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Ex parte Oetiker No. 88-3256

U.S. Patent and Trademark Office Board of Patent Appeals and Interferences

Decided May 30, 1990 Reconsidered December 20, 1990

Released January 14, 1992

United States Patents Quarterly Headnotes

**PATENTS**

[1] Patent construction -- Specification and drawings -- Defining terms (Section 125.1103)

Patent construction -- Claims -- Defining terms (Section 125.1305)

Words in claim are generally not limited in their meaning to what is shown in disclosure, especially in non-chemical cases; thus, "pan-shaped depression" is not required to be broad and shallow, and is not required to have flat bottom, as shown in drawing of subject application.

**PATENTS**

[2] Patentability/Validity -- Obviousness -- In general (Section 115.0901)

Test for obviousness-type double patenting is not whether claims in one case are broader than claims in another case; instead, test is whether claimed invention in subject application would have been obvious from subject matter of claims in other case in light of prior art.

**PATENTS**

[3] Patentability/Validity -- Specification -- Claim adequacy (Section 115.1109)

Claim language which states that depression means is "relatively shallow," without any guidelines in specification to enable one skilled in art to distinguish claimed structure from structures in which depression means is not relatively shallow, is indefinite; language stating that depression means encompasses "substantial" portions of length and width of bridging part is also indefinite, since "substantial" is term of degree, and specific-

ation lacks guidelines necessary when such term is used.

**PATENTS**

[4] Patentability/Validity -- Specification -- Claim adequacy (Section 115.1109)

Applicant's assertion that person skilled in art "would clearly know" what claim language "relatively shallow" means, when read in light of specification, is not sufficient to demonstrate that such term is not indefinite, since arguments of counsel cannot take place of evidence.

**PATENTS**

[5] Patentability/Validity -- In general (Section 115.01) Arguments pertaining to patentability of claims over prior art are irrelevant in view of rejection of claims as indefinite, since if no reasonably definite meaning can be ascribed to certain terms in claim, subject matter does not become obvious.

**PATENTS**

[6] Patentability/Validity -- Specification -- In general (Section 115.1101)

Compliance with 35 USC 112, second paragraph, is not to be treated lightly, since public interest is involved, in that definiteness of claims allows others who wish to enter marketplace to ascertain boundaries of protection that are provided upon issuance of patent.

Appeal from examiner's rejection of claims 1 through 29 (Kenneth J. Dorner, supervisory primary examiner, L. Cranmer, examiner).

Application for patent filed Oct. 23, 1986, by Hans Oetiker, serial no. 922,408, a continuation of serial no. 622,764, filed June 20, 1984 (deformable ear for clamps). From rejection of claims, applicant appeals. Examiner's rejections reversed; new ground of rejection entered.

Paul M. Craig, Jr., Washington, D.C., for appellant.

Before McCandlish, Pate, and Staab, examiners-in-chief.

Progressive Exhibit 2008  
Liberty Mutual v. Progressive  
CBM2012-00002

McCandlish, examiner-in-chief.

This appeal is from the examiner's rejection of claims 1 through 29, which are all of the claims in the application.

Appellant's invention is directed to a clamping band for a hose or other object. The band is of the type having a deformable, radially outwardly offset portion which appellant refers to in his specification and brief as an "Oetiker ear." The claimed invention is directed to im-

Oetiker (Oetiker '463)	3,789,463	Feb. 5, 1974
Oetiker (Oetiker '584)	4,237,584	Dec. 9, 1980
Oetiker (Oetiker '012)	4,299,012	Nov. 10, 1981

The claims stand rejected as follows:

1. Claims 1, 16, 17 and 18 are rejected under [35 U.S.C. 102\(b\)](#) as being anticipated by Oetiker '012.
2. Claim 19 is rejected under [35 U.S.C. 103](#) as being unpatentable over Oetiker '012 alone.
3. Claims 2 through 7 and 10 are rejected under [35 U.S.C. 103](#) as being unpatentable over Oetiker '012 in view of Oetiker '584.
4. Claims 8 and 9 are rejected under [35 U.S.C. 103](#) as being unpatentable over Oetiker '012 in view of Oetiker '584 as applied in the rejection of claim 6 above, and further in view of Oetiker '463.
5. Claims 11, 12 and 24 through 29 are rejected under [35 U.S.C. 103](#) as being unpatentable over Oetiker '012 in view of Oetiker '463.
6. Claims 1 through 7, 16 and 17 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being "unpatentable over claims 8, 7, 2, 1 of copending application serial no. 922,473" (answer, page 6).
7. Claims 18 and 19 are also provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over "claims 4, 3, 2, 1 of copending application serial no. 922473"

provements in the ear.

Claim 1 is representative of the appealed subject matter. A copy of this claim, as it appears in appellant's brief, is appended hereto.

The examiner relies upon the following references in support of his rejections of the appealed claims:

Feb. 5, 1974
Dec. 9, 1980

(answer, page 6).

8. Claims 14, 15 and 20 are also provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over "claims 6, 2, 1 of copending application serial no. 992,473" (answer, page 7).

In addition to the foregoing rejections carried forward from the final office action (Paper No. 2), the following new grounds of \***1653** rejection have been entered in the examiner's answer:

1. Claim 13 is rejected under [35 U.S.C. 103](#) as being unpatentable over Oetiker '012 in view of Oetiker '463.
2. Claims 21 through 23 are provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over "claims 6, 2, 1 of copending application serial no. 922,473 in view of Oetiker ('584)" (answer, page 8).

[1] Considering first the [Section 102](#) rejection of claims 1 and 16, we cannot agree with appellant that the claimed subject matter distinguishes from Oetiker '012 by reciting that the depression means has a generally pan-shaped configuration. According to its dictionary definition, <sup>FNI</sup> a pan is "a metal, earthenware, or plastic container (as a warming pan, dustpan, dishpan) for domestic use that is usu. [and hence, not necessarily] broad, shallow and open. . ." Thus, when the claim lan-

guage is given its broadest reasonable interpretation as required in *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983), a pan-shaped depression or depression means is not even required to be broad and shallow and certainly is not required to have a flat bottom as shown in the drawings of the subject application. Instead, especially in non-chemical cases, such as the case at bar, the words in a claim are generally not limited in their meaning to what is shown in the disclosure. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 622 (CCPA 1970).

Moreover, rather than just defining the configuration as being pan-shaped, claim 16 more broadly recites that the depression means is *generally* pan-shaped. Thus, when this claim language is given its broadest reasonable interpretation, it reads on the depression 17 shown in Figure 15 of Oetiker '012. The mere fact that the depression 17 in Oetiker '012 may have been described or labeled as “a groove” does not establish a distinction between the structure shown in the reference and the claim limitation that the depression means is of generally pan-shaped configuration.

With further regard to the Section 102 rejection of claims 1 and 16, appellant argues that Oetiker '012 does not disclose that the depression means is relatively shallow. However, for reasons stated *infra* in our new rejection under 37 C.F.R. 1.196(b), no reasonably definite meaning can be ascribed to this limitation as well as to the limitation referring to the “non-reinforced condition” of the bridging part. It therefore is not possible to apply the prior art to claims 1 and 16 in deciding the question of patentability without requiring speculation as to what these limitations mean.

Accordingly, we are constrained to reverse the examiner's Section 102 rejection of claims 1 and 16, as well as the Section 102 rejection of claims 17 and 18, which are directly or indirectly dependent from claim 16, under the holding in *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). For the same reasons we are constrained to reverse the examiner's Section 103 rejection of claims 2 through 9 and 11 through 13, all of which are directly or indirectly dependent from claim 1, as well as the Section 103 rejection of claim 19, which depends from claim 18. As will be discussed *infra* in our

new rejection under 37 C.F.R. 1.196(b), claims 2 through 9, 11, 13 and 19 contain additional indefinite language which precludes us from applying the prior art in determining the question of obviousness.

Regarding the Section 103 rejection of claim 10, to the extent that the subject matter encompassed by this claim is understandable, we cannot sustain the examiner's rejection thereof. Apparently conceding that Oetiker '012 does not disclose the claimed angular relationship of the connecting portions to the bottom portion of the depression means, the examiner relies upon Figure 4 of Oetiker '584 for a teaching of the subject matter added by claim 10. However, Figure 4 and the other relevant illustrations in Oetiker '584 are simply too vague to determine whether the angle of the connecting portions differ from a right angle by no more than about 20 degrees as called for in claim 10. Furthermore, the specification in Oetiker '584 contains no disclosure of the feature defined in claim 10. Accordingly, the examiner has failed to make out a *prima facie* case of obviousness with respect to claim 10.

Turning now to the Section 103 rejection of claim 24, the recitation that the depression means is generally pan-shaped does not distinguish the claimed subject matter from Oetiker '012 for reasons discussed *supra* with respect to claims 1 and 16. However, claim 24 contains other language which, for reasons stated *infra* in our new rejection under 37 C.F.R. 1.196(b), is considered to be indefinite to preclude us from applying the prior art for determining the question of obviousness under Section 103. Accordingly, we are constrained to reverse the examiner's Section 103 rejection of claim 24, as well as the Section 103 rejection of dependent claims 25 through 27 and 29, under the holding in *In re Steele*, *supra*. As indicated *infra*, claims 25 through 27 and 29 contain additional indefinite language which \*1654 precludes us from resolving the question of obviousness under Section 103.

As for the Section 103 rejection of dependent claim 28, to the extent that the subject matter encompassed by this claim is understandable, we cannot sustain the examiner's rejection thereof. Neither Oetiker '012 nor Oetiker '463 teaches or even remotely suggests the concept of

providing the bridging portion with concavely curved sides as defined in claim 28.

Turning now to the double patenting rejection of claims 1 through 7 and 14 through 20, the examiner relies solely upon the subject matter of claims 1, 2, 7 and 8 in appellant's copending application Serial No. 922,473 to support his rejection. In particular, the examiner's position is that claims 1 through 7 and 14 through 20 in the subject application are broader than what the examiner refers to as "claims 8, 7, 2, 1" of the aforesaid copending application (see pages 6 and 7 of the answer).

Appellant does not dispute the examiner's contention that claims 1 through 7 and 14 through 20 are broader than the subject matter covered by claim 8 (which because of the dependency of claim 8, includes the subject matter of claims 1, 2 and 7). Instead, appellant correctly points out that the subject matter of the claims in the subject application are drawn to the subcombination of the deformable ear structure while the claims in the copending application are drawn to the combination of the ear structure and other elements including the hook means for interconnecting the ends of the clamping band.

We have carefully considered the issues raised by the foregoing double patenting rejection of claims 1 through 7 and 14 through 20. As a result of our review, we conclude that this double patenting rejection cannot be sustained. Our reasons follow.

[2] The test for obviousness-type double patenting is not whether the claims in one case are broader than claims in another case. Instead, the test is whether the claimed invention in the subject application would have been obvious from the subject matter of the claims in the other case (in this instance, appellant's copending application Serial No. 922,473) in light of the prior art. See *In re Longi*, 774 F.2d 1100, 225 USPQ 645 (Fed. Cir. 1985).

In the present case, the examiner has neglected to make any findings as to the differences between the subject matter of claims 1 through 7 and 14 through 20 in the subject application and the subject matter encompassed

by claim 8 of appellant's copending application. In the present case, it is evident that the claims in appellant's copending application differ from claims 1 through 7 and 14 through 20 in the subject application by reciting, *inter alia*, the hook means for closing the clamping band. The examiner has cited no prior art whatever for showing that this difference amounts to an obvious modification of the invention defined in claims 1 through 7 and 14 through 20. For these reasons, the double patenting rejection of claims 1 through 7 and 14 through 20 cannot stand.

We also cannot sustain the examiner's double patenting rejecting of claims 21 through 23 based upon the subject matter of claims 6, 2 and 1 of appellant's aforementioned copending application taken with Oetiker '584. There is nothing in Oetiker '584 to show that the addition of the cold-deformed and tab-like hooks, which are defined in claim 1 of the copending application, to the subject matter of claims 21 through 23 of the subject application would have amounted to an obvious modification of the invention defined in claims 21 through 23 of the subject application.

Under 37 C.F.R. 1.196(b), the following new ground of rejection is entered against the appealed claims:

Claims 1 through 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite and hence failing to particularly point out and distinctly claim the subject matter which appellant regards as his invention. With respect to the independent claims, namely claims 1, 16 and 24, our first difficulty stems from the recitation that the depression means occupies some area of the bridging portion in its "non-reinforced condition." It is not clear from appellant's specification what is meant by the "non-reinforced condition." Certainly, there is no antecedent basis in each of the independent claims for the recitation of the "non-reinforced condition." The claims simply fail to define what the non-reinforced condition is.

With further reference to independent claims 1 and 16, our next difficulty with the claim language stems from the recitation that the depression means is "relatively shallow" (emphasis added). The term "relatively", as

discussed in our decision in appellant's copending application Serial No. 922,479 (Appeal No. 88-3440), is a term of degree. When a word of degree is used, such as the term “relatively”, it is necessary to determine whether a specification provides some standard for measuring that degree. See *Seattle Box Company, Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 221 USPQ 568 (Fed. Cir. 1984).

[3]\*1655 In the present case, there are no explicit guidelines in appellant's specification to enable one skilled in the art to distinguish the claimed structure from structures in which the depression means is not relatively shallow. Absent such guidelines, we are of the opinion that a skilled person would not be able to determine the metes and bounds of the claimed invention with the precision required by the second paragraph of Section 112. See *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

With further regard to claim 1, our next difficulty with the claim language resides in the recitation that the depression means encompasses “substantial portions of the length and width of the bridging part. . . .” The word “substantial” as used in this instance is also a word of degree for which we find no standard or guidelines in appellant's specification to enable one skilled in the art to distinguish the claimed structure from structures in which the depression means encompasses a portion of the bridging part that is not substantial. Again, absent such guidelines we are of the opinion that a skilled person would be unable to determine the metes and bounds of the claimed invention in evaluating the possibility of infringement and dominance. See *In re Hammack*, *supra*.

With further reference to claim 1, the use of the term “substantial” in the phrase “so that the total area of said depression means is a substantial portion of the area of the bridging part” is subject to the same criticism outlined *supra* with respect to the recitation of “substantial portions of the length and width of the bridging part. . . .” Once again, we find no guidelines or standard in appellant's specification to determine if a given portion of the area of the bridging portion constitutes a “*substantial* portion” (emphasis added).

All things considered, because a patentee has the right to exclude others from making, using and selling the invention covered by a United States letters patent, the public must be apprised of what the patent covers, so that those who approach the area circumscribed by the claims of a patent may more readily and accurately determine the boundaries of protection in evaluating the possibility of infringement and dominance. See *In re Hammack*, *supra*.

Referring again to claim 24, this claim is further indefinite in that the depression means appears to be twice claimed. It is first referred to as a “pan-shaped depression means” and next referred to as “a respective depression means.” Likewise, the bottom portion of the depression means appears to be twice claimed in that the claim refers first to “a bottom portion” and then to “a respective bottom portion.” Still further, there are no guidelines in appellant's specification to enable one skilled in the art to determine what constitutes a “major portion” of the length of the bridging portion and what constitutes a portion less than a “major portion.”

Dependent claims 2 through 15 are subject to the same deficiencies discussed *supra* with respect to claim 1. Dependent claims 3 and 11 are further indefinite in that there are no guidelines in appellant's specification to enable one skilled in the art to distinguish bottom portions that are “at least nearly flat” from bottom portions that are not at least nearly flat. Also, there are no guidelines in appellant's specification to enable one skilled in the art to distinguish “a substantial part” of the length of the bottom portion from a part that is less than substantial.

Dependent claims 4, 5, and 23 are also rendered indefinite by reciting that the radii of curvature of the corners are “relatively small.” Again, there are no guidelines in appellant's specification to enable one skilled in the art to distinguish relatively small radii of curvature from those radii of curvature that may be something other than relatively small.

As for dependent claims 6, 7, 15, 17, and 25, the phrase “non-reinforced condition” is indefinite for reasons discussed *supra* with respect to the independent claims.

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