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EXAMINER
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BOES, TERENCE

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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* HANS-JUERGEN OBERLE, WILLI SCHMIDT, and  
ANDREAS LIENIG

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Appeal 2014-009516  
Application 11/574,305  
Technology Center 3600

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Before EDWARD A. BROWN, AMANDA F. WIEKER, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Hans-Juergen Oberle et al. (“Appellants”) appeal under 35 U.S.C. § 134(a) from the Examiner’s non-final decision rejecting claims 1–5, 7, 8, and 19–31.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and designate our affirmance as NEW GROUNDS OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

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<sup>1</sup> Appellants submit the real party in interest is Robert Bosch GmbH. Appeal Br. 2 (filed Jan. 16, 2014).

THE CLAIMED SUBJECT MATTER

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

1. A gear drive unit (1), which is fastened on a base part (50), the gear drive unit (1) comprising:

a spindle (40), on which a drive gear (42) that drives the spindle (40) is provided, *the drive gear (42) having a substantially constant diameter along its entire axial length;*

a drive assembly (20), which drives the drive gear (42) by a driven element (500); and

a gear housing (30) on which the drive assembly (20) is mounted and which operationally couples at least the driven element (500) and the drive gear (42),

wherein at least one additional support (100,100') is positioned in the gear housing such that the driven element (500) is disposed at least partially radially outside of the at least one additional support (100,100'), and the drive gear (42) is mounted in the at least one additional support, and the at least one additional support is fastened to the base part (50) and supports the gear housing (30), in that the at least one additional support (100, 100') is substantially tubular in shape, and in that the at least one additional support (100, 100') has at least one radial opening (130), through which the driven element (500) of the drive assembly (20) and the drive gear (42) are connected to one another.

Appeal Br. i (Claims App.) (emphasis added).

## REJECTIONS

- 1) Claims 1–5, 7, 8, and 19–31 are rejected under 35 U.S.C. § 112, first paragraph, as lacking the written description requirement.
- 2) Claims 1–5, 7, 8, and 19–31 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite.
- 3) Claims 1, 2, 4, 5, 8, 19–29, and 31 are rejected under 35 U.S.C. § 102(b) as anticipated by Houston (US 6,575,421 B1, iss. June 10, 2003).
- 4) Claims 3, 7, and 30 are rejected under 35 U.S.C. § 103(a) as unpatentable over Houston and Gauger (US 5,613,402, iss. Mar. 25, 1997).

## DISCUSSION

### *35 U.S.C. § 112, First Paragraph–Written Description*

Independent claims 1 and 19 each contain the limitation “the drive gear (42) having a substantially constant diameter along its entire axial length.” Appeal Br. i-ii (Claims App.). The Examiner finds that this limitation is not “in the original disclosure” and “does not appear in the drawings.” Non-Final Act. 2. The Examiner finds that Appellants’ element 40 is a spindle nut that is formed integrally with drive gear 42, while the spindle (element 41) is “a separate component located inside of the spindle nut 40.” Ans. 11. The Examiner then reasons that “drive gear 42 **is merely a portion (emphasis added)** of spindle nut 40. It is clear that this drive gear portion 42 is integrally formed with the unnumbered stepped down side portions of the rest of the spindle nut (40).” *Id.* at 10–11.

The Specification discloses that element 40, the “spindle component,” includes spindle 41, worm wheel 42, and ball 43. Spec. ¶ 24. The Examiner

has not directed us to any part of the Specification where element 40 is described as a spindle nut, or where element 40 is described as being formed integrally with drive gear 42 (termed “worm wheel” in the Specification). The Examiner also does not direct us to any part of the Specification describing drive gear 42 as having stepped down side portions. Based on the foregoing, the Examiner’s rejection is not supported by the disclosure in the Specification. Nonetheless, we sustain the rejection of claims 1–5, 7, 8, and 19–31 under the written description requirement of 35 U.S.C. § 112, first paragraph, for different reasons.

In response to the Examiner’s rejection, Appellants rely solely on Figure 3 of the application for support for this limitation. Appeal Br. 5. Appellants do not point to any original disclosure in support of this limitation. *Id.* Our review of the original disclosure reveals that it includes no description regarding the diameter of the drive gear (worm wheel 42) and does not specify whether it has a substantially constant diameter.

The Federal Circuit explained that:

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, rather than the presence or absence of literal support in the specification for the claim language. . . . The content of the drawings may also be considered in determining compliance with the written description requirement.

*In re Kaslow*, 707 F.2d 1366, 1375 (Fed. Cir. 1983) (citations omitted).

Appellants’ Figure 3 is a side sectional view of an embodiment of the claimed gear drive unit illustrating drive gear 42 without any accompanying reference to or delineation of its diameter provided in the Specification. Spec. ¶ 15. Figure 2 also illustrates drive gear 42 from a similar perspective.

None of the drawings in the application illustrate drive gear 42 from the top, bottom, or any other perspective. Therefore, we cannot conclude that this one drawing, Figure 3, clearly shows that drive gear 42 has a substantially constant diameter along its entire axial length. *Cf. In re Mraz*, 455 F.2d 1069, 1072 (CCPA 1972) (“Patent drawings are not working drawings \*\*\*.’ However, we did not mean that things patent drawings show clearly are to be *disregarded.*”)(emphasis in original). In the absence of any written description in the Specification concerning a *substantially* constant diameter of the drive gear, we determine that Figure 3 standing alone would not have reasonably conveyed to one of ordinary skill in the art that Appellants had possession of the claimed gear unit including a drive gear having a substantially constant diameter. We therefore exercise our discretion under 37 C.F.R. § 41.50(b) and designate as a new ground the rejection under 35 U.S.C. § 112, first paragraph, against claims 1 and 19 and claims 2–5, 7, and 8 which are dependent on claim 1, and claims 20–31 which are dependent on claim 19, for failing to comply with the written description requirement.

*35 U.S.C. § 112, Second Paragraph–Indefiniteness*

The Examiner determined, for the same reasons noted above in connection with Rejection 1, that the same limitation in claims 1 and 19 renders the metes and bounds of claims 1 and 19 unclear. Non-Final Act. 3. This rejection is based on the same unsupported interpretation of the Specification noted above for Rejection 1. Nonetheless, we sustain the rejection of claims 1–5, 7, 8, and 19–31 under 35 U.S.C. § 112, second paragraph, for different reasons.

“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.” *In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014). “It is the applicants’ burden to precisely define the invention, not the PTO’s.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). When words of degree, such as “substantially” are used, we “must determine whether the patent’s specification provides some standard for measuring that degree . . . [and] whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification.” *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826 (Fed. Cir. 1984); *see also Interval Licensing, LLC v. AOL, Inc.*, 766 F.3d 1364, 1379 (Fed. Cir. 2014) (“Claim language employing terms of degree has long been found definite when it provided enough certainty to one of skill in the art when read in the context of the invention”).

As noted above, the Specification contains no disclosure in regard to the diameter of the drive gear, and does not contain the phrase “substantially constant diameter.” Consequently, the Specification provides no standard for measuring or determining the degree associated with the term “substantially.” *See Seattle Box*, 731 F.2d at 826. Nor does the claim language provide sufficient certainty to one skilled in the art when read in the context of the Specification. *See Interval Licensing*, 766 F.3d 1379. We, therefore, determine that it would not have been clear to one of ordinary skill in the art, after reading the Specification, what a “*substantially* constant diameter” means in claims 1 and 19. We exercise our discretion under 37 C.F.R. § 41.50(b) and designate as a new ground the rejection under 35 U.S.C. § 112, second paragraph, against claims 1 and 19 and claims 2–5, 7, and 8 which are dependent on claim 1, and claims 20–31 which are dependent on claim 19 as indefinite.

*Anticipation by Houston and Obviousness over Houston and Gauger*

We do not sustain the rejection of claims 1, 2, 4, 5, 8, 19–29, and 31 under 35 U.S.C. § 102(b) as anticipated by Houston, or the rejection of claims 3, 7, and 30 under 35 U.S.C. § 103(a) as unpatentable over Houston and Gauger, because these rejections are necessarily based on speculative assumptions as to the meaning of the limitation “substantially constant diameter” in claims 1 and 19. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962). It must be understood, however, that our decision regarding these rejections is based solely on the indefiniteness of the claims and does not reflect in any manner on the adequacy of the prior art evidence relied upon in the Examiner’s rejections.

DECISION

The Examiner’s decision rejecting claims 1–5, 7, 8, and 19–31 under 35 U.S.C. § 112, first paragraph, is affirmed and designated as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R § 41.50(b).

The Examiner’s decision rejecting claims 1–5, 7, 8, and 19–31 under 35 U.S.C. § 112, second paragraph, is affirmed and designated as a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R § 41.50(b).

The Examiner’s decision rejecting claims 1, 2, 4, 5, 8, 19–29, and 31 under 35 U.S.C. § 102(b) is reversed.

The Examiner’s decision rejecting claims 3, 7, and 30 under 35 U.S.C. § 103(a) is reversed.

### FINALITY OF DECISION

This decision contains new grounds 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, [Appellants], within two months from the date of the decision, must exercise one of the following two options with respect to the new ground[s] 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. The new ground[s] of rejection [are] binding upon the Examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground[s] of rejection designated in this decision. Should the examiner reject the claims, [Appellants] may again appeal to the Board pursuant to this subpart.
- (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of

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rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

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

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

AFFIRMED; 37 C.F.R. § 41.50(b)