

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte WOLFGANG BAYER, ANDREAS BERCHTOLD,  
THOMAS BOCK, HARALD LESTI and XAVER BACHMEIR

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Appeal No. 2004-0622  
Application No. 09/875,602

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1-4 and 6-11, which are all of the claims pending in this application.

We REVERSE and enter new grounds of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a doctor blade device which can remove excess water from the soft surface of a printing machine roller without damaging the roller surface and without removing an ink layer possibly adhering to it (specification, page 4). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Laverick	4,632,030	Dec. 30, 1986
Bock (British patent specification)	1,381,941	Jan. 29, 1975

The following rejections are before us for review.

Claim 11 stands 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 appellants regard as their invention.

Claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bock.

Claims 7-11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Laverick in view of Bock.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 15) for the examiner's complete reasoning in support of the rejections and to

the brief and reply brief (Paper Nos. 14 and 16) for the appellants' arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

#### *The indefiniteness rejection*

The examiner contends that the language "said plate cylinder reaches said nip" and "said roller reaches said nip" in claim 11 renders the claim indefinite "since it has no meaning" (answer, page 3). On page 5 of the answer, the examiner explains that

[i]t is clear that the language has no meaning when seen in view of the drawing and the specification since the plate cylinder or the roller can never reach the nip before or upstream relative to the applying point of the dampening medium or ink on the surface of a cylinder. To one of ordinary skill in the art, the language appears to state that the plate cylinder and the ink applicator roller can be moved toward or away from each other. However, this is not appellant's invention, and thus the meaning of the language is unclear.

Initially, we note that the purpose of the second paragraph of Section 112 is to basically insure, with a **reasonable** degree of particularity, an **adequate** notification of the metes and bounds of what is being claimed. See In re Hammack, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). When viewed in light of this authority, we

cannot agree with the examiner that the metes and bounds of claim 11 cannot be determined because of the language criticized by the examiner. A degree of **reasonableness** is necessary. As the court stated in In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of Section 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis ours; footnote omitted.]

Here, while the language “before said plate cylinder reaches said nip” and “before said roller reaches said nip” is perhaps inarticulate, inasmuch as the plate cylinder and applicator roller, as arranged as illustrated in appellants’ drawing, both have a surface portion which is always located at the nip and other surface portions which are not located at the nip and thus always “reach the nip,” it cannot seriously be contended that one of ordinary skill in the art would not understand that claim 11 recites a dampening unit for applying said dampening medium to a portion of said plate cylinder upstream of said nip and an inking unit for applying ink to a portion of said ink applicator roller upstream of said nip. Thus, in our opinion, the language alluded to by the examiner in rejecting claim 11 does not in fact render claim 11 indefinite. Accordingly, we shall not sustain this rejection.

*The prior art rejections*

We shall not sustain the examiner's rejections of claims 1-4 and 6 under 35 U.S.C. § 102 as being anticipated by Bock and claims 7-11 under 35 U.S.C. § 103 as being unpatentable over Laverick in view of Bock. For the reasons expressed below in the new ground of rejection under 35 U.S.C. § 112, second paragraph, these claims are indefinite. Therefore, the prior art rejections must fall because they are necessarily based on speculative assumption as to the meaning of the claims. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

NEW GROUNDS OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we make the following new grounds of rejection.

Claims 1-4 and 6-11 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim what appellants regard as their invention.

Each of independent claims 1 and 7 recites a doctor blade having an edge which contacts the soft surface of a roller, said edge having an "edge radius" in the range of 2 mm to 10 mm. The term "radius" is generally understood in the geometric sense to mean "any straight line extending from the center to the periphery of a circle or sphere"

or “the length of such a line.”<sup>1</sup> Appellants’ reference to an “edge radius” would thus lead one of ordinary skill in the art to conclude that the doctor blade of appellants’ invention has a curved edge, with “edge radius” referring to the radius of curvature of such curved edge. That the doctor blade has a curved edge appears to be confirmed on page 7 of appellants’ specification, which refers to “an approximately circularly arcuate doctor blade edge 22 placed against the surface 6 of the ink applicator roller 2.”<sup>2</sup> Appellants’ specification, however, defines “edge radius” on page 4 as “the cross sectional width of the edge surface which [is] placed against the surface of the printing roller.” We recognize that an applicant can be his own lexicographer provided the applicant's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification. Beachcombers Int’l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994). In this instance, however, appellants’ definition, even viewed in light of the remainder of the specification and drawing, fails to paint a clear picture of what an “edge radius” is or how it is to be measured. For example, a doctor blade may have an arcuate blade edge, only a portion of which contacts the surface of the roller when the blade is pressed against the roller. It is thus not clear whether the “edge radius” is the width of the entire arcuate edge or only that portion of the edge which contacts or is “placed against” the surface of

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<sup>1</sup> Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

<sup>2</sup> It is worthy of note, however, that appellants’ drawing figure does not clearly illustrate an arcuate blade edge, inasmuch as the details of edge 22 pressed against the surface 6 of the ink applicator roller cannot be deciphered from the drawing.

the roller. In this regard, it is also unclear what is meant by “cross sectional width.” Inasmuch as a doctor blade is a three-dimensional object, a cross section can be taken in any number of planes, including a plane normal to the axis running through the center of curvature of the arcuate surface and a plane parallel to such axis. Likewise, it is not clear whether a doctor blade having an arcuate blade edge having a width within the claimed range (2 mm to 10 mm) but having only a small portion thereof, less than 2 mm in width, which actually contacts or is placed against the surface of a printing roller, would meet the “edge radius” limitation of claim 1 or claim 7.

For the foregoing reasons, we conclude that one of ordinary skill in the art would not be able to determine from appellants’ underlying disclosure what is meant by “edge radius” as used in independent claims 1 and 7 so as to ascertain the metes and bounds of these claims. Claims 1 and 7 are thus indefinite. Claims 2-4, 6 and 8-11 depend from claims 1 and 7 and are likewise indefinite.

Claims 1-4 and 6-11 are rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which fails to adequately disclose the invention so as to enable one of ordinary skill in the art to make and/or use the invention.

For the reasons discussed above in the new rejection under 35 U.S.C. § 112, second paragraph, one of ordinary skill in the art would not be able to determine from appellants’ underlying disclosure what is meant by “edge radius” and thus would not be able to make the claimed invention.

### CONCLUSION

To summarize, the decision of the examiner to reject claim 11 under 35 U.S.C. § 112, second paragraph, claims 1-4 and 6 under 35 U.S.C. § 102 and claims 7-11 under 35 U.S.C. § 103 is reversed and new grounds of rejection of claims 1-4 and 6-11 under 35 U.S.C. § 112, first and second paragraphs, are entered pursuant to 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b), which provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
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JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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Appeal No. 2004-0622  
Application No. 09/875,602

Page 10

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