

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 ALBERT E. ORTEGA and
R. WAYNE THOMLEY

Appeal 2007-0141
Application 10/654,324
Technology Center 1700

Decided: March 23, 2007

Before PETER F. KRATZ, JEFFREY T. SMITH, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the Examiner's final rejection of claims 7-16, the only claims pending in this application. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

Appellants' invention relates to an improved process for producing a nonwoven nylon fabric. The process is said to provide a softer hand or

"feel" to the filaments and fabric made therefrom. Independent claims 7 and 11 are illustrative of the invention:

7. A nonwoven fabric consisting essentially of a plurality of polymeric filaments bonded to one another to form a nonwoven web, said filaments comprising a blend of about 0.1 to about 1.2 percent polyethylene by weight, the remaining weight balance made up of a nylon polymer, or copolymer, or a mixture thereof; and wherein said filaments do not degrade at a temperature between about 180°C and about 250°C, and therefore, said filaments can be bonded at a temperature between about[] 180°C and about 250°C

11. A spunbonded nonwoven fabric consisting essentially of a plurality of polymeric filaments bonded to one another to form a single-layer nonwoven web; wherein said filaments comprise a blend of about 0.1 percent to about 10 percent by weight nylon 6 and about 0.05 percent to about 20 percent by weight polyethylene, balance nylon 6,6; and wherein said filaments do not degrade at a temperature between about 180°C and about 250°C, and therefore, said filaments can be bonded at a temperature between about[] 180°C and about 250°C.

The Examiner relies on the following prior art references to show unpatentability:

Ortega	5,431,986	Jul. 11, 1995
Lickfield	5,484,645	Jan. 16, 1996,

Definition of the word "degrade", The American Heritage Dictionary of the English Language (1992).

Tony Café, *Physical Constants For Investigators* 7 pages, T.C. Forensic.

The Examiner has made the following rejections:

1. Claims 7-16 under 35 U.S.C § 112(1) as lacking sufficient written description.
2. Claims 7-16 under 35 U.S.C § 103(a) as unpatentable over Lickfield in view of Ortega.

The initial inquiry into determining the propriety of the Examiner's § 112 and § 103(a) rejections is to correctly construe the scope of the claimed subject matter. Thus, the first issue before us is: Would a person of ordinary skill in the art at the time of the invention have recognized the meaning of the phrase "wherein said filaments do not degrade at a temperature between about 180°C and about 250°C"? We answer this question in the negative.

In order to make a proper comparison between the claimed invention and the prior art, the Examiner must first construe the language of the claims. *See In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994). *See also, Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567-68, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, . . . will normally control the remainder of the decisional process.") *See Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute). During examination, claims are given the broadest reasonable construction in light of the Specification. *See In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). If the scope and breadth of the claims cannot be properly determined, then the claims

should be rejected under 35 U.S.C. § 112, ¶ 2. *See In re Zletz*, 893 F.2d 319, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (if claims do not “particularly point[] out and distinctly claim[]”, in the words of section 112, appropriate PTO action is to reject the claims for that reason) and *In re Bigio*, 381 F.3d 1320, 1324, 72 USPQ2d 1209, 1211 (Fed. Cir. 2004)(“[A] patent applicant has the opportunity and responsibility to remove any ambiguity in claim term meaning by amending the application.”). Cf. *In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)(rejections under 35 U.S.C. § 103 cannot be based on speculations and assumptions).

Appellants maintain that the term "degrade" is used to illustrate that the filaments forming the claimed fabric do not decompose at bonding temperatures of about 180°C to 250°C. (Br. 5).¹ Appellants argue that this interpretation is supported by the Specification description of the qualities of the resulting fabrics as exhibiting substantially the same qualities as various known spunbonded nylon fabric. (Br. 5). The Examiner argues that the word “degrade” does not reasonably convey whether “the appellant is claiming that the filaments do not melt, soften, weaken, change color, lengthen, shorten, chemically decompose, etc.” (Answer 6).

Appellants have not identified any language in the specification or provided other evidence which convincingly shows that a person of ordinary skill in the art would have recognized the properties or characteristics that are encompassed by the phrase “wherein said filaments do not degrade at a temperature between about 180°C and about 250°C.” Thus, we are unable

¹ These arguments were made in response to the rejection under 35 U.S.C. § 112, ¶ 1.

to determine the meaning of the phrase “wherein said filaments do not degrade at a temperature between about 180°C and about 250°C.” We therefore reject claims 7-16 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as his invention.

Since the meaning of the phrase “wherein said filaments do not degrade at a temperature between about 180°C and about 250°C” is unclear, we cannot determine whether the claims meet the written description requirement of 35 U.S.C. § 112, first paragraph. Nor can we compare the claimed subject matter with the relevant prior art. Therefore, we are constrained to reverse both grounds of rejection. It is to be understood, however, that this reversal is not based upon an evaluation of the merits. Thus, the examiner is not precluded from rejecting a definite claim upon the art of record.

ORDER

The rejection of claims 7-16 under 35 U.S.C § 112(1) as lacking sufficient written description is reversed.

The rejection of claims 7-16 under 35 U.S.C § 103(a) as unpatentable over Lickfield in view of Ortega is reversed.

NEW GROUND OF REJECTION

Pursuant to the provisions of 37 C.F.R. § 41.50(b), we reject claims 7-16 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 C.F.R. § 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:

(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 proceedings 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 C.F.R. § 1.136(a)(1)(iv) (2006).

REVERSED
37 C.F.R. § 41.50(b).

tf/ls

Saliwanchik Lloyd & Saliwanchik
A Professional Association
P.O. Box 142950
Gainesville, FL 32614-2950