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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT ANTHONY NEUBAUER
and RYAN MICHAEL SCHMIDT

Appeal 2019-004344
Application 14/854,290
Technology Center 1700

Before KAREN M. HASTINGS, MERRELL C. CASHION, JR., and
JANE E. INGLESE, *Administrative Patent Judges*.

CASHION, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 7–12. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse and ENTER a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “The Goodyear Tire & Rubber Company.” Appeal Br. 3.

Claim 7 illustrates the invention:

7. A system for forming a continuous material ply of the type used to make vehicle tires, the continuous material ply being made by joining multiple plies, the system comprising:

a first splice edge of a first ply at a first location;

a second splice edge of a second ply at a second location, the second splice edge being left bare;

a gum strip wrapped around the first splice edge such that the gum strip forms a U-shaped structure in section that allows the gum strip to extend from a first planar side of the first ply over the first splice edge to a second opposite planar side of the first ply, the gum strip being constructed of a material at least 20% softer than a substrate material of the first and second plies, both the first ply and the second ply having predetermined uniform spacing between wire cords in the first ply and the second ply, the predetermined uniform spacing being equal to a nominal thickness of the gum strip;

the first splice edge being placed in abutting relationship to the second splice edge at a third location:

the first splice edge being stitched to the second splice edge such that stitches each extend from the first planar side of the first ply, through the gum strip, to a first planar side of the second ply; and

the first splice edge being cured to the second splice edge.

Appellant (Appeal Br. 4–5) requests review of the Examiner’s rejection of claims 7–12 under 35 U.S.C. § 103 as unpatentable over Winkler (DE 10 2005 010 467 A1, published September 14, 2006), Smith (GB 833,994 A, published May 4, 1960), Gugen (GB 1 389 095 A, published April 3, 1975), Dyrlund (US 2004/0118513 A1, published June 24, 2004), Itoh (US 2011/0061783 A1, published March 17, 2011), Lucas (US 4,322,462, issued March 30, 1982), and Martindale (US 6,503,354 B1, issued January 7, 2003). *See generally* Appeal Br.; Final Act. 2.

OPINION

Without reaching the merits of these rejections, we REVERSE the Examiner's prior art rejection of claims 7–12 under 35 U.S.C. § 103.

We enter the following NEW GROUNDS OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

REJECTION UNDER § 112(b) - Indefiniteness

Claims 7–12 are rejected under 35 U.S.C. § 112(b).

The text of 35 U.S.C. § 112 (b) requires “[t]he specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor 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) 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). With regard to the reasonableness standard, one must consider the language in the context of the circumstances. *Packard*, 751 F.3d at 1313. Language is an

imprecise method of drawing boundaries delineating patent rights, thus unreasonable precision cannot be demanded. *Id.* On the other hand, the claims must notify the public of what they are excluded from making and using. *Id.* For this reason, while exact precision is not required, an applicant is required to use language as precise as the subject matter reasonably permits. *Id.*

Independent claim 7 is a “system” claim “for forming a continuous material ply.” However, the claim does not positively recite any method steps or apparatus’s components that are used to form a continuous ply. Instead, claim 7 recites materials worked upon at what appears to be the various changes the materials undergo to become the continuous material ply. Therefore, we must first construe the claims by defining the scope and meaning of the term “system.” *See Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997).

“[D]uring examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification.” *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1256 (Fed. Cir. 2007) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). *See also In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (explaining that the scope of the claims in patent applications is not determined solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005) (“[T]he specification ‘is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.’” (citation omitted)). In general, the terms

in the appealed claims must be given their broadest reasonable interpretation including the ordinary meaning unless another meaning is intended by Appellant as established in the written description of their Specification. *See, e.g., In re Zletz*, 893 F.2d 319, 321–22 (Fed. Cir. 1989).

The Specification describes a “system” as including a method aspect (Spec. ¶ 14 (reciting positive method steps to make the continuous material ply)) and apparatus aspect (*id.* ¶ 15 (describing specific components of an apparatus as another aspect of the system)). Thus, the broadest interpretation of the term “system” in claim 7 is as an overarching term that includes more than one of the statutory classes of invention enunciated in 35 U.S.C. § 101, i.e., a process, machine, manufacture, or composition of matter. In this case, when read in light of the Specification, independent claim 7 encompasses both a method and an apparatus. However, the subject matter of a claim must fit into one and only one of the statutory classes of invention to be patentable. Claims cannot be directed to combinations of the classes of invention because the claims then become indefinite. *See IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (claims to a combination of statutory classes of invention are not permitted and are indefinite).

Thus, after careful review of the record before us, we determine that the language of claim 7 does not particularly point out and distinctly claim the subject matter which the inventor or a joint inventor regards as the invention. That is, we are unable to determine the metes and bounds of the subject matter of independent claim 7.

Dependent claims 8–12 recite components for an apparatus. For example, claim 8 specifically recites a system “*further including an*

apparatus” comprising a conveyor for providing gum strips having a desired length and thickness and a transfer device for automatically removing the gum strips from the conveyor and placing the gum strips at the butt joint. The language of claim 8 focuses on the apparatus aspect of the “system.” However, the claim 8 language “*further including*” does not limit claim 8 to an apparatus because it does not resolve the indefiniteness issues of independent claim 7 noted above, the claim from which it depends. Therefore, claims 8–12 are also indefinite for the reasons we give above with respect to independent claim 7.²

For the foregoing reasons, the scope of the claimed invention cannot be determined.

Accordingly, on this record, claims 7–12 are indefinite for the reasons given above.

REJECTION UNDER § 103

Having determined that the subject matter of claims 7–12 is indefinite, we are unable to determine the propriety of the prior art rejection of claims 7–12. The review of the rejection of claims 7–12 under 35 U.S.C. § 103 would require considerable speculation as to the scope of the claims. Such speculation would not be appropriate. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962). We, therefore, procedurally reverse the prior art rejection of claims 7–12 under 35 U.S.C. § 103. We emphasize that this is a technical

² In addition, we note that claim 8 as well as claims 9–12 appear to address additional indefinite issues with respect to one of the changes the materials worked upon undergo in claim 7. However, these claims do not address the indefiniteness issues with respect to the remaining stages of claim 7.

reversal of the rejection under 35 U.S.C. § 103, and not a reversal based upon the merits of the rejections.

CONCLUSION

In summary:

| Claims Rejected | 35 U.S.C. § | References/Basis | Affirmed | Reversed | New Ground |
|------------------------|--------------------|---|-----------------|-----------------|-------------------|
| 7-12 | 103 | Winkler, Smith, Gugen, Dyrlund, Itoh, Lucas, Martindale | | 7-12 | |
| 7-12 | 112(b) | Indefiniteness | | | 7-12 |
| Overall Outcome | | | | 7-12 | 7-12 |

TIME PERIOD FOR RESPONSE

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

REVERSED

NEW GROUND OF REJECTION (37 C.F.R. § 41.50(b))