 19 and 33 under 35 U.S.C. § 103 is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 and 34 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 1 to 20 and 34 under 35 U.S.C. § 112, first paragraph, is reversed; the decision of the examiner to reject claims 1 to 12, 15 to 17, 20 to 32, 34 and 35 under 35 U.S.C. §

102(b) is reversed; and the decision of the examiner to reject claims 1 to 35 under 35  
U.S.C. § 103 is reversed.

REVERSED

KENNETH W. HAIRSTON  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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