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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte IDAN HAZANI

Appeal 2018-004542
Application 14/726,619
Technology Center 3700

Before JENNIFER D. BAHR, MICHELLE R. OSINSKI, and
BRANDON J. WARNER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Idan Hazani (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 1–4, 12, 14–18, 20, and 22–31. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

THE CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A method for wrist support comprising:
 - providing a strip comprising:
 - a sheet with oppositely disposed ends; and,
 - a plurality of elastic protrusions extending from the sheet in a longitudinal dimension, each of the protrusions of a lateral dimension of of [*sic*] a diameter of approximately 2 mm to 10 mm, the lateral dimension at least substantially perpendicular to the longitudinal dimension, and in an arrangement with the other protrusions to cooperatively support a wrist by providing a resistive force proximate to the corresponding location of the strip where pressure is applied by the wrist, the protrusions of an elasticity greater than the elasticity of the sheet; and,
 - placing the strip in communication with a surface, such that when pressure is applied to the strip from the wrist, the protrusions, proximate to the location of the pressure on the strip, cooperate to provide a resistive force for supporting the wrist.

REJECTIONS

- I. Claims 1–4, 12, 14–18, 20, and 22–29 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.¹

¹ The Examiner's inclusion of claims 5, 13, and 21 in the statement of this rejection on page 5 of the Final Action is presumed to be inadvertent error, as these claims were canceled in the Amendment filed December 29, 2016, and, thus, are not involved in this appeal. We note that the Examiner did not include pending claims 30 and 31, which depend from claim 1, in the statement of this rejection.

- II. Claims 1–4, 20, 22–25, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Chen (US 2002/0157163 A1, pub. Oct. 31, 2002) and Prokop (US 5,566,913, iss. Oct. 22, 1996).
- III. Claims 12, 16–18, and 26–29 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Hsueh (US 5,857,217, iss. Jan. 12, 1999) and Prokop.
- IV. Claim 14 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsueh, Prokop, and Kelly (US 5,418,980, iss. May 30, 1995).
- V. Claim 15 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Hsueh, Prokop, and Chen.

DISCUSSION

Rejection I

For the reasons discussed below in the new ground of rejection, we determine that claims 1–4, 12, 14–18, 20, and 22–31 are indefinite because the meaning of “protrusions of an elasticity greater than the elasticity of the sheet” is unclear. Given that the meaning of this claim limitation is required to assess whether it is adequately supported by the original disclosure of the Specification, we cannot reach a determination as to the correctness of the Examiner’s finding that the limitation lacks adequate written description support sufficient to comply with 35 U.S.C. § 112, first paragraph. *Cf. In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971) (One is not in a position to determine whether a claim is enabled under the first paragraph of 35 U.S.C.

§ 112 until the metes and bounds of that claim are determined under the second paragraph of this section of the statute.).

Accordingly, we do not sustain the rejection of claims 1–4, 12, 14–18, 20, and 22–29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Rejections II–V

Having determined that claims 1–4, 12, 14–18, 20, and 22–31 are indefinite, for the reasons discussed below in the new ground of rejection, we do not sustain the Examiner’s rejections of claims 1–4, 12, 14–18, 20, and 22–31 under 35 U.S.C. § 103(a) because to do so would require speculation as to the scope of the claims. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a), because the rejection was based on speculative assumptions as to the meaning of the claims). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

New Ground of Rejection

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 1–4, 12, 14–18, 20, and 22–31 under 35 U.S.C. § 112, second paragraph, as being indefinite.

In determining whether a claim is definite under 35 U.S.C. § 112, second paragraph, “[t]he USPTO, in examining an application, is obliged to test the claims for reasonable precision.” *In re Packard*, 751 F.3d 1307,

1313 (Fed. Cir. 2014). “As the statutory language of ‘particular[ity]’ and ‘distinct[ness]’ indicates, claims are required to be cast in clear — as opposed to ambiguous, vague, indefinite — terms.” *Id.*

Independent claims 1 and 26 recite, in relevant part, “protrusions of an *elasticity greater than the elasticity* of the sheet.” Appeal Br. 28, 30 (Claims App.) (emphasis added). This language renders the claims indefinite because the meaning of the term “elasticity” is unclear. Namely, it is unclear to what property “elasticity” refers. It is also unclear whether the term refers to a property of the components (i.e., sheet and protrusions) or the materials used to make the components.

Appellant’s Specification describes that “the sheet . . . and the protrusions may be of different materials typically with the sheet a *stiffer material* than that of the protrusions.” Spec. 3, ll. 4–5 (emphasis added). In addressing the Examiner’s written description rejection based on the above-identified limitation, Appellant takes the position that, because the Specification describes the sheet material being “stiffer” than the protrusion material, “it follows that the protrusions are less stiff, and therefore, more flexible and more elastic than the flexibility and elasticity of the sheet.” Appeal Br. 16; *see also* Reply Br. 3 (stating that “[s]tiffness is related to elasticity, as a synonym for ‘stiff’ is ‘inelastic’ and ‘inflexible[,]’ as seen at the underlined portion of Appendix A, a page from www.Dictionary.com for the word ‘[s]tiff”). Appellant appears to suggest that there is an inverse relationship between stiffness, as used in the Specification, and elasticity, as recited in the claims. However, this interpretation creates confusion regarding the meaning of “elasticity,” as used in the claims, because stiffness and elasticity are different properties.

“[S]tiffness is proportional to the modulus of elasticity.” Eugene A. Avallone & Theodore Baumeister III, *Marks’ Standard Handbook for Mechanical Engineers* 8-47 (10th ed. 1996). “The modulus of elasticity, lb/in² (kgf/cm²), is the ratio of the increment of unit stress to increment of unit deformation within the elastic limit.” *Id.* at 5-17 (boldface omitted). In other words, stiffness relates to the ability of a material to resist elastic deformation, and a given material with a higher modulus of elasticity is stiffer than a material with a lower modulus of elasticity. However, the “modulus of elasticity” of a material is not the same as “elasticity” in accordance with its conventional meaning. Elasticity is “the ability of a material to return to its original dimensions after the removal of stresses.” *Id.*

Consistent with this meaning of the term “elasticity,” Appellant’s Specification describes rubber elasticity as providing “a restoring force, which causes the polymer chain to return to its equilibrium or unstretched state, such as a high entropy random coil configuration, once the external force is removed.” Spec. 2, ll. 1–7. On the other hand, however, Appellant’s Specification also describes the sheet and backing of Figure 7 as being “typically more elastic (less rigid) than that of Figure 6.” *Id.* at 7, ll. 25–27. This statement suggests that Appellant’s Specification may be using “more elastic” as a synonym of “less rigid,” or, similarly, “elasticity greater” (as used in claims 1 and 26) to mean lower rigidity or lower stiffness. Given that stiffness and elasticity are two different properties, it is unclear whether Appellant’s use of the term “elasticity” in the claims is intended to mean the ability to resist elastic deformation (i.e., stiffness) or the ability to return to an original state after removing an external force.

It is also unclear whether “elasticity,” as recited in the claims, is a characteristic of the components (i.e., the sheet and protrusions) or the materials used to make the component. Although the Specification describes that the sheet material may be stiffer than that of the protrusions (*see* Spec. 3, ll. 4–5), the claims do not recite the term “material.” Rather, “protrusions of an elasticity greater than the elasticity of the sheet,” as recited in claims 1 and 26, appears to use the term “elasticity” to describe characteristics of the individual components (i.e., the protrusions and sheet).

In light of the above, independent claims 1 and 26 are “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.” *Packard*, 751 F.3d at 1311. Dependent claims 2–4, 12, 14–18, 20, 22–25, and 27–31 inherit this problematic ambiguity. Accordingly, we conclude that claims 1–4, 12, 14–18, 20, and 22–31 are indefinite under 35 U.S.C. § 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention.

DECISION

The Examiner’s decision rejecting claims 1–4, 12, 14–18, 20, and 22–31 is reversed due to the indefiniteness of the claims.

We enter a new ground of rejection of claims 1–4, 12, 14–18, 20, and 22–31 under 35 U.S.C. § 112, second paragraph, as being indefinite.

FINALITY OF DECISION

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of

rejection pursuant to this paragraph shall not be considered final for judicial review.” 37 C.F.R. § 41.50(b) also provides:

When the Board enters such a non-final decision, 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 the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. . . .

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED; 37 C.F.R. § 41.50(b)