

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 18

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte RAYMOND KEITH FOSTER  
and  
SCOTT DELAMARTER

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Appeal No. 2003-0534  
Application No. 09/650,014

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ON BRIEF<sup>1</sup>

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Before COHEN, McQUADE, and NASE, 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 to 11. Claims 12 to 27, the only other claims pending in this application, have been allowed.

We REVERSE.

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<sup>1</sup> On April 15, 2003, the appellants waived the oral hearing (see Paper No. 17) scheduled for June 11, 2003.

### BACKGROUND

The appellants' invention relates to a reciprocating slat conveyor having a first set of slats for conveying a load and a second set of slats for lifting and holding the load while the set of conveying slats retract (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1 to 11 stand rejected under 35 U.S.C. § 112, second paragraph, for being incomplete.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (Paper No. 12, mailed November 8, 2002) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 11, filed October 29, 2002) and reply brief (Paper No. 13, filed December 11, 2002) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we will not sustain

the rejection of claims 1 to 11 under 35 U.S.C. § 112, second paragraph, for the reasons which follow.

Under 35 U.S.C. § 112, second paragraph, a specification shall conclude with one or more claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." Determining whether a claim is indefinite requires an analysis of "whether one skilled in the art would understand the bounds of the claim when read in light of the specification. . . . If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, [section] 112 demands no more." Miles Lab., Inc. v. Shandon Inc., 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993), cert. denied, 114 S. Ct. 943 (1994); see also Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987).

The examiner's basis (answer, p. 3) for the rejection of claims 1-11 under 35 U.S.C. § 112, second paragraph, for being incomplete is as follows:

The preamble of claims 1-11 indicates that the invention is a slat conveyor not a portion of a slat conveyor. The disclosed slat conveyor has vertically movable slats 10 that lift the load and horizontally movable slats 12 that move the load horizontally. The cooperation of the two types of slats conveys the load. If only one type of slat were to be used, the load would not be conveyed along the slats but would only sit in the same location on the slat. However, there is no mention of the horizontally movable conveyor slats 12 in the claims. The conveying slats 12 must be claimed along with the combination in the claims for the claimed

structure to operate as a slat conveyor. The structure currently claimed will not function as a slat conveyor because the article will only be moved vertically to and from its original position on the lifting slats, which is not conveying.

The appellants argue (brief, pp. 4-8; reply brief, pp. 2-3) that claims 1 to 11 are definite as required by the second paragraph of 35 U.S.C. § 112. The appellants assert that it has long been held that it is entirely consistent with the claim definiteness requirement to present claims reciting only one or more elements of the invention. Thus, it is not necessary that a claim recite each and every element needed for the practical utilization of the claimed subject matter. See Carl Zeiss Stiftung v. Renishaw plc, 945 F.2d 1173, 1181-82, 20 USPQ2d 1094, 1101 (Fed. Cir. 1991); Bendix Corp. v. United States, 600 F.2d 1364, 1369, 204 USPQ 617, 621 (Ct. C. 1979).

The examiner chose not to further respond to the argument of the appellant raised in the brief (see answer, p. 3).

In our view, claims 1 to 11 are definite as required by the second paragraph of 35 U.S.C. § 112 for the reasons adequately set forth by the appellants in the briefs. While claims 1 to 11 do not specifically claim conveyor slats, these claims do reasonably apprise one skilled in the art of the metes and bounds of the claimed subject matter. In fact, the examiner has not set forth any explanation of why these

claims do not reasonably apprise one skilled in the art of the metes and bounds of the claimed subject matter. Accordingly, claims 1 to 11 comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11 under 35 U.S.C. § 112, second paragraph, is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

JOHN P. McQUADE  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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