

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GREGORY S. HILL,  
JEFFERY L. HILL,  
and  
ROBERT J. BRETL

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Appeal No. 1999-0956  
Application No. 08/584,084

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ON BRIEF

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Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.  
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 28-53. Claims 54-61, the only other claims currently pending in the application, have been withdrawn from further consideration pursuant to 37 CFR § 1.142(b) as not being readable on the elected invention.

Appellants' invention pertains to an apparatus for folding a card carrier form along preweakened fold lines. Independent

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claims 28, 39, and 48 are illustrative of the subject matter on appeal. A copy of the appealed claims can be found in Appendix A to appellants' brief.<sup>1</sup>

The following reference has been relied upon by the examiner as evidence of anticipation:

Labombarde	2,857,827	Oct. 28, 1958
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Claims 28-53 stand rejected under 35 U.S.C. § 112, second paragraph, "as being indefinite" (answer, page 5) and/or "as being incomplete" (answer, pages 8-10).

Claims 28-53 stand rejected under 35 U.S.C. § 112, first paragraph, "as based on a disclosure which is not enabling and does not comply with the written description requirement" (answer, page 2).

Claims 28-31 and 33-35 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Labombarde.

Reference is made to appellants' main and reply briefs (Paper Nos. 13 and 15) and to the examiner's answer (Paper No. 14) for the respective positions of appellants and the examiner regarding the merits of these rejections.

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<sup>1</sup>Appendix A also includes a copy of claims 54-61, which, as noted above, have been withdrawn from consideration pursuant to 37 CFR § 1.142(b).

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The 35 U.S.C. § 112, second paragraph, rejection

We shall consider first the rejection under 35 U.S.C. § 112, second paragraph, because any analysis of claims rejected under both the first and second paragraphs of 35 U.S.C. § 112 should begin with the determination of whether the claims satisfy the requirements of the second paragraph. *In re Moore*, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The test for compliance with the second paragraph of § 112 is "whether the claim language, when read by a person of ordinary skill in the art in light of the specification, describes the subject matter with sufficient precision that the bounds of the claimed subject matter are distinct." *In re Merat*, 519 F.2d 1390, 1396, 186 USPQ 471, 476 (CCPA 1975). In other words, does a claim reasonably apprise those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994).

The examiner's first reason for rejecting the claims under 35 U.S.C. § 112, second paragraph, is that the phrase "means for guiding the leading end section to move in a second direction" in claim 28, in combination with other claim limitations,

is indefinite since it is unclear what part of the leading end section moves in a second direction. (emphasis added). As such, the claims misleadingly

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define the whole leading end section to move in such a second direction relative to the first direction in which the middle and lagging end sections move in. As shown in FIGS. 5A and 5B, the leading end section 35 does not merely *move in a second direction* but pivot[s] about [the] first fold line. [Answer, page 5.]

We do not agree with the examiner that claim 25 is misleading. While the claim terminology describing the manner in which the leading end section moves is somewhat broad, breadth does not automatically render the claim indefinite. *In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971). In the present instance, we consider that the content of claim 28 can be reasonably understood, notwithstanding the breadth thereof. Thus, the examiner's first reason for rejecting the claims under 35 U.S.C. § 112, second paragraph, is not well taken.

The examiner's second reason for rejecting the claims under 35 U.S.C. § 112, second paragraph, is that, according to the examiner, the limitations "means for defining a fold path" and "means for folding the leading end section over the first side of the middle section" in claim 39 contradict one another because they misleadingly imply that these "means" are distinct from one another. The examiner takes a similar position with respect to the "means for folding" and "means for flipping" limitations of claim 48.

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We do not share the examiner's concerns in this matter. While we appreciate that the structures disclosed in the specification that correspond to the above mentioned "means" share certain common elements,<sup>2</sup> there is no *per se* rule prohibiting what is, in effect, the double recitation of such common elements. *Palmer v. United States*, 423 F.2d, 316, 320, 163 USPQ 250, 253, adopted 165 USPQ 88 (Ct. Cl.), *cert. denied*, 400 U.S. 951 (1970)("[D]ouble recitation of elements of combination inventions does not necessarily render a claim vague and indefinite, particularly if the claim is drafted in terms of means clauses under 35 U.S.C. § 112, or if an element performs more than one function or overlapping functions.") See also, *In re Knowlton*, 481 F.2d 1357, 1368, 178 USPQ 486, 494 (CCPA 1973); *In re Kelley*, 305 F.2d 909, 914, 134 USPQ 397, 401 (CCPA 1962).

We also appreciate that claim 48 does not state when the leading end section faces in the first direction, and when it faces in the second direction in the course of being flipped. However, we do not agree with the examiner that this circumstance renders the claimed subject matter unascertainable. Instead, the claim is simply broad, which is not to be equated with

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<sup>2</sup>For example, stopping element 156 is involved in both the folding and flipping of the carrier form.

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indefiniteness. *In re Miller*, 441 F.2d at 693, 169 USPQ at 600.

Another reason relied upon by the examiner in rejecting the claims under 35 U.S.C. § 112, second paragraph, is that claims are, in the examiner's view, "incomplete" for omitting essential elements or essential cooperative relationships of elements, such omissions amounting to gaps between the elements and their necessary structural connections. For example, the examiner notes (answer, page 8) that claim 28 omits folding of the lagging end section and middle section together along the second fold line, which folding function the examiner considers to be essential for producing card packages.

This reasoning is not persuasive because the examiner has not established that the elements and/or cooperative relationships omitted from the claim are regarded *by appellants* as being essential to the invention. In this regard, the specification may not be used as evidence that the scope of the claims is inconsistent with the subject matter which appellants regard as their invention. *In re Ehrreich*, 590 F.2d 902, 906, 200 USPQ 504, 508 (CCPA 1979). Also relevant is the following statement of the court in *In re Borkowski*, 422 F.2d 904, 909, 164 USPQ 642, 645-46 (CCPA 1970):

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The examiner's approach to determining whether appellants' claims satisfy the requirements of [the second paragraph] of § 112 appears to have been to study appellants' disclosure, to formulate a conclusion as to what he (the examiner) regards as the broadest invention supported by the disclosure, and then to determine whether appellants' claims are broader than the examiner's conception of what "the invention" is. We cannot agree that § 112 permits of such an approach to claims. The first sentence of the second paragraph of § 112 is essentially a requirement for *precision and definiteness* of claim language. If the scope of subject matter embraced by a claim is clear, *and if the applicant has not otherwise indicated that he intends that claim to be of a different scope*, [emphasis added] then the claim does particularly point out and distinctly claim the subject matter which the applicant regards as his invention. [Footnotes deleted.]

In that the examiner has not directed us to anything in contentions and admissions found, for example, in briefs or remarks filed by appellants that indicate that the claims do not correspond to that which appellants regard as their invention, the examiner's position is not well founded. *See Manual of Patent Examining Procedure* § 2172 (7<sup>th</sup> ed., Rev. 1, February 2000).

In light of the foregoing, we shall not sustain the rejection of claims 28-53 under 35 U.S.C. § 112, second paragraph.

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The 35 U.S.C. § 112, first paragraph, rejection

In rejecting the appealed claims under 35 U.S.C. § 112, first paragraph, the examiner states (answer, page 2):

. . . [The claims are] based on a disclosure which is not enabling and does not comply with the written description requirement. The following is critical or essential to the practice of the invention, but not included in the claim(s). . . [Thus, the claims are] not enabled nor adequately described by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The enablement and written description requirements of 35 U.S.C. § 112, first paragraph, are separate and distinct. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). In the present instance, the examiner's rejection is based, at least in part, on both the enablement and written description requirements of the statute. We shall therefore consider both requirements in reviewing this rejection.

Insofar as the enablement requirement 35 U.S.C. § 112 is concerned, the dispositive issue is whether appellants' disclosure, considering the level of ordinary skill in the art as of the date of appellants' application, would have enabled a person of such skill to make and use the *claimed* invention without undue experimentation. *In re Strahilevitz*, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). As to the written description requirement, the test for determining compliance

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therewith is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventors had possession at that time of the later *claimed* subject matter, rather than the presence or absence of literal support in the specification for the claim language. *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983). Thus, in both instances, the focus is on the *claimed* invention.

The examiner's first reason for rejecting the claims applies to claims 28-47. The examiner considers that

[t]he specification defines and provides an enabling disclosure for a sheet folded along first and second respective fold lines to constitute . . . a package while the claims merely define a sheet folded along a single first fold line. [Answer, page 3.]

This reason clearly does not apply to independent claim 39, and the claims that depend therefrom, because claim 39 expressly sets forth means for folding a carrier along first and second fold lines. As to independent claim 28, while we appreciate that this claim does not include means for folding the carrier form about a second fold line, the examiner has not established that folding about a second fold line has been stated by appellants as being critical or essential to the practice of the invention. In this regard, we note that the "principal object" of the invention

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is to provide a card package production system "for *multiple types of carriers*" (emphasis added, specification, page 2) and that, consistent with appealed claim 28, original claim 28 also did not require means for folding the carrier form about a second fold line. These disclosures undercut the examiner's position and indicate to us that appellants from the outset did not consider folding about the second fold line to be critical. For these reasons, the examiner's first reason for rejecting the claims is not persuasive.

The examiner's second reason for rejecting the claims applies to claims 28-38. The examiner considers that

the specification fails to disclose how a leading end section can move in a second direction transverse to a first direction while "the leading end, middle and lagging end sections" move in the same first direction. Clearly[,] the leading end section merely pivots about the first fold line . . . . In order for the leading end section to move in a direction transverse to the direction that the middle and lagging end sections move in, as defined by the claim[s], the leading end section would clearly have to be disconnected from the middle and lagging end sections. [Answer, pages 3-4.]

During prosecution, independent claim 28 was amended to recite that the "means for guiding the leading end section" moves the leading end section in a second direction "transverse to" the first direction of movement of the leading end, middle and lagging end sections. It appears from the examiner's second

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reason for rejecting the claims that the examiner considers claim 28 as amended to require the leading end section to bodily shift in its entirety crosswise relative to the first direction of movement. In our view, this interpretation of "transverse to" is strained and fails to take into account the well established maxim that claim language must be read in light of the specification as it would be interpreted by one of ordinary skill in the art.<sup>3</sup> Unlike the examiner, we do not consider the meaning of the word "transverse" added by amendment to claim 28 to be inconsistent with the pivoting movement of the leading end section as it moves about the first fold line.<sup>4</sup> Instead, we view the description of the motion of the leading end section as being "transverse" (i.e., crosswise) to the first direction of movement as being merely another, *albeit* somewhat broader, way of setting forth the motion of the leading end section as it pivots about the first fold line. Because our view of the *claimed* subject matter differs fundamentally from that of the examiner, we cannot

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<sup>3</sup>See, for example, *In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

<sup>4</sup>The word "transverse" may mean "situated or lying across: crosswise." *Webster's II New Riverside University Dictionary*, Riverside Publishing Co., copyright © 1984 by Houghton Mifflin Co.

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support the examiner's position that the original disclosure does not enable and/or provide descriptive support for the subject matter of amended claim 28.

The examiner's third reason for rejecting the claims applies to claims 48-52. The examiner considers that

[b]ecause the specification defines multiple means cooperating to accomplish the claimed multiple functions [e.g., folding about first and second fold lines, or folding and flipping the form] while the claims define distinct means to accomplish the claimed multiple functions the claims are directed to an invention distinct from that disclosed and, thus, do not satisfy the written description requirement.  
[Answer, page 4.]

Once again, the examiner's reasoning in support of the rejection is based on an interpretation of the claims with which we do not agree. While the examiner appears to take the position that the claim terminology requires the means for folding about the first fold line and the means for folding about the second fold line (claim 39), and the means for folding and the means for flipping (claim 48), to be separate and distinct entities with no common elements, we view the claims as encompassing within their metes and bounds means that may have certain elements in common. *See Palmer v. United States*, 423 F.2d at 320, 163 USPQ at 253; and *In re Kelley*, 305 F.2d at 916, 134 USPQ at 402 (fact that structural elements performing more than one function are common

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to mechanisms which are recited separately in claims does not prevent claims from being sufficiently supported by the disclosure, the governing consideration is not double inclusion, but rather what is a reasonable construction of claim language). In our view, when the claim language is given a reasonable construction, the original disclosure both enables and provides descriptive support for the claimed subject matter. Hence, the examiner's third reason in support of the rejection also is not well taken.

In light of the foregoing, we shall not sustain the rejection of claims 28-53 under 35 U.S.C. § 112, first paragraph.

*The anticipation rejection*

In rejecting independent claim 28 as being anticipated by Labombarde, the examiner has determined that Labombarde discloses "a device for folding a work piece" (answer, page 11), and that the reference device comprises means for supporting, moving, guiding, and folding the work piece that correspond to the various means called for in the body of claim 28. With respect to the preamble recitations of claim 28, the examiner states the following:

. . . [I]t has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the

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preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). In regard to the alleged folding about a second fold line recitations, such limitations on which applicant relies are not stated in the applied claims. [Answer, page 25.]

It is thus apparent that in rejecting claim 28 as being anticipated by Labombarde, the examiner has largely disregarded the preamble recitation of the claim.

Claim 28 is drafted in "the improvement comprising" format, a claim format expressly provided for in 37 CFR § 1.75(e)(1998). Paragraph (e) of the rule reads as follows (with emphasis added):

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order:

(1) [a] preamble comprising a general description of all the elements or steps of *the claimed combination* which are conventional or known,

(2) [a] phrase such as "wherein the improvement comprises," and

(3) [t]hose elements, steps[,] and/or relationships which constitute that portion of *the claimed combination* which the applicant considers as the new or improved portion.

Hence, by operation of rule, claim 28 is drawn to a *combination*, namely, *the combination* generally recited in the preamble, with the portion of the claim following the transitional "improvement

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comprising" phrase denoting those elements of *the claimed combination* which appellants consider to be new or improved.

Based on the claim format appellants have chosen to use, the examiner's attempt to read the preamble recitations out of claim 28 is not appropriate. This is so because 37 CFR § 1.75(e) indicates that in an "improvement comprising" claim, the portion of the claim following the preamble is *not* a self-contained description of the structure being claimed, and the subject matter described in the body of the claim *does* depend for completeness upon the introductory (preamble) clause. Accordingly, we view claim 28 as being drawn not merely to a "device for folding a work piece," as urged by the examiner, but rather to "a card package production system" that is capable of producing the specialized "card packages" described in the preamble of the claim.

Turning to Labombarde, we note that the device disclosed therein is a "mechanism for folding the leading flaps of a plurality of flat articles such as box blanks advancing individually and successively along the paper line of a folding machine" (column 1, lines 15-18). The operation of a representative embodiment of Labombarde's mechanic is illustrated in Figure 1-5, wherein it can be seen that when the leading end

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of flap 36 of a box blank encounters folding finger 50, the flap is folded over a trailing portion of the box blank as the folding finger rotates about its axis. Labombarde is silent as to the remainder of the "paper line" into which the folding mechanism is apparently incorporated. Looking at Labombarde in a light most favorable to the examiner's point of view, it reasonably appears that the mechanism disclosed in Labombarde corresponds to those parts of the claimed "system" set forth in the body of claim 28. However, the question of whether the Labombarde mechanism is capable of producing card packages of the type called for in the preamble of claim 28 simply has not been addressed by the examiner.

Where the PTO has a *reasonable basis* for concluding that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. *In re Swinehart*, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971). Here, however, the examiner has not provided any evidence or logical reasoning, and none is apparent to us, as to why the mechanism of Labombarde is capable

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of functioning in the manner called for in the preamble of claim 28. This being the case, the examiner has not met his initial burden of establishing a *prima facie* case of anticipation.

In light of the foregoing, we shall not sustain the rejection of claim 28, or claims 29-31 and 33-35 that depend therefrom, as being anticipated by Labombarde.

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Summary

Each of the examiner's rejections is reversed.

The decision of the examiner finally rejecting claims 28-53  
is reversed.

REVERSED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
	)	
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	

LJS:hh

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