

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* PAUL E. MOODY

---

Appeal No. 97-3198  
Application No. 08/502,408<sup>1</sup>

---

ON BRIEF

---

Before CALVERT, ABRAMS and PATE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal from the decision of the examiner finally rejecting claims 1-3, which constitute all of the claims remaining of record in the application.

The appellant's invention is directed to a high-torque quiet gear. The subject matter before us on appeal is

---

<sup>1</sup> Application for patent filed July 14, 1995.

Appeal No. 97-3198  
Application No. 08/502,408

illustrated by reference to claim 1, which has been reproduced in an appendix to the Brief.

**THE REFERENCES**

The references relied upon by the examiner to support the final rejection are:

Gribben 1930	1,785,812	Dec. 23,
Kiser, Jr. (Kiser) 1978	4,078,445	Mar. 14,

**THE REJECTIONS**

Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Gribben.

Claims 1-3 stand rejected under 35 U.S.C. § 103 as being unpatentable over Gribben in view of Kiser.

The rejections are explained in the Examiner's Answer.

The opposing viewpoints of the appellant are set forth in the Brief.

**OPINION**

*New Rejections By The Board  
of Patent Appeals and Interferences*

Appeal No. 97-3198  
Application No. 08/502,408

At the outset, pursuant to our authority under 37 C.F.R. § 1.196(b), we enter the following new rejections:

(1) Claims 1-3 are rejected under 35 U.S.C. § 112, first paragraph, as the specification does not contain a description of the invention as presently set forth in the claims.

Claim 1 recites an inner hub having a plurality of circumferentially spaced elongated arms extending radially outwardly, an outer ring member having a plurality of circumferentially spaced elongated teeth extending radially inwardly and received in the spaces between the elongated arms, and a relatively incompressible elastomeric member received in space between the side surfaces of the arms and the teeth. The opposed adjacent side surfaces of the arms and the teeth extend substantially parallel to one another. The relationship between the arms and the teeth further requires "said arms and said teeth intermeshing substantially entirely along an entire length of said side surfaces" (emphasis added), and this gives rise to the problem under the first paragraph of Section 112.

The limitation quoted above was added by the first amendment (Paper No. 3). It was not present in the original

Appeal No. 97-3198  
Application No. 08/502,408

claims, nor does it appear in the specification. With regard to the relationship between the opposed side surfaces of adjacent arms and teeth, the specification teaches only that they "at least partially overlap" (pages 4 and 6; emphasis added), which clearly provides no support for "substantially entirely." Some degree of overlap is shown in the drawing, but no amplifying information is provided from which the percent of overlap shown can be determined. Thus, from the original disclosure, there is no support for the phrase in issue, that is, one of ordinary skill in the art receives no guidance in the specification with regard to the meaning to be attached to "substantially entirely" along an entire length.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991). Here, we are of the view that the original disclosure does not meet this requirement with regard to the "substantially entirely" limitation later added by the

Appeal No. 97-3198  
Application No. 08/502,408

appellant, and therefore does not satisfy the written description requirement of 35 U.S.C. § 112, first paragraph.

(2) Claims 1-3 also are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in that they fail to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Because a patentee has the right to exclude others from making, using and selling the invention covered by the patent (35 U.S.C. 154), the public must be apprised of exactly what the patent covers, so that those who would approach the area circumscribed by the claims of a patent may readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. It is to this that the second paragraph of 35 U.S.C. 112 is directed. See *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). It is our view that the phrase "substantially entirely along an entire length of said side surfaces," which appears in independent claim 1, is indefinite.

As we pointed out above with regard to the rejection under the first paragraph of Section 112, the original

Appeal No. 97-3198  
Application No. 08/502,408

disclosure of the appellant's invention does not include this language. The only clue provided in the specification as to the extent of overlap of the opposed sides of the arms and teeth in the appellant's invention is that they "at least partially overlap" (pages 4 and 6). This not only is not synonymous with "substantially entirely" but is, in our view, contradictory thereof, which fuels the issue of what constitutes "substantially entirely." Turning to the common definitions of these two words does not alleviate the situation.<sup>2</sup> When a word of degree is used in a claim, the specification must provide some standard for measuring that degree, so that one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. See *Seattle Box Co., Inc. V. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 824, 221 USPQ 568, 574 (Fed. Cir. 1984). In the present case, it is our view that one of ordinary skill in the art would not be so taught.

---

<sup>2</sup> "Substantially" is defined as considerable in quantity, but not wholly, and "entirely" means largely, but not the full extent, Merriam Webster's Collegiate Dictionary, Tenth Edition, 1996, pages 1174 and 386.

Appeal No. 97-3198  
Application No. 08/502,408

Thus, it is our view that the metes and bounds of the appellant's claims cannot be determined. This is illustrated by considering that the appellant has urged that the Gribben arrangement displays a 50-60 percent overlap and thus does not fall within the scope of the invention as recited in the claims (Brief, page 6), even though such an overlap clearly falls within the "at least partially overlap" scope of the invention as described in the specification. How much intermeshing of arms and gears is necessary to fall within the scope of claim 1 is indeterminable to one of ordinary skill in the art from the record before us.

*The Examiner's Rejections*

When no definite meaning can be ascribed to certain terms in a claim, the subject matter does not become unpatentable, but rather the claim becomes indefinite. See *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Since it is clear to us that considerable speculation and assumptions are necessary to determine the metes and bounds of what is being claimed, and since a rejection cannot be based upon speculation and assumptions, we are constrained not to sustain

Appeal No. 97-3198  
Application No. 08/502,408

the examiner's rejections. See *In re Steele*, 309 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to point out, however, that this action should not be construed as an indication that the claimed subject matter would have been patentable over the prior art cited against the claims. We have not addressed that issue, for to do so would require on our part the very speculation which formed the basis of our rejection under the second paragraph of Section 112.

Appeal No. 97-3198  
Application No. 08/502,408

**SUMMARY**

The rejection of claims 1 and 2 under Section 102(b) is not sustained.

The rejection of claims 1-3 under Section 103 is not sustained.

New rejections of claims 1-3 have been entered under the first and second paragraphs of Section 112.

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) 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 the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new

Appeal No. 97-3198  
Application No. 08/502,408

ground 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, 1.196(b)**

PATENT

IAN A. CALVERT	)	
Administrative Patent Judge)	)	
	)	
	)	
NEAL E. ABRAMS	)	BOARD OF
Administrative Patent Judge)	)	APPEALS AND
	)	INTERFERENCES

Appeal No. 97-3198  
Application No. 08/502,408

)  
)  
WILLIAM F. PATE, III )  
Administrative Patent Judge)

Appeal No. 97-3198  
Application No. 08/502,408

Office of Counsel  
Building 112T  
Naval Undersea Warfare Center  
Division Newport  
Newport, RI 02841-1708