Please find below and/or attached an Office communication concerning this application or proceeding.

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STATEMENT OF CASE

Appellant\(^2\) seeks review under 35 U.S.C. § 134(a) from the Examiner’s maintained rejection under 35 U.S.C. § 103 of claims 1–8, 13–16, 19, and 20 over Shigeta\(^3\) in view of Iida\(^4\) and of claims 9–12, 17, and 18.


\(^2\) The Appellant, Think Laboratory Co., Ltd., is also identified as the real party in interest. App. Br. 1.


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over Shigeta and Iida, in further view of Castle. An oral hearing was held on April 30, 2019. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse the decision to reject claims 1–20 and enter a new ground of rejection of claims 1–20.

CLAIMED SUBJECT MATTER

Appellant’s invention relates to a processing unit or system for making a gravure plate including a condenser to condense vaporized processing solution. Spec., Abstract. Claims 1, 4, and 13 are independent.

1. A processing unit including a condenser, which is to be used for a fully automatic gravure plate-making processing system for manufacturing a plate-making roll by performing a series of processes on an unprocessed plate-making roll, the processing unit comprising:

   a processing bath;

   a chuck means for holding a gravure cylinder inside the processing bath;

   an intake port for taking in air, which is provided in a part of the processing bath, said intake port being located on one side of said processing bath;

   an exhaust port for exhausting gas, which is provided in another part of the processing bath, said exhaust port being provided on another side of said processing bath, said intake port facing in a direction of said exhaust port, said intake port, said exhaust port and said processing bath defining a fluid flow path, wherein fluid moves along said fluid flow path from said one side of said processing bath to said another side of said processing bath, the gravure cylinder being located between the intake port and the exhaust port, at least a portion of the gravure cylinder being located in said fluid flow path during a plating process of the gravure cylinder, said at least said

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portion of the gravure cylinder being located at a spaced location from said processing bath, at least another portion of the gravure cylinder being in contact with said processing bath;

a condenser provided between the processing bath and the exhaust port; and

a processing solution return pipe for returning, to the processing bath, a processing solution obtained by the condenser that liquefies a part of the gas to be exhausted, said condenser being arranged adjacent to said processing solution return pipe, said processing bath and said exhaust port.

4. A fully automatic gravure plate-making processing system, comprising:

a processing unit including a condenser, said processing unit comprising:

a processing bath;

a chuck means for holding a gravure cylinder inside the processing bath;

an intake port for taking in air, which is provided in a part of the processing bath, said intake port being provided on a first side of said processing bath;

an exhaust port for exhausting gas, which is provided in another part of the processing bath, said exhaust port being provided on a second side of said processing bath, said first side being located opposite said second side, said intake port, said processing bath and said exhaust port defining a fluid flow path, at least a portion of the gravure cylinder being located in said fluid flow path, said portion of the gravure cylinder being in contact with a flow of fluid during a plate-making process of the gravure cylinder and another portion of the gravure cylinder being in contact with said processing bath during said plate-making process of the gravure cylinder, wherein the fluid moves along said fluid flow path from said first side of said processing bath to said second side of said processing bath;
a condenser provided between the processing bath and the exhaust port; and

a processing solution return pipe for returning, to the processing bath, a processing solution obtained by the condenser that liquefies a part of the gas to be exhausted, said condenser being arranged adjacent to said processing solution return pipe, said processing bath and said exhaust port.

13. A processing unit including a condenser, which is to be used for a fully automatic gravure plate-making processing system for manufacturing a plate-making roll by performing a series of processes on an unprocessed plate-making roll, the processing unit comprising:

a processing bath, said processing bath being in fluid communication with a processing bath outlet;

an intake port for taking in air, which is provided in a part of the processing bath, said intake port being arranged on one side of said processing bath;

an exhaust port for exhausting gas, which is provided in another part of the processing bath, said exhaust port being arranged on another side of said processing bath, said intake port facing in a direction of said exhaust port, said exhaust port, said intake port and said processing bath defining at least a portion of a fluid flow path, wherein a fluid is moved along said fluid flow path;

a chuck means for holding a gravure cylinder inside the processing bath such that a first portion of the gravure cylinder is arranged in said fluid flow path during a plate-making process of the gravure cylinder and a second portion of the gravure cylinder engages the processing bath during the plate-making process of the gravure cylinder, said first portion being located at a spaced location from said second portion, said first portion of the gravure cylinder being located at a spaced location from said processing bath, whereby the first portion of the gravure cylinder engages the fluid during the plate-making process of the gravure cylinder;
a condenser provided between the processing bath and the exhaust port, said condenser being arranged adjacent to said processing bath outlet and said exhaust port; and

a processing solution return pipe for returning, to the processing bath, a processing solution obtained by the condenser that liquefies a part of the gas to be exhausted.


DISCUSSION

We do not reach the merits of the rejections under 35 U.S.C. § 103 at this time. Before a proper review of the Examiner’s rejections can be performed, the subject matter encompassed by the claims on appeal must be reasonably understood without resort to speculation.

The pending claims are not subject to being understood without such speculation. Each of the independent claims recites a “processing bath” and the arrangement of an intake port, the processing bath, and an exhaust port to define a fluid flow path. Also, in each independent claim, the intake port is recited as being “provided in a part of the processing bath” and the exhaust port is recited as being “provided in another part of the processing bath.” Further, in each independent claim, chuck means are recited “for holding a gravure cylinder inside the processing bath.” Having indicated that the elements defining the fluid flow path—the intake port, the processing bath, and the exhaust port—are either “part of the processing bath” or are the “processing bath” itself, and that there are means “for holding a gravure cylinder inside the processing bath,” the independent claims set forth seemingly inconsistent requirements. Independent claim 1 recites that:

at least a portion of the gravure cylinder being located in said fluid flow path . . . , said at least said portion of the gravure cylinder being located at a spaced location from said processing
bath, at least another portion of the gravure cylinder being in contact with said processing bath.

App. Br. 34. Independent claim 4 recites that:

a portion of the gravure cylinder being in contact with a flow of fluid . . . and another portion of the gravure cylinder being in contact with said processing bath.

Id. at 35–36. Independent claim 13 recites that:

a first portion of the gravure cylinder is arranged in said fluid flow path . . . and a second portion of the gravure cylinder engages the processing bath . . . , said first portion being located at a spaced location from said second portion, said first portion of the gravure cylinder being located at a spaced location from said processing bath.

Id. at 38. In sum, there are significant issues in regard to what elements are properly included in, or are part of, the “processing bath,” and what elements are separate from it, and how such elements either contact or are positioned apart from the recited gravure cylinder.

For these reasons, we determine that each of the independent claims, and the claims depending from them, are indefinite. Section 112, second paragraph, requires that “[t]he specification . . . conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.” 6 “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).

Accordingly, we enter a new ground of rejection as to claims 1–20 under 35 U.S.C. § 112, second paragraph.

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6 The application is subject to examination under the pre-AIA first to invent provisions. Final Act. 2.
It necessarily follows that we are unable to determine the propriety of the Examiner’s § 103 rejections because to do so would require considerable speculation with regard to the metes and bounds of the claimed subject matter. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (“Our analysis of the claims indicates that considerable speculation as to meaning of the terms employed and assumptions as to the scope of such claims were made by the examiner and the board. [W]e do not think a rejection under 35 U.S.C. § 103 should be based on such speculations and assumptions.”); *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (“If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.”). Therefore, we procedurally reverse the rejections of claims 1–20 under 35 U.S.C. § 103.

In doing so, we emphasize that we do not take any position on the merits of the underlying prior art rejections, and upon clarifying the indefinite language in the claims, we will consider such rejections based on the prior art of record, if maintained by the Examiner and then brought before us again on appeal.

**DECISION**

The Examiner’s rejections of claims 1–20 under 35 U.S.C. § 103 is procedurally REVERSED.

Pursuant to 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION under 35 U.S.C. § 112, second paragraph, of claims 1–20.
Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground 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 of rejection is 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 of rejection designated in the decision. Should the examiner reject the claims, appellant 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 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.

REVERSED; NEW GROUND OF REJECTION PURSUANT TO 37 C.F.R. § 41.50(b)