

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte FREDERIC S. SIEGEL

Appeal No. 2005-0934
Application No. 10/414,060

ON BRIEF

Before McQUADE, 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 (mailed May 19, 2004) of claim 1, which is the only claim pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates generally to an umbrella improvement which facilitates on a rainy day an umbrella-assisted departure from a vehicle. Claim 1 reads as follows:

For an umbrella in the use of which said umbrella in an open condition is used during departure of an individual with packages through an open door of an automobile on a rainy day, the improvement comprising attaching a bottom end of a handle of said open umbrella to a top edge of said open door bounding a window of said door to provide an operative attached position of said umbrella to said top edge bounding said door window providing standing room for said departing individual beneath said umbrella, operative positions of both hands of said departing individual engaged about said packages during departure through said open door, and one hand of said individual removed from said engaged operative position about said packages and assuming an operative position in contact with and disengaging said handle bottom end from said top edge of said door, whereby said disengaged umbrella has use value in maintaining said individual and packages dry during said departure from said automobile.

The rejections under appeal as set forth in the final rejection are as follows:

Claim 1 is 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 applicant regards as the invention.

Claim 1 is indefinite because:

- 1) The claim starts with the language "For an umbrella" yet nothing is claimed that is for an umbrella.
- 2) It is unclear if the claim is meant to be a structural claim or a method claim. The body of the claim appears to be a method claim, but this is not set forth in the preamble. The claim is structured more like a paragraph than a claim.
- 3) It is not clear if the applicant intends on claiming the car door as part of the present invention since the applicant has included more structure for the car door.

Claim 1, as best understood, is rejected under 35 U.S.C. 102(b) as being anticipated by Takamiya (JP 09156426 A). Takamiya teaches the use of an umbrella during a departure through an open door of a car on a rainy day comprising attaching a bottom end of a handle of the umbrella to a top edge of the open door (as shown in Figure 1b) to provide standing room and allow the user to have both hands available.

The appellant's arguments against the above-noted rejections are set forth in the brief (filed August 23, 2004) and reply brief (filed December 20, 2004). The examiner's response to those arguments is set forth in the answer (mailed December 3, 2004).

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 reference to Takamiya,¹ 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 claim 1 under 35 U.S.C. § 112, second paragraph.

¹In determining the teachings of Takamiya, we will rely on the translation of record provided by the USPTO.

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. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

Furthermore, the appellant 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.

One of the examiner's basis for the indefiniteness rejection is that "[i]t is unclear if the claim is meant to be a structural claim or a method claim." Our review of claim 1 reveals that it is a method claim, not an apparatus claim. While claim 1 is not written as artfully as possible, the metes and bounds of the claimed invention can be understood with a reasonable degree of precision and particularity. In our view, claim 1, as a whole, is drawn to a method for using an umbrella in an open condition during departure of an individual with packages through an open door of an automobile on a rainy day, the improved method comprising the steps of: (1) attaching a bottom end of a handle of said open umbrella to a top edge of said open door bounding a window of said door to provide an operative attached position of said umbrella to said top edge bounding said door window providing standing room for said departing individual beneath said umbrella; (2) operatively positioning both hands of said departing individual to engage about said packages during departure through said open door; and (3) removing one hand of said individual from said engaged operative position about said packages and assuming an operative position in contact with and disengaging said handle bottom end

from said top edge of said door, whereby said disengaged umbrella has use value in maintaining said individual and packages dry during said departure from said automobile.

The next basis for the indefiniteness rejection is that "[t]he claim starts with the language 'For an umbrella' yet nothing is claimed that is for an umbrella." As set forth in the preceding paragraph, the appellant is claiming a method for using an umbrella. While a better introductory clause would be preferred, we see nothing in the current introductory clause that prevents the scope of the invention sought to be patented to be determined with a reasonable degree of certainty.

The last basis for the indefiniteness rejection is that "[i]t is not clear if the applicant intends on claiming the car door as part of the present invention since the applicant has included more structure for the car door." In our view, the claim makes it clear that a car door having a top edge bounding a window is part of the claimed method.

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

The anticipation rejection

We will not sustain the rejection of claim 1 under 35 U.S.C. § 102(b).

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."

Takamiya provides that in the past it was a laborious burden to carry bags in one hand while an umbrella was open. Takamiya teaches to solve that problem by the use of an umbrella which during departure through an open door of a car on a rainy day is attached to the glass window of the door to provide standing room and allow the user to have both hands available (see Figures 1(a) and 1(b)).

The appellant argues that Takamiya does not teach attaching a bottom end of a handle of an open umbrella to a top edge of an open door bounding a window of the door to provide an operative attached position of the umbrella to the top edge bounding the door window. We agree. Instead, Takamiya teaches attaching a bottom end of a handle of an open umbrella to a top edge of a window of the door to provide an operative attached position of the umbrella to the top edge of the door window. As such, the umbrella in Takamiya is not attached to a top edge of a car door which bounds (i.e., determines the limits of) the door window.

The examiner asserts (answer, p. 6) that "[t]he appellant is not claiming the vehicle itself. Thus what kind of door the umbrella is attached to is not accorded patentable weight in such method claim." All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Furthermore, it is well established that the materials or apparatus on which a process is carried out must be accorded weight in determining the obviousness of that process. See In re Pleuddemann, 910 F.2d 823, 825-28, 15 USPQ2d 1738, 1740-42 (Fed. Cir. 1990); In re Kuehl, 475 F.2d 658, 664-65, 177 USPQ 250, 255 (CCPA 1973); Ex parte Leonard, 187 USPQ 122, 124 (Bd. App. 1974). In our view, the case law clearly establishes that the position of the examiner in this case is in error.

For the reasons set forth above, the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claim 1 under 35 U.S.C. § 112, second paragraph, is reversed and the decision of the examiner to reject claim 1 under 35 U.S.C. § 102(b) is reversed.

REVERSED

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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