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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* KARL WEINMANN

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Appeal 2015-001480  
Application 12/498,428  
Technology Center 3700

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Before JENNIFER D. BAHR, LINDA E. HORNER, and  
BRANDON J. WARNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Karl Weinmann (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1, 2, 4, 7, and 10–12.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> Claims 5, 6, 8, and 9 are withdrawn from consideration and not before us in the present appeal. Claim 3 has been cancelled.

### CLAIMED SUBJECT MATTER

Appellant's claimed subject matter "relates to devices for conveying workpieces." Spec. 3, 1. 2. Of those claims before us on appeal, claim 1 is the sole independent claim and is reproduced below.

1. A device or apparatus for conveying a workpiece to and/or from a processing station, comprising:

a conveying device;

a gripping device having gripping jaws for moving the workpiece along said conveying device to and/or from the processing station;

a carrier, wherein said gripping jaws reach over the workpiece and are situated on said carrier in such a manner that a distance between said gripping jaws is adjustable; and

at least one processing tool for processing the workpiece, which processing tool is movable between said gripping jaws and is also situated on said carrier;

wherein said carrier is used similarly to a portal of a tool portal machine.

### REJECTIONS

Appellant appeals from the Final Action, dated February 10, 2014 ("Final Act."), which includes the following rejections:<sup>2</sup>

1. Claims 1, 2, 4, 7, and 10–12 under 35 U.S.C. § 112, second paragraph, as indefinite.

2. Claims 1, 2, 4, 7, and 10–12 under 35 U.S.C. § 102(b) as anticipated by Lacrosse (US 5,615,122, iss. Mar. 25, 1997).

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<sup>2</sup> The Examiner withdrew a rejection of claims 1, 2, 4, 7, and 10–12 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Ans. 9.

## ANALYSIS

### *First Ground of Rejection: Indefiniteness*

#### *“Conveying device”*

Claim 1 is directed to “[a] *device or apparatus for conveying a workpiece to and/or from a processing station, comprising: a conveying device.*” Br. 22 (Claims App.) (emphasis added). The Examiner rejected the claim as indefinite because “[i]t is unclear . . . whether ‘a conveying device’ (as set forth in line 1, for example) is intended to be the same as or different from the ‘conveying device’ (set forth in line 3 . . .).” Final Act. 5.

Appellant argues that “[t]he *conveying device at line 3 is conveying device 10*, as shown in the drawings.” Br. 14 (emphasis added); *see* Spec. Fig. 1. According to Appellant, the claim sets forth “a device or apparatus for conveying a workpiece to and/or from a processing station with *inter alia* a conveying device (10).” *Id.*

We are not persuaded by Appellant’s argument because, as the Examiner explains, the argument is inconsistent with the Specification. Ans. 10–11. Appellant’s Specification suggests that conveying device 10 is the overall “device or apparatus for conveying” to which claim 1 is directed. *See* Spec. 9, ll. 2–3 (describing that, “[i]n accordance with the present invention[,] a conveying device 10 is provided”). The Specification also describes that the “*conveying device includes . . . gripping device 20 having gripping jaws 13, 14,*” which suggests that gripping device 20 is an element of conveying device 10. *Id.*, ll. 7–8 (emphasis added). Therefore, we understand gripping device 20 to be an element of conveying device 10. However, in claim 1, the “conveying device” of line 3 and the “gripping

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device” of line 4 are recited as separate elements of the overall “device or apparatus for conveying.” Br. 22 (Claims App.). If, as argued by Appellant, conveying device 10 is not the overall “device or apparatus for conveying” to which claim 1 is directed, but rather an element of the overall device or apparatus, then it is unclear how conveying device 10 can *include* gripping device 20, as described in the Specification.

On the other hand, the Specification also describes “conveying device [30] . . . formed by two roller tracks 31, 32 on the feed side of processing station 12 and . . . by two roller tracks 33 and 34 on the removal side.” Spec. 9–10. This description demonstrates that the “conveying device” recited in line 3 is amenable to two plausible constructions, i.e., the conveying device of line 3 is the overall conveying device 10, of which the gripping device 20 is a part, or the conveying device of line 3 is conveying device 30. “[I]f a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim unpatentable under 35 U.S.C. § 112, second paragraph, as indefinite.” *Ex parte Miyazaki*, 2008 WL 5105055 (BPAI 2008) (precedential). As such, claim 1 is indefinite because the scope of “a conveying device” is not reasonably ascertainable by those skilled in the art when the claim is read in light of the Specification.

*“[R]each over the workpiece”*

Claim 1 recites “said gripping jaws reach *over* the workpiece.” *Id.* (emphasis added). The Examiner rejected the claim as indefinite because:

[I]t is not clear whether the limitation “over the workpiece” is intended to refer to/require a *physical location* of the gripping jaws (i.e., they “reach” in a location that is over/above the workpiece), or to *some ability* of the gripping jaws to reach over a certain (unspecified in the claim) extent or dimension of the workpiece, etc.

Final Act. 6 (emphasis added). Appellant argues that the limitation “is intended to refer to a physical location of the gripping jaws *or* some ability of the gripping jaws to reach over something unspecified in the claim.”

Br. 15. In particular, the phrase “is meant to convey that the gripping jaws extend over the workpiece in a sense that the gripping jaws are *above the workpiece.*” *Id.* (emphasis added).

Although we accept Appellant’s interpretation of “over” the workpiece as meaning “above” the workpiece, we nonetheless agree with the Examiner that the language specifying that the gripping jaws perform a method step, i.e., that the “gripping jaws reach over the workpiece,” renders the claim indefinite. Namely, the limitation appears to encompass both system structure and a method step to be carried out, and thus the scope of the claim is not clearly set forth. *See IPXL Holdings, LLC v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (“Because [the claim] recites both a system and the method for using that system, it does not apprise a person of ordinary skill in the art of its scope, and it is invalid under section 112, paragraph 2.”). In other words, it is unclear whether infringement would occur, for example, when one creates a system in which the gripping jaws are simply structurally positioned above where a workpiece would be disposed, or whether infringement would occur only when the gripping jaws

actually perform an act of moving and extending out above the workpiece. Ans. 12–13. As such, claim 1 is indefinite because one of ordinary skill in the art would not be able to ascertain with reasonable certainty the metes and bounds of gripping jaws that *reach over* a workpiece, as called for in claim 1.

*“[T]ool portal machine”*

Claim 1 also recites “wherein said carrier is used similarly to a portal of a tool portal machine.” Br. 22 (Claims App.). The Examiner rejected the claim as indefinite because “it is not clear what configuration or use of the carrier results in a carrier that is structured or configured ‘similarly to’, or that is used ‘similarly to’, a portal of a tool portal machine.” Final Act. 6. According to the Examiner, “for any given ‘carrier’, it is unclear how to determine whether the carrier meets the claim limitation because it is unclear how or in what regard a given carrier must be ‘used similarly to’ such a portal in order to meet the claim language.” *Id.* Appellant argues “that the skilled artisan would clearly understand what using a carrier similar to a portal of a tool portal machine means, i.e., using the carrier like a portal to the tool portal machine.” Br. 16.

Appellant’s argument is not persuasive of error in the Examiner’s rejection because Appellant does not offer any evidence or technical reasoning in support of the assertion that one of ordinary skill in the art would understand the scope of the limitation. Moreover, the Specification does not adequately explain what a “portal of a tool portal machine” comprises or what “used similarly” encompasses. The Specification also fails to provide any explanation as to what structural limits, if any, such use

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might impose upon the carrier. Therefore, the language of claim 1 does not define the claimed subject matter with an adequate degree of particularly and distinctness such that one of ordinary skill in the art would understand what is being claimed as to the carrier being used similarly to a portal of a tool portal machine.

*“[A] position where said gripping jaws are open . . . [and] a position where said gripping jaws are closed”*

Claim 4 depends from claim 1 and recites, in relevant part, “said gripping jaws are in a position selected from the group consisting of a position where said gripping jaws are *open*, a position where said gripping jaws are *closed*, and both the position where said gripping jaws are open and the position where said gripping jaws are closed.” *Id.* at 22 (Claims App.) (emphasis added). The Examiner rejected claim 4 as indefinite because “it is unclear . . . what position(s) of the jaws constitute ‘open’ and what constitutes ‘closed.’” Final Act. 7. According to the Examiner:

For example, it is unclear whether the position wherein the jaws are as far apart as they can possibly be is the only position that is considered to be “open”, and it is unclear whether any position that is not the maximum spaced apart position is considered to be “closed”, or whether the jaws are only to be considered to be “closed” when they reach a certain distance from one another, or whether the jaws are only considered to be “closed” when they are in a position wherein the two jaws are in contact with one another, etc.

*Id.* Appellant argues that gripping jaws that are “closed” and “open” is meant “to be interpreted according to . . . common meaning, for example, when a human’s jaws are closed” and “when a human’s jaws are open.”

Br. 16.

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Appellant's argument is not persuasive of error because neither the claim, nor the Specification, provides a point of reference from which to determine what constitutes gripping jaws that are "open" and "closed." Appellant's proffered example regarding a human jaw is unavailing because, as the Examiner explains:

[I]f the human is biting an apple, for example, it would be unclear whether such jaws were closed or open when they are contacting the apple to bite it, noting that in such a position the human's jaws are "closed" to a position where they grip the apple, and yet, ***at that same position***, the human's jaws are "open" in that they are not in contact with one another but are instead spaced apart by an amount equal to the size of the apple portion contacted by the jaws.

Ans. 17 (underlining omitted). It is not clear whether "open" requires that the jaws are positioned at their fullest extent apart or that the jaws simply are not secured upon a workpiece. Similarly, it is unclear whether "closed" requires that the jaws are shut together, such that the jaws contact each other, or that the jaws are merely secured upon a workpiece. As such, one of ordinary skill in the art would not be able to ascertain the scope of "a position where said gripping jaws are *open*" and "a position where said gripping jaws are *closed*," as recited in the claim. For this reason, we agree with the Examiner that one of ordinary skill in the art would not be able to determine the scope of claim 4, and thus the claim is indefinite.

*"[V]ertical members for a wall element"*

Claim 12 depends from claim 1 and recites "wherein the workpiece is a bar, a plate, *vertical* members for a wall element or a wall element."

Br. 22 (Claims App.) (emphasis added). The Examiner rejected claim 12 as

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indefinite because “the intended meaning of ‘vertical’ . . . is not clear, i.e., there is no axis or frame of reference provided . . . for determining what is meant by ‘vertical.’” Final Act. 7 (underlining omitted). The Examiner explains that “it appears that the term ‘vertical’ is used to refer to a member that has a horizontal longitudinal axis as it passes through the machine (see 11.2 in Figure 1).” *Id.* The Examiner also explains that “[t]he term ‘vertical’ . . . is apparently used by the claim to mean ‘horizontal’, or some non-vertical direction or dimension while the accepted meaning is ‘perpendicular to the plane of the horizon’ or ‘upright.’” *Id.* at 8.

Appellant argues:

[T]he phrase “vertical members for a wall element” should be interpreted as a part of wall element 11 that is vertical and . . . that “vertical” is not used in the claim to mean “horizontal,” even without a specific axis or frame of reference included expressly in the claim.

Br. 16–17. Appellant’s argument is persuasive of error. We do not understand the term “vertical” to refer to an *orientation of the workpiece* relative to the conveying device, but rather the term simply describes a *type* of workpiece by its end use (i.e., as “vertical members for a wall element”). To the extent that the Examiner accurately characterizes Figure 1 as showing a workpiece in a horizontal orientation relative to the conveying device, we see no reason why “vertical members for a wall element” could not be processed in a horizontal position. As such, the limitation reciting “vertical members for a wall” does not render claim 12 indefinite.

*Antecedent basis*

The Examiner additionally rejected claims 1, 2, 4, 7, and 10–12 because of limitations lacking antecedent basis. Final Act. 5–6. The antecedent basis issues stem from the lack of clarity regarding the “conveying device” recited in claim 1. *See id.* at 5 (with the Examiner “noting that the claim potentially previously sets forth plural conveying devices”). Although we have considered the antecedent basis issues in view of Appellant’s arguments (Br. 14–15), we do not reach a separate conclusion as to these issues. Instead, we rely on our analysis discussed *supra* with respect to the “conveying device” limitation of claim 1. In other words, the indefiniteness of claim 1 due to the lack of clarity as to the “conveying device” recited therein, likewise renders claims 2, 4, 7, and 10–12 indefinite.

Accordingly, we sustain the rejection of claims 1, 2, 4, 7, and 10–12, under 35 U.S.C. § 112, second paragraph, as indefinite.<sup>3</sup>

*Second Ground of Rejection: Anticipation*

Having determined that claims 1, 2, 4, 7, and 10–12 are indefinite, we cannot sustain the rejections of these claims under 35 U.S.C. § 102(b), because to do so would require speculation as to the scope of the claims. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (holding that the Board erred in

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<sup>3</sup> Although Appellant persuades us of error in the Examiner’s determination that the limitation “vertical member” renders claim 12 indefinite, this claim depends from claim 1, and thus claim 12 inherits the indefiniteness issues of claim 1.

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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 rejection.

#### DECISION

The decision of the Examiner to reject claims 1, 2, 4, 7, and 10–12 under 35 U.S.C. § 112, second paragraph, as indefinite is AFFIRMED.

We reverse the decision of the Examiner to reject claims 1, 2, 4, 7, and 10–12 under 35 U.S.C. § 102(b) as anticipated by Lacrosse.

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