

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

This opinion (1) was not written for publication and (2) is not binding precedent of the Board.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 KUNIAKI ONO

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Appeal No. 95-2783  
Application 08/026,504<sup>1</sup>

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HEARD: 5 May 1998

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Before HAIRSTON, TORCZON, and CARMICHAEL, Administrative Patent Judges.

TORCZON, Administrative Patent Judge.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

FINDINGS OF FACT

We have reviewed the record in its entirety in light of the arguments of Appellant and the examiner. Our decision presumes familiarity with the entire record. A preponderance of the evidence of record supports each of the following fact findings.

A. The nature of the case

1. This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1-5. (Paper 12 (Not. App.)) No other

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<sup>1</sup> Attorney docket no. A29339.

claims are pending. (Paper 7 at 1.) We affirm subject to a statement pursuant to 37 CFR § 1.196(c).

2. The application on appeal was filed on 4 March 1993. (Paper 1 at 1.) Appellant claims the benefit of Japanese kokai Hei4-070863. (Paper 1, Comb. Decl.; Paper 2.) Fuji Photo Optical K.K. is the real party in interest.

3. The application is entitled "Zoom lens optical system". The subject matter of the invention "relates to a zoom lens optical system provided with an optical path splitting means for splitting a light beam, which has passed through a negative film, into light beams following optical paths heading towards a printing section and a photometric section." (Paper 1 at 1.) In particular, the specification details a

zoom lens optical system [that] satisfies the conditions

$$\begin{aligned} 1.2 fw < f1 < 2.4 fw & \dots (1) \\ 0.4 fw < f3/f2 < 0.8 fw & \dots (2) \end{aligned}$$

where fw is a number equal to the minimum focal length of the whole system in millimeters, f1 represents the composite focal length of the first-lens set, f2 represents the composite focal length of the second-lens set, and f3 represents the composite focal length of the third-lens set.

(Paper 1 at 3-4 (amendments included).) For the appeal, Appellant has amended claim 1 to state formula (2) in words as follows:

. . . wherein the zoom lens optical system satisfies the conditions

1.2 fw < f1 < 2.4 fw ... (1)  
[0.4 fw < f3/f2 < 0.8 fw ... (2)]

and the ratio of f3 to f2 is between 0.4 and 0.8 times  
fw, . . .

(Unnumbered paper (Subst. Amdt. After Final) at 1-2, filed 22  
Sep. 1994.)

B. The rejection

4. There is no reference-based rejection before us.  
Instead, the examiner has rejected the claims under section 112.  
Specifically, the examiner finally rejected claim 1 as vague and  
indefinite because

the equation --  $0.4 fw < f3/f2 < 0.8 fw$  -- does not  
make sense because [if] fw, f2, [and] f3 are in  
millimeters then the first and the third expression[s]  
are in millimeters; meanwhile, the second expression  
(f3/f2) is dimensionless since (millimeters/milli-  
meters) is dimensionless. Therefore, they are of  
incomparable units.

(Paper 7 at 2.) On appeal, the examiner has also rejected  
claim 1 for lack of an enabling disclosure for the same reason  
that the examiner considers it indefinite. (Paper 14 at 4.)

5. Claims 2-5 depend from, and thus share the defect and  
the rejection of, claim 1.

6. The Appellant argues (Paper 15 (Reply) at 2), and we  
agree, that the basis for the new ground of rejection is  
essentially the same as the basis for the indefiniteness  
rejection.

7. We find that the examiner is technically correct that  
formula (2) as written and claimed does not make sense. The

after-final amendment does not solve the problem or improve the clarity of the claim.

#### CONCLUSIONS OF LAW

##### A. Indefiniteness

1. Claims must reasonably apprise those skilled in the art both of the use and the scope of the invention, and their language must be as precise as the subject matter permits. Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 624, 225 USPQ 634, 641 (Fed. Cir. 1985). An examiner must permit applicants wide latitude in claiming subject matter as they see fit, but the examiner must work to ensure that claims are as clear and precise as possible.

2. In the case before us, it seems unlikely that one skilled in the art would miss Appellant's intent. At the same time, neither Appellant nor the examiner were able to arrive at language that would eliminate the technical inaccuracy. Consequently, the claims are not as precise as the subject matter allows.

3. At the hearing, we discussed the following formulation with counsel for Appellant:

$$0.4 \text{ fw/mm} < f3/f2 < 0.8 \text{ fw/mm}$$

where the first and third terms are divided by millimeters, the unit for fw, so that all of the expressions are now

dimensionless. Counsel indicated to us that this formulation would be acceptable. Unfortunately, procedurally the only way we can ensure entry of this amendment is to affirm the rejection with a statement pursuant to Rule 196(c).

4. In affirming this rejection, we do not mean to indicate satisfaction with the way prosecution was handled below. This appeal was unnecessary, will burden the public with a later termination date for the resulting patent, has cost Appellant and other applicants (who subsidize most of the cost of each appeal) a considerable sum, and has contributed to the Board's backlog. This is not the way the system is intended to work. This result could have been avoided if the examiner and Appellant had worked together instead of digging into their respective positions. In particular, the Manual of Patent Examining Procedure recommends a practice that would have avoided this appeal:

Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

MPEP § 2173.02. Once it became apparent that Appellant did not understand the point of the rejection, the examiner should have helped out by offering acceptable language. The fact that the examiner was able to apply prior art against claim 1 (Paper 4 at 3) strongly suggests that the examiner understood what Appellant meant to claim. See MPEP § 2173.06.

B. Enablement

5. Since our affirmance of the indefiniteness rejection disposes of all claims on appeal, we need not separately reach the merits of the enablement rejection. Moreover, the stated Rule 196(c) amendment will cure the problem underlying this rejection.

DECISION AND RULE 196(c) STATEMENT

The examiner's rejection of claims 1-5 under section 112 as indefinite is affirmed. Claims 1-5 may be allowed if claim 1 is amended to recite the formula (2) element as follows:

"0.4 fw/mm < f3/f2 < 0.8 fw/mm".

We set a time period in which Appellant may file an amendment for the purpose stated in section 1.196(c) to expire two months from the date of this decision. No time period for taking subsequent

action in connection with this appeal may be extended under  
37 CFR § 1.136(a). 37 CFR § 1.136(b).

AFFIRMED; RULE 196(c)

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
RICHARD TORCZON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	

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