



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/827,642	08/17/2015	Hilmar Gensert	051831-1810	2990
24504	7590	09/17/2019	EXAMINER	
THOMAS HORSTEMEYER, LLP 3200 WINDY HILL ROAD, SE SUITE 1600E ATLANTA, GA 30339			BATTULA, PRADEEP CHOUDARY	
			ART UNIT	PAPER NUMBER
			3725	
			NOTIFICATION DATE	DELIVERY MODE
			09/17/2019	ELECTRONIC

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

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@thomashorstemeyer.com
ozzie.liggins@tkhr.com
uspatents@tkhr.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HILMAR GENSERT

Appeal 2017-011853
Application 14/827,642
Technology Center 3700

Before JOSEPH A. FISCHETTI, ROBERT L. KINDER, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant¹ appeals under 35 U.S.C. § 134 from the Examiner's rejections of claims 1–5 and 7–11. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. According to Appellant, “[t]he real party in interest of the instant application is KAMAX Holding GmbH & Co. KG.” Appeal Br. 2.

STATEMENT OF THE CASE

Appellant's invention "relates to a pressing tool for producing components by deforming and especially by cold forming," wherein "[t]he pressing tool includes a die and a punch." Spec. 1, ll. 7–10. The formed components may consist of screws, threaded bolts, ball pins and other components with substantially symmetrical shape. *Id.* The invention more specifically "relates to a die module set for a pressing tool including two different cores and two different reinforcement rings." *Id.* at 2, ll. 13–16. "[A] first die includ[es] a first core and reinforcement rings or alternatively a second die including the other core and only one of the reinforcement rings can be composed thereof." *Id.*

Illustrative Claim

1. A die module set for mounting different dies from different combinations for a pressing tool, comprising:
 - a first core including a first inner diameter and a first outer diameter;
 - a second core including a second inner diameter and a second outer diameter, the second outer diameter of the second core being greater than the first outer diameter of the first core;
 - a first reinforcement ring having a third inner diameter and a third outer diameter, the third outer diameter of the first reinforcement ring being identical to the second outer diameter of the second core; and
 - a second reinforcement ring having a fourth inner diameter and a fourth outer diameter, wherein the die module set comprises a first die or a second die, the first outer diameter of the first core and the third inner diameter of the first reinforcement ring as well as the third outer diameter of the first reinforcement ring and the fourth inner diameter of the second reinforcement ring are coordinated in a way that the first die comprises the first

core, the first reinforcement ring and the second reinforcement ring, and

the second outer diameter of the second core and the fourth inner diameter of the second reinforcement ring are coordinated in a way that alternatively the second die comprises the second core and the second reinforcement ring, but not the first reinforcement ring.

Rejections

Claims	Grounds	References	Office Action Citation
1, 2, 5, and 8–11	35 U.S.C. § 102(a)(1)	Akamatsu ²	3–7
3, 4, and 7	35 U.S.C. § 103	Akamatsu and Memmott ³	7 and 8

ANALYSIS

Claim 1 is the only independent claim on appeal, with the rest of the claims on appeal (i.e., claims 2–5 and 7–11) depending directly or ultimately from independent claim 1. *See* Appeal Br., Claims App’x. Appellant challenges whether Akamatsu discloses certain limitations of claim 1 as discussed below. For the reasons set forth below, we find the Examiner’s reasoning persuasive and affirm the rejections based on Akamatsu.

Appellant first argues that “Akamatsu does not disclose a die module set designed and arranged such that different dies can be composed thereof.” Appeal Br. 5. According to Appellant, “the elements relied upon in Figure 10 of Akamatsu by the [Examiner] are not part of a die module set for

² Akamatsu, US 5,956,993, Sept. 28, 1999.

³ Memmott, US 7,540, 181 B1, June 2, 2009.

composing different dies, but instead they are simply part of a die.” *Id.* (emphases omitted). Similarly, Appellant argues that “Akamatsu does not and cannot serve to mount different dies from different combinations of the components since Akamatsu does not disclose modules as defined by the present disclosure, but instead Akamatsu discloses elements that are part of (only) one die having specific dimensions.” Reply Br. 3.

The Examiner responds that Claim 1 requires “that the die module set is *for mounting* different dies from different combinations,” and “[t]his indicates that the die module set is not for making up different dies but the module set is used to make different mounting configurations for different dies.” Answer 14 (emphasis added). The Examiner also notes “that all of the elements of the die module set are parts that are combined to complete a die,” and further, “it is seen in Akamatsu and the annotated drawings that the die module set is presented by the completed die which comprises the two dies claimed.” *Id.* The Examiner also finds that the preamble language of “for mounting different dies from different combinations,” “is to intended use,” but regardless, “[t]he claim language does not make it clear that it is either a first die only or either a second die only that is made by the die module set and not both that can be made or exist at the same time.” *Id.* The Examiner determines “that the indicated dies of Akamatsu are capable to be used independently in a pressing tool,” because “[e]ach of the dies of Akamatsu can be used separately as the second core can be removed from the construction and then another construction where the first core and reinforcement ring are removed and the second core is placed at the top of the die construction.” *Id.*

As to this argument, we find the Examiner's reasoning persuasive. First, because the claim language "for mounting different dies from different combinations for a pressing tool," is intended use language found only in the preamble, we find that this language does not limit the structure of the claimed invention. *See Catalina Mktg. Int'l v. Coolsavings.com, Inc.*, 289 F.3d 801, 808, (Fed. Cir. 2002). If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999). Thus, Appellant's arguments that "Akamatsu does not disclose a die module set *designed and arranged such that different dies can be composed thereof*," are not persuasive because they are not commensurate with the broadest reasonable interpretation of claim 1. *See also* Answer 15 ("The claimed invention is different from the disclosed invention.").

Second, even if this intended use were considered a limitation, the Examiner has persuasively established that Akamatsu discloses all the claimed limitations of claim 1 as explained below.

Appellant challenges the meaning of the term "module." Appellant contends that the Examiner's proposed claim construction for the term "module" "is not a complete definition of the term 'module' and submits that a module is further defined as 'a separable component, frequently one that is interchangeable with others, for assembly into units of differing size, complexity, or function.'" Appeal Br. 7 (emphasis omitted). The

Examiner's proposed definition of module to mean "one of a set of parts that can be connected or combined to build something," is broad, but reasonable, based on the Specification. Appellant has not shown why its proposed construction is the broadest reasonable interpretation.

Appellant contends that Akamatsu cannot mount different dies from different combinations of the components because Akamatsu does not disclose modules, but instead discloses elements that are part of only one die having specific dimensions. Appeal Br. 6; Reply Br. 4. Based on the claim language, we find the Examiner's response more persuasive. *See* Answer 15. Specifically, we agree with the Examiner that "[t]he claimed invention is different from the disclosed invention," (*id.*) and many of the limitations that Appellant argues are simply not part of the claimed invention. As noted by the Examiner, "[t]he claimed invention is to a die module set for mounting different dies, which makes the claim appear it is actually to die mounts," and the claim language of mounting different dies from different combinations does not require mounting separate dies from different combinations of the same pieces. *Id.* As also noted by the Examiner, claim 1 requires "alternatively the second die comprises the second core and the second reinforcement ring, but not the first reinforcement ring," but using "the term 'alternatively' at the bottom of Claim 1 does not indicate . . . separate dies, just the alternate configurations of the dies." Answer 15 (emphasis omitted). Thus, contrary to Appellant's contention, we see no requirement in the claim that the first and second die cannot be used together. *See* Appeal Br. 6.

Accordingly, the Examiner establishes adequately that the die module set forth in independent claim 1 is anticipated by Akamatsu. Thus, we

sustain the Examiner's rejection of independent claim 1 under 35 U.S.C. § 102 based on Akamatsu.

Dependent Claims 2, 5, and 8–11

These dependent claims are not argued separately (*see* Appeal Br. 7), and so they fall with independent claim 1. Thus, we sustain the Examiner's rejection of dependent claims 2, 5, and 8–11 under 35 U.S.C. § 102 based on Akamatsu.

Dependent Claims 3, 4, and 7

Claims 3, 4, and 7 stand rejected under 35 U.S.C. § 103 over Akamatsu and Memmott. Ans. 7. The Examiner has offered reasonable explanation for combining Memmott with Akamatsu (Ans. 7–8) and explained where each limitation of these claims is taught in the combination (*id.*). These dependent claims are not argued separately (*see* Appeal Br. 8) by Appellant, and so they fall with independent claim 1. Thus, we sustain the Examiner's rejection of dependent claims 3, 4, and 7 under 35 U.S.C. § 103 over Akamatsu and Memmott.

SUMMARY

Claim(s) Rejected	Basis	Affirmed	Reversed
1, 2, 5, and 8–11	35 U.S.C. § 102(a)(1) Akamatsu	1, 2, 5, and 8– 11	
3, 4, and 7	35 U.S.C. § 103 Akamatsu and Memmott	3, 4, and 7	
Overall Outcome		1–5 and 7–11	

Appeal 2017-011853
Application 14/827,642

DECISION

We AFFIRM the Examiner's rejections of claims 1–5 and 7–11.

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).

AFFIRMED