

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORG BURKHART,
ROLF-DIETER LANGENHAGEN and ANDREAS WEIER

Appeal No. 2002-2241
Application 09/548,294

ON BRIEF

Before GARRIS, WARREN and POTEATE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

ORDER VACATING ORAL HEARING

On March 31, 2003, Mr. Craig R. Feinberg, a Program and Resources Administrator of the Board of Patent Appeals and Interferences, informed appellants' counsel, Mr. Mark W. Russell, that the Merits Panel assigned to this application had decided to reverse the decision of the examiner. Mr. Feinberg further informed Mr. Russell that therefore, the Oral Hearing scheduled for March 18, 2003, will be vacated.

Accordingly, as counsel was informed on March 31, 2003, it is ORDERED that the Oral Hearing scheduled for 1:00 PM on April 2, 2003, is *VACATED*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner, in the answer, and appellants, in the brief and reply brief,

and based on our review, find that we cannot sustain the rejection of appealed claims 5 and 6¹ under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.²

It is well settled that the examiner must consider *all* claim limitations in determining whether the claimed invention as defined by *all* of the claim limitations of the claim complies with any and all applicable statutory provisions. *See, e.g., In re Geerdes*, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791-92 (CCPA 1974) (In considering grounds of rejection under 35 U.S.C. §§ 103 and 112, “*every* limitation in the claim must be given effect rather than considering one in isolation from the others.”). In the present appeal, we agree with appellants (e.g., brief, page 6 third paragraph) that the examiner has ignored the claim limitation “where the siloxane block copolymer has ≤ 600 Si atoms.” Thus, while certain formula members, separately and severally, would appear to render appealed claims 5 and 6 open-ended and thus indefinite, the clear limitation on the number of silicon atoms in said limitation assures that these claims are indeed closed and thus definite with respect to the encompassed siloxane block copolymer.

Accordingly, since the examiner has failed to establish a *prima facie* case of indefiniteness under § 112, second paragraph,³ we reverse the ground of rejection.

¹ See the amendments of April 12, 2000 (Paper No. 2) and February 28, 2002 (Paper No. 16). We observe that the clerical entry of the latter amendment with respect to appealed claim 5 is incomplete. Also of record are claims 12 and 13 which have been objected to by the examiner, and claims 7 through 12 and 14 through 24 which have been withdrawn from consideration by the examiner under 37 CFR § 1.142(b).

² Answer, pages 3-4.

³ *See In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992), *citing In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984) (“As discussed in *In re Piasecki*, the examiner bears the initial burden, on review of the prior art *or on any other ground*, of presenting a *prima facie* case of unpatentability. [Emphasis supplied.]”).

The examiner's decision is reversed.

Reversed

BRADLEY R. GARRIS
Administrative Patent Judge

CHARLES F. WARREN
Administrative Patent Judge

LINDA R. POTEATE
Administrative Patent Judge

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