

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0823
Application No. 10/284,474

ON BRIEF

Before KRATZ, TIMM, and JEFFREY T. SMITH, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-7.

BACKGROUND

Appellant's invention relates to a plastic lid or hinge assembly for securing a lid to a container. An understanding of the invention can be derived from a reading of exemplary claims 1 and 5, which are reproduced below.

1. A plastic lid securable to a container using a substantially straight hinge pin, the plastic lid comprising a hinge line shaped to receive the substantially straight hinge pin and secure the lid to the container, wherein the hinge line is

initially closed via a plastic wall at at least one end, and wherein the hinge pin is held in the hinge line via contraction of an entry hole formed by passing the hinge pin through the plastic wall.

5. A hinge assembly for securing a lid to a container, the hinge assembly comprising:

a hinge line formed in one of the lid and the container, at least one end of the hinge line being initially closed via a plastic wall; and

a substantially straight hinge pin secured in the hinge line via contraction of an entry hole formed by passing the hinge pin through the plastic wall.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Schurman 3,886,645 Jun. 03, 1975

Claims 1-7 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Schurman.

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

The initial inquiry into determining the propriety of the examiner's Section 102(b) rejection is to correctly construe the

scope of the claimed subject matter. Gechter v. Davidson, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032 n.3 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). Upon careful review of the claimed subject matter in light of the specification, it is apparent to us that the metes and bounds of the claimed subject matter cannot be ascertained. Therefore, we are unable to determine the propriety of the examiner's Section 102(b) rejection. To do so would require speculation with regard to the metes and bounds of the claimed subject matter for reasons set forth below. See In re Wilson, 424, F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we procedurally reverse the examiner's Section 102(b) rejection¹ and enter a new ground of rejection against the claims on appeal as shown below:

¹ This procedural reversal is not based upon the merits of the examiner's Section 102(b) rejection.

Pursuant to the provisions of 37 CFR § 41.50(b) (2004), claims 1 through 7 are rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which the appellant regards as his invention.²

A principal purpose of the second paragraph of § 112 is to provide those who would endeavor, in future enterprises, to approach the area circumscribed by the claims of a patent, with adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

As the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

² The examiner had maintained separate rejections of claims 1-7 under the first and second paragraphs of 35 U.S.C. § 112, as set forth in the final rejection mailed December 02, 2004. However, those rejections were withdrawn, as indicated at page 2 of the answer.

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of language employed 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. [Footnote omitted.]

In order to satisfy the requirements of the second paragraph of § 112, a claim must accurately define the invention in the technical sense. See In re Knowlton, 481 F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973).

As further explained by our reviewing court in Allen Eng's Corp. v. Bartell Indus. Inc., 299 F.3d 1336, 1348, 63 USPQ 2d 1769, 1775 (Fed. Cir. 2002), the second paragraph of Section 112 requires that (1) the claims on appeal "particularly point out and distinctly claim an invention" and (2) the claims on appeal set forth what "the applicant regards as his invention." The former requires the claims on appeal to be definite while the latter requires the claims on appeal to recite the appellants' invention. Allen Eng's Corp. v. Bartell Indus. Inc., 299 F.3d at 1348-49, 63 USPQ2d at 1775-76.

Although no limitation in the specification is normally imputed to the claims being interpreted, see In re Paulsen, 30 F.3d at 1480, 31 USPQ2d at 1674, the specification can still be used to impart the meaning of words in the claims, see In re

Barr, 444 F.2d 588, 593, 170 USPQ 330, 335 (CCPA 1971). After all, it is well established that appellant can be his own lexicographer so long as terms are clearly defined and not given meanings repugnant or abhorrent to the ordinary meaning.

Applying these principles to the present case, we observe that all of the claims before us require either a plastic lid including a hinge line (claims 1-4) or a hinge assembly including "a hinge line formed in one of the lid and the container...", as recited in independent claim 5 and, consequently, also required in dependent appealed claims 6 and 7. In the brief (pages 10 and 11), appellant notes that the claim term "hinge line" is defined at page 3, paragraph 0015 of their specification. In the cited specification paragraph, a hinge line (14) is "defined by aligned openings of the container and lid(s) and a hinge pin" See drawing figure 1.

However, the above reproduced specification definition for the claim term "hinge line", as asserted by appellant in the brief as being operative, is internally inconsistent with the use of that term in the appealed claims.

As for appealed claims 1-4, this is so because those claims do not require a container and a lid with aligned openings. Rather they are drawn to a plastic lid including a hinge line.

Yet, as appellant has asserted in the brief, the specification definition for the claim term "hinge line" requires not only a lid but a container in combination therewith to furnish the requisite aligned openings in the container and lid(s), as well as a hinge pin as the specification definition provides for. Consequently, the meaning of the term "hinge line" as it relates to a plastic lid, as called for in claims 1-4, is not readily determinable as the definition provided for that term in the specification would require other components that are not part of the lid of claim 1.

Moreover, appealed claims 5-7 are drawn to a hinge assembly that require a hinge line formed in "one of the lid and container" and a hinge pin. As evident by reviewing appellant's definition for the claim term "hinge line", the claim requirement for a hinge line in either a lid or a container is inconsistent therewith. Also, the separate claim requirement for a hinge pin in addition to the hinge pin that is part of the hinge line, by definition, appears inconsistent.

In light of the above noted inconsistencies in each of the independent claims on appeal, i.e., claims 1 and 5, we are of the view that one of ordinary skill in the art cannot ascertain the boundaries of protection sought by the claims on appeal. Also,

as a result of these inconsistencies between the claims on appeal and the description of the invention in the specification, we are of the view that the claims on appeal do not recite subject matter which the appellant regards as his invention as required by the second paragraph of Section 112.

In other words, the appealed claims are inconsistent and fail to particularly point out and distinctly claim appellant's invention as a final assembled lid and container including aligned openings of both of those parts, including an entry hole in at least one of those assembled parts with a hinge pin secured or held in the aligned openings of both of those parts, as argued in the briefs.

Looked at another way, it is reasonable to construe the language used in claims 1 and 5 as suggesting, albeit ambiguously, an intermediate unassembled part that includes a hinge line forming portion rather than the final product argued by appellants as invention. Of course, such a possible claim construction further evidences the indefiniteness thereof and would yield the same result of the claims being in violation of the second paragraph of Section 112. See In re Collier, 397 F.2d 1003, 1005, 158 USPQ 266, 267 (CCPA 1968).

Thus, we determine that the appealed claims run afoul of both requirements of the second paragraph of § 112.

CONCLUSION

In view of the new rejection set forth above, the examiner's Section 102(b) rejection is procedurally reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50 (b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

§ 1.136(a).

REVERSED/§ 41.50(b)

PETER F. KRATZ)
Administrative Patent Judge)
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) BOARD OF PATENT
CATHERINE TIMM) APPEALS
Administrative Patent Judge) AND
) INTERFERENCES
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