

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 VLADIMIR ABRAMOVICH MICHLIN
and
IGOR IGOREVICH STUKANOV

Appeal No. 2005-1349
Application No. 10/079,686

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 December 30, 2003) of claims 1 to 8, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a pulsation dampener and particularly to an apparatus that reduces the effect of pulsations of liquid/gas flow in a hydraulic/pneumatic system that includes a pumping device (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 8 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.¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed September 2, 2004) for the examiner's complete reasoning in support of the rejection, and to the brief (filed April 26, 2004) and reply brief (filed October 8, 2004) for the appellants' arguments thereagainst.

¹On page 3 of the final rejection, the examiner stated that "[t]he claims are still not structurally sufficient to enable one to make and/or use the invention." We note that no rejection under the enablement requirement of 35 U.S.C. § 112, first paragraph, is before us in this appeal.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, 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 initial burden of establishing a prima facie case on any ground under the second paragraph of § 112 rests with the examiner. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992), citing In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) ("As discussed in In re Piasecki, the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.").

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.

Thus, 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).

Furthermore, the 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.

With this as background, we analyze the specific bases set forth by the examiner for the rejection under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal (see pages 3-4 of the answer). The first basis is that:

Claim 1 recites ". . . disks form phase shifted on 180 degrees waves of pulsations . . .", which is not clear and indefinite [sic, definite].

The second basis is that:

Claim 3 recites "additional orifices" without proper antecedent basis. "Orifices" is [sic, are] not previously recited in claim 1.

The third basis is that:

Claim 5 recites ". . .disk for creation of phase shifted on 180 degrees waves of pulsation . . .", which again, is not clear. It is not clear what "phase shifted on 180 degrees waves of pulsation" is.

The appellants' specification (p. 3) provides that:

The interference disk has central and secondary channels that separate the initial pulsated flow into several flows in which 180-degree phase-shifted waves of pulsations are formed. These waves interfere where the channels are connected which results in the reduction of pulsations in the output flow. If there is a need for additional reduction of pulsations, another disk is placed consequently in the device. To minimize the diameter of the disk, a geometric configuration of the secondary channels is optimized by means of combinations of corresponding spirals, and segments of arcs. The disk may have additional orifices and

reflective shields to reach desired performance for the required spectrum of pulsations frequencies.

In addition, in the background of the invention section of the application, the appellants teach that the majority of companies use two approaches to reduce pulsations in hydraulic systems. The first approach consists in using a dampening element to absorb or damper pulsations in the flow. The second approach consists in using the interference of 180-degree phase-shifted waves to reduce pulsations in a system. The appellants state that Russian Pat. No. 626 304 discloses a dampener in which a phase-shifted wave is formed in a secondary channel of an interference disk. The present invention is said to be an advanced/improved modification of the previous dampener.

In our view, the examiner has not established a prima facie case of indefiniteness. In fact, the examiner has not provided any rationale as to why the metes and bounds of the claimed invention are not set forth with a reasonable degree of precision and particularity when the language employed in the claims is analyzed in light of the teachings of the prior art and of the application's disclosure as it would be interpreted by one possessing the ordinary level of skill in the art. All the examiner has

done in this case is stated that particular phrases are unclear or lack antecedent basis. This is insufficient to establish a prima facie case of indefiniteness.

Moreover, based on the record on appeal, including the parts of the specification cited above, we agree with the appellants that one of ordinary skill in this art would have arrived at a reasonable interpretation of the disputed phrases as set forth in the briefs. Thus, we find that the appealed claims in fact set out and circumscribe a particular area with a reasonable degree of precision and particularity such that one skilled in the art would understand the metes and bounds of what is claimed.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 112, second paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 8 under 35 U.S.C. § 112, second paragraph, 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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