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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* THOMAS A. BUCKNELL

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Appeal 2016-008097  
Application 13/695,975<sup>1</sup>  
Technology Center 3600

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Before LARRY J. HUME, LINZY T. McCARTNEY, and  
NORMAN H. BEAMER, *Administrative Patent Judges*.

HUME, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) of the Final Rejection of claims 21, 23–28, 30–40, and 49–58. Appellant has canceled claims 1–20, 22, 29, and 41–48. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

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<sup>1</sup> According to Appellant, the real party in interest is Durr Systems GmbH. App. Br. 2.

STATEMENT OF THE CASE<sup>2</sup>

*The Invention*

Appellant's disclosed embodiments and claimed invention relate to a device and method for handling components, preferably components to be coated. Title.

*Exemplary Claims*

Claims 21, 51, and 55, reproduced below, are representative of the subject matter on appeal (*emphases* added to contested limitations):

21. A component-handling device for handling a component to be coated, comprising:

*a grasping element having a resilient support, and not a rigid support, disposed therein; and*

a fluid supply to the grasping element such that at least one of supply and removal of the fluid changes at least one of a volume and a shape of the grasping element.

51. A device, comprising:

*a grasping element having a resilient support that is a sole support disposed therein; and*

a fluid supply to the grasping element such that at least one of supply and removal of the fluid changes at least one of a volume and a shape of the grasping element.

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<sup>2</sup> Our decision relies upon Appellant's Appeal Brief ("App. Br.," filed Feb. 1, 2016); Reply Brief ("Reply Br.," filed Aug. 22, 2016); Examiner's Answer ("Ans.," mailed June 21, 2016); Final Office Action ("Final Act.," mailed Sept. 18, 2015); and the substitute Specification ("Spec.," filed Dec. 20, 2012).

55. A device, comprising:

a grasping element having a resilient support disposed therein; and

a fluid supply to the grasping element such that at least one of supply and removal of the fluid changes at least one of a volume and a shape of the grasping element;

*wherein the resilient support is configured to move along, and bend away from, a central axis.*

*Prior Art*

The Examiner relies upon the following prior art as evidence in rejecting the claims on appeal:

Frost	US 3,347,587	Oct. 17, 1967
Nissan Motor Co. Ltd. ("JP '885")	JP 08-294885	Nov. 12, 1996

*Rejections on Appeal*

R1. Claims 21, 23–28, 30, 40, and 49–58 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being anticipated by Frost. Final Act. 4; Ans. 2.

R2. Claims 31–33 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Frost. Final Act. 7; Ans. 2.

R3. Claims 34–39 are rejected under pre-AIA 35 U.S.C. 103(a) as being unpatentable over the combination of Frost and JP '885. Final Act. 7; Ans. 2.

## CLAIM GROUPING

Based on Appellant's arguments (App. Br. 6–14), we decide the appeal of anticipation Rejection R1 of claims 21, 23–28, 30, 40, 49, and 50 on the basis of representative claim 21; we decide the appeal of anticipation Rejection R1 of claims 51–54 on the basis of representative claim 51; and we decide the appeal of anticipation Rejection R1 of claims 55–58 on the basis of representative claim 55.

Remaining claims 31–39 in Rejections R2 and R3, not argued separately, stand or fall with the respective independent claim from which they depend.<sup>3</sup>

## ISSUES AND ANALYSIS

In reaching this decision, we consider all evidence presented and all arguments actually made by Appellant. We do not consider arguments that Appellant could have made but chose not to make in the Briefs, and we deem any such arguments waived. 37 C.F.R. § 41.37(c)(1)(iv).

We agree with particular arguments advanced by Appellant with respect to claims 51–58 for the specific reasons discussed below.

However, we disagree with Appellant's arguments with respect to claims 21, 23–28, 30–40, 49, and 50. Unless otherwise noted, we incorporate herein and adopt as our own: (1) the findings and reasons set

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<sup>3</sup> "Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately." 37 C.F.R. § 41.37(c)(1)(iv). In addition, when Appellant do not separately argue the patentability of dependent claims, the claims stand or fall with the claims from which they depend. *In re King*, 801 F.2d 1324, 1325 (Fed. Cir. 1986).

forth by the Examiner in the action from which this appeal is taken, and (2) the reasons and rebuttals set forth in the Examiner's Answer in response to Appellant's arguments. We highlight and address specific findings and arguments regarding claims 21, 51, and 55 for emphasis as follows.

1. § 102(b) Rejection R1 of Claims 21, 23–28, 30, 40, 49, and 50

Issue 1

Appellant argues (App. Br. 6–11; Reply Br. 2–3) the Examiner's rejection of claim 21 under 35 U.S.C. § 102(b) as being anticipated by Frost is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a "component-handling device for handling a component to be coated" that includes, *inter alia*, the limitation of "a grasping element having a resilient support, and not a rigid support, disposed therein," as recited in claim 21?

Analysis

Appellant contends "the rejection of claim 21 should be reversed at least because Frost requires a 'rigid support,' and claim 21 specifically excludes a 'rigid support' [and] Frost does not teach or suggest a resilient support, and cannot teach or suggest 'not a rigid support,'" and therefore does not anticipate claim 21. App. Br. 7. Appellant further argues no reasonable claim construction supports the interpretation that spring 136 of Frost is a "resilient support." *Id.*

Appellant continues by arguing:

The spring 136 of Frost is not a "support" at all, but rather simply allows the tube 128 to move axially; therefore the spring 136 cannot read on "a resilient support." Frost's spring 136

imparts no structure, provides no resistance to loads, and has no interaction with the inflatable finger 126. Because the spring 136 is entirely within the tube 128, any interaction with the inflatable finger 126 will be transferred to the tube 128. Frost's spring 136 does not keep a grasping element in a certain shape or orientation, or serve in any way that could reasonably be construed by one of ordinary skill in the art as a "support."

App. Br. 8.

Our reviewing court holds, "[i]n the patentability context, claims are to be given their broadest reasonable interpretations . . . limitations are not to be read into the claims from the specification." *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citations omitted). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants, Inc. v. Medzam, Ltd.*, 133 F.3d 1473, 1477 (Fed. Cir. 1998); *see also Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1381 (Fed. Cir. 2008) ("A patentee may act as its own lexicographer and assign to a term a unique definition that is different from its ordinary and customary meaning; however, a patentee must clearly express that intent in the written description."). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (citation omitted).

In response to Appellant's contention, the Examiner finds, "[c]ompression springs are well known in the art for utility as vibration

dampers and shock absorbers. Thus, Frost's compression spring 136 would definitely meet the plain meaning of 'resilient support.'" Ans. 2. We further note Appellant has not cited to a definition of "resilient support" in the Specification that would preclude the Examiner's broader reading.

In this vein, we also observe that Appellant has not recited in the claim or otherwise pointed to evidence of record that describes the manner in which their claimed "resilient support" exercises its resiliency. More importantly, under the broadest reasonable interpretation, the claim recitation does not preclude the resilient support being resilient only in the axial direction, as apparently disclosed by Frost Figure 14, and as pointed out by Appellant. *See* App. Br. 8 ("spring 136 . . . simply allows the tube 128 to move axially."); *cf.* Rejection R1 of claim 55, *infra*. Under the broadest reasonable interpretation, we find Frost's axial movement therefore discloses a "grasping element . . . [that is] not a rigid support." *See* Reply Br. 2 (arguing "[t]he recitation of 'and not a rigid support' is not modifying 'a resilient support,' but rather 'a grasping element.'"). Furthermore, Frost discloses:

When finger unit 30 is extended into trees to pick the target fruit, there is a possibility that certain of the fingers will strike a branch with sufficiently great enough force to damage the fingers. To prevent such a result from occurring, inflatable finger 126 is telescopic so that the length thereof may be reduced as much as about 50% on striking a branch.

Frost col. 4, ll. 59–65. We find this portion of Frost teaches a resilient support.

Therefore, based upon the findings above, on this record, we are not persuaded of error in the Examiner's reliance on the disclosure of the cited

prior art to disclose the disputed limitation of claim 21, nor do we find error in the Examiner's resulting finding of anticipation. Therefore, we sustain the Examiner's anticipation rejection of independent claim 21, and grouped claims 23–28, 30, 40, 49, and 50 which fall therewith. *See Claim Grouping, supra.*

2. § 102(b) Rejection R1 of Claims 51–54

Issue 2

Appellant argues (App. Br. 11–13; Reply Br. 3–4) the Examiner's rejection of claim 51 under 35 U.S.C. § 102(b) as being anticipated by Frost is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a device that includes, *inter alia*, the limitation of "a grasping element having a resilient support that is a sole support disposed therein," as recited in claim 51?

Analysis

Appellant argues:

Frost discloses an inflatable finger 126 having a rigid spring-loaded tube 128 with a spring 136 disposed therein. The Office has repeatedly asserted that the spring 136 reads on "a resilient support," but the finger 126 does not only include the spring 136; the finger 126 also includes the tube 128. The tube 128 necessarily supports the finger 126, as described above, and thus the finger 126 includes, at best, two supports: the spring 136 *and the tube* 128.

App. Br. 12. Appellant further contends, "[t]he plain meaning of the term 'sole' in the recitation 'a sole support' is 'a single support,' as shown in Figure 1 of the present application." Reply Br. 3.

The Examiner relies upon a selective definition of the term "sole" in the Answer, with which we disagree. "Sole can be considered to be a 'lower part of something or the base on which something rests.'" Ans. 4 (citing <http://www.merriam-webster.com/dictionary/sole>).

We disagree with the Examiner's claim construction because "the PTO must give claims their broadest reasonable construction consistent with the specification[,] . . . claims should always be read in light of the specification and teachings in the underlying patent." *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1259–60 (Fed. Cir. 2010) (internal citations and quotation omitted). We find one of ordinary skill in the art, in light of the Specification and plain meaning of the claim language, would have understood "sole" to be "single," as argued by Appellant. We find the Examiner construes "sole" too broadly by including the "lower part of something" or "a base on which something rests" within its scope. Nor has the Examiner cited to any evidence of record to allow for broadening the ordinary meaning of "sole" in light of the disclosure of the Specification.<sup>4</sup>

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's reliance on the disclosure of the cited prior art to disclose the disputed limitation of claim 51, such that we find error in the Examiner's resulting finding of anticipation. Therefore, we do not sustain the Examiner's anticipation rejection of independent

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<sup>4</sup> We adopt the following definition as not being unreasonable in light of Appellant's Specification: "Sole . . . only or single." *See* <http://www.merriam-webster.com/dictionary/sole>.

claim 51, and grouped claims 52–54 which stand therewith. *See* Claim Grouping, *supra*.<sup>5</sup>

3. § 102(b) Rejection R1 of Claims 55–58

Issue 3

Appellant argues (App. Br.13–14; Reply Br. 2–3) the Examiner's rejection of claim 55 under 35 U.S.C. § 102(b) as being anticipated by Frost is in error. These contentions present us with the following issue:

Did the Examiner err in finding the cited prior art discloses a device that includes, *inter alia*, "a resilient support . . . configured to move along, and bend away from, a central axis," as recited in claim 51?

Analysis

Appellant argues "Frost lacks . . . [disclosure] of 'wherein the resilient support is configured to move along, and bend away from, a central axis' because the rigid tube 128 prevents the spring 136 from bending away from its central axis." Reply Br. 5.

The Examiner states, "Appellant has not defined where specifically is this 'central axis' relative to the other structural members in claim 55.

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<sup>5</sup> In the event of further prosecution, we invite the Examiner's consideration of whether the recitation of "a sole support" has adequate written description support under pre-AIA 35 U.S.C. § 112, first paragraph, or post-AIA 35 U.S.C. § 112(a). Furthermore, although not before us on Appeal, we offer no opinion concerning whether claim 51 would be unpatentable under 35 U.S.C. § 103(a) over Frost alone, or in combination with one or more prior art references in light of our construction of the term "sole." Although the Board is authorized to reject claims under 37 C.F.R. § 41.50(b), no inference should be drawn when the Board elects not to do so. *See* Manual of Patent Examining Procedure (MPEP) § 1213.02.

Furthermore, Appellant did not define or recite a fixed axis of orientation," and "[o]ne of ordinary skilled in the art would have known that compression springs are inherently coiled and have slight angle of bending when moving from a compressed state to an uncompressed state and vice versa." Ans. 5.

We disagree with the Examiner's finding because we find a person of ordinary skill in the art would know the recited "central axis" implicitly refers to the longitudinal axis of the "resilient support" of claim 55, and reads on the longitudinal axis of resilient support 11 as defined by the directional arrows "Rav" and "Rah" in Appellant's Figure 1.

Therefore, based upon the findings above, on this record, we are persuaded of at least one error in the Examiner's reliance on the disclosure of the cited prior art to disclose the disputed limitation of claim 55, such that we find error in the Examiner's resulting finding of anticipation. Therefore, we do not sustain the Examiner's anticipation rejection of independent claim 55, and grouped claims 56–58 which stand therewith. *See Claim Grouping, supra.*

4. Rejections R2 and R3 of Claims 31–39

In view of the lack of *any* substantive or separate arguments directed to obviousness Rejections R2 and R3 of claims 31–39 under § 103, and in light of our affirmance of Rejection R1 of claim 21 from which these claims depend, we sustain the Examiner's rejection of these claims. Arguments not made are waived.

REPLY BRIEF

To the extent Appellant may advance new arguments in the Reply Brief (Reply Br. 2–6) not in response to a shift in the Examiner's position in

the Answer, we note arguments raised in a Reply Brief that were not raised in the Appeal Brief or are not responsive to arguments raised in the Examiner's Answer will not be considered except for good cause (*see* 37 C.F.R. § 41.41(b)(2)), which Appellant has not shown.

### CONCLUSIONS

(1) The Examiner did not err with respect to anticipation Rejection R1 of claims 21, 23–28, 30, 40, 49, and 50 under 35 U.S.C. § 102(b) over the cited prior art of record, and we sustain the rejection.

(2) The Examiner erred with respect to anticipation Rejection R1 of claims 51–58 under 35 U.S.C. § 102(b) over the cited prior art of record, and we do not sustain the rejection.

(3) The Examiner did not err with respect to obviousness Rejections R2 and R3 of claims 31–39 under 35 U.S.C. § 103(a) over the cited prior art combinations of record, and we sustain the rejections.

### DECISION

We affirm the Examiner's decision rejecting claims 21, 23–28, 30–40, 49, and 50.

We reverse the Examiner's decision rejecting claims 51–58.

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). *See* 37 C.F.R. § 41.50(f).

AFFIRMED-IN-PART