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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DIETER BALDAUF
and SWEN SCHNEIDER

Appeal 2014-009248
Application 12/310,453
Technology Center 1700

Before ADRIENE LEPIANE HANLON, CATHERINE Q. TIMM, and
BEVERLY A. FRANKLIN, *Administrative Patent Judges*.

HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

A. STATEMENT OF THE CASE

The Appellants filed an appeal under 35 U.S.C. § 134 from a final rejection of claims 13–26, 28, and 29.¹ We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The Appellants' invention is directed to a hot glue application system. Independent claim 13 is reproduced below from the Claims Appendix of the Appeal Brief dated February 14, 2014 (“App. Br.”). The limitations at issue are italicized.

¹ Claims 9–12 are also pending but have been withdrawn from consideration.

Claim 13. A hot glue application system comprising:
a control unit;
a melter; and
components permanently connected to the melter,
wherein,
each of the components comprise a data storage medium
configured to be machine readable and to save technical data
necessary to automatically adjust automatic control parameters for a
multizone temperature control and monitoring so that the components
maintain a hot glue supplied by the melter in a liquid state, and
the components do not comprise the control unit.

App. Br. 17.

The claims on appeal stand rejected as follows:

- (1) claims 13–26, 28, and 29 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement;
- (2) claims 13–26, 28, and 29 under 35 U.S.C. § 112, second paragraph, as being indefinite;
- (3) claims 13, 15–17, 19–25, 28, and 29 under 35 U.S.C. § 103(a) as being unpatentable over Pallante et al.² in view of Colangelo et al.³ and Boger et al.;⁴
- (4) claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Pallante in view of Colangelo and Boger, and further in view of Yonezawa et al.;⁵

² US 2005/0095359 A1, published May 5, 2005 (“Pallante”).

³ US 2004/0011817 A1, published January 22, 2004 (“Colangelo”).

⁴ US 2001/0037670 A1, published November 8, 2001 (“Boger”).

⁵ US 2003/0231020 A1, published December 18, 2003 (“Yonezawa”).

(5) claims 18 and 26 under 35 U.S.C. § 103(a) as being unpatentable over Pallante in view of Colangelo and Boger, and further in view of Murphy et al.⁶ and Janiak et al.⁷

B. DISCUSSION

1. Rejection (2)

In the rejection of claims 13–26, 28, and 29 under § 112, second paragraph, the Examiner concludes that the limitation “‘components *permanently* connected to the melter’” is unclear. Final 3.⁸ The Examiner questions whether “a permanent connection mean[s] that the components are never removed from the melter, either for repair or replacement” or whether “a permanent connection mean[s] that the components are permanently affixed while the system is in operating status (e.g., dispensing the hot glue).” Final 3.

In response, the Appellants argue that “the word ‘permanently’ merely makes clear that the claimed system requires the components to be connected to the melter and that said connection is *not transitory* in nature.” App. Br. 6 (emphasis added).

The definiteness of language employed in a claim “must be analyzed—not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

⁶ US 6,125,868, issued October 3, 2000 (“Murphy”).

⁷ US 2002/0030581 A1, published March 14, 2002 (“Janiak”).

⁸ Final Office Action dated September 25, 2013.

In this case, the Appellants do not expressly disclose that components are “permanently connected to the melter” as recited in claim 13 or provide a definition of the word “permanently” in their Specification.

We find the word “permanent” is defined as “[l]asting or remaining without essential change” or “not expected to change in status, condition, or place.” Definition of “permanent,” <http://www.the-free-dictionary.com/permanently> (last visited Nov. 4, 2016); *see also* Ans. 3 (finding that “[p]ermanent”, as defined by the Merriam-Webster dictionary, is defined as ‘continuing or enduring without fundamental or marked change’. In other words, ‘permanently’ means non-changing.”).⁹

The only components exemplified in the Appellants’ Specification are heatable feed hoses and heatable application valves.¹⁰ Spec. 8. The Appellants disclose:

To evaluate the state of maintenance and to diagnose a hot glue system, it is necessary that the control unit 170 have information on the operating time and on the exceeding of limiting parameters of the melter 100, the connected heatable feed hoses 200, and the heatable application valves 300. In this regard, it is advantageous if this information is stored in the hoses and application valves themselves, so that after a repair and during connection of the components that were already in use, the previously attained operating time and the exceeding of established limiting parameters are automatically reported to the control unit 170. *During operation*, the control unit cyclically updates the elapsed time indicators contained in the components and the data memories for the limiting parameters. The operating time and the attained limiting parameters of the components can thus either be interrogated by the control unit 170 *if the*

⁹ Examiner’s Answer dated June 19, 2014.

¹⁰ Claim 14, which depends from claim 13, recites that “the components contain *at least one* heatable feed hose and *at least one* heatable application valve.” App. Br. 17 (emphasis added).

components are connected to the melter 100, or, after detachment from the melter 100, externally interrogated if the component, for example, is being subjected to repair.

Spec. 9–10 (emphasis added).

Based on the Appellants' disclosure, we find that the connection between the heatable feed hoses and the heatable application valves (i.e., components) and the melter is temporary or transitory because the components are detached from the melter when, for example, the components are subjected to repair. We find that the temporary or transitory connection disclosed in the Appellants' Specification is not consistent with the permanent connection recited in claim 13. *See* App. Br. 6 (arguing that the word “permanently” makes clear that the connection between the components and the melter “is *not transitory* in nature” (emphasis added)).

The Appellants argue that a permanent connection between the components and the melter is required only *during operation* (App. Br. 6), apparently to account for the fact that the components are detached from the melter when the components are repaired. *See* Ans. 4 (Appellants argue that “permanently is meant to be only permanent during operation.”).

Claim 13, however, does not recite such a limitation. Moreover, even if we were to interpret claim 13 as reciting that the connection between the components and the melter is permanent only during operation of the claimed system, it is not clear on this record that the claimed system stops operating when the feed hose(s) and the application valve(s) are detached from the melter. For example, it is not clear on this record that the melter stops melting glue and the control unit stops monitoring the system when the feed hose(s) and the application valve(s) are

detached from the melter. To that end, we find the Appellants have failed to define the phrase “during operation” as limited to, for example, dispensing hot glue.¹¹

In sum, we conclude that the scope of the word “permanently,” as recited in claim 13, is not clear. That is, on this record, it is not clear how long, and under what conditions, the components must be connected to the melter to be “permanently connected” thereto. For that reason, the § 112, second paragraph, rejection of claims 13–26, 28, and 29 is sustained.

2. Rejections (1) and (3)–(5)

The Examiner finds the Specification does not expressly disclose the following limitation recited in claim 13: “components permanently connected to the melter.” Final 2. According to the Examiner, “[w]hile the instant specification suggests that the hose is connected to the melter, it does not say that the connection is permanent.” Final 2.

“The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.” *In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983). A disclosure may meet this burden by providing either “express” or “inherent” support for a claim limitation. *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998).

¹¹ We note the Appellants disclose that “a variable number of heatable feed hoses 200 and heatable application valves 300 with variable heating capacity and automatic control response can be connected to the melter 100.” Spec. 3. In the case where more than one feed hose and more than one application valve are connected to the melter, it not clear on this record that detaching one feed hose and one application valve from the melter when, for example, they are subjected to repair, would cause the claimed system to stop dispensing hot glue.

The Examiner correctly finds that the Specification, as originally filed, does not expressly disclose that the components are “permanently connected to the melter” as recited in claim 13. However, as discussed above, the scope of the word “permanently” in claim 13 is not clear on this record. Thus, speculation would be required to determine whether the Appellants’ original disclosure provides inherent support for the limitation at issue.

As for the § 103(a) rejections of claims 13–26, 28, and 29, the Examiner correctly concludes that the word “connected” in claim 13 “does not mean that components needs [*sic*, need] to be separately and directly connected to the melter,” as argued by the Appellants (*see* App. Br. 8), but rather means that the components are “linked in some way (e.g., through other parts)” to the melter. Final 11; Ans. 5. In that regard, the Examiner points out:

As seen in instant claim 14, [Appellants recite] that the components are at least one heatable feed hose and at least one heatable application valve. However, in [Appellants’] Fig. and the instant disclosure, application valve 300 is not directly or separately connected to the melter. In fact, Fig. 2 shows that the valve 300 is actually at the end of the hose and not directly connected to the melter.

Ans. 5; *see also* Final 11.

In Pallante, card **70** having magnetic strip **70a** (i.e., a machine readable element) is “connected” to melter or tank **22** when card **70** transmits information to controller **28** via scanner or reader **72**. Pallante ¶ 19. However, speculation would be required to determine whether the connection between card **70** and melter **22** is a *permanent* connection as recited in claim 13.

We decline to engage in speculation to decide the issues raised in the § 112, first paragraph, and § 103(a) rejections on appeal. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (rejections should not be based on “considerable speculation as

to the meaning of the terms employed and assumptions as to the scope of such claims”). Therefore, we will not sustain the rejections of claims 13–26, 28, and 29 under § 112, first paragraph, and § 103(a). It should be understood that our decision is based solely on the indefiniteness of the word “permanently” in claim 13 and not on the merits of the rejections under § 112, first paragraph, and § 103(a).

C. DECISION

The decision of the Examiner is affirmed.

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).

AFFIRMED