

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 MICHAEL WEISS

Appeal 2006-1675
Application 10/415,798
Technology Center 3700

Decided: February 22, 2007

Before BRADLEY R. GARRIS, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GARRIS, *Administrative Patent Judge*.

ORDER REMANDING TO THE EXAMINER

Upon review of the image file wrapper record for this application, we determine that this appeal is not ready for decision at this time.

Accordingly, pursuant to the authority and provisions of 37 C.F.R. § 41.50(a)(1)(2006), we remand this application to the jurisdiction of the Examiner for action consistent with our comments below.

I. Brief Summary of Prosecution History Prior to Appeal

The record shows that Appellant filed a first submission of national application papers on May 2, 2003. Those papers included a copy of an unexecuted declaration identifying PCT Application No. PCT/DE02/03185, an English translation of a Specification, and a Preliminary Amendment. The Specification, as translated, is directed to a heating element including “a stranded wire (6, 6’) . . . [having] a relatively large number of filaments wires” (Specification Translation 3). The Specification also discloses that “[t]he stranded wire is twisted only loosely” (*id.*).

In the Preliminary Amendment, Appellant (1) significantly amended the content of the May 2, 2003 English translation of the Specification, (2) canceled original claims 1-8 and presents new claims 9-27, and (3) presented amended Figure 1. After further application papers were filed on September 12, 2003, a NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 was mailed on October 07, 2003. On this record, it is unclear whether the Preliminary Amendment was considered as part of the original application.

The Preliminary Amendment to the Specification principally added the content of original claims 1-8 to the content of the Specification. The Preliminary Amendment also amended the Specification to include a reference to a heating element having a “stranded wire . . . with a plurality of filament wires and [the strand] is only loosely twisted” (Preliminary Amendment 3; emphasis deleted) and to “loosely wound filament wires” (*id.* at 6; emphasis deleted). Newly added independent claim 9 recites “a stranded wire (6, 6’) . . . comprising a plurality of filament wires (9, 9’)

which are, at most, only loosely twisted together.” Newly added claims 22, 25, and 26 also recite the plurality of filament wires as twisted.

In a non-final Office Action mailed May 20, 2004, the Examiner objected to the drawing under 37 C.F.R. § 1.83(a) as not showing “every feature of the invention specified in the claims” (non-final Office Action 2). The Examiner specifically required “the twisted filament wires twisted at a rate between 0 and 10 must be shown as claimed in the claims 22 and 26 or the feature(s) canceled from the claim(s)” (*id.*). In addition, the Examiner stated that “[n]o new matter should be entered” (*id.*). The Examiner made no comments with respect to the Preliminary Amendment to the Specification.

Appellant replied on August 20, 2004 by filing: (1) a second amendment to the Specification, (2) a second amended Figure 1, (3) new Figure 2, (4) a second amendment to the claims, and (5) *Remarks* to the Examiner’s non-final Office Action. The Amendment to the Specification principally added textual reference related to the new Figure 2 in the content of the Specification. On pages 8 through 9 of the *Remarks* section, Appellant maintained that no new matter was added in making the above noted amendments.

In the Final Office Action mailed November 15, 2004, the Examiner noted that the drawings submitted on August 20, 2004 were accepted (Final Office Action 1). No other comments were made with respect to the drawings and the amendments to the Specification and the claims.

II. 35 U.S.C. § 112, Second Paragraph Concerns

Independent claim 9 recites “the stranded wire (6, 6’) comprising a plurality of filament wires (9, 9’) which are, at most, only loosely twisted together.”

There is a conflict in the record as to what is being twisted that frustrates an attempt to provide a reasonable interpretation of the claimed subject matter consistent with the Specification and drawing. According to independent claim 9, the filament wires (9, 9’) are “loosely twisted together.” In contrast, page 3 of the Specification, as amended on August 20, 2004, discloses: “As shown in Figure 2, the stranded wire (6, 6’) is twisted only loosely.” On the other hand, Figure 2 shows subunits of twisted filaments with these subunits also being twisted to form a twisted strand. Appellant furthers this frustration in their discussion in the Brief of the claim limitation “at most, only loosely twisted” by first stating that there are “small gaps between the filament wires (9, 9’)” (Br. 8) and subsequently indicating that the gaps “exist . . . between the strands” (*id.*). Thus, the record is inconsistent as to whether the filaments, the strand(s) or both are “loosely twisted.” In light of this inconsistency, there is a possible violation under § 112, second paragraph, that the Examiner needs to address and resolve on the written record.

In response to this Remand, the Examiner must address and resolve on the written record of this application whether the claim language “at most, only_loosely_twisted” refers to the filament wires, the strand wire or both and whether the claim language complies with the second paragraph requirements of § 112.

III. 35 U.S.C. § 112, First Paragraph (written description) Concerns

We additionally note that there is a possible violation of § 112, first paragraph, (written description) since the amended disclosure regarding Figure 2 does not appear to be supported by the original disclosure.

As noted above, Figure 2 shows subunits of twisted filaments with these subunits also being twisted to form a twisted strand. The original disclosure does not appear to describe subunits of twisted filaments with these subunits also being twisted to form a twisted strand, as illustrated in Figure 2.

In response to this Remand, the Examiner must address this issue and resolve it on the written record by reviewing the English translation of the Specification of May 2, 2003, the Preliminary Amendment of May 2, 2003, and the Amendment of August 20, 2004 to make a determination of whether the Amendments to the Specification, the claims and the drawing comply with the written description requirement of the first paragraph of 35 U.S.C. § 112.

IV. Claim Interpretation

The record before us contains no adequate interpretation of the claimed subject matter by Appellant or Examiner. If the above discussed § 112 issues are resolved and the prior art rejection is maintained, the Examiner must respond to this Remand by interpreting the claims on the written record consistent with Office policy.

In interpreting the claims, the Examiner should be mindful that, during examination, claim language is given its broadest reasonable

interpretation that is consistent with the Specification. *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). Additionally, a Specification is examined for whatever enlightenment by way of definitions or otherwise it may provide to construing claim language. *Id.* When interpreting a claim, the Specification is usually the single best guide to the meaning of disputed claim language. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315, 1321, 75 USPQ2d 1321, 1327, 1332 (Fed. Cir. 2005).

Further, we note that, on pages 7 through 8 of the Brief, Appellant argues that the independent claim 9 limitation “a plurality of filament wires (9, 9’) which are, at most, loosely twisted together” distinguishes over the primary reference to Futahashi. In arguing this position, Appellant “assume[s] that the filament wires 4a of Futahashi are conventional, tightly twisted wires” (Br. 7). Appellant does not provide any information as to what is considered “conventional, tightly twisted wires.” Thus, Appellant has not fully explained why independent claim 9 distinguishes from the primary reference to Futahashi. This information is necessary to adequately interpret the appealed claims.

Thus, in response to this Remand, the Examiner must also require Appellant to define what is meant by “conventional, tightly twisted wires” (Br. 7) and to provide any available evidence which supports the definition.

IV. English Translation Needed

In the Answer, the Examiner maintains a § 103(a) rejection of appealed claims 9-27 over the Japanese Patent No. 2001237052A to Futahashi in view of U.S. Patent No. 5,824,996 to Kochman (Answer 2). In so doing, the Examiner does not rely on a verified English language

translation of the Japanese language patent document. Rather, the Examiner relies on a computer (machine) translation of the Japanese document. A review of the computer (machine) translation reveals that it is inadequate to make the factual findings necessary for a full review of the issues on appeal.

If the Examiner maintains the rejection under § 103 after responding to the § 112 concerns noted above, a verified translation of Futahashi must be provided by the Examiner in response to this Remand.

CONCLUSION

Accordingly, this application is remanded to the Examiner for appropriate action on the following:

1. to address and resolve on the written record of this application whether the claim phrase “at most, only_loosely twisted” refers to the filament wires, the strand wire or both and whether the claim language complies with the second paragraph requirements of § 112;
2. to address and resolve on the written record of this application whether the amendments to the Specification, the claims and the drawing comply with the written description requirement of the first paragraph of 35 U.S.C. § 112;
3. if the § 112 issues are resolved and the prior art rejection is maintained, to interpret the claims on the written record consistent with Office policy;
4. if the Examiner maintains the rejection under § 103 after responding to the § 112 concerns noted above, to provide a full verified translation of Futahashi; and

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5. to require Appellant to define what is meant by “conventional, tightly twisted wires” (Br. 7).

We hereby remand this application to the Examiner, via the Office of a Director of the Technology Center, for appropriate action in view of the above comments.

This Remand to the Examiner pursuant to 37 C.F.R. § 41.50(a)(1) (2006) is not made for further consideration of a rejection. Accordingly, 37 C.F.R. § 41.50(a)(2) does not apply.

REMANDED

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