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Cantor Colburn LLP - Otis Elevator
INTELLECTUAL PROPERTY DEPARTMENT
20 Church Street, 22nd Floor
Hartford, CT 06103

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usptopatentmail@cantorcolburn.com
frederic.tenney@otis.com
frederic.tenney@otis.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte DAVID R. POLAK, CHRISTOPHER T. CHIPMAN,
CHARLES C. COFFIN, ARTHUR BLANC,
JOHN P. WESSON, YAN CHEN, DANIEL G. OPOKU, and
SERGEI F. BURLATSKY

Appeal 2018-001858
Application 13/980,621
Technology Center 3600

Before: CHARLES N. GREENHUT, GEORGE R. HOSKINS, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

GREENHUT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from a rejection of claims 1, 3–5, 7–10, 12, 13, 15–17, 19 and 28–30. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

CLAIMED SUBJECT MATTER

The claims are directed to a system and method for reducing belt noise. Claim 1, reproduced below, is illustrative of the claimed subject matter:

- 1 An elevator system, comprising:
 - an elevator car;
 - a counterweight;
 - at least one belt connecting the car and counterweight; and
 - at least one sheave having at least one surface for engagement with the at least one belt;
 - wherein said at least one belt is flat and at least part of the at least one surface has a plurality of features thereon configured to interact with the belt for reducing unwanted noise from interaction between the surface and the at least one belt;
 - wherein the plurality of features comprises at least one of indentations or projections.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Williams	GB 168,043	Aug. 17, 1922
Perron	US 2008/0289912 A1	Nov. 27, 2008

REJECTIONS

Claims 3, 4, 10, 15, 16, and 29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1, 3–5, 7–10, 12, 13, 15–17, 19 and 28–30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Perron and Williams.

OPINION

Indefiniteness

The indefiniteness rejection concerns the imprecision of the term “about” as it is used to define the ranges recited in the claims rejected under section § 112, second paragraph. According to the Examiner, the Specification lacks sufficient guidance so as to determine the degree of imprecision allowed by the use of the word “about.” Final Act. 2–3. As Appellants correctly point out, there is no *general* requirement for reciting exact range limitations. App. Br. 4–5. However, as the Examiner correctly points out, in certain instances the term “about” has been held to introduce sufficient uncertainty as to the claim scope so as to render the claims noncompliant with the requirements of § 112, second paragraph. Ans. 3–4 (citing MPEP § 2173.05(b); *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200 (Fed. Cir. 1991)). The important takeaway from *Amgen* is that that acceptableness of the term “about” in the context of defining range limitations is highly dependent upon the situation. *Amgen*, 927 F.2d at 1218. In the litigation context a frequently-quoted standard for determining the necessary exactness regarding ranges is: “If the claims, read in the light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more.” *Georgia-Pacific Corp. v. United States Plywood Corp.*, 258 F.2d 124, 136 (2d Cir.), *cert. denied*, 358 U.S. 884 (1958), *cited with approval in In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014).

Examination is an interactive process. Where the Examiner questions the clarity of a claim term it becomes incumbent upon the applicant to

respond with some amendment or explanation as to why the term, as used in the particular context of the application at issue, is reasonably clear. *See, e.g., In re Packard*, 751 F.3d at 1313–14 (“Mr. Packard did not respond adequately to this group of claim language problems. . .he did not focus on the claim-language difficulties, nor did he propose clarifying changes or show why, on close scrutiny, the existing claim language really was as reasonably precise as the circumstances permitted.”). Here, Appellants’ arguments do not point to any guidance in the Specification or elsewhere to inform us as to how one skilled in the art would ascertain the degree of imprecision allowable at the range endpoints in this particular context. Rather, Appellants only cite to other instances of cases involving claims that used the term “about.” App. Br. 4–5. These cases cannot be read to have created a per-se rule that the term “about” never raises issues of indefiniteness so as to relieve Appellants of their obligation to provide some explanation as to why the term is appropriate in this particular context or as precise as this particular subject matter permits.

Although, ultimately, exact range limitations may not necessarily be required in this context and the use of “about” is not necessarily inappropriate, we will not scour the record to make arguments or provide explanation on Appellants’ behalf. *See Ex Parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential) (“Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection.”). Appellants, having drafted the claims, as opposed to this Board, are in the best position to clarify the prosecution record so as to resolve any ambiguities during the examination process and prior to issuance. *In re Packard*, 751 F.3d at 1313 (quoting *Halliburton Energy Servs., Inc. v. M-I*

LLC, 514 F.3d 1244, 1255 (Fed.Cir.2008)); *see also SkyHawke Technologies v. Deca Int'l*, 828 F.3d 1373, 1376 (Fed. Cir. 2016) (Holding that a party that did not advocate the claim construction ultimately adopted by the Board is not necessarily bound to that claim construction for purposes of prosecution history disclaimer); *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997) (In prosecution before the PTO “[i]t is the applicants’ burden to precisely define the invention, not the PTO’s.”). As Appellants have not presented arguments to specifically address the issues of claim clarity raised by the Examiner, we consider any arguments that could have been made concerning these issues as waived for purposes of this appeal. *See* 37 C.F.R. § 41.37(c)(1)(iv). Accordingly, we sustain the Examiner’s indefiniteness rejection.

Obviousness

Each of the independent claims before us, claims 1, 12 and 30, recite the following limitation: “a plurality of features [on a sheave surface] configured to interact with the belt for reducing unwanted noise from interaction between the surface and the at least one belt.” Appellants contend this limitation is not satisfied by Williams as determined by the Examiner because, “[t]he noise in Williams is caused by the rapid rotation of the pulley and air in the features, not interaction between the surface of the pulley and the belt.” App. Br. 6.

According to the Examiner, “the interaction between the belt and the pulley in Williams is what causes the noise. Without the features A-C in Williams, the belt and pulley will interact and trap air pockets between them, the air pocket will cause a whistle when released.” Ans. 4. The Examiner’s

position is not supported by Williams's disclosure, the evidence of record. Williams discusses the goal of noise reduction (p. 1, ll. 16–19) and also discharging the air between the belt and pulley (p. 1, ll. 19–23). However, the Examiner does not cite any evidence to establish that the removal of the air pockets between the belt and pulley in Williams contributes to noise reduction. Williams instead indicates that the air discharge is for “a further object” of “improv[ing] the contact of a high speed belt and pulley.” P. 1, ll. 19–32. Williams's discussion of the pulley edges being not presented to the air to produce humming or whistling (p. 2, ll. 9–16) and Williams's analogy to the noise generated by the sharp teeth of a saw in air (p. 2, ll. 20–28) lends further credibility to Appellants' position that it is the noise generated by the interaction between the pulley and the air that Williams' grooves serve to reduce. It is not apparent from the Examiner's explanation how or why Williams's grooves would also serve to “reduc[e] unwanted noise from interaction between the [sheave] surface and the at least one belt.” As the Examiner has not sufficiently explained how the proposed combination of Perron and Williams would have yielded this aspect of the claimed subject matter, the Examiner's obviousness rejection cannot be sustained on the basis set forth by the Examiner.

DECISION

The Examiner's indefiniteness rejection is affirmed.

The Examiner's obviousness rejection is reversed.

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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-IN-PART