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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte THOMAS HESS and ERWIN BAYER

Appeal 2019-003307
Application 13/989,270
Technology Center 1700

Before BRADLEY R. GARRIS, CHRISTOPHER L. OGDEN, and
LILAN REN, *Administrative Patent Judges*.

REN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 11–21 and 27–35. Final Act. 2–4. We have jurisdiction 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(a). Appellant identifies the real party in interest as “MTU Aero Engines AG of Munich, Germany.” Appeal Br. 3.

OPINION

Indefiniteness of claims 11–18, 20, 21, and 27–35

The Examiner rejects claim 11 finding that the limitation “if the at least one parameter exceeds a predetermined value” is contingent and therefore ambiguous failing to meet the definiteness requirement under section 112. Final Act. 2; Ans. 5.

Appellant, on the other hand, argues that, when read in light of the Specification, a skilled artisan would understand the limitation to mean that the depression is filled when the recited condition is met. Appeal Br. 6 (citing Spec. 2:20–27, 6:4–27).

Under the broadest reasonable interpretation, a method claim having contingent limitations requires only those steps required to be performed when the condition precedent is met. *See Ex parte Schulhauser*, Appeal 2013-007847, slip op. at 10 (PTAB April 28, 2016) (precedential) (“If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.”); *see also* MPEP § 2111.04 (9th ed. Rev. 08.2017, Jan. 2018) (“The broadest reasonable interpretation of a method (or process) claim having contingent limitations requires only those steps that must be performed and does not include steps that are not required to be performed because the condition(s) precedent are not met.”). “It is of course true that method steps may be contingent. If the condition for performing a contingent step is not satisfied, the performance recited by the step need not be carried out in order for the claimed method to be performed.” *Cybersettle, Inc. v. Nat’l Arbitration Forum, Inc.*, 243 Fed. App’x. 603, 607 (Fed. Cir. 2007). We accordingly do not sustain the indefiniteness rejection of claim

11. The indefiniteness rejection of claims 12–18, 20, 21, and 27–35, based on their dependency from claim 11, is likewise reversed.

Indefiniteness of claim 19

Claim 19 depends from claim 11 and additionally recites: “wherein the at least one parameter is detected concurrently with forming the layer.”

The Examiner rejects claim 19 under section 112, second paragraph because “[i]t is unclear how a recess could be in existence prior to the layer being formed.” Final Act. 2. Appellant argues, on the other hand, that a skilled artisan would “understand claim 19 to mean that during the period of time required for forming the layer also a detection of depressions in the part of the layer that has already been formed during the process is carried out.”³ Appeal Br. 6.

We do not sustain the indefiniteness rejection of claim 19 because the Examiner’s reasoning (Final Act. 2) is not based on the limitations (e.g., a recess in existence prior to forming the layer (Final Act. 2)) recited in the claim.

Anticipation of claims 11–16, 18–21, and 27–35⁴

The Examiner finds that claim 11 is anticipated by Dorscheid. Final Act. 3 (citing Dorscheid Abstract, 7:11–19, 12:27–30, 6:23, 13:27–30, 8:10–17, Fig. 2a).

³ We note that Appellant has not directed us to the record (e.g., the Specification) to support this argument. *See* Appeal Br. 6 (arguing without providing citation support). In the event that persecution continues, we encourage both Appellant and the Examiner to analyze whether claim 19 meets the written description requirement under section 112, first paragraph.

⁴ Appellant’s argument is solely based on claim 11 without arguing claims 12–16, 18–21, and 27–35 separately. *See* Appeal Br. 7–12. We accordingly analyze claim 11 as representative. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Appellant argues that the anode of an X-ray source to which Dorscheid's material is applied is not "a structural component" as recited in claim 11. Appeal Br. 8. We are not persuaded by this argument because Appellant does not sufficiently explain why the recited "structural component" excludes the prior art anode. Appellant does not propose a definition of the recited "structural component" to exclude the prior art structure, nor does Appellant refer to the Specification to the argument.

We are also not persuaded by the argument that the Examiner reversibly erred for failing to provide evidence that the prior art anode "would necessarily have been manufactured" by Dorscheid's method. *Id.* Claim 11 is a method claim requiring no more than the "detecting," "smoothing," and "filling" steps. To the extent that Appellant attempts to argue that the preamble "for the layered manufacturing of a structural component" is an additional step of the claim, Appellant does not explicitly make this argument. *See* Appeal Br. 8 (arguing instead that the prior art does not inherently manufacture a structural component). It is long established that a preamble— such as the one recited in claim 11— that is "only a statement of purpose and intended result" and "does not result in a manipulative difference in the steps of the claim," is not limiting. *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001).

Appellant's argument that the method in Dorscheid repairs instead of manufactures a structural component is not persuasive. Appellant does not propose a definition of the term "manufacturing," nor does Appellant sufficiently explain why "manufacturing" excludes repairing. Appellant instead argues that recited "formed layer" is absent in the anode of Dorscheid but does not provide evidence supporting the structural

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distinction. Appeal Br. 9. Again, method claim 11 recites three steps which the Examiner has found to be described in Dorscheid. Appellant does not dispute that Dorscheid describes the recited actions. *See id.* (arguing instead that “it is not even known by which method the anode of DORSCHEID has been manufactured”). No reversible error has therefore been identified in the Examiner’s findings in support of the rejection.

Appellant next argues that Dorscheid does not teach the “smoothing” step because “there clearly is no ‘smoothing’ of the recess before the recess is filled with powder.” Appeal Br. 10. Appellant’s argument is not persuasive as it is incommensurate in scope with the claim. Claim 11 requires only a method step of “smoothing the depression” but does not limit the smoothing step to be applied to an unfilled depression. In other words, claim 11 requires “filling the smoothed depression” but does not require the “smoothing the depression” step to occur before the filling step as Appellant argues.

Claim 11 is also open ended and does not preclude, for example, a preliminary filling of the depression followed by “smoothing the depression” as well as a subsequent step of “filling the smoothed depression with powder” as recited. As the Examiner finds, Dorscheid discloses applying a preliminary layer of material to a damaged surface followed by sintering which corresponds to the “smoothing the depression” step. Final Act. 3 (citing Dorscheid 8:10–17, 13:27–30, 6:23); Dorscheid 8:10–14 (describing applying “a thin layer of repair material . . . to a damaged surface”); *see also* Dorscheid 8:23–25 (cited in Appeal Br. 13) (“In order to only locally melt the pre-sintered repair material, a focused beam of electrons or light may be applied to the respective damaged regions of the anode’s surface which have previously been filled with repair material.”). Appellant does not address the

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Examiner's fact findings but instead argues that Dorscheid "does not disclose the smoothing or melting of a recess or depression in the surface of an anode of an X-ray source by a laser beam or electron beam." Appeal Br. 11–12. We are not persuaded by this argument again because the argument is not commensurate in scope with the claim language which requires no more than "smoothing the depression"

Anticipation of claim 17

Claim 17 depends from claim 11 and additionally recites: "wherein smoothing is performed by repeatedly melting the depression."

Appellant argues that the Examiner reversibly erred because Dorscheid 8:10–17 "does not relate to the depression (recess) that is to be repaired (filled with repair material) but to the repair material (powder) itself." Appeal Br. 12–13. Appellant, however, acknowledges that Dorscheid 8:18–27 "mentions that the sintered repair material may be melted" while arguing that Dorscheid 8:18–27 does not describe "repeatedly melting" as recited. *Id.*

We are not persuaded that Dorscheid has been patentably distinguished. As Appellant acknowledges, Dorscheid 8:18–27 – particularly Dorscheid 8:23–25 – provides: "In order to only locally melt the pre-sintered repair material, a focused beam of electrons or light may be applied to the respective damaged regions of the anode's surface which have previously been filled with repair material." The record before us therefore supports the Examiner's conclusion that claim 17 is anticipated.

CONCLUSION

The Examiner's rejection of claims 11–21, 27–35 is affirmed.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
11-21, 27-35	112, second paragraph	Indefiniteness		11-21, 27-35
11-21, 27-35	102(b)	Dorscheid	11-21, 27-35	
Overall Outcome			11-21, 27-35	

TIME PERIOD AND RESPONSE

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