

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE E. KOCHANOWSKI

Appeal No. 1998-1782
Application No. 08/472,332¹

ON BRIEF

Before STAAB, NASE, and CRAWFORD, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 14 and 19 through 21. Claims 15 and 16 have been allowed. Claims 17 and 18 have been

¹ Application for patent filed June 7, 1995. According to the appellant, the application is a continuation-in-part of Application No. 08/119,291, filed September 8, 1993, now U.S. Patent No. 5,442,870, issued August 22, 1995.

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withdrawn from consideration under 37 CFR § 1.142(b) as being
drawn to a nonelected invention.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a reflective sign. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's brief.

The references of record relied upon by the examiner in rejecting the appealed claims are:

Eskilson 1929	1,719,602	July 2,
Kochanowski 1995	5,442,870	Aug. 22,

Claims 4 through 14 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 appellant regards as the invention.

Claims 1 and 2 stand rejected under the judicially created doctrine of double patenting over claim 1 of Kochanowski.

Claims 1 through 14 and 19 through 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Eskilson.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 12, mailed August 28, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellant's brief (Paper No. 11, filed July 23, 1997) and reply brief (Paper No. 13, filed October 28, 1997) for the appellant's arguments thereagainst.

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

The indefiniteness rejection

We sustain the rejection of claims 4 through 14 under 35 U.S.C. § 112, second paragraph.

The examiner determined (answer, p. 4) that claims 4 through 14 were indefinite because "it is not clear how the gap can be formed between the face member, the back member, and the side wall" as recited in lines 12-13 of claim 4.

The appellant did not contest this rejection (see brief, pp. 4-5). Instead, the appellant requests sufficient time to amend claim 4 with language to resolve this issue.

Since the appellant has not contested the examiner's determination that claims 4 through 14 are indefinite, we are constrained to sustain the rejection under 35 U.S.C. § 112, second paragraph, because the appellant has not pointed out how the examiner erred in rejecting those claims.

The double patenting rejection

We sustain the rejection of claims 1 and 2 under the judicially created doctrine of double patenting.

The examiner determined (answer, p. 5) that claims 1 and 2 were rejectable under the judicially created doctrine of double patenting over claim 1 of Kochanowski and that a terminal disclaimer in compliance with 37 CFR § 1.321 would overcome the rejection.

The appellant did not contest this rejection (see brief, pp. 5-6). Instead, the appellant requests sufficient time to file a terminal disclaimer to overcome this rejection.

Since the appellant has not contested the examiner's determination that claims 1 and 2 are obvious over claim 1 of Kochanowski, we are constrained to sustain the rejection the judicially created doctrine of double patenting because the appellant has not pointed out how the examiner erred in rejecting those claims.

The anticipation issue

We will not sustain the rejection of claims 1 through 14 and 19 through 21 under 35 U.S.C. § 102(b) as being anticipated by Eskilson.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

All the claims under appeal recite a retro-reflective sign including "a single layer face member incorporating information therein."

The appellant argues (brief, pp. 6-8 and reply brief, pp. 1-2) that the above-noted limitation is not readable on Eskilson's reflector 12. The examiner argues (answer, pp. 7-8) that the above-noted limitation is readable on Eskilson's reflector 12.

The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d

760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

In resolving the issues raised by the appellant and the examiner, it is necessary for us to determine the meaning of the term "information" as used in the phrase "a single layer face member incorporating information therein." It is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). In applying this guidance, we conclude that the appellant has used the term "information" as synonymous with "indicia" and thus conclude that the term "information" means identifying marks (e.g., letters, symbols).

In applying this definition to the teachings of Eskilson, we conclude that Eskilson's reflector 12 does not incorporate "information" since it does not incorporate any identifying marks.

Since all the limitations of claims 1 through 14 and 19 through 21 are not found in Eskilson, the decision of the examiner to reject claims 1 through 14 and 19 through 21 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4 through 14 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 1 and 2 under the judicially created doctrine of double patenting is affirmed; and the decision of the examiner to reject claims 1 through 14 and 19 through 21 under 35 U.S.C. § 102(b) is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPLICATION NO. 08/472,332

APJ NASE

APJ STAAB

APJ CRAWFORD

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 11 Mar 99

FINAL TYPED: