

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte OLIVIER FARGES

Appeal No. 1998-2356
Application 08/373,860¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, COHEN and FRANKFORT,
Administrative Patent Judges,

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 19, which are all of the claims in this application.

¹ Application for patent filed January 17, 1995.

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Appellant's invention relates to a lighter than air balloon containing a lighting device.

Independent claim 1 is representative of the subject matter on appeal and a copy of that claim, as reproduced from the Appendix to appellant's brief, is attached to this decision.

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

Martin	2,619,303	Nov. 25, 1952
Mack	3,546,944	Dec. 15, 1970
Moran	3,745,677	July 17, 1973
Goddard	3,839,631	Oct. 1, 1974
Rosenblatt et al. (Rosenblatt)	4,262,529	Apr. 21, 1981
Stockton	4,810,223	Mar. 7, 1989

Claims 1 through 4, 7 and 9 through 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Goddard in view of Stockton.

Claim 8 stands rejected under 35 U.S.C. § 103 as being unpatentable over Goddard in view of Stockton as applied to claim 1 above, and further in view of Mack and Rosenblatt.

Claim 5 stands rejected under 35 U.S.C. § 103 as being unpatentable over Goddard in view of Stockton as applied to claims 1 and 4 above, and further in view of Moran.

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Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Goddard in view of Stockton as applied to claims 1 and 4 above, and further in view of Martin.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 18, mailed December 23, 1997) for the reasoning in support of the rejections and to appellant's brief (Paper No. 17, filed September 29, 1997) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, this panel of the Board has given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we find that we must reverse the examiner's rejections of claims 1 through 19 on appeal under 35 U.S.C. § 103 because we are unable to clearly understand the claimed subject matter due to language which renders the claims indefinite. Our reasons for this determination follow.

Before addressing an examiner's rejections based on prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellant's claims on appeal to derive an understanding of the scope and content thereof.

As set forth in the preamble of claim 1 on appeal the subject matter appellant regards as his invention is “[a] lighter than air balloon enclosing a light source.” Thus, we understand the subject matter of appellant’s claim 1 to be the combination of a lighter than air balloon and a light source contained within the balloon. However, we note that the body of claim 1 additionally sets forth that the balloon is “secured at pole level by a feeder cable,” and that the light source is “supported by a rod, attached to the pole.” These recitations convey the impression that the subject matter on appeal is something more than just the balloon and light source set forth in the preamble of the claim, that is, that the subject matter on appeal is an assembly of components apparently including a balloon, a light source, a feeder cable, a rod supporting the light source within the balloon and a pole of some type attached to the rod and supporting the balloon at a certain level above the ground. Accordingly, we find claim 1 to be indefinite since the subject matter defined in the body of the claim is inconsistent with the

invention as set forth in the preamble of the claim. Moreover, we have no idea what the language "at pole level" is intended to mean, since no pole is shown in the drawings of the application or described in the specification.

Regarding dependent claim 4, we see no way that the outer ring-shaped collar (20) can be "locked against the inner and outer collars" as is set forth in lines 5 and 6 of that claim, since such recitation would seem to require the outer collar to be locked to itself. In addition, the recitation in line 8 of claim 4 of "the openings" lacks a clear antecedent basis. In this regard, we note that the detachable plug (30) seen in Figure 2 of the drawings seals the openings in the inner and outer ring-shaped collars (10, 20) and not the openings in the inner and outer envelopes (1, 2) as the claim seems to imply. As for dependent claims 6 and 7, we find the recitation of "plug means" screwed onto or clipped onto one of the collars to be indefinite, since we are not sure as to whether the "plug means" is intended to be the same as or different from the "detachable plug" already set forth in claim 4, from which claims 6 and 7 depend.

In claim 8, the recitation that the outer envelope "comprises a slightly elastic material" is vague and indefinite. Regarding claim 9, is the feeder cable required in this claim the same as or in addition to the feeder cable already set forth in claim 1 on appeal? Moreover, how are the telescopic mast of

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claim 9 and “the pole” of claim 1 related? In claims 11 through 14 and 16 through 18, the use of the term “varies” renders the claimed subject matter indefinite since it is unclear exactly how the “light source power” varies in the manner set forth in these claims, that is, are there a range of light sources that a given balloon can carry, or does the power of a given light source actually vary, e.g., from a few hundred watts up to about 6,500 watts (claim 11).²

Under the provisions of 37 C.F.R. § 1.196(b), we enter the following new ground of rejection against appellant's claims 1 through 19 on appeal:

Claims 1 through 19 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as the invention.

Turning to the examiner's rejections of the appealed claims under 35 U.S.C. § 103, we emphasize again that these claims contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of our new ground of rejection under 35 U.S.C. § 112,

² With regard to the subject matter set forth in claims 1, 4 and 9 on appeal, we direct appellant's attention to 37 C.F.R. § 1.83(a), noting that the drawings of the application “must show every feature of the invention specified in the claims.”

second paragraph. Accordingly, we find that it is not possible to apply the prior art relied upon by the examiner to these claims in deciding the question of obviousness under 35 U.S.C.

§ 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned limitations in the claims. This being the case, we are therefore constrained to reverse the examiner's rejections of claims 1 through 19 under 35 U.S.C. § 103 in light of the holding in In re Steele, 305 F.2d 858, 134 USPQ 292 (CCPA 1962). We hasten to add that this reversal of the examiner's rejections is not based on the merits of the rejections, but only on technical grounds relating to the indefiniteness of the appealed claims³.

In summary, all of the examiner's rejections of the appealed claims under 35 U.S.C. § 103 have

³ As mere guidance to the examiner and appellant, we note that appellant's arguments in the brief (pages 4-7) regarding the combination of Goddard and Stockton appear to be unpersuasive. In the first place, we note that the recitation in independent claim 1 of a light source "having a power up to about 6,500 watts" has no lower limit and thus would read on any light source of less than 6,500 watts, e.g., as in Goddard, which appellant appears to concede is "only about 250 watts (max.)" (brief, page 4). As for the argument that Goddard lacks any teaching of appellant's "effective field of illumination" (brief, page 5), we note that claim 1 on appeal does not specify any effective field of illumination. Regarding appellant's argument on page 7 of the brief concerning suggestion to combine and hindsight, we note that it appear to us that it would have been obvious to one of ordinary skill in the art, based on the teachings of Stockton, to provide the balloon in Goddard with a protective and decorative cover like that seen at (12) in Stockton, thereby protecting the balloon of Goddard and providing the lamp of Goddard with the appearance of a conventional hot air balloon. Appellant has in no way disputed this suggestion or motivation found in Stockton for modifying the lighted balloon of Goddard. On the other hand, the examiner has not accounted for the "pole" recited in claim 1 as being attached to the rod, nor for the telescopic mast set forth in claim 9 on appeal.

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been reversed and a new rejection of claims 1 through 19 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 C.F.R. § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 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 C.F.R. § 1.196(b) provides that, “A new ground of rejection shall not be considered final for purposes of judicial review.”

37 C.F.R. § 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 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. . . .

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

REVERSED, 37 C.F.R. § 1.196(b)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
)	
)	BOARD OF PATENT
)	APPEALS AND
IRWIN CHARLES COHEN)	INTERFERENCES
Administrative Patent Judge)	
)	
)	
)	
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

CEF/dal

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WILLIE KRAWITZ
3001 CHAPEL HILL ROAD
ORANGE, CA 92867

APPENDIX

1. A lighter than air balloon enclosing a light source, comprising a balloon containing helium, the balloon being secured at pole level by a feeder cable, the light source being positioned approximately in the middle of the balloon, the light source having a power up to about 6,500 watts, sufficient helium being employed for cooling purposes, the light source being supported by a rod, attached to the pole, the balloon being characterized by: a thin, flexible, elastic and expandable inner envelope transparent to the outward flow of light and heat radiation without damage to the inner envelope, and impervious to the helium, and an outer envelope surrounding the inner envelope and made of a colored material, with optical properties which enable the outer envelope to receive and diffuse light from the inner envelope, without dazzling a viewer, and providing effective, ground based lighting.