

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 JAMES R. BIELOZER

Appeal 2007-0516
Application 10/438,506
Technology Center 1700

Decided: April 27, 2007

Before RICHARD E. SCHAFER, TEDDY S. GRON, and ROMULO H. DELMENDO, *Administrative Patent Judges*.

SCHAFER, *Administrative Patent Judge*.

DECISION ON APPEAL

Statement of the Case

1 Applicant appeals under 35 U.S.C. § 134(b) from a Primary
2 Examiner's final rejection of Claims 1 and 3-23. Applicant timely filed the
3 appeal on December 27, 2005. We have jurisdiction. 35 U.S.C. § 6(b).

4 The Examiner rejected all claims under 35 U.S.C. § 112, ¶ 1, as
5 directed to subject matter not supported by the original disclosure. The

1 Examiner additionally rejected Claims 3 and 4 under 35 U.S.C. § 112, ¶ 2,
2 as indefinite.

3 We reverse the rejection under 35 U.S.C. § 112, ¶ 1 as to Claims 1, 5-
4 16 and 22-23 and affirm as to claims 3, 4 and 17-21. We also affirm the
5 rejection of Claims 3 and 4 as indefinite.

6 **New matter**

7 **Findings of Fact**

8 **The invention**

9 F. 1. The subject matter of Application 10/438,506 relates to a drum which
10 incorporates an agitator. Spec. p. 1.

11 F. 2. The agitator is used to mix liquids, such as paint, which include solids
12 that tend to settle to the bottom of the drum. Spec. p. 1.

13 F. 3. The agitator includes a bladed shaft that is rotated to mix the liquid
14 and solids in the drum. Spec. p. 1

15 F. 4. A removable motor mounted on the container rotates the shaft and
16 blades. Spec. p. 1.

17 F. 5. The motor mounts to the top of the drum by means of an externally
18 threaded mounting component on the motor and an internally threaded
19 flange on the top of the drum. Spec. p. 1-2.

20 F. 6. The externally threaded mounting component engages the internal
21 threads of the flange opening securing the motor to the top of the container.
22 Spec. p. 1-2.

23 F. 7. Applicant noted that there may be a mismatch between the externally
24 threaded motor mounting component and the internally threaded flange
25 opening preventing mounting the motor on certain containers. Spec. p. 2.

26 F. 8. Applicant's invention provides an adaptor, a "one piece conversion
27 device," that addresses the mismatch. Spec. p. 2.

1 F. 9. The claims specify that the adapter has external threads with a
2 diameter corresponding to the internal threads of the flange. Amended
3 Appeal Br. p. 13, Claim 1.

4 F. 10. The adapter is also required to have internal threads of a different
5 diameter than the internal threads of the flange and which engage the
6 external threads on the motor. Amended Appeal Br. p. 13, Claim 1.

7 F. 11. In relevant part, Claim 1 states:

8 the drum including a top wall having a central
9 opening defined by a flange having internal threads of a
10 certain diameter; . . .

11 the one-piece conversion device, including an
12 annular portion . . .

13 the annular portion having external threads with a
14 diameter corresponding to the internal threads of the
15 flange;

16 the annular portion also having internal threads
17 with a different diameter than the internal threads of the
18 flange;

19 the annular portion being positioned within the
20 central opening with its external threads engaged with the
21 internal threads of the flange . . .

22 the motor including a mounting component having
23 external threads corresponding to the internal threads of
24 the conversion device and threadably engaged
25 therewith

26 Amended Appeal Br., p. 13, Claim 1.

27 F. 12. Claims 3, 4 and 17-21 specify the diameter of the external threads of
28 the mounting component and/or the diameter of the internal threads of the
29 flange.

30 F. 13. Claims 3 and 4 state:

31 3. The combination set forth in claim 2, wherein the
32 external threads of the motor's mounting component and

1 the internal threads of the conversion device are 1 ½
2 inches in diameter.

3 4. The combination set forth in claim 3, wherein the
4 external threads of the flange are 2 inches in diameter.

5 **The original disclosure of Application 10/438,506**

6 F. 14. Applicant's original specification described and claimed the adapter in
7 terms of the pitches of the threads rather than their diameters.

8 F. 15. Thread pitch is the distance between adjacent threads. *Marks'*
9 *Standard Handbook for Mechanical Engineers* (Tenth Ed.), 8-9 (Eugene A.
10 Avallone and Theodore Baumeister III, eds., McGraw-Hill 1996.) (Marks);
11 *Miriam-Webster's 10th Collegiate Dictionary*, 886 (1996) (Webster).¹

12 F. 16. Under the section of the specification titled "Summary of the
13 Invention" applicant describes the adapter as a one piece conversion device
14 that allows quick and easy compatibility between a flange and motor mount
15 having different thread pitches:

16 The present invention provides a one-piece conversion
17 device that quickly and easily allows a drum having a
18 flange with one pitch of internal threads (e.g., 2 inches)
19 to be compatible with a motor having a mounting
20 component with a different pitch of external threads
21 (e.g. 1 ½ inches).

22 Spec. p. 2 (emphasis added).

23 F. 17. Similarly, all applicant's original claims described the adapter
24 in terms of differences in thread pitch.

25 F. 18. For example, in relevant part original Claim 1 provides:

¹ The Primary Examiner cited and relied upon these references. He discussed the former at Page 3 of the final rejection mailed August 23, 2005, and the latter at Page 6 of the Examiner's answer mailed August 9, 2006.

1 the drum including a top wall having a central
2 opening defined by a flange having internal threads of a
3 certain pitch; . . .

4 the one-piece conversion device, including an
5 annular portion . . . ;

6 the annular portion having external threads with a
7 pitch corresponding to the internal threads of the flange;

8 the annular portion also having internal threads
9 with a different pitch than the internal threads of the
10 flange;

11 the annular portion being positioned within the
12 central opening with its external threads engaged with the
13 internal threads
14 of the flange

15 Spec. p. 9 (emphasis added).

16 F. 19. Applicant has not identified any portion of the original specification
17 which expressly refers to the internal or external diameters of the adapter.

18 F. 20. Our review of the original specification did not reveal any express
19 reference to the diameters of the internal and external threads of the adapter.

20 F. 21. Applicant's original disclosure includes drawings.

21 F. 22. Figures 5 and 6 are said to show the adapter. Specification, p. 4.

22 F. 23. Figure 6 is reproduced below:

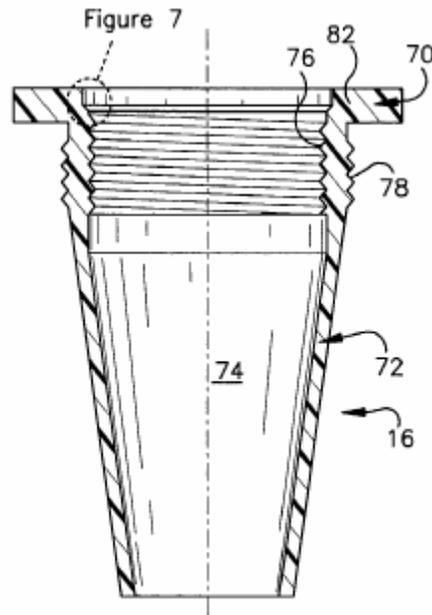


Figure 6

1

2 Figure 6 depicts an adapter

3 F. 24. The internal threads of the adapter are identified in Figure 6 by
4 numeral 76 and the external threads by 78.

5 F. 25. Figures 3 and 4 are said to show the adapter in place on the drum.

6 F. 26. Figure 4 shows the adapter in use mounting a motor to the drum.

7 Spec. p. 4.

8 F. 27. Both Figures 3 and 4 show that the adapter has both external and
9 internal threads.

10 F. 28. Both Figures 3 and 4 show the adapter in engaged with the flange on
11 the drum.

12 F. 29. Figures 3 and 4 are reproduced below:

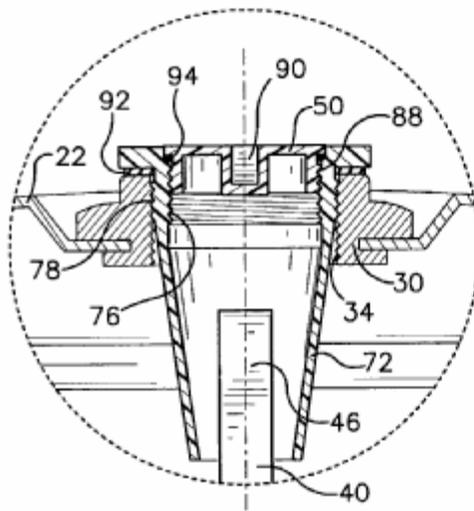


Figure 3

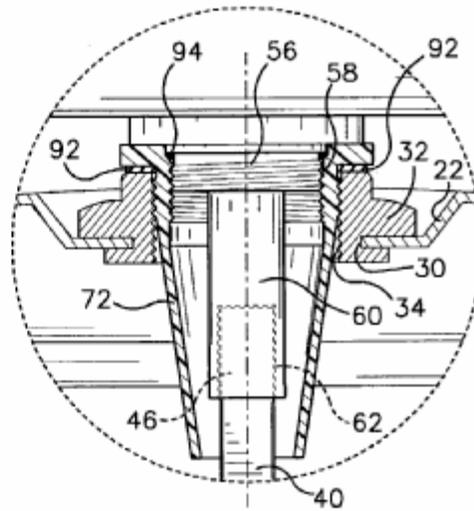


Figure 4

1

2 Figures 3 and 4 depict an adapter's internal threads

3 F. 30. Figures 3 and 4 show the flange 32 (Figure 4) with internal threads 34.

4 F. 31. Figures 3 and 4 also show the adapter's internal threads 76 (Figure 3).

5 F. 32. Figures 3 and 4 show that the diameter of the internal threads 76 of
6 the adapter (Figure 3) is smaller than the diameter of the internal threads 34
7 of the flange.

8 **The prosecution of Application 10/438,506**

9 F. 33. The Examiner rejected applicant's claims as unpatentable over certain
10 prior art. Application 10/438,506, Office Action mailed March 7, 2005.

11 F. 34. Applicant responded, *inter alia*, by amending the specification and
12 claims. Application 10/438,506, paper entered June 3, 2005.

13 F. 35. The amendments included changing or eliminating essentially every
14 occurrence of the word "pitch" in the written description and claims.

15 Application 10/438,506, paper entered June 3, 2005.

16 F. 36. The Examiner entered a final Office Action objecting to the June 3
17 amendment as adding new matter and rejected all claims under 35 U.S.C.

1 § 112, ¶ 1, as not supported by the original disclosure. Application
2 10/438,506, Office Action mailed August 23, 2005, pp. 2-3.
3 F. 37. Applicant submitted an amendment after final which the Examiner
4 refused to enter.
5 F. 38. Applicant timely filed an appeal on December 27, 2005.

6 **Issues**

7 The Examiner contends that the amendment to the written description
8 and claims submitted June 3, 2005, added new matter contrary to 35 U.S.C.
9 § 132(a). Specifically, the Examiner contends that the substitution of the
10 word “diameter” with the word “pitch” in the written description and claims
11 introduced new matter into the disclosure and changed the concept of the
12 invention. Examiner Answer, p. 3-5. With respect to Claims 1 and 3-23, the
13 Examiner contends that each of the independent claims recite the newly
14 added “diameter” which is not supported by the written description. The
15 Examiner additionally contends with respect to Claims 3 and 4, and
16 apparently Claims 17-21, that the original disclosure does not support the
17 diameters of 1 ½ and/or 2 inches required by those claims.

18 Applicant contends that the word “pitch” as used in the original
19 disclosure and claims means the same as “diameter” and does not add new
20 matter. Amended Appeal Br., p. 8.

21 The overall issue before us is whether the subject matter of claims 1
22 and 3-23, is supported by applicant’s original disclosure. The specific
23 dispositive issues are:

24 (1) whether the original disclosure supports a drum including a one
25 piece conversion device with an annular portion having (a) external threads
26 with a diameter corresponding to the internal threads of the flange and

1 (b) internal threads with a diameter different than the internal threads of the
2 flange and

3 (2) whether the original disclosure supports a one piece conversion
4 device which allows compatibility between a flange having a 2 inch
5 diameter and a mounting component having a 1 ½ inch diameter.

6 **Principles of Law**

7 The specification must include a written description of the invention.
8 35 U.S.C. § 112, ¶ 1 (“The specification shall contain a written description
9 of the invention . . .”). The invention which must be described is the now
10 claimed invention. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19
11 USPQ2d 1111, 1117 (Fed. Cir. 1991). (“The invention is, for purposes of
12 the ‘written description’ inquiry, whatever is now claimed.”). The original
13 disclosure “must . . . convey with reasonable clarity to those skilled in the art
14 that . . . [the inventor] was in possession of the invention.” *Vas-Cath*, 935
15 F.2d at 1563-64, 19 USPQ2d at 1117. Put another way, one
16 skilled in the art, reading the original disclosure, must “immediately discern
17 the limitation at issue” in the current claims. *Waldemar Link GmbH & Co. v.*
18 *Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994).

19 The original disclosure includes the original specification and the
20 original drawings. Amendments may not add new matter to the original
21 disclosure. 35 U.S.C. § 132(a). It is not prohibited new matter to add
22 subject matter disclosed only in the drawings to the specification. *In re*
23 *Wolfensperger*, 302 F.2d 950, 955, 133 USPQ 537, 542 (CCPA 1962)
24 (“Whatever [the drawing] does disclose may be added to the specification in
25 words without violation of the statute and rule which prohibit ‘new matter,’
26 35 U.S.C 132 . . . for the simple reason *that* what *is* originally disclosed
27 cannot be ‘new matter’ within the meaning of this law”).

1 **Analysis**

2 **Claims 1, 5-16 and 21-23**

3 The original disclosure supports an adapter having internal threads of
4 a different diameter than the internal threads of the flange. Specifically
5 applicant's Figures 3, 4 and 6 disclose an adapter having internal threads 76
6 (Figure 3) which have a smaller, and thus different, diameter than the
7 internal threads 34 (Figure 3) of the flange. Thus, applicant's original
8 disclosure shows possession of an adapter having internal threads with a
9 diameter different than the diameter of the internal threads of the flange.
10 Amending the written description and claims to describe an adapter shown
11 in the original drawings does not introduce new matter into the disclosure.
12 *Wolfensperger*, 302 F.2d at 955, 133 USPQ at 542. The written description
13 was amended to provide support for claims to subject matter including an
14 adapter having internal threads which have a different diameter than the
15 internal threads of the container flange without adding new matter. The
16 rejection of Claims 1, 5-16 and 22-23 is reversed.

17 The Examiner argues that changing "pitch" to "diameter" changed the
18 basic concept of the invention as set out in the original claims and written
19 description. We agree. However, that is not dispositive of the new matter
20 question with respect to the subject matter of Claims 1, 5-16 and 21-23.
21 Whether amendments add new matter is gauged against the original
22 disclosure not just the original specification. The original drawings are part
23 of the original disclosure.² The original drawings disclose an adapter having

² The drawings while part of the original disclosure are not part of the original specification. See 35 U.S.C. § 111 ("[An] application shall include—

(A) a specification as prescribed by section 112 of this title;

1 internal threads with a diameter different than the diameter of the internal
2 threads of the flange.³

3 **Claims 3, 4, and 17-21**

4 Each of Claims 3, 4 and 17-21 specifically requires threads having a
5 diameter of 1 ½ and/or 2 inches.

6 The Examiner notes that the original disclosure does not make any
7 reference to diameters of 1 ½ or 2 inches and correctly notes that every
8 reference to the values 1 ½ and 2 inches is in relation to thread pitch. Our
9 review of the original specification confirms the Examiner’s finding. The
10 Examiner has referenced Marks and Webster to establish the ordinary
11 meaning of pitch as the distance between adjacent threads. We think the
12 person skilled in the art would have given the word pitch its ordinary
13 meaning and would not immediately discern the values 1 ½ and 2 inches as
14 relating to diameter. Applicant’s original disclosure did not provide a
15 written description of the limitation. *Waldemar*, 32 F.3d at 558, 31 UPSQ2d
16 at 1857.⁴

(B) a drawing as prescribed by section 113 of this title; and
(C) an oath by the applicant as prescribed by section 115 of this title.”

³ In this regard we note that the Examiner has a means to address the situation where an applicant by amendment changes the fundamental concept of the invention. See MPEP ¶ 819.

⁴ We note that the specific 1 ½ inch and 2 inch diameter limitations, as well as essentially any other useful diameter, are enabled. However, the Federal Circuit has stated that the written description and enablement requirements are separate requirements of section 112, ¶ 1. *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d 1111 at 1117 (“we hereby reaffirm, that 35 U.S.C. §112, first paragraph, requires a ‘written description of the invention’ which is separate and distinct from the enablement requirement.”). Similarly, the 1 ½ inch and 2 inch diameter limitations would have been obvious from applicant’s original disclosure. However, possession of the invention is not established by obviousness from the disclosure. *Lockwood v. Am. Airlines, Inc.*, 107

1 Applicant argues that “pitch” as used in the original application
2 meant the same as “diameter.” Amended Appeal Br., p. 8. Applicant
3 specifically makes reference to portions of the specification to support the
4 argument. Referring to page 2, lines 6-10, applicant says:

5 Specifically, for example, in the background
6 section of the original specification, it is set forth that, "in
7 the paint industry, many motors are designed for
8 mounting within an 1 ½ inch threaded flange" and "[i]f a
9 drum has a different sized flange (e.g., 2 inches), the
10 motors mountable on an 1 ½ inch flange cannot be used,
11 whereby such a drum probably would not be purchased."

12 Amended Appeal Br., p. 8. However, applicant takes these quotes out of
13 context. The lead sentence of the paragraph from which applicant took the
14 quotes expressly states that the example refers to the pitch of the threaded
15 flange. We reproduce the entire paragraph below:

16 Accordingly, the pitch of the drum's threaded
17 flange must be compatible with the pitch of the motor's
18 threaded mounting component. For example, in the paint
19 industry, many motors are designed for mounting within
20 an 1½ inch threaded flange. If a drum has a different
21 sized flange (e.g., 2 inches), the motors mountable on an
22 1½ inch flange cannot be used, whereby such a drum
23 probably would not be purchased. In addition to
24 convenient motor-mounting, a drum design also must
25 incorporate means for maintenance of the agitator shaft
26 in an upright position so that, when the motor is coupled
27 to the drum, the agitator shaft will be positioned for
28 coupling to the motor shaft. This can be accomplished by

F.3d 1565, 1571-72, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) (One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.”). On the other hand, if the applicant’s original disclosure was a prior art printed publication, the subject matter of Claims 3, 4, and 17-21 would not be “described” in the sense of an anticipation under 35 U.S.C. § 102.

1 installing welding) a metal bracket to the interior surface
2 of the drum's head wall, which will hold the 15 shaft
3 upright within the drum.

4 Spec. p. 2 (emphasis added).

5 Applicant further argues (Amended Appeal Br. p. 8) that changing
6 pitch to diameter is mere rephrasing or rewording and that rewording where
7 the meaning stays intact is not new matter. However, the change from pitch
8 to diameter does not keep the meaning intact. The change fundamentally
9 alters the meaning. As the original written description stated in the section
10 titled "Summary of the Invention":

11 The present invention provides a one-piece conversion
12 device that quickly and easily allows a drum having a
13 flange with one pitch of internal threads (e.g. 2 inches) to
14 be compatible with a motor having a mounting
15 component with a different pitch of external threads (e.g.,
16 1 ½ inches)"

17 Spec. p. 2 (emphasis added). Similarly the original claims referred to
18 different pitch. For example, original Claim 1 in relevant part states:

19 the drum including a top wall having a central
20 opening defined by a flange having internal threads of a
21 certain pitch; . . .
22 the one-piece conversion device, including an
23 annular portion . . . ;
24 the annular portion having external threads with a
25 pitch corresponding to the internal threads of the flange;
the annular portion also having internal threads
with a different pitch than the internal threads of the
flange;
26 the annular portion being positioned within the
27 central opening with its external threads engaged with the
28 internal threads of the flange

29 Amended Appeal Br., p. 13, Claim 1.

1 Thus the focus of the invention as originally stated was matching
2 threads having different pitches. As established by the Examiner, “pitch”
3 has a recognized meaning in the art. The change to “diameter” significantly
4 alters the meaning.

5 Applicant refers to page 4, line 23 to Page 5, line 2 ; page 6, lines 3-7;
6 and page 6, lines 15-21 of the original written description and argues that
7 these sections “make[] it clear that ‘diameter’ is the dimension of concern.”
8 Amended Appeal Br., p. 8-9. However, we fail to see how those sections
9 suggest that the values 1 ½ and 2 refer to diameter rather than to pitch. Our
10 reading of those sections indicates that they are neutral on the matter. They
11 shed no light one way or the other.

12 Lastly, applicant argues that a feature expressed in terms of inches
13 would not be compatible with the definition of “pitch.” Amended Appeal
14 Br. p. 9-10. Thus, applicant specifically argues:

15 It is almost difficult to imagine the giant proportions of
16 threads having pitches of 1 - 2 inches and, in any event,
17 such monstrous threads could not be incorporated into a
18 tank having a 55 gallon capacity and/or a motor designed
19 to accommodate such a tank.

20 Amended Appeal Br., p. 10.

21 This argument presumes knowledge of the level of skill in the art
22 which is not supported by facts introduced into the record. Applicant has
23 not directed us to the parts of the record or presented other evidence showing
24 that one skilled in the art would understand the “tank” to have a 55 gallon
25 capacity. Our review of the original specification does not reveal any
26 disclosure which indicates the size of the “tank.” Nor has applicant directed
27 us to evidence that establishes what thread pitch would be considered
28 unacceptable by those working in the art. Indeed, applicant has not directed

1 us to any evidence demonstrating how one skilled in the art would have
2 understood the original disclosure relating to “pitch” and “diameter.”
3 Applicant, for example, has not submitted declaration evidence explaining
4 how one skilled in the art would understand applicant’s original disclosure.⁵
5 *Cf. In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1584 (Fed. Cir.
6 1996). On the other hand, the Examiner has referred to extrinsic evidence
7 which shows that “pitch” is a term used in the art and has an accepted
8 meaning. Applicant has responded only with attorney argument. Counsel's
9 argument can not take the place of evidence lacking in the record. *Estee*
10 *Lauder Inc. v. L'Oreal, S.A.*, 129 F.3d 588, 595, 44 USPQ2d 1610, 1615
11 (Fed. Cir. 1997); *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230
12 (CCPA 1978).

13 The Examiner has established, prima facie, that the change of “pitch”
14 to “diameter,” where associated with the specific values 1 ½ and 2 inches,
15 introduced new matter into the disclosure. The subject matter of Claims 3, 4
16 and 17-21 are not supported by the original disclosure. The rejection of
17 Claims 3, 4 and 17-21 under 35 U.S.C. § 112, ¶ 1, is affirmed.

18 **Conclusions of Law**

19 Claims 1, 5-16 and 22-23 have not been shown to be unpatentable
20 under 35 U.S.C. § 112, ¶ 1.

21 Claims 3, 4, and 17-21 are unpatentable under 35 U.S.C. § 112, ¶ 1, as
22 not supported by the original disclosure.

⁵ Our reference to the lack of declaration evidence is not an invitation to submit additional evidence as part of any request for reconsideration or when this application returns to the jurisdiction of the Commissioner of Patents. Any such evidence should have been submitted during the previous prosecution before the Examiner.

1 **Definiteness**

2 **Findings of Fact**

3 F. 39. In response to the Office Action mailed March 7, 2005, applicant
4 filed an amendment cancelling Claim 2. Application 10/438,506, paper
5 entered June 3, 2005, p. 10.

6 F. 40. Claims 3 and 4 depend from Claim 2.

7 F. 41. The amendment did not change the dependency of Claims 3 and 4.

8 F. 42. The Examiner entered a final Office Action rejecting Claims 3 and
9 4 as indefinite. Application 10/438,506, Office Action mailed August 23,
10 2005, p. 2-3.

11 F. 43. Claims 3 and 4 were said to be indefinite because they depended on
12 cancelled Claim 2. Application 10/438,506, Office Action mailed August
13 23, 2005, p. 2-3.

14 F. 44. Applicant submitted an after-final amendment which was not
15 entered. Application 10/438,506, Paper submitted October 24, 2005 &
16 Office Action dated November 1, 2005.

17 F. 45. The after-final amendment, inter alia, tried to change the
18 dependency of Claims 3 and 4 from cancelled Claim 2 to Claim 1.
19 Application 10/438,506, Paper submitted October 24, 2005, p. 7.

20 F. 46. No petition was taken from the Examiner's refusal to enter the after-
21 final amendment.

22 **Issue**

23 The Examiner contends that Claims 3 and 4 are indefinite because
24 those claims depend from a cancelled claim. Applicant contends that the
25 incorrect dependency was corrected by an after final amendment which
26 should have been entered.

1 The issue before us is whether Claims 3 and 4 are unpatentable under
2 35 U.S.C. § 112, ¶ 2, as indefinite

3 **Principles of Law**

4 An applicant must particularly point out and distinctly claim the
5 subject matter which the applicant regards as the invention. 35 U.S.C.
6 § 112, ¶ 2. Claims may be written in dependent form. 35 U.S.C. § 112, ¶ 3.
7 A dependent claim incorporates by reference the subject matter of the claim
8 or claims from which it depends. 35 U.S.C. § 112, ¶ 4. Whether a claim is
9 indefinite requires a determination whether those skilled in the art would
10 understand what is claimed when the claim is read in light of the
11 specification. *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470,
12 28 USPQ2d 1190, 1194 (Fed. Cir. 1993). A claim is indefinite under § 112,
13 ¶ 2, if it is “insolubly ambiguous, and no narrowing construction can
14 properly be adopted.” *Exxon Research & Eng'g Co. v. United States*, 265
15 F.3d 1371, 1375, 60 USPQ2d 1272, 1276 (Fed. Cir. 2001);

16 **Analysis**

17 The Examiner correctly noted that Claims 3 and 4 depend on
18 cancelled Claim 2. Dependent claims incorporate by reference the subject
19 matter of the claims from which they depend. 35 U.S.C. § 112, ¶ 4. Since
20 Claim 2 has been cancelled the subject matter to be incorporated by
21 reference from that claim is not specified. Therefore, a person skilled in the
22 art would not be able to know what exactly applicant regards as the
23 invention. Therefore, Claims 3 and 4 are insolubly ambiguous. Claims 3
24 and 4 are indefinite.

25 Applicant does not assert that the claims are definite. Rather applicant
26 argues that the problem was corrected by the after-final amendment filed
27 October 25, 2005. However, the Examiner did not enter the amendment on

1 the grounds that the amendment introduced new matter. Applicant responds
2 that the amendment did not include new matter and, in any event, the
3 amendment correcting the dependency should have been entered.

4 Applicant should have petitioned the Examiner's refusal to enter the
5 amendment. 37 CFR § 113(a). The correctness of the Examiner's refusal is
6 not before us. We have neither statutory nor delegated authority to address
7 the matter. Claims 3 and 4 remain dependent on cancelled Claim 2 and are
8 indefinite

9 **Conclusion of Law**

10 Claims 3 and 4 are indefinite and unpatentable under 35 U.S.C. § 112,
11 ¶ 2.

12 **Decision**

13 The rejection of Claims 1, 5-16 and 22-23 under 35 U.S.C. § 112, ¶ 1,
14 is reversed.

15 The rejection of Claims 3, 4 and 17-21 under 35 U.S.C. § 112, ¶ 1, is
16 affirmed

17 The rejection of Claims 3 and 4 under 35 U.S.C. § 112, ¶ 2 is
18 affirmed.

19 No time period for taking any subsequent action in connection with
20 this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

21

22

AFFIRMED IN-PART

23

24

25

26 smt

Appeal 2007-0516
Application 10/438,506

1 CYNTHIA S. MURPHY
2 RENNER, OTTO, BOISELLE & SKLAR, LLP
3 NINETEENTH FLOOR
4 1621 EUCLID AVENUE
5 CLEVELAND, OH 44115-2191