

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 33

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte LUIS J. RODRIGUEZ

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Appeal No. 2004-1331  
Application No. 09/812,664

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ON BRIEF

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Before COHEN, 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 53 to 72, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to surface treatment disks, especially to such surface treatment disks which are attachable to rotary tools (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:

Stratford	1,779,682	Oct. 28, 1930
Barry et al. (Barry)	5,725,423	Mar. 10, 1998

Tool and Manufacturing Engineers Handbook, Fourth Edition, Volume 1 Machining, 1983, Society of Manufacturing Engineers, page 11-57 (Handbook)

Claims 57 to 72 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.

Claims 53, 54, 57 and 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Handbook.

Claims 55, 56, 59 to 66 and 68 to 72 stand rejected under 35 U.S.C. § 103 as being unpatentable over Handbook and Stratford.

Claim 67 stands rejected under 35 U.S.C. § 103 as being unpatentable over Handbook, Stratford and Barry.

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. 26, mailed March 19, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 24, filed November 18, 2003) and reply brief (Paper No. 28, filed March 29, 2004) 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 57 to 72 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.

With this as background, we turn to the specific bases for the rejection under 35 U.S.C. § 112, second paragraph, made by the examiner. The two bases set forth by

the examiner (answer, p. 4) were (1) "the angle" in independent claims 57 and 68 lacks antecedent basis, and (2) "the hook and loop system" in dependent claim 67 lacks antecedent basis.

Since the examiner has not set forth any basis to reject independent claim 61 and claims 62 to 66 dependent thereon, the decision of the examiner to reject claims 61 to 66 under 35 U.S.C. § 112, second paragraph, is reversed.

The failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, 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). In our view, the lack of antecedent basis for "the angle" in independent claims 57 and 68 does not render the scope of those claims unascertainable by one skilled in the art. In that regard, one skilled in the art would clearly understand "the angle of said substantially conical shape" as referring to the vertex angle of the cone. In our view, the lack of antecedent basis for "the hook and loop system" in claim 67 does not render the scope of that claim unascertainable by one skilled in the art. In that regard, one skilled in the art would clearly understand "the hook and loop system" as reciting a hook and loop system.

For the reasons set forth above, the decision of the examiner to reject claims 57 to 72 under 35 U.S.C. § 112, second paragraph, is reversed.

### **The anticipation rejection**

Claims 53, 54, 57 and 58 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Handbook.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 53, 54, 57 and 58 recite in one manner or another a disk comprising, inter alia, two sides opposite one another, wherein one side has a substantially conical

shape projecting in opposite direction from the other side, and wherein the angle of the substantially conical shape is obtuse.

The examiner's position (answer, pp. 9-10) is that claims 53, 54, 57 and 58 are readable on the wheel shown in Fig. 11-29 of Handbook. We do not agree. As pointed out by the appellant in the brief, the wheel shown in Fig. 11-29 of Handbook does not have a substantially conical shape<sup>1</sup> but instead has a substantially frustoconical shape. Accordingly, claims 53, 54, 57 and 58 are not anticipated by Handbook.

For the reasons set forth above, the decision of the examiner to reject claims 53, 54, 57 and 58 under 35 U.S.C. § 102(b) is reversed.

### **The obviousness rejections**

We have also reviewed the references to Stratford and Barry additionally applied in the rejection of claims 55, 56 and 59 to 72 but find nothing therein which makes up for the deficiencies of Handbook discussed above. Accordingly, we cannot sustain the examiner's rejection of appealed claims 55, 56 and 59 to 72 under 35 U.S.C. § 103.

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<sup>1</sup> We agree with the appellant that the disks shown in Figures 8-12 of the application do have a substantially conical shape.

CONCLUSION

To summarize, the decision of the examiner to reject claims 57 to 72 under 35 U.S.C. § 112, second paragraph, is reversed; the decision of the examiner to reject claims 53, 54, 57 and 58 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 55, 56 and 59 to 72 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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