

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. OPENCHOWSKI, SCOTT A. BEATTY,
ANDREAS M. HAAS, KENNETH F. PACKER and JITEN V. SHAH

Appeal No. 1999-0368
Application 08/636,033

ON BRIEF

Before COHEN, ABRAMS and STAAB, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claim 1. Claims 2-20, the only other claims remaining in the application, have been allowed. Two amendments filed subsequent to the final rejection have been submitted, however, neither has been entered.

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Appellants' invention pertains to a replacement knuckle for use in a railroad car coupler, and in particular to a lightweight knuckle that can be used in an emergency to replace an existing AAR standard knuckle that became damaged during operation and needs replacement. A copy of the appealed claim can be found in an appendix to appellants' brief.

The sole reference of record relied upon by the examiner in support of the final rejection is:

Packer	1,480,863	Jan. 15, 1924
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Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Packer.

The patent to Packer, issued in 1924, discloses an emergency knuckle "particularly designed for use with the many standard types of railway cars couplings which as is well understood are universally made in accordance with the M.C.B. standards" (page 1, lines 18-23). The body or supporting head 1 of the coupler that receives Packer's emergency knuckle "is of a standard modern type . . . having its forward active

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surface of the usual contour conforming to the M.C.B. standards" (page 1, lines 91-95). Packer further states that the emergency knuckle "is formed with the locking jaw 8 of a contour conforming to the M.C.B. standards" (page 2, lines 2-3).

Concerning the operation of Packer's emergency knuckle, a reading of page 2, lines 7-74, of the specification makes clear that the emergency knuckle thereof does not function like the standard knuckle it replaces in all respects. For example, the emergency knuckle has a holding lug 12 and a rearwardly extending arm portion that cooperate with the supporting head 1 of the coupler to prevent the knuckle from rotating, thereby securing the emergency knuckle in operative locked position at all times (page 2, lines 46-54).

Turning to the examiner's rejection of claim 1 as being anticipated by Packer, the examiner found (answer, page 3) that Packer discloses an emergency knuckle having an altered outer shape and core structure, such that it is lighter than the standard coupler knuckle it is designed to replace.

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Concerning the requirement of claim 1 that the emergency knuckle "has functioning parts which are substantially the same as those of an AAR Standard knuckle, such that, when installed, the knuckle can function like an existing AAR Standard knuckle during the coupling and uncoupling operations," the examiner has taken the following position:

. . . The extremely broad language of the claim[] only requires that the [claimed] knuckle . . . be capable . . . of functioning like an existing AAR standard knuckle Since one of the requirements of an existing AAR standard knuckle is to couple [and uncouple] cars . . . the Packer reference can in fact function like an AAR standard knuckle in this regard, because it too couples [and uncouples] cars . . . and thus does "comprise" a device which "can function like" an existing AAR standard knuckle during the coupling [and uncoupling] operation[s] While it may . . . be true that the knuckle of Packer does not perform all of the functions like an AAR standard knuckle . . . this is irrelevant . . . as the claim[] only require[s] that the knuckle . . . be capable of performing "like" [an] AAR standard knuckle in some manner The knuckle of Packer clearly does this by coupling and uncoupling from cars which is in fact a requirement for all AAR standard knuckles. There is no recitation in the claim[] of how much like an AAR standard knuckle the [claimed] knuckle . . . must perform, nor is there any recitation of which specific functions of an AAR standard knuckle the [claimed] knuckle . . . must perform

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[Answer, pages 4-6; emphasis in original.]

Opinion

While the examiner rejects the appealed claim under 35 U.S.C. § 102(b), it is clear from the above quoted portion of the answer that the examiner has encountered substantial difficulty in understanding the meaning and scope of that part of the appealed claim calling for the knuckle to function like an existing AAR Standard knuckle. For reasons stated *infra* in our new rejection pursuant to 37 CFR § 1.196(b), we also have been troubled by the claim language of this portion of the claim. Nevertheless, in this instance, we feel we understand the appealed claim sufficiently to decide the appealed § 102 rejection on the merits.

At the outset, we observe that the initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. If that burden is met, the burden of coming forward with evidence or argument shifts to appellants. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

In the present instance, the appealed claim calls for a

knuckle that (1) has voids and an outer configuration which are different from an existing AAR Standard knuckle, (2) weighs substantially less than such an AAR Standard knuckle, (3) has functioning parts which are substantially the same as those of an AAR Standard knuckle, and (4) functions like an existing AAR Standard knuckle when installed. In rejecting the appealed claim based on Packer, it appears that the examiner has assumed that the "standard" knuckle of Packer's era (e.g., a coupling made in accordance with M.C.B. standards¹) conforms to present day AAR Standards, notwithstanding that Packer is silent on this point.

Appellants disputed this position, and in fact submitted a declaration by co-inventor Scott A. Beatty which states that

the '863 patent to Packer discloses an emergency knuckle 5 which is totally unsuitable for use in a modern or present day AAR Standard E or F type railroad car coupler, since the Packer knuckle 5, unlike a present day AAR Standard knuckle, is provided with an outstanding lug 12 which would certainly not fit or function in a modern AAR Standard E or F type coupler

The examiner has not challenged the facts alleged in the

¹See Packer, page 1, lines 18-25 and 90-95, and page 2, lines 1-3.

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Beatty declaration.

Based on the evidence before us, namely, the Packer reference and the declaration of co-inventor Scott A. Beatty, the standing anticipation rejection cannot be sustained. In a nutshell, the silence in the Packer reference regarding the relationship between the knuckle thereof and present day AAR standards, and undisputed statements in the Beatty declaration in this regard, necessitate reversal of the examiner's anticipation rejection.

New rejection pursuant to 37 CFR § 1.196(b)

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection.

Claim 1 is rejected under 35 U.S.C. § 112, second paragraph, as being vague and indefinite.

The purpose of the requirement stated in the second paragraph of 35 U.S.C. § 112 is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more

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readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance. *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970).

Appealed claim 1 fails to give such "adequate notice" in that it is not possible to determine with any reasonable degree of certainty to what extent a particular knuckle may differ in its function from that of an existing AAR Standard knuckle and still fall within the metes and bounds of the claim. Stated differently, it is not possible to accurately determine the boundaries of protection set forth by the claim language calling for the claimed knuckle to "function like an existing AAR Standard knuckle during coupling and uncoupling operations."

Further, in that the construction of the parts of a railroad knuckle would appear to be dictated by function as opposed to aesthetics, it is not clear what constitutes a functioning part

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of a knuckle as opposed to a non-functioning part. For this reason, the meaning of the term "functioning parts" in line 4 of claim 1 is unclear.

Finally, it is not clear how close in function and/or operation a particular knuckle part must be to its AAR Standard counterpart in order for that particular part to be substantially the same as its AAR Standard counterpart. Therefore, the meaning to the term "substantially the same as those of an AAR Standard knuckle" in lines 4-5 of claim 1 also in unclear.

Remand

In addition to the foregoing, this case is remanded to the examiner for consideration of the following matter.

In the event appellants, in response to our new rejection, amend claim 1 or present a claim modeled thereon that satisfies the requirements of 35 U.S.C. § 112, second paragraph, such that the examiner can accurately determine the metes and bounds thereof, the examiner should consider whether the teachings of Packer, when considered in combination with a present day coupler and knuckle designed in accordance with

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AAR Standards, would render any such new or amended claim unpatentable under 35 U.S.C. § 103.

Summary

The standing rejection of claim 1 under 35 U.S.C. § 102(b) is reversed.

A new rejection of claim 1 pursuant to our authority under 37 CFR § 1.196(b) has been made.

This case is remanded to the examiner to consider the patentability under 35 U.S.C. § 103 of any claim submitted by appellants that overcome our new rejection of claim 1.

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,

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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. . . .

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

REVERSED, 37 CFR § 1.196(b) & REMANDED

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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) BOARD OF PATENT

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