

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS E. POULSEN

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Appeal No. 98-2456  
Application No. 08/748,158<sup>1</sup>

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ON BRIEF

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Before CALVERT, MEISTER 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 10, 14, 18, 23, 24, 27 and 28. Claims 1 through 9, 11 through 13, 15 through 17, 19 through 22, 25 and

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<sup>1</sup> Application for patent filed November 12, 1996. According to appellant, this application is a continuation of Application No. 08/483,281, filed June 7, 1995, now abandoned.

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26, the only other claims remaining in this application, have been allowed. In the examiner's answer (page 3), the examiner has indicated that claim 18 is now also allowed, thus, leaving only claims 10, 14, 23, 24, 27 and 28 for our consideration on appeal.

Appellant's invention is directed to a disposable razor that has a feature to record how many times it has been used. As noted on page 2 of the specification,

[i]n the several embodiments, the disposable razor includes push tabs formed into the handle so that external pressure applied onto a surface of a push tab, as applied with the user's finger or thumb, will cause a portion of the push tab to break away from the remainder of the handle leaving a visible "break line" that will serve to record a single usage. Ideally, the razor handle will be formed of plastic by the plastic injection molding process. In each of the embodiments shown, the handles (if formed of plastic) can be manufactured by the injection molding process in molds that do not require the use of "slides". Slides are a feature necessarily present on some (but not all) plastic injection molds. When slides must be used in an injection mold, the per part manufacturing cost of the item being molded are [sic, is] generally higher.

No prior art references have been applied against the claims before us on appeal.

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Claims 10, 14, 23, 24, 27 and 28 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which appellant regards as his invention. In this regard, it is the examiner's position that

[t]he structure that applicant is attempting to claim by the manufacturing process steps that have been included in the claims is unclear. What structural limitations are being claimed? Are there structural differences between an injection molded device and one that is injection molded without a slide? If so what are they? [final rejection, page 2).

Rather than reiterate the examiner's full explanation of this rejection and the conflicting viewpoints advanced by the examiner and appellant, we refer to pages 2 and 3 of the final rejection (Paper No. 8, mailed March 19, 1997), pages 2 through 4 of the examiner's answer (Paper No. 13, mailed January 13, 1998), appellant's brief (Paper No. 12, filed November 28, 1997) and reply brief (Paper No. 14, filed March 16, 1998) for the full exposition thereof.

OPINION

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In reaching our decision in this appeal, we have 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 will not sustain the examiner's rejection of claims 10, 14, 23, 24, 27 and 28 before us on appeal. Our reasons follow.

After reviewing appellant's specification and claims, and appellant's arguments in the brief and reply brief, it is our opinion that the scope and content of the subject matter embraced by appellant's claims on appeal are reasonably clear and definite, and fulfill the basic requirement of 35 U.S.C. § 112, second paragraph, that they provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. See In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970).

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It is by now well settled that product claims may be drafted to include process steps to wholly or partially define the claimed product, and that to the extent that the process limitations distinguish the claimed product from the prior art, they must be given the same consideration as traditional product characteristics or limitations. See In re Hallman, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981). This type of claim is referred to as a product-by-process claim and, as noted in In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972), does not inherently conflict with the second paragraph of 35 U.S.C. § 112. However, due to the lack of physical description in a product-by-process claim, this form of claim does impose a certain burden with regard to determining the patentability thereof, since in spite of the fact that the claims may recite only process limitations, it is the patentability of the product claimed and not the recited process steps which must be established. Accordingly, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section

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103 of the statute is eminently fair and acceptable. Id. at 688. The rationale for this conclusion is that the Patent and Trademark Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. Thus, this burden is shifted to the appellant in those instances where prior art is applied by the examiner against product-by-process claims and appellant must specifically point out or demonstrate how the process limitations structurally distinguish the claimed product from the product of the prior art, which may be made by a different process.

In the present case, the examiner has not applied prior art against the product-by-process claims before us on appeal. Instead, the examiner has taken the position that the structural limitations imposed on the claimed product by the process limitations are "unclear," and has imposed on appellant the requirement that he (appellant) specifically point out the structural limitations imposed on the claimed product. In particular, the examiner has inquired as to whether there are "structural differences between an injection

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molded device [product] and one that is injection molded [in a mold] without a slide" and, if so, has required appellant to state what they are.

While it is not entirely clear to us exactly what structural limitations or physical characteristics might be imparted to the plastic handle of appellant's razor as a result of being "formed as a single piece in a plastic injection mold" (claim 23) or "formed as a single piece in a plastic injection mold without a slide" (claims 10 and 24), we nonetheless find the examiner's requirement here to be unreasonable. As is apparent from the above-noted case law, appellant is normally only put to the burden of specifying the exact structural limitations imposed on the claimed product by the process limitations when the examiner has applied prior art which teaches, discloses or makes obvious a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim. This the examiner has not done in the present application, since no prior art has been applied by the examiner. Accordingly, we do not see that appellant should be

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put to the onerous task of pointing out the specific structural limitations imposed on the claimed product by the recited process limitations.<sup>2</sup>

Like the Court in In re Hughes, 496 F.2d 1216, 1218, 182 USPQ 106, 108 (CCPA 1974), we do not consider that defining the product of the present application in terms of the process by which it is made makes the language of the claims imprecise or indefinite. Their scope, if anything, is more definite in reciting a novel product made by a specific process, which process would have been fully understood by one of ordinary skill in the art. Thus, we conclude that these claims do not create a definiteness problem under 35 U.S.C. § 112, second paragraph, and for that reason will not sustain the examiner's rejection before us on appeal.

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<sup>2</sup> We are particularly of this view since the examiner has already allowed claims (e.g., claims 2, 3, 9, 16 and 17) which include one or the other of the process limitations questioned by the examiner in the rejection before us on appeal.

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The decision of the examiner rejecting claims 10, 14, 23,  
24, 27 and 28 under 35 U.S.C. § 112, second paragraph, is reversed.

REVERSED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
JAMES M. MEISTER	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	

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