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crasmussen@zarleylaw.com
emarty@zarleylaw.com
kconrad@zarleylaw.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRADLEY D. BARGER

Appeal 2019-004613
Application 15/068,683
Technology Center 3600

Before MICHAEL P. ASTORINO, PHILIP J. HOFFMANN, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

HOFFMANN, *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 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART, 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 Westinghouse Electric Company LLC. Appeal Br. 1.

According to Appellant, the “invention relates . . . to reusable bundling sleeves for . . . hoses and cables.” Spec. 1. Claims 1, 17, and 18 are the independent claims on appeal. Below, we reproduce claims 1 and 17 as representative of the appealed claims:

1. A reusable hose bundling sleeve, comprising:

an elongated section of material having a front surface and an opposite reverse surface, wherein the elongated section of material extends between a first edge and a second edge that is opposite the first edge; and

a strip of loops attached on the front surface and the first edge so that a portion of the loops extends outwardly beyond the first edge of the elongated section of material in a direction opposite the second edge, wherein the portion of the loops that extends beyond the first portion has an identifiable portion configured to visibly distinguish the elongated section of material, such that the reusable hose bundling sleeve can be associated with the identifiable portion selected from a group consisting of reflective material, color, letters, words, symbols, pictures, designs, and patterns.

17. A reusable hose bundling sleeve, comprising:

an elongated section of material having a front surface and an opposite reverse surface and a first edge opposite a second edge wherein the elongated section of material extends between a first edge and a second edge that is opposite the first edge; and

a strip of loops attached on the front surface and the first edge, wherein the strip of loops have an identifiable portion that is configured to visibly distinguish the elongated section of material, such that the reusable hose bundling sleeve can be associated with the identifiable portion.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:²

- I. Claims 1–3 under 35 U.S.C. § 102(a)(1) as anticipated by James et al. (US 2003/0221858 A1, pub. Dec. 4, 2003) (“James”); and
- II. Claims 1–20 under 35 U.S.C. § 103 as unpatentable over James and Barger et al. (US 8,127,405 B2, iss. Mar. 6, 2012) (“Barger”).

ANALYSIS

New Ground of Rejection—Indefiniteness rejection of claims 1–16, 19, and 20

Claims 1–16

As set forth above, independent claim 1 recites, in relevant part,

a strip of loops attached on the front surface and the first edge so that a portion of the loops extends outwardly beyond the first edge of the elongated section of material in a direction opposite the second edge, wherein *the portion of the loops that extends beyond the first portion has an identifiable portion* configured to visibly distinguish the elongated section of material, such that the reusable hose bundling sleeve can be associated with the identifiable portion selected from a group consisting of reflective material, color, letters, words, symbols, pictures, designs, and patterns.

Appeal Br., Claims App. (emphases added). The emphasized recitation was added by Appellant’s Amendment filed on August 3, 2018. *See* Amendment (filed Aug. 3, 2018), 2. In claim 1, there is no antecedent basis for “the first

² In the Answer, the Examiner withdraws a nonstatutory obviousness-type double patenting rejection from the Final Office Action. Answer 5; Final Action 5–6.

portion,” as claimed. Further, it is not clear to us whether “the first portion” should refer to either “the first edge” of the elongated section, a “first portion” of the loops, beyond which a portion of the loops which has the identifiable portion extends, or something else.

Because we cannot determine what is meant by the claim recitation “the first portion,” claim 1 as currently pending is ambiguous, and fails to meet the definiteness requirement of 35 U.S.C. § 112(b). *See In re Packard*, 751 F.3d 1307, 1310–13 (Fed. Cir. 2014) (“[A] claim is indefinite when it contains words or phrases whose meaning is unclear,” i.e., “ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention.”); *see also In re McAward*, No. 2015-006416, 2017 WL 3669566, at *3 (PTAB Aug. 25, 2017) (precedential). Further, dependent claim 2 recites “the first portion,” and thus also is ambiguous. Appeal Br., Claims App. Still further, because claims 3–16 depend from claim 1, the foregoing is equally applicable to these dependent claims.

Accordingly, for the reasons given above, and pursuant to our authority under 37 C.F.R. § 41.50(b), we determine that claims 1–16 are indefinite under 35 U.S.C. § 112(b). Consequently, we enter a new ground of rejection.

Claims 19 and 20

Claim 19 depends from itself. *See* Appeal Br., Claims App. (Claim 19). Thus, the claim’s dependence is improper, and it is not clear to us from which claim this claim should depend. Accordingly, claim 19 as currently pending is ambiguous, and fails to meet the definiteness requirement of 35 U.S.C. § 112(b). *See In re Packard*, 751 F.3d at 1310–13 (Fed. Cir. 2014); *see also In re McAward*, No. 2015-006416, 2017 WL

3669566, at *3 (PTAB Aug. 25, 2017) (precedential). Further, because claim 20 both depends from claim 19, and recites “the first portion” (Appeal Br., Claims App.), claim 20 is also ambiguous, and fails to meet the definiteness requirement of 35 U.S.C. § 112(b). Therefore, we determine that claims 19 and 20 are indefinite under 35 U.S.C. § 112(b), and enter a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

Rejection I—Anticipation rejection of claims 1–3

As explained above, we are unable to determine what is meant by independent claim 1’s recitation of “the first portion.” Thus, we cannot assess the merits of the Examiner’s anticipation rejection of claims 1–3. Consequently, we *pro forma* do not sustain the rejection, because sustaining any such rejection would necessarily be based upon assumptions as to the meaning of the claims’ recitations. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection).

Rejection II—Obviousness rejection of claims 1–20

Claims 1–16

As explained above, we are unable to determine what is meant by independent claim 1’s recitation of “the first portion.” Thus, we cannot assess the merits of the Examiner’s obviousness rejection of claims 1–16. Consequently, we *pro forma* do not sustain the rejection, because sustaining any such rejection would necessarily be based upon assumptions as to the meaning of the claims’ recitations. *See In re Steele*, 305 F.2d 859, 862–63 (CCPA 1962) (addressing an obviousness rejection).

Claims 17 and 18

As set forth above, independent claim 17 recites, in relevant part,

a strip of loops attached on the front surface and the first edge, wherein the *strip of loops have an identifiable portion that is configured to visibly distinguish the elongated section of material, such that the reusable hose bundling sleeve can be associated with the identifiable portion.*

Appeal Br., Claims App. (emphasis added).

Appellant argues that the Examiner errs because “James does not disclose th[e] . . . [above] limitation.” Appeal Br. 4. More specifically, Appellant argues that the Examiner’s rejection is in error for the following reasons:

The claim[] require[s] a portion of loops having an identifiable portion that is (1) configured to visibly distinguish the elongated section of material, and (2) such that the reusable hose bundling sleeve can be associated with the identifiable portion. James fails to disclose this limitation. While the loops of James, which according to the Office, are traditionally black, may be distinguishable from the elongated section of material, which according to the Office is white, copper, or grey, there is no support that the reusable hose bundling sleeve can be associated with the single black color. As a result, in contrast to the example provided in . . . [Appellant’s Specification] at page 6, lines 18–20, *a plurality of hose sleeves 10 would not each have a unique identifiable portion allowing the sleeves to be distinguished from one another.* Because, according to James, all loops have the color black, one sleeve cannot be associated with the identifiable portion (i.e., black color), as all sleeves would have the same identifiable portion. As James has failed to disclose that the sleeve is associated with the identifiable portion of the loops, as is required by the claims, James cannot . . . render . . . [claim 17] obvious.

Reply Br. 2 (emphases added). We disagree with Appellant, however, that independent claim 17 recites that different sleeves must be distinguishable

from each other by the identifiable portions. *See* Answer 7. Instead, we agree with the Examiner that

[A]ppellant’s argument[] [is] more detailed than the structure defined by the claim language. There is nothing in . . . [claim 17] about distinguishing between a plurality of different bundling sleeves. The claim[] . . . [is] directed to a single bundling sleeve. There are no system limitations defined in the claim[] directed to distinguishing between a plurality of bundle sleeves.

Id. at 7–8. Restated, we determine that independent claim 17’s recitation that “the strip of loops have an identifiable portion that is configured to visibly distinguish the elongated section of material, such that the reusable hose bundling sleeve can be associated with the identifiable portion” does not require that James disclose using identifiable portions on different sleeves to distinguish the sleeves from one another. We note, for example, that consistent with claim 17’s recitations as currently pending, an association may be made in the mind of a user of the sleeve, the association being based on the identifiable portion, and the user may use the association to distinguish the sleeve from something else (i.e., from anything that is not the sleeve itself). Thus, Appellant does not show error in the Examiner’s reliance on James.

Also, we do not agree with Appellant that the Examiner’s rationale for combining James and Barger is inadequate. *See* Appeal Br. 5–6. Instead, we agree with the Examiner that “it would have been obvious to modify Barger’s device,” based on James’s disclosure of a “type of strip loop attachment [that] allows for a wider range of bundle diameters to be secured within the bundling strap,” which would thereby “increase the versatility of [Barger’s] . . . bundling strap.” Final Action 3.

Thus, based on the foregoing, Appellant does not show error in the Examiner's obviousness rejection. Therefore, we sustain the Examiner's rejection of independent claim 17 as obvious based on James and Barger. We also sustain the Examiner's obviousness rejection of independent claim 18 for substantially the same reasons that we sustain claim 17's rejection.

Claims 19 and 20

As explained above, claims 19 and 20 are indefinite. Thus, we cannot assess the merits of the Examiner's obviousness rejection of these claims. Consequently, we *pro forma* do not sustain the Examiner's rejection, because sustaining any such rejection would necessarily be based upon assumptions as to the meaning of the claims' recitations. *See In re Steele*, 305 F.2d at 862–63 (CCPA 1962) (addressing an obviousness rejection).

CONCLUSION

We REVERSE *pro forma* the Examiner's anticipation rejection of claims 1–3.

We REVERSE *pro forma* the Examiner's obviousness rejection of claims 1–16, 19, and 20.

We AFFIRM the Examiner's obviousness rejection of claims 17 and 18.

We ENTER a NEW GROUND OF REJECTION for claims 1–16, 19, and 20 as indefinite.

In summary:

Claims Rejected	35 U.S.C. §	Basis/Reference(s)	Affirmed	Reversed	New Ground
1-3	102(a)(1)	James		1-3	
1-20	103	James, Barger	17, 18	1-16, 19, 20	
1-16, 19, 20	112(b)	Indefiniteness			1-16, 19, 20
Overall Outcome			17, 18		1-16, 19, 20

As set forth above, this Decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2008), which provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that 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 [e]vidence 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 [E]xaminer. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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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 IN PART; 37 C.F.R. § 41.50(b)