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Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO. Includes details for application 10/892,389, inventor Jorg Sames, and attorney HAHN LOESER & PARKS, I.L.P.

Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JORG SAMES

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Appeal 2010-006255  
Application 10/892,389  
Technology Center 3600

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Before: WILLIAM V. SAINDON, JILL D. HILL, and  
JEREMY M. PLENZLER, *Administrative Patent Judges*.

PLENZLER, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 33-42. Claims 1-22 are cancelled and claims 23-32 are withdrawn from consideration. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

## CLAIMED SUBJECT MATTER

Claims 33, 37, and 40 are independent. Claim 33, reproduced below, is illustrative of the claimed subject matter:

33. A pickup apparatus for use with sausage packaging machines having a loop feed means for transporting loops, the pickup apparatus comprising:

a non-rotating pickup having a front end extending downward from a horizontally extending portion;

a moveable pin movable vertically between a first position extending through a transported loop and engaging the pickup front end and a second position distal the pickup front end; and

a torque support positioned about the pickup front end, the torque support selectively engaging the pickup front end,

the moveable pin having a contact surface engaging the pickup front end in such a way that the pickup front end does not bear against the torque support when the moveable pin is in the first position.

## REJECTIONS

1. Claims 33-42 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement;

2. Claims 33-42 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite; and

3. Claims 33 and 35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Jahns (DE 38 06 467; pub. May 11, 1989).

## OPINION

### *Enablement*

The Examiner asserts that

[t]he movement of the loop from positions indicated at 130 to the position at 116 is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention because it is not understood how the loop can cross the torque support means absent interference.

Ans. 3. Appellant challenges the Examiner's enablement rejection of claims 33-42. App. Br. 7-11; Reply Br. 5-6.

When rejecting a claim for lack of enablement, the USPTO bears an initial burden of setting forth a reasonable explanation as to why the Examiner believes that the scope of protection provided by the claim is not adequately enabled. *In re Wright*, 999 F.2d 1557, 1561-62 (Fed. Cir. 1993). The Examiner makes no attempt to explain why it would require undue experimentation for one of ordinary skill in the art to make and/or use the invention. Ans. 3. For example, the Examiner does not address any of the *Wands* factors. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Even if it is not clear from Appellant's disclosure exactly how the loop can cross the torque support means without interference, as the Examiner maintains, it does not necessarily follow that undue experimentation would be required to

make and use the claimed invention. Accordingly, we do not sustain the Examiner's rejection of claims 33-42 as lacking enablement.

*Indefiniteness*

The Examiner asserts that claims 33-42 are indefinite because "the preamble recites a 'pickup apparatus', but it is not set forth what the apparatus does; i.e., what item does it pick up and how?" Ans. 3-4. The Examiner explains that the issue "is that the body of the claims do not recite any structure which operates to perform the function recited in the preamble." Ans. 7. Failure of the body of the claim to recite structure which carries out the purpose recited in the preamble may raise a question as to whether the preamble should be given patentable weight, but it does not make the claim *per se* indefinite.

The Examiner has not identified any ambiguity in the claims that would result in the claims being insolubly ambiguous or that would result in multiple plausible claim constructions. Therefore, we do not sustain the rejection of claims 33-42 as being indefinite.

*Anticipation*

The Examiner finds that Jahns discloses each of the features recited in claims 33 and 35 including "a torque support means (the unlabeled pins adjacent and to the right of pin 13 as seen in figs. 1-2) selectively engaging the pickup front end." Ans. 4. Appellant argues that "[t]he claims distinguish over Jahns by including a torque support positioned about the pickup front end where the torque support selectively engages the pickup front end." App. Br. 12; Reply Br. 7. Appellant explains that "[t]he piston

cylinder units [18] of Jahns engage the main portion of the pickup means” and “do not selectively engage the *downwardly extending front end* of the pickup means.” App. Br. 12; Reply Br. 7-8. In response, the Examiner explains that “the recitation of the ‘pickup having a front end extending downward from a horizontally extending portion’ does not define over Jahns, since the downwardly extending portion of the pickup does not necessarily comprise the entire front end.” Ans. 4.

During examination of a patent application, pending claims are given their broadest reasonable interpretation consistent with the specification. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). While Appellant’s Specification describes an embodiment in which the portion of the front end engaged with the torque support is a downwardly extending portion of the pickup (Spec. paras. [0026], [0032]; figs. 2, 3), we are not constrained to read any such arrangement into claim 33 when Appellant has chosen to claim the invention using broad language, which under the broadest reasonable interpretation, does not require such an arrangement. Appellant does not point to anything other than the claim language itself to support the position that claim 33 requires the *entire* front end to extend downward.

We agree with the Examiner that the claim language “a front end extending downward from a horizontally extending portion,” under its broadest reasonable interpretation, does not require the entire front end to extend downward. Therefore, we also agree with the Examiner’s finding that “the portion of Jahn’s pickup that the torque support means selectively engages is considered to be ‘a front end’ of the pickup (as is apparent from figs. 1-2) . . . even though it is not the downwardly extending portion

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thereof.” Ans. 4-5. Accordingly, we sustain the Examiner’s rejection of claim 33 as being anticipated by Jahns. Claim 35 depends from claim 33 and is not argued separately. Thus, claim 35 falls with claim 33.

#### DECISION

We REVERSE the Examiner’s decision to reject claims 33-42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

We REVERSE the Examiner’s decision to reject claims 33-42 under 35 U.S.C. § 112, second paragraph, as indefinite.

We AFFIRM the Examiner’s decision to reject claims 33 and 35 under 35 U.S.C. § 102(b) as being anticipated by Jahns.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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