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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BIN GENG

Appeal 2018-001946
Application 14/454,896
Technology Center 3600

Before EDWARD A. BROWN, CHARLES N. GREENHUT, and
SCOTT A. DANIELS, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–4 and 6–9. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM and enter new grounds of rejection.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies Bin Geng as the Applicant and real party in interest. Appeal Br. 3.

THE CLAIMED SUBJECT MATTER

Appellant's claims relate to a pivoting and sliding window or door.
Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A pivot-slide door or window, comprising:

a door or window panel;

a guide rail track frame being a U-shaped elongated channel having a pair of edges being configured as rails, having a pair of rail-protrusions constructed along inside said U-shaped elongated channel wherein said pair of rail-protrusions match with said pair of edges forming two pairs of guide rails around said pair of edges;

a wheel assembly having a pair of wheels, each wheel being configured to rotate around a respective horizontal axle, each of said pair of wheels is respectively disposed on one of said pair of guide rails to [slide along] said guide rails;

a pivot mechanism having a pivot shaft and a seating structure, the pivot shaft being rotatably mounted on said wheel assembly; and

a door panel holding component having a first and second holding grooves, wherein the first holding groove is configured to fixedly hold the door or window panel, and the second holding groove is configured to fixedly hold the seating structure of said pivot mechanism.

REFERENCES

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

Isopahkala	US 5,749,172	May 12, 1998
Goldenberg	US 5,927,014	July 27, 1999
Weidner	US 3,434,236	Mar. 25, 1969

REJECTIONS

Claims 1–4, and 6–9² are rejected under 35 U.S.C. § 112(b), as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.³

Claims 1, 4, 6, and 9 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Isopahkala and Goldenberg.

Claims 2, 3, 7, and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Isopahkala, Goldenberg, and Weidner.

DRAWING OBJECTIONS

The originally filed drawings are objected to under 37 C.F.R. § 1.83(a), for not showing every feature of the claimed invention, and also that the responsive drawing amendments in the drawing replacement sheets filed December 14, 2016, are objected to under 35 U.S.C. § 132(a), as including new matter.

OPINION

Rejection of claims 1–4, and 6–10 under 35 U.S.C. § 112(b)

By way of background, the Examiner entered a Non-Final Office Action (“Non-Final OA”), March 9, 2017, including the § 112(b) rejections, following a request for continued examination by Appellant under 37 C.F.R. § 1.114. Appellant’s response to the Non-Final Office Action was the filing of a Notice of Appeal (“NOA”) on June 2, 2017. Subsequently, Appellant filed their Appeal Brief (“Appeal Br.”), on July 27, 2017.

² Claims 5 and 10 stand canceled.

³ The Examiner explained in her Answer that part of the § 112(b) rejection of claims 2 and 7, “has been withdrawn above as the issues are covered by the drawing objections.” Ans. 2–3.

In the Non-Final Office Action the Examiner rejected claims 1–4 and 6–9 under 35 U.S.C. § 112(b) as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor regards as the invention. Non-Final OA 6–7. The Examiner noted numerous aspects of the various claims which include superfluous and confusing claim language, antecedent basis issues, as well as incorrect and conflicting claim element nomenclature. *Compare, e.g.*, claim 1 (“a door panel holding component”), *with* claims 2 and 3 (“said door panel clamping component.”).

Appellant argues that the claim language is clear and that the Examiner’s rejections under 35 U.S.C. § 112(b) are misplaced, although Appellant submits in their Appeal Brief suggested amendments to clarify certain claims. Appeal Br. 11. Appellant states for example that, “[c]laim 1 may be amended by deleting ‘around said pair of edges,’ and in “[c]laim 2, claim 3, claim 8, ‘said door panel clamping component’ is a typo, ‘clamping’ should be ‘holding.’” *Id.* at 11–12. These suggested amendments to the claims, which *were not submitted* by Appellant in a response to the Non-Final Office Action prior to filing the NOA, will not be considered here. *See* 37 C.F.R. § 41.37(c)(2) (“A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other Evidence.”). Further, we do not agree with Appellant that the claim language (i.e., absent the suggested amendments) is clear.

We agree with the Examiner, for example considering claim 1, it is difficult to understand how if an edge forms a rail and a protrusion forms a rail, together they form “two pairs of guide rails around said pair of edges,” as called for in claim 1. Non-Final OA 6. Claim 1 also recites “a pair of wheels” and that “each of said pair of wheels is respectively disposed on one

of said pair of guide rails to [slide along] said guide rails.” We cannot reasonably discern from this language whether one pair of wheels is required of the claimed subject matter, or multiple pairs of wheels, or if “each of said pair of wheels” refers to each wheel individually of one pair of wheels. Further, it is unclear which wheel, or which pair or wheels, “is respectively disposed on one of said pair of guide rails,” and whether “one of said pair of guide rails” means the claimed wheels or pair of wheels are “disposed” on just one of the pair of guide rails or on both pair of guide rails. *See Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential) (“[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 . . . indefinite”); *id.* at 1213 (finding indefinite a claimed height that “does not present a structural limitation on the height at all.”).

Considering the Specification, Appellant’s Figures 3A–E, and specifically wheel component 13, we observe a pair of wheels illustrating each wheel of the pair engaging one of opposing pairs of guide rails on track 12. Observing Figures 4A–B we understand also that wheel component 13 can also include multiple pairs of wheels. Even though we can discern the wheel and track structures in these figures, and understand from the Specification that wheel component 13 includes a pair of wheels that can slide on rails of guide track 12, it is improper for us to import limitations from the Specification into the claims. Furthermore, it is not up to us to speculate as to what Appellant intended to claim because “[i]t is the applicants’ burden to precisely define the invention, not the PTO’s. *See* 35 U.S.C. § 112 ¶ 2 . . . this section puts the burden of precise claim drafting

squarely on the applicant.” *In re Morris*, 127 F.3d 1048, 1056 (Fed. Cir. 1997). A fair reading of the claim language in its present form is ultimately confusing as to a definite relationship between the claimed elements of a guide rail track, wheel assembly, pair of wheels, and guide rails. Indeed, the Appeal Brief simply concludes that “the claim language is clear,” and reiterates the claim language and a proposed amendment to claim 1. *See* Appeal Br. 11 (Appellant argues that “[c]laim 1 may be amended by deleting ‘around said pair of edges.’”).

We are not apprised from reading the claims in light of the Specification, or Appellant’s arguments and proposed amendments, that a person of ordinary skill in the art would find the present claim language is clear. If the language of a claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. § 112(b) is appropriate. *See Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986); *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1350 (Fed. Cir. 2005) (“Some objective standard must be provided in order to allow the public to determine the scope of the claimed invention.”).

We sustain the Examiner’s rejection of claim 1, and also respective dependent claims 2–4 under 35 U.S.C. § 112(b).

Independent claim 6 recites slightly different, but ultimately similarly confusing limitations and elements as claim 1 with respect to a pair of wheels and guide rails. As with claim 1, we cannot reasonably determine from reading claim 6 if “each of said pair of wheels” refers to each wheel individually, one pair of wheels or multiple pairs of wheels. Also for claim

6, it is not clear from the recitation “said each pair of wheels are respectively disposed on said first pair or said second pair of guide rails” whether the claimed wheels or pair of wheels are “disposed” on just one of the pair of guide rails or on both pair of guide rails. Consequently, for similar reasons as discussed above with respect to claim 1, we sustain the Examiner’s rejection of claim 6, and also respective dependent claims 7–9 under 35 U.S.C. § 112(b).

New ground of rejection of claims 2 and 7 under 35 U.S.C. § 112(b)

Because the Examiner’s Answer indicates for claims 2 and 7 that “the 112 rejection . . . has been withdrawn above as the issues are covered by the drawing objections,” we address claims 2 and 7 specifically here as to § 112(b). Ans. 3. We address the drawing objection as it relates to claims 2 and 7 under 37 C.F.R. § 1.83(a) under a separate heading below.

We agree with the Examiner’s initial finding in the Non-Final Office Action that these claims are grammatically incorrect. *See* Non Final OA 7 (Claim 2 depends directly from claim 1 and recites “an operable bar movably mounted within the second groove of said door panel holding component, being configured to be [sic] to move to bridge between said door panel clamping component and said wheel assembly.”). It is also not clear from this phrase, as it is also found in claim 7, which element is the object of the predicate “to move to bridge between” Perhaps the object is “an operable bar,” or “said door panel holding component,” but this is grammatically unclear.

In view of the Examiner’s withdrawal of this ground, we must reject claims 2 and 7 under 35 U.S.C. § 112(b) as indefinite, by adding a new ground of rejection. *See* 37 C.F.R. § 41.50(b).

*Drawing objections under 37 C.F.R. § 1.83(a) and 35 U.S.C. § 132(a)
and new ground of rejection under 35 U.S.C. § 112(a)*

Appellant does not specifically request our review of the Examiner's objections to the drawings under 37 C.F.R. § 1.83(a) as not showing features of the claims. Appeal Br. 8; Non-Final OA 3–6. Appellant does expressly request our review of the Examiner's objection to Appellant's replacement drawings under 35 U.S.C. § 132(a) as including new matter. Ordinarily an objection is reviewable by petition under 37 C.F.R. § 1.181, and may not be within the jurisdiction of the Board. *See* MPEP § 608.04(c). However, here the resolution and effect of the drawing and new matter objections are intertwined with issues related to 35 U.S.C. § 112(a). The review of such issues falls within our 35 U.S.C. § 6 jurisdiction regardless of whether termed “objection” or “rejection.” *In re Haas*, 486 F.2d 1053, 1056 (CCPA 1973); *In re Searles*, 422 F.2d 431, 434–435 (CCPA 1970); MPEP § 608.04(c).

For purposes of clarity, we address under separate headings the drawing objections pertaining to the sufficiency of the drawings under 37 C.F.R. § 1.83(a), the new matter issue raised under 35 U.S.C. § 132(a), and the new ground of rejection under § 112(a).

37 C.F.R. § 1.83(a)

The Examiner objects to the drawings under 37 C.F.R. § 1.83(a) as not showing every feature of the claimed invention as recited in claims 2, 3, and 8, because the drawings do not show, for example as recited in claim 2, the relation and functioning of “an operable bar” as it pertains to both “said door panel holding component” and “said door panel clamping component.” *See* Non-Final OA 7. Appellant does not contest the Examiner's objection

on this basis. We therefore reach neither the issue of whether we have jurisdiction over the Examiner's determination, nor the merits of whether certain claim features must be shown in the drawings under 37 C.F.R. § 1.83(a).

35 U.S.C. § 132(a)

Appellant specifically requests our review of the Examiner's drawing objections under 35 U.S.C. § 132(a). Appeal Br. 9.

The Examiner objects to certain of the amended Figures in the drawing replacement sheets as introducing new matter into the disclosure.

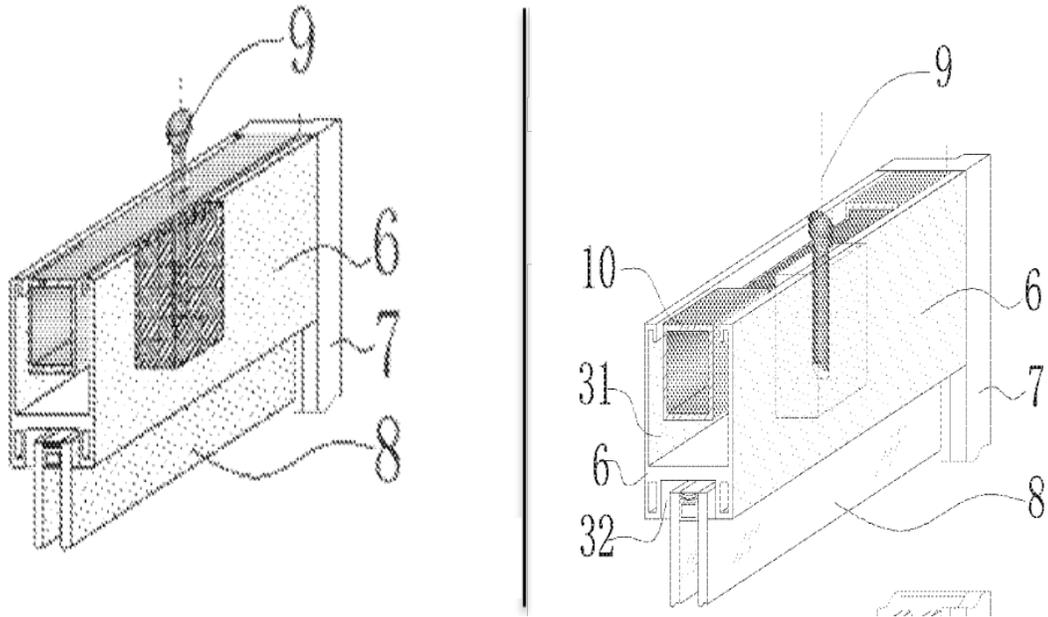
The Non-Final Office Action explained that

[t]he added material which is not supported by the original disclosure is as follows: the large rectangular hole in operable bar 10 in figures 3B, C, D, 4B and C was not shown in the original figures. The original figures clearly show only a small circular hole around pivot shaft 9 in figure 4B that is not large enough to engage wheel assembly 13.

Non-Final OA 2; Ans. 3.

Appellant argues that although amendments made for example, to Figure 4B in the replacement drawing sheets differ from the original drawings, the original drawings included an error, and that "[a]n amendment to correct an obvious error does not constitute new matter." Appeal Br. 11 (citing *In re Oda*, 443 F.2d 1200 (CCPA 1971); MPEP § 2163.07).

Appellant argues specifically that although the operable bar 10 shown in the original figures is non-functional, "FIG. 4[A] must be an obvious error, because even a patent examiner can recognize the non-functionality." *Id.* at 10. Original Figure 4A and amended Figure 4A are reproduced below.



A portion of original Figure 4A is shown above on the left, including operable bar 10, and the coinciding portion of amended Figure 4A, shown on the right, having a rectangular hole formed in operable bar 10 about pivot shaft 9.

We are not persuaded that the drawing error, as it is acknowledged by Appellant, can be corrected by this drawing amendment. The drawing amendment adds an entirely new element to the drawings and the disclosure, that is—a rectangular hole, formed in operable bar 10. The rectangular hole amendment is intended, we understand, to illustrate a structural feature that would allow operable bar 10 to essentially overlap trolley 13—instead of simply butt up against the lower-most surface of the trolley. Appeal Br. 10–11. Appellant does not, however, point to any support in the written description for this rectangular hole structure, nor does our review of the Specification reveal any such language expressly or inherently discussing such structure. We appreciate that addition of this rectangular hole structure

might permit operable bar 10 to overlap trolley 13, but neither the written description, the original drawings, nor Appellant's argument that the error is obvious, provide persuasive evidence that the inventor was in possession of such a structure and device as shown in the amended Figure 4A at the time of filing of the patent application. Also, Appellant's reliance on *In re Oda* is misplaced. *In re Oda* addresses mainly the issue of a translation error and not issues of new matter raised by the addition of new elements to the specification and drawings. Moreover, *In re Oda* also requires not only that the error be obvious, but that *the solution* to the error must be obvious to a person of ordinary skill in the art. *See In re Oda*, 443 F.2d at 1206 (Overturning the new matter rejection, the court explained "that one skilled in the art would appreciate not only the existence of error in the specification but . . . how to correct it."); MPEP § 2163.07. Appellant's suggestion that the rectangular hole in operable bar 10 as shown in amended Figure 4A could fix the error in the original drawings does not explain sufficiently why the rectangular hole must have been the obvious correction to one of skill in the art.

We sustain the Examiner's objection under 35 U.S.C. § 132(a) to the amended drawings.

Claims 2, 3, 7, and 8—New ground of rejection under 35 U.S.C. § 112(a)

Where we sustain the objections under 35 U.S.C. § 132(a), we determine that the facts of this case also require rejection of claims 2, 3, 7, and 8 under 35 U.S.C. § 112(a). Section 112(a) requires that the claim language be supported in the specification. In this case, the Examiner has pointed out a lack of supporting disclosure for the claimed subject matter. Although the Examiner articulates this in the context of an objection, a lack

of supporting disclosure typically raises issues under the first paragraph of § 112 (MPEP § 2174).

Claim 2 recites:

The pivot-slide door or window of Claim 1, wherein said door panel clamping component further comprises:

an operable bar movably mounted within the second groove of said door panel holding component, being configured to be to move *to bridge between said door panel clamping component and said wheel assembly, thereby preventing the door or window panel from rotating.*

Claims App. (emphasis added).

Different from the elements and functioning recited in claim 2, the written description does not designate the operable bar as bridging between the door panel holding (or clamping) component *and the wheel assembly*, but describes “[o]perable bar 10 . . . having sufficient height to bridge the space gap *between track 12* and horizontal [holding/clamping] component 6.” Spec. 7. However, observing the original drawings, for instance Figures 4A–D, and Figures 5A–C, and as the Examiner has noted, it appears *impossible* that the operable bar 10 bridging between the door panel clamping component and the wheel assembly, as called for in claim 2, would engage the track and prevent the door from rotating. *See* Non-Final OA 4–5 (The Examiner explained that the drawings “fail to show how the operable bar 10 engages the track 12 sufficient to prevent pivoting of the panel about pivot axle 9 as described in the specification.”). Without some additional undisclosed structure that allows the operable bar 10 to be moved into the area of wheel component 13, there would be a physical interference between operable bar 10 and wheel component 13. It is not apparent to us how to demonstrate possession of, or enable, a structure whose operation depends

on two discrete components physically occupying the same space at the same time. Thus, Appellant's disclosure, as originally filed clearly fails to satisfy the written description and enablement requirements of 35 U.S.C. § 112(a) with regard to the rotation prevention recitations in claims 2 and 7.

Appellant does not controvert the substance of the Examiner's findings in this regard. Rather, in order to rectify this problem, as discussed above, Appellant has supplied amended drawings including the "rectangular hole" shown in amended Figure 4A. Along with this drawing amendment to Figure 4A, Appellant argues that "FIG. 5A shows that operative bar 10 has an opening around the wheel 13." Appeal Br. 12. Again, it may be that forming or fabricating a rectangular hole in the operable bar 10 in the manner that amended Figure 4A shows would permit the functional and structural elements of claim 2 to be met. However, as discussed above, we agree with the Examiner that the rectangular hole introduces new matter into the Specification and is not described or shown in the original Specification and drawings, or for example in Figure 5A, as Appellant argues. *Id.* Thus, this subject matter in the amended figures cannot be relied upon to resolve the original disclosure's shortcomings with respect to the written description and enablement requirements.

In view of the foregoing, we additionally reject the claims under § 112, first paragraph as failing to comply with the written-description and enablement requirements.

In light of the ambiguities associated with the rejection under 35 U.S.C. § 112(b), we will not reach the prior-art rejection at this time. *See In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (A prior art rejection cannot be

sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of claim language.).

CONCLUSION

The Examiner’s rejection under 35 U.S.C. § 112, second paragraph, is affirmed. We enter new grounds of rejection under 35 U.S.C. § 112, first and second paragraph. We reverse, without reaching the merits of, the prior-art rejections.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Grounds
1–4, 6–9	112(b)	Indefinite	1–4, 6–9		
2, 7 (Drawings)	112(b) 132(a)	Indefinite	2, 7 (Drawings)		2, 7
1, 4, 6, 9	103	Isopahkala, Goldenberg		1, 4, 6, 9	
2, 3, 7, 8	103	Isopahkala, Goldenberg, Weidner		2, 3, 7, 8	
2, 3, 7, 8	112(a)	Written description, Enablement			2, 3, 7, 8
Overall Outcome			1–4, 6–9		2, 3, 7, 8

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 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.

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; 37 C.F.R. § 41.50(b)