

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK L. BIVENS

Appeal No. 1999-0053
Application 08/714,954¹

ON BRIEF

Before ABRAMS, PATE and McQUADE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Jack L. Bivens appeals from the final rejection of claims 10 through 13, all of the claims pending in the application. We reverse and remand the application to the examiner for

¹ Application for patent filed September 17, 1996. According to appellant, the application is a division of Application 08/521,530, filed August 30, 1995, now Patent No. 5,590,625, issued January 7, 1997.

further consideration.

The invention relates to a two-cycle diesel engine derived from the prior art Detroit Diesel Series 92 Turbo Charged Engine.² The differences between the two involve structural modifications which are said to contribute to advantageous timing characteristics in the appellant's engine. The timing characteristics of the prior art engine are embodied in the timing sequence chart set forth on specification page 11 and in the circle diagram depicted in Figure 9A, while the timing characteristics of the appellant's engine are embodied in the timing sequence chart set forth on specification page 12 and in the circle diagram depicted in Figure 9B. Appealed claims 10 through 13 make use of these charts and diagrams to define what the appellant regards as his invention.³ A copy of

² According to the appellant's specification (see page 6), a review of this prior art engine appears in Detroit Diesel Corporation literature published in October 1988.

³ As the apparent result of a printing error, the timing sequence charts contained in claims 10 and 11 are somewhat garbled, an informality which is deserving of correction in the event of further prosecution before the examiner. For

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claims 10 through 13 appears in the appendix to the appellant's brief (Paper No. 10).

Claims 10 through 13 stand rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Reference is made to the appellant's brief (Paper No. 10) and to the examiner's first Office action and answer (Paper Nos. 3 and 11) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

The examiner's explanation of the rejection indicates that the claims are considered to be indefinite due to the mere inclusion therein of the aforementioned charts and diagrams, especially those relating to the prior art engine, as well as to the particular content of the charts and diagrams.

purposes of this appeal, we assume that the appellant intended the charts in the claims to be identical to the corresponding charts in the specification. Also, given the nature of the charts as embodying the content of Figures 1A through 7A and Figures 1B through 7B, respectively, we assume the reference to "9A" in the "DRAWING #" heading in each chart to be erroneous and thus deserving of deletion in the event of further prosecution.

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The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). It is not apparent,

nor has the examiner cogently explained, why the inclusion in a claim of the sort of charts and diagrams at issue here necessarily runs afoul of this standard. As for the content of the particular charts and diagrams contained in the appealed claims, it again is not apparent, nor has the examiner cogently explained, why the timing characteristics embodied therein are unclear. Although these timing characteristics are functional in nature in that they define the prior art engine and the appellant's engine by what they do rather than by what they are, it is well settled that there is nothing intrinsically wrong with the use of such a technique in drafting patent claims. See In re Swinehart, 439

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F.2d 210, 213, 169 USPQ 226, 228 (CCPA 1971). Also, the limitations in engine claims 10 and 12 drawn to the chart and diagram relating to the prior art engine amount to product-by-process limitations used to define the appellant's engine. Such product-by-process limitations do not inherently conflict with the second paragraph of § 112. See In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). The corresponding limitations in method claims 11 and 13 merely present a starting point for the processes recited therein.

In light of the foregoing, and notwithstanding the somewhat unconventional claim format employed by the appellant, the examiner has not made out a prima facie case that claims 10 through 13 fail to set out and circumscribe a particular area with a reasonable degree of precision and particularity. Therefore, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of these claims.

Finally, the examiner's comments in the first Office

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action and answer raise the issue of a double patenting problem between the appealed claims and the claims in U.S. Patent No. 5,590,625 which matured from parent Application 08/521,530. Since the examiner has never entered a double patenting rejection in the instant application, this issue is not before us on appeal. Given the examiner's concern, however, we remand the application to the examiner for further consideration of this matter.

In summary:

- a) the decision of the examiner to reject claims 10 through 13 is reversed; and
- b) the application is remanded for further consideration of the double patenting issue raised by the examiner.

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REVERSED AND REMANDED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE, III)	
Administrative Patent Judge)	APPEALS AND
)	
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)	
JOHN P. McQUADE)	
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