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EXAMINER
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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* WAI KUEN FAN and BERNHARD GARTHE

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Appeal 2014-009211  
Application 12/788,700  
Technology Center 3600

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Before ANNETTE R. REIMERS, LISA M. GUIJT, and PAUL J. KORNICZKY,  
*Administrative Patent Judges.*

GUIJT, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134 of the Examiner's decision<sup>2</sup> rejecting claims 1–12, 14, and 16–21. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Appellants identify the real party of interest as Abus August Bremicker Sohne KG. Appeal Br. 3.

<sup>2</sup> Appeal is taken from the Non-Final Office Action dated January 10, 2014 (“Non-Final Act.”).

CLAIMED SUBJECT MATTER

Claims 1 and 19 are the independent claims on appeal. Claim 1, reproduced below, is illustrative of the claimed subject matter on appeal, with the disputed limitation italicized for emphasis.

1. A padlock comprising:

a lock body;

a shackle with two shanks each having a groove for the reception of a part region of a corresponding locking element;

a pin operable to be acted on by a lock cylinder core to make a rotational movement for moving the locking elements into a locked position, the pin having a jacket surface that includes a pair of oppositely disposed grooves as well as another groove having a depth greater than the pair of oppositely disposed grooves, and at least one engagement element configured to cooperate with at least one entrainer formation of the lock cylinder core;

a spring biasing the pin into the locked position;

a blocking plate located between the pine and the lock cylinder core that is fastened in the lock body and has an opening through which the entrainer formation of the lock cylinder core projects into a plane of the engagement element, with the opening being configured such that rotational movement of the lock cylinder core is possible and such that a marginal region of the opening forms an abutment that is engageable with the entrainer formation for restricting rotational movement of the lock cylinder core; and

a selectively removable bridge member inserted between the engagement element and the entrainer formation, the bridge member operable to be inserted through the opening in the blocking plate into the plane of the engagement element;

*wherein the pine is arranged entirely outside a plane defined by the blocking plate,*

a core play exists between the engagement element and the entrainer formation that allows rotation of the lock cylinder core about a specific angle without the pin co-rotating, and

the bridge member, when selectively inserted between the engagement element and the entrainer formation, eliminated the play.

Appeal Br. 18, 19 (Claims App.).

#### REJECTIONS

I. The drawings are objected to under 37 C.F.R. § 1.83(a) as failing to show every feature of the claimed invention. Non-Final Act. 2–3.

II. Claims 1–12, 14, and 16–21 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Non-Final Act. 3–4.

III. Claims 1–12, 14, and 16–19 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watts (US 6,813,913 B2; iss. Nov. 9, 2004) and Meckbach (US 5,363,678; iss. Nov. 15, 1994). Non-Final Act. 4–10.

IV. Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Watts, Meckbach, and Borgmann (US 4,998,422; iss. Mar. 12, 1991). Non-Final Act. 10–11.

#### ANALYSIS

##### *Objection I*

The Examiner objects to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Non-Final Act. 2. In particular, the Examiner finds that “the pin being arranged entirely outside a plane defined by the blocking plate must be shown or the feature(s) canceled from the claim(s),” cautioning that “[n]o new matter should be entered.” *Id.* The Examiner determines that the figures in the Specification do not show “the extents of the pin and the extents of the blocking plate.” Ans. 2.

Appellants argue that Figure 10 depicts the pin arranged entirely outside a plane defined by the blocking plate. Appeal Br. 7–8. In support, Appellants submit that paragraph 65 of the Specification discloses that “pin 24 also includes engagement elements 28 and 28” and that Figure 10 depicts that “engagement element 28’ is hidden by a portion of blocking plate 36.” *Id.* Moreover, Appellants submit that paragraph 83 of the Specification discloses that “‘engagement element 28’ is located *behind* the region 42 of the blocking plate 36’ such that the pin 24 is arranged *entirely* outside a plane defined by the blocking plate.” *Id.* Appellants conclude that “[b]ecause engagement element 28 is hidden by blocking plate 36, the pin 24 including engagement element 28 must be arranged entirely outside a plane defined by the blocking plate, as claimed.” *Id.* Appellants also rely on Figure 15 of the Specification, as depicting that “only one of the engagement elements (no reference number) of the pin 24 is visible through the aperture of the blocking plate 36 because the other ‘engagement element’ is hidden by the pie-shaped piece of the blocking plate 36[,]” concluding that “this oblique view clearly shows that the ‘pin [24] is arranged entirely outside a plane defined by the blocking plate [36].” Reply Br. 4 (also citing Spec., Fig. 15).

Ordinarily, an objection is reviewable by petition under 37 C.F.R. § 1.181 and a rejection is appealable to the Patent Trial and Appeal Board. When the issue of new matter presented is the subject of both an objection and a rejection, the issue is appealable. *See* MPEP § 608.04(c) (providing that “where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also”). To the extent that the objection to the drawings in the Non-Final Rejection turns on the same issues as the rejection under 35 U.S.C. § 112, first paragraph, our

decision with respect to the rejection is dispositive as to the corresponding objection, supplemented by the analysis below.

Figure 10 from Appellants' Specification is reproduced below.

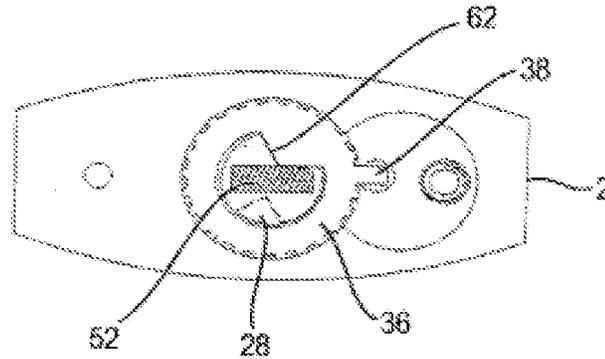


Figure 10 depicts a bottom view of lock body 2, including engagement element 28 of ball pin 24 and blocking plate 36. Figures 14 and 15 of Appellants' Specification are also reproduced below.

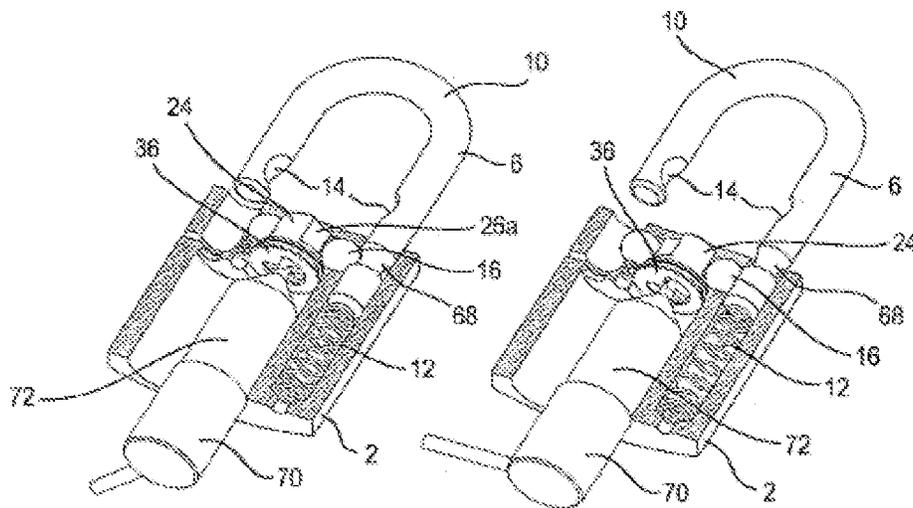


Fig. 14

Fig. 15

Figures 14 and 15 depict sectioned views of a padlock, with tool 70 in first and second positions, respectively.

We determine that a preponderance of the evidence supports that Figures 10, 14, and 15 depict pin 24, including engagement elements 28, 28', as being arranged entirely outside a plane defined by blocking plate 36, as recited in claims 1 and 19. The description of pin 24 and blocking plate 36 in the Specification is consistent with this interpretation of the figures. The Specification describes entrainer formations 54, 54' of cylinder core 50 "extending *through* the opening 40" of the blocking plate, such that entrainer formations 54, 54' "lie at least partly in the same plane" as engagement elements 28, 28' of ball pin 24 and abut engagement elements 28, 28' to transmit rotational movement of cylinder core 50 to ball pin 24. *See* Spec. ¶ 75 (emphasis added). The Specification also discloses that surfaces 62, 64 of blocking plate 36 abut entrainment member 52, so that blocking plate 36 restricts movement of entrainment member 52. *See id.* ¶ 79 (citing Fig.6). The Specification does not disclose that engagement elements 28, 28' of pin 24 extend through opening 40 of the blocking plate to abut entrainer formations 54, 54' or that engagement elements 28, 28' of pin 24 abut surfaces 62, 64 of blocking plate 36, and thus, functionally, there is no support for the conclusion that engagement elements 28, 28' are arranged to intersect a plane defined by blocking plate 36. Moreover, as submitted by Appellants, the Specification describes that, during certain operations, "engagement element 28' is located behind the region 42 of the blocking plate 36," which would not be possible if engagement element 28 was in the same plane as blocking plate 36. *Id.* ¶ 83. Notably, none of the figures of the Specification depicts pin 24, including engagement elements 28, 28', extending *into* the plane of blocking plate 36; rather, the Specification expressly discloses that "[i]t is particularly preferred for padlocks in which replacement of the shackle is possible if the pin is arranged completely outside the plane of the blocking plate in accordance with the invention." *Id.* ¶ 33.

Accordingly, we do not sustain the Examiner's objection to the drawings.

*Rejection II*

The Examiner rejects all of the pending claims as failing to comply with the enablement requirement of 35 U.S.C. § 112, first paragraph, because “[t]he pin being arranged entirely outside a plane defined by the blocking plate is not enabled by the [S]pecification.” Non-Final Act. 3. In support, the Examiner determines that the disclosure in paragraph 33 of the Specification, which states that “replacement of the shackle is possible if the pin is arranged completely outside of the blocking plate,” does not enable the recitation of this structure in the claim because it is unclear to the Examiner whether the stated position applies to the padlock in a completely assembled state, as claimed, or to the padlock in a disassembled state wherein the shackle is removed. *Id.* The Examiner also determines that paragraph 75 describes “the engagement elements of the pin extend[ing] through the opening of the blocking plate and lying at least partly in the same plane so that rotational movement of the cylinder core can be transmitted to the pin.” *Id.* at 3–4; *see also* Ans. 3 (“without proper punctuation [(in paragraph 75)] it is unclear . . . if only the entrainer formations extend through the opening . . . , or both the engagement elements and the entrainer formations extend through the blocking plate.”). The Examiner further determines that paragraph 83 of the Specification discloses that “the opening of the blocking plate is reduced exclusively by an engagement element of the pin” (Non-Final Act. 4), and reasons that “it is feasible . . . that the engagement elements are different in size, shape, orientation, and/or function” (Ans. 4), such that “one can perceive that the other engagement element 28’ is shorter than the engagement element 28, allowing for the other engagement element to be hidden beneath the blocking plate” (Ans. 4).

Appellants submit that

only the entrainer formations 54 and 54' are extending through the opening 40 formed in the blocking plate 36. That is, the engagement element 28' is designed to engage with spiral spring 30. . . . Blocking plate is then inserted over pin 24 and spring 30. . . . Once locking cylinder 20 is inserted into the lock body 2, . . . the entrainer formations 54 and 54' of entrainer member 52 pass through opening 40 of blocking plate 36 to engage with engagement elements 28 and 28'.

Appeal Br. 10–11 (citing Spec. ¶ 75, Figs. 4–6). Appellants further submit that

[b]ecause Figures 4–6 illustrate contact between entrainer member 52 (including entrainer formations 54 and 54') and engagement elements 28 and 28', and because Figure 10 . . . clearly shows that engagement element 28' is hidden *behind* blocking palate 36, . . . only the entrainer formations 54 and 54' break a plane defined by the blocking plate 36.

Appeal Br. 11; *see also* Reply Br. 6–7. Regarding paragraph 83 of the Specification, Appellants submit that

Figure 11 is a bottom-perspective view of the lock 2. When viewed from this perspective, it can be seen that the opening 40 of blocking plate 36 is 'reduced' by engagement element 28. The disclosure of paragraph [0083], however, does not in any way convey that the engagement element 28 breaks the plane defined by blocking plate 36. Rather, the disclosure in paragraph [0083] merely describes the view shown in Figure 11.

Appeal Br. 12; *see also* Reply Br. 5–6 (citing Figs. 14, 15). Thus, Appellants submit that the Specification, including the written description and figures, "enable one skilled in the art to recognize that the pin is arranged entirely outside a plane defined by the blocking plate, as claimed." Reply Br. 6; *see also* Appeal Br. 12.

When rejecting claims for lack of enablement "the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application [.]” *In re Wright*,

999 F.2d 1557, 1561–62 (Fed. Cir. 1993). The test for compliance with the enablement requirement is whether the disclosure, as filed, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). Here, we determine that Appellants’ submissions *supra* are evidence that the disclosure of pin 24, including engagement elements 28, 28’, is sufficiently complete to enable one of ordinary skill in the art to make and use the claimed invention without undue experimentation. Additionally, we do not agree with the Examiner’s determination that paragraph 75 of the Specification discloses that engagement elements 28, 28’ extend through the opening 40 of blocking plate 36, but rather, that only entrainer formations 54, 54’ extend through the opening 40. The Examiner’s evidence also relies on speculation, for example, with respect to a possible difference in sizing of elements 28, 28’, rather than on what one of ordinary skill in the art would understand from the description and figures of the Specification.

Accordingly, we do not sustain the Examiner’s rejection of claims 1–12, 14, and 16–21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

### *Rejection III*

Regarding independent claims 1 and 19, the Examiner finds, *inter alia*, that Watts’s stop means 62 corresponds to the claimed blocking plate, and that Watts’s member 25 corresponds to the claimed pin and includes at least one engagement element in the form of drive portion 42. Non-Final Act. 4–5. The Examiner further finds that “the body of the pin [25] is arranged entirely outside a plane defined by the blocking plate [62].” *Id.* at 5 (citing Watts, Figs. 5, 6, 9). Appellants argue that “Watts *explicitly* teaches that the alleged engagement

element [42] of the alleged pin 25 abuts portions of the alleged blocking plate 63,”<sup>3</sup> and thus, “the alleged pin 25 of Watts is not ‘arranged entirely outside a plane defined by the blocking plate,’” as recited by claims 1 and 19. Appeal Br. 14 (citing Watts 10:44–55); *see also* Reply Br. 7. The Examiner responds that “Watts discloses separate elements 25 and 42 that are integral to allow for rotational movement of the lock cylinder core to be transmitted to pin element 25,” and therefore, Watts’s “pin element 25 resides entirely outside a plane defined by the blocking plate 62.” Ans. 7 (citing Watts, Figs. 1, 4, 9, 12, 13, and 16). Noting that the Examiner’s position is contrary to the Examiner’s interpretation of the claimed pin 24 including engagement elements 28, 28’ (Reply Br. 7), Appellants submit that Watts discloses that “alleged pin 25 and every portion thereof is not ‘arranged entirely outside a plane defined by the blocking plate,’ as claimed” (*id.* at 8).

A preponderance of the evidence does not support the Examiner’s finding that Watts discloses “[a] pin having . . . at least one engagement element . . . wherein the pin is arranged entirely outside a plane defined by the blocking plate,” as required by independent claims 1 and 19. Appeal Br. 18, 19, 23 (Claims App.). Rather, as correctly argued by Appellants, Watts discloses that member 62, 63 (the blocking plate) has wedges 65, 66 that are located in drive recess 48, 49 of drive portion 42 (the engagement element) of member 25 (the pin), and thus, member 25 including drive portion 42 is not entirely outside a plane defined by member 62, 63 as required by the independent claims. *See* Watts 9:23, 38, 42–44; 10:28–29.

Accordingly, we do not sustain the Examiner’s rejection of independent claims 1 and 19, and claims 2–12, 14, and 16–18 depending therefrom.

#### *Rejection IV*

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<sup>3</sup> Watts discloses that stop means 62 comprises an annular member 63. Watts 10:28–29, *see id.*, *e.g.*, Figs. 3, 5, 6.

Claims 20 and 21 depend from independent claim 19. Because we do not sustain the Examiner's rejection of independent claim 19, and the Examiner's reliance on Borgmann does not cure the deficiency in the Examiner's finding regarding Watts as applied to claims 1 and 19, we also do not sustain the Examiner's rejection of claims 20 and 21 depending therefrom.

#### DECISION

We reverse the Examiner's objection to the drawings under 37 C.F.R. § 1.83(a).

We reverse the Examiner's rejection of claims 1–12, 14, and 16–21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

We reverse the Examiner's rejection of claims 1–12, 14, and 16–19 under 35 U.S.C. § 103(a) as being upatentable over Watts and Meckbach.

We reverse the Examiner's rejection of claims 20 and 21 under 35 U.S.C. § 103(a) as being upatentable over Watts, Meckbach, and Borgmann.

REVERSED