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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* SHAILESH SHRINKANT KOZAREKAR and  
GREGORY DEAN GARDNER<sup>1</sup>

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Appeal 2019-000467  
Application 13/198,740  
Technology Center 3600

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Before CHARLES N. GREENHUT, WILLIAM A. CAPP, and  
MICHAEL L. WOODS, *Administrative Patent Judges*.

WOODS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

STATEMENT OF THE CASE

Shailesh Shrinkant Kozarekar and Gregory Dean Gardner (“Appellants”) filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.52 on August 27, 2019, of the Decision on Appeal 2019-000467 mailed June 27, 2019 (“Decision”).

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<sup>1</sup> According to Appellants, the real party in interest is Ford Global Technologies, LLC. Appeal Br. 1.

Below is a summary of our Decision:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 4, 7–13, 15, 17, 19– 21, 23–26	112(a)	Written Description	1, 4, 7–13, 15, 17, 19– 21, 23–26	
1, 4, 7, 8, 12, 15, 17, 21, 23–26	102(b)	Minagawa <sup>2</sup>		1, 4, 7, 8, 12, 15, 17, 21, 23–26
9–11, 13, 19, 20	103(a)	Minagawa		9–11, 13, 19, 20
<b>Overall Outcome</b>			1, 4, 7–13, 15, 17, 19– 21, 23–26	

Decision 10.

#### ORIGINAL DECISION ON APPEAL

In our Decision, we affirmed the Examiner’s written description rejection and agreed with the Examiner that the claimed terms “when a vehicle speed is above a threshold speed,” “motoring mode,” and “operating a generator in a reverse direction” lack written description support.

Decision 3–9.

We further agreed with the Examiner that “motoring mode” and “operating the generator in reverse direction” may have multiple different interpretations, and absent any written description support or other evidence of record, we could not discern the meaning of the limitations. *See id.* at 6–8; *see also, e.g.*, Ans. 8 (“[T]he term ‘motoring-mode’ could have many

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<sup>2</sup> Minagawa is U.S. Patent Publication Number 2003/0181276 A1, published Sept. 25, 2003.

different meanings”); *see also, e.g.*, Ans. 9 (“The term ‘reverse direction’ could [have] multiple different interpretations”).

Because we could not discern the meaning of the terms “motoring-mode” and “operating the generator in reverse direction,” and although we did not exercise our discretion to enter a new ground of rejection of the claims under 35 U.S.C. § 112, second paragraph, as also being indefinite, we nevertheless reversed *pro forma* the prior art rejections based on Minagawa. *See* Decision 9–10. As explained in the Decision, reviewing the merits of the prior art rejections would resort to unsupported speculative assumptions as to the scope of the claims. *See id.* at 9 (citing: *Ex parte Miyazaki*, 89 USPQ2d 1207, 1217 (precedential) (BPAI 2008); *Ex parte Smith*, 2008 WL 4998624 (BPAI 2008); and *In re Steele*, 305 F.2d 859, 863 (CCPA 1962)).

#### APPELLANTS’ CONTENTIONS

Appellants’ Request alleges that the Board “has misapprehended and overlooked the Appellants’ remarks in the Appeal Brief and Reply Brief that the term ‘motoring mode’ is supported by the specification, *as the term is used in the claims.*” Request 2 (emphasis added).

Appellants’ Request further alleges that “the Board misapprehended the Appellants’ arguments regarding the claim Examiner’s claim [sic] interpretation in the Reply Brief,” namely, the claimed “motoring-mode.” Request 2–3.

We disagree with Appellants’ assertions that we overlooked or misapprehended Appellants’ arguments.

## ANALYSIS

Appellants' contention that the term "motoring mode" is supported by the Specification because of how the term is "used in the claims" (Request 2) is unpersuasive circular logic. The claims are rejected for lacking written description support from the original specification, and Appellants' attempt to rely on amended claims to provide the subject matter support does not address the rejection before us. In other words, the originally filed claims *do not* recite the term "motoring mode," and Appellants cannot cite to the amended claim language as providing the needed subject matter support. *See* Spec. 9–12 (claims).

As to Appellants' Appeal and Reply briefs, Appellants also contend that paragraph 17 of the Specification provides written description support for the claimed "motoring mode." *See* Appeal Br. 10 (citing Spec. ¶ 17); *see also* Reply Br. 4 (citing Spec. ¶ 17). As explained in our Decision, however, "Paragraph 17 of the Specification does not use the term 'motoring mode' and Appellants do not submit declaration evidence to support its contention that a skilled artisan would understand 'motoring-mode' to mean the generator operating as a motor." Decision 6 (citing *In re Cole*, 326 F.2d 769, 773 (CCPA 1964)). Indeed, and upon reviewing the entirety of Appellants' original disclosure, we find no reference to "motoring-mode" to guide us in our understanding of the term. "The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import." MPEP § 608.01(o). "[A]n issue of new matter will arise if the content of [an] amendment is not described in the application as filed." MPEP § 2163.06. "If new matter is added to the claims, the examiner should reject the claims under [ ] 35 U.S.C.

112, first paragraph - written description requirement.” *Id.* This is precisely what the Examiner did. Final Act. 3–4; Decision 4–5.

Moreover, we further agree with the Examiner that the term does not have a standard meaning and that it may mean many different things, such as the motor driving the vehicle. *See id.* (citing Ans. 8); *see also* Ans. 8 (“the term ‘motoring-mode’ could have many different meanings . . . [such as] referring to when the vehicle is being driven using the motor.”).

As to Appellants’ contention that we “misapprehended the Appellants’ arguments regarding the claim Examiner’s claim [sic] term interpretation” of “motoring-mode,” we also disagree. Request 2–3. Appellants argue that the Examiner’s interpretation of the term “would be redundant under the Examiner’s interpretation of Minagawa,” (*id.* at 3), but the issue is not whether the Examiner’s interpretation of the term would somehow be redundant. Rather, our inability to address the prior art rejections stems from our inability to make heads-or-tails of the claimed terms, including “motoring-mode” and “operating the generator in reverse direction.” *See* Decision 9. Although we did not exercise our discretion under 37 C.F.R. § 41.50(b) to enter a new ground of rejection under 35 U.S.C. § 112, second paragraph, for indefiniteness, this lack of clarity precluded us from reaching a conclusion regarding the Examiner’s prior-art rejections.

To reiterate, *we simply cannot discern* what “motoring-mode” means, and additionally find that neither the Specification nor other evidence of record (e.g., declaration testimony) supports the term. *Id.* As explained in our Decision, addressing the prior art rejections would require us to resort to unsupported speculative assumptions as to the scope of the claimed terms,

including, “motoring-mode” and “operating the generator in reverse direction.” *See id.*

Finally, Appellants request that we reconsider the prior art rejections—even though we reversed them *pro forma*—presumably due to our misapprehension of the claimed term “motoring-mode.” *See* Request 2–3. Missing from Appellants’ Request, however, is any discussion as to the claimed term “operating the generator in reverse direction” (*see id.*), which we are also unable to interpret based on the lack of any written description support. *See* Decision 6–8; *see also id.* at 9 (“the claims recite multiple limitations (e.g., ‘motoring-mode,’ ‘operating the generator in reverse direction’) that are not supported by the Specification and which we, frankly, do not understand.”). In other words, *even if* we agreed with Appellants’ interpretation of the claimed “motoring-mode,” we would still have to resort to speculative assumptions about the claim limitation “operating the generator in reverse direction” in addressing the prior art rejections.

For the above reasons, the arguments in Appellants’ Request do not apprise us of error in our Decision.

## DECISION

We have granted Appellants’ Request to the extent that we have considered our Decision in light of the points raised therein, but have denied the Request with respect to any modification to the Decision.

Below is a summary of our Rehearing Decision:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Granted</b>	<b>Denied</b>
1, 4, 7–13, 15, 17, 19– 21, 23–26	112(a)	Written Description		1, 4, 7–13, 15, 17, 19– 21, 23–26
1, 4, 7, 8, 12, 15, 17, 21, 23–26	102(b)	Minagawa		1, 4, 7, 8, 12, 15, 17, 21, 23–26
9–11, 13, 19, 20	103(a)	Minagawa		9–11, 13, 19, 20
<b>Overall Outcome</b>				1, 4, 7–13, 15, 17, 19– 21, 23–26

Below is a summary of the outcome of our Rehearing Decision:

<b>Claim(s) Rejected</b>	<b>35 U.S.C. §</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1, 4, 7–13, 15, 17, 19– 21, 23–26	112(a)	Written Description	1, 4, 7–13, 15, 17, 19– 21, 23–26	
1, 4, 7, 8, 12, 15, 17, 21, 23–26	102(b)	Minagawa		1, 4, 7, 8, 12, 15, 17, 21, 23–26
9–11, 13, 19, 20	103(a)	Minagawa		9–11, 13, 19, 20
<b>Overall Outcome</b>			1, 4, 7–13, 15, 17, 19– 21, 23–26	

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).

DENIED