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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* HEIKO ROEHM

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Appeal 2018-008649  
Application 13/925,088  
Technology Center 3700

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Before PHILIP J. HOFFMANN, AMEE A. SHAH, and  
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), the Appellant<sup>1</sup> appeals from the Examiner’s final decision to reject claims 1–3 and 5–19, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and ENTER a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. The Appellant identifies the real party in interest as “Robert Bosch GmbH.” Appeal Br. 1.

CLAIMED SUBJECT MATTER

The Appellant's invention "relates to a power tool." Spec. 1, l. 8.

Claims 1, 18, and 19 are the independent claims. Claim 1 is illustrative of the subject matter on appeal and is reproduced below (with added bracketing for reference):

1. A power tool, comprising:

[(a)] an electric motor and a housing;

[(b)] a tool holder rotatably mounted on the housing about an axis of rotation, the electric motor being connected to the tool holder;

[(c)] a handle for an operator being provided on the housing, the handle having a handle length; and

[(d)] a static stall torque which is defined as the stall torque of the driven tool holder when a gear of the power tool is set to a lowest speed of the gear and/or a speed controller is set to a highest rotational speed, wherein the ratio of the static stall torque to the handle length is greater than 400 Nm/m,

[(e)] wherein the power tool has two handles for two-handed holding, the two handles forming an angle between 160° and 200° to one another and the sum of the two handle lengths being used as the handle length.

Claims App'x 1.

## REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Sedwick	US 2,813,517	Nov. 19, 1957
Guzzella	US 5,584,619	Dec. 17, 1996
Myers et al. (“Myers”)	US 7,164,252 B1	Jan. 16, 2007
Zhang et al. (“Zhang”)	US 2007/0084613 A1	Apr. 19, 2007
Carrier et al. (“Carrier”)	US 7,395,871 B2	July 8, 2008
Uehlein-Proctor et al. (“Uehlein-Proctor”)	US 7,557,534 B2	July 7, 2009
Limberg et al. (“Limberg”)	US 2012/0111592 A1	May 10, 2012
Makita Product Details, <a href="https://www.makitatools.com/products/details/6952">https://www.makitatools.com/products/details/6952</a> , retrieved Oct. 5, 2016 (“Product Details”)		
Makita USA, <a href="https://web.archive.org/web/20101218050723/http://makitatools.com/en-us/Modules/Tools">https://web.archive.org/web/20101218050723/http://makitatools.com/en-us/Modules/Tools</a> , retrieved Sept. 29, 2016 (“Makita”)		

## REJECTIONS

Claims 1–3 and 5–19<sup>2</sup> stand rejected under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as being indefinite.

Claims 1–3 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, and Product Details.

Claims 6–10 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Zhang, and Product Details.

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<sup>2</sup> The Examiner’s inclusion of canceled claim 4 in this rejection is considered inadvertent harmless error.

Claims 6–11, 16, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Guzzella, and Product Details.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Uehlein-Proctor, and Product Details.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Guzzella, Uehlein-Proctor, and Product Details.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Carrier, and Product Details.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Sedwick, Myers, and Product Details.

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, and Product Details.

Claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Makita, Limberg, Guzzella, and Product Details.

## OPINION

### ***35 U.S.C. § 112***

#### *Claims 1, 18, and 19*

The Examiner rejects independent claims 1, 18, and 19 under 35 U.S.C. § 112(b)/second paragraph because the limitation, recited in all three claims, of a speed controller being set to a highest rotational speed “is vague and indefinite because it is not clear if the speed controller is rotating and set to rotate at the highest rotational speed or if the speed controller sets

another structure to rotate at the highest rotational speed.” Final Act. 4. Specifically, “[i]f the claim should be interpreted as the speed controller setting another structure to rotate at the highest rotational speed, what is that other structure?” *Id.* In other words, the Examiner determines that “the claims do not connect the ‘rotational speed’ or the speed controller to any structure,” and it is thus unclear “how . . . the speed controller function[s] within the context of the power tool” as there is “no linking structure” in the claims. Ans. 17.

The Appellant directs attention to the last paragraph of the Specification, emphasizing the portion: “**If a speed controller is provided on the power tool, then the highest rotational speed is used for ascertaining the stall torque or the slip torque of the clutch.**” Appeal Br. 3–4. The Appellant contends

that one skilled in the art understands the term “speed controller” in the context of a power tool. The claim states that the “speed controller is set to a highest rotational speed.” In other words, if a speed controller (known to one skilled in the art) is provided on the power tool, then the speed controller “is set to a highest rotational speed” in order to ascertain the static stall torque.

Reply Br. 1.<sup>3</sup>

Claim 1 recites, in relevant part, a power tool having a static stall torque which is defined as the stall torque of the driven tool holder when a gear of the power tool is set to a lowest speed of the gear and/or a speed controller is set to a highest rotational speed, wherein the ratio of the static stall torque to the handle length is greater than 400 Nm/m.

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<sup>3</sup> We note the Reply Brief does not contain page numbers. Therefore, we consider page titled “**REPLY BRIEF UNDER 37 C.F.R. § 41.41**” as page 1 with each page thereafter consecutively numbered.

Claims App'x 1. Claims 18 and 19 recite the same limitation. We note that the limitation does not recite any structure, but defines the static stall torque requirement for the claimed power tool. In other words, the speed controller is not recited as a structural element, but as an element in how the parameter of a static stall torque is determined. Further, the speed controller is in addition to or an alternative for a gear set to a lowest speed. We agree with the Appellant that one of ordinary skill in the art would understand the claim to recite that static stall torque is determined when a gear is set to a lowest speed and/or a conventional speed controller is set to a highest speed, with no further structure required.

Based on the foregoing, we do not sustain the indefiniteness rejection of the independent claims 1, 18, and 19, and of the associated dependent claims, on the basis discussed above.

*Claim 5*

Dependent claim 5 recites the power tool having “two handles for two-handed holding, the two handles forming an angle of less than 160° to one another and the longest handle length being used as the handle length.” Claims App. 1. The Examiner further rejects claim 5 as being indefinite because it is not clear whether claim 5 recites an additional two handles or is further defining the angle between the handles of claim 1 and thus being outside the range claimed in claim 1. *See* Final Act. 4–5.

The Appellant provides no argument against this rejection, stating “in the event prosecution is reopened, Appellant agrees to cancel this claim.” Appeal Br. 4.

Based on the foregoing, we sustain the indefiniteness rejection of the dependent claim 5.

***New Ground of Rejection – 35 U.S.C. § 112***

*Claims 1–3 and 5–17*

Pursuant to 37 C.F.R. § 41.50(b), independent claim 1 is hereby rejected under AIA 35 U.S.C. § 112(b) or pre-AIA 35 U.S.C. § 112, second paragraph, as being indefinite, because the scope and meaning of the limitations of the claims cannot be determined. Because the same indefiniteness issue affects dependent claims 2, 3, and 5–17, they are also rejected on the same basis.

Independent claim 1 recites a power tool comprising, in relevant part, a handle provided on the tool's housing for an operation, the handle having a handle length, a ratio of the static stall torque to the handle length greater than 400 Nm/m, and the power tool having two handles for two-handle holding, formed at an angle to each other between 160° and 200°, with “the sum of the two handle lengths being used as the handle length.” Claims App'x 1.

The text of AIA 35 U.S.C. § 112(b) and pre-AIA 35 U.S.C. § 112, second paragraph requires “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the [Appellant] regards as the invention.” “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). Claims are in compliance with 35 U.S.C. § 112(b)/second paragraph if “the claims, read in 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.” *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385 (Fed. Cir. 1986) (citing *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624 (Fed. Cir. 1985)). Thus, the test for determining the question of indefiniteness may be formulated as whether the claims “set out and circumscribe a particular area with a reasonable degree of precision and particularity.” *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

Claim 1 is indefinite because one of ordinary skill in the art cannot ascertain without considerable speculation what the inventor regards as the invention nor the scope and meaning of the claims. First, it is not clear to one of ordinary skill in the art whether the power tool has three handles, i.e., the “handle for an operator” as recited in limitation (c) and the “two handles for two-handed holding” as recited in limitation (e), or whether the tool has two handles, i.e., whether the “handle for an operator” of limitation (c) comprises the “two handles for two-handed holding” of limitation (e). Figure 7 of the Specification indicates two handles (although not necessarily with an angle between 160° and 200°). However, Figure 8 of the Specification indicates two handles approximately 180° apart with a third handle on the rear. Second, it is not clear whether the handle length used for the ratio of torque to handle length is the single handle length or the sum of the two handles. As such, it is not clear to one of ordinary skill in the art what comprises the scope of the tool, i.e., having two or three handles, or the meaning of handle length as used in the ratio, i.e., whether the length of one handle or the sum of two handles.

Therefore, independent claim 1 and thus also dependent claims 2, 3, and 5–17 have ambiguities such that they are unclear, and are thus indefinite. *See In re Packard*, 751 F.3d at 1314.

**35 U.S.C. § 103**

*Claims 1–3 and 5–17*

The Appellant contends that the Examiner’s rejection of claim 1 is in error because “[n]owhere do the cited references disclose or suggest the feature of *the power tool has two handles for two-handed holding, the two handles forming an angle between 160° and 200° to one another*,” nor do the references “disclose or suggest the feature of taking the sum of the two handle lengths as the grip length for the ratio of the static stall torque to the handle length.” Appeal Br. 5; *see also* Reply Br. 2. Conversely, the Examiner determines that these limitations are met by the combination of Makita, Limberg, and Sedwick. *See* Final Act. 7; Ans. 17–19.

Having determined that this subject matter of claim 1 is indefinite, we are unable to determine the propriety of the Examiner’s prior art rejections of claims 1–3 and 5–17. The review of the rejections of these claims as obvious under 35 U.S.C. § 103(a) would require considerable speculation as to the scope and meaning of the claims. Such speculation would not be appropriate. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

We, therefore, reverse *pro forma* the prior art rejections under 35 U.S.C. § 103(a) of claims 1–3 and 5–17. We emphasize that this is a technical reversal of the rejections under 35 U.S.C. § 103, and not a reversal based upon the merits of the rejections.

*Claims 18 and 19*

The Appellant argues the rejections of independent claims 1, 18, and 19 together. *See* Appeal Br. 5; Reply Br. 2. However, independent claims 18 and 19 do not recite the limitation of having two handles forming a specific angle. Thus, the Appellant's arguments that the prior art does not teach two-handles or taking the sum of the two handle lengths (Appeal Br. 5) are not applicable to rejections of claims 18 and 19.

The Appellant further states

nowhere do the cited references disclose or suggest the feature of a static stall torque which is defined as the stall torque of the driven tool holder when a gear of the power tool is set to a lowest speed of the gear and/or a speed controller is set to a highest rotational speed, wherein the ratio of the static stall torque to the handle length is greater than 400 Nm/m, as recited in the context of the present invention.

*Id.*; Reply Br. 2.

However, the Appellant fails to meet the burden to rebut the Examiner's prima facie case by distinctly and specifically pointing out the supposed errors in the Examiner's action, as well as the specific distinctions believed to render the claims patentable over the applied references. *See* 37 C.F.R. § 41.37(c)(iv) (2015) ("A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim."); *see also In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) ("[W]e hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art."). Rather than distinctly pointing out the Examiner's supposed errors, the Appellant recites the claim language and

summarily concludes that the references do not meet the quoted claim language. The Appellant has not identified error in the Examiner's interpretations of the cited references or the claim language. The Appellant may well disagree with how the Examiner interpreted and applied the references, but the Appellant offers no substantive arguments to rebut the specific underlying factual findings made by the Examiner in support of the ultimate legal conclusion of obviousness. And we decline to examine the claims *sua sponte*, looking for distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”).

In the absence of a more detailed explanation, we are not persuaded of error on the part of the Examiner. *See In re Jung*, 637 F.3d 1356, 1365 (Fed. Cir. 2011) (“[I]t has long been the Board's practice to require an applicant to identify the alleged error in the examiner's rejections,” citing *Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010) (precedential) (“The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon.”)). Therefore, we sustain the Examiner's rejections of claims 18 and 19 under 35 U.S.C. § 103(a).

#### CONCLUSION

The Examiner's decision to reject claims 1–3 and 5–19 under 35 U.S.C. § 112 is affirmed in part.

The Examiner's decision to reject claims 1–3 and 5–17 under 35 U.S.C. § 103(a) is reversed *pro forma*.

The Examiner's decision to rejection claims 18 and 19 under 35 U.S.C. § 103(a) is affirmed.

DECISION SUMMARY

In summary:

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
1-3, 6-19	112(b)/ 112, 2 <sup>nd</sup> paragraph	Indefiniteness	5	1-3, 6-19	1-3, 5-17
1-3, 5	103(a)	Makita, Limberg, Sedwick, Product Details		1-3, 5	
6-10, 17	103(a)	Makita, Limberg, Sedwick, Zhang, Product Details		6-10, 17	
6-11, 16, 17	103(a)	Makita, Limberg, Sedwick, Guzzella, Product Details		6-11, 16, 17	
12	103(a)	Makita, Limberg, Sedwick, Uehlein- Proctor, Product Details		12	
13	103(a)	Makita, Limberg, Sedwick, Guzzella, Uehlein-		13	

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/ Basis</b>	<b>Affirmed</b>	<b>Reversed</b>	<b>New Ground</b>
		Proctor, Product Details			
14	103(a)	Makita, Limberg, Sedwick, Carrier, Product Details		14	
15	103(a)	Makita, Limberg, Sedwick, Myers, Product Details		15	
18	103(a)	Makita, Limberg, Product Details	18		
19	103(a)	Makita, Limberg, Guzzella, Product Details	19		
<b>Overall Outcome</b>			5, 18, 19	1-3, 6-17	1-3, 5-17

This decision contains new ground 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-IN-PART; 37 C.F.R. § 41.50(b)