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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* ROBERT SCOTT LIPPERT and REID ALAN BALDWIN

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Appeal 2019-005140  
Application 13/788,535  
Technology Center 3600

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Before: CHARLES N. GREENHUT, JAMES P. CALVE, and  
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant<sup>1</sup> seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 14–19. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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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(a). Appellant identifies Ford Global Technologies, LLC as the Applicant and real party in interest. Appeal Br. 2.

### THE INVENTION

Appellant's invention is a vehicle transmission. Spec. ¶ 1. Claim 14, reproduced below with emphasis added, is illustrative of the subject matter on appeal.

14. A transmission comprising:  
a first shift element configured to selectively hold a first shaft against rotation *independently of other shift elements*;  
a second shift element configured to selectively couple the first shaft to an input shaft;  
a third shift element configured to selectively couple the first shaft to a second shaft; and  
a fourth shift element configured to selectively couple the first shaft to a third shaft.

### THE REJECTIONS

The Examiner relies upon the following as evidence in support of the art rejection:<sup>2</sup>

NAME	REFERENCE	DATE
Ohnemus	US 2013/0252780 A1	Sept. 26, 2013

The following rejections are before us for review:

1. Claims 14–19 are rejected under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.
2. Claims 14–19 are rejected under 35 U.S.C. § 112, first paragraph, for failure to comply with the written description requirement.
3. Claim 14 is rejected under 35 U.S.C. § 102(b) as anticipated by Ohnemus.

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<sup>2</sup> Claims 1–13 are allowed. Final Act. 1. Rejections under 35 U.S.C. § 112, first paragraph, as non-enabled have been withdrawn. Ans. 5.

OPINION

*Indefiniteness*

The Examiner considers it unclear how the first shift element holds the first shaft against rotation “*independently of other shift elements*,” when there is always at least one other shift element engaged. Final Act. 7.

Appellant argues that the Examiner fails to establish those of skill in the art would be unsure of what is covered by the claims. Appeal Br. 5. Appellant argues that the standard for indefiniteness that the Examiner must meet is set forth in the Supreme Court’s decision in *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898 (2014). *Id.*

In response, the Examiner reiterates that it is unclear how the first shift element limitation is achieved. Ans. 7. The Examiner takes the position that claim 14 is broader than what Appellant is asserting. *Id.* at 6. More particularly, the Examiner maintains that the first shift element does not have to be a brake and that “*independently of other shift elements*” does not necessarily mean regardless of whether or not other shift elements are engaged. *Id.*

In reply, Appellant accuses the Examiner of failing to apply the proper test for definiteness. Reply Br. 3–4. Appellant reiterates that:

The final rejection does not find/discuss how a person skilled in the art would be unable to determine the meets and bounds of “a first shift element configured to selectively hold a first shaft against rotation independently of other shift elements.”

*Id.* at 4.

The PTO can properly reject a claim as indefinite if the claim is ambiguous, vague, incoherent, opaque, or otherwise unclear. *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014). The test for definiteness

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under 35 U.S.C. § 112, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.”

*Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted). During patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed. *See In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

Careful and straightforward claim drafting by prosecuting attorneys and agents, and rigorous application by examiners of the statutory standard to particularly point out and distinctly claim the subject matter regarded to be the invention, see 35 U.S.C. § 112, ¶ 2 (2000), serve an important public notice function.

*Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1300 (Fed. Cir. 2008). As the Federal Circuit explained in *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244 (Fed. Cir. 2008) (cited with approval in *Nautilus*, 572 U.S. at 910):

We note that the patent drafter is in the best position to resolve the ambiguity in the patent claims, and it is highly desirable that patent examiners demand that applicants do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation.

*Id.* at 1255.

Initially, Appellant states the wrong legal standard to be applied in an indefiniteness analysis during patent prosecution. Appeal Br. 5. The *Nautilus* standard applies to District Court litigation that occurs after a patent has issued. *Ex parte McAward*, Appeal 2015-006416, 2017 WL 3669566, at \*4 (PTAB Aug. 25, 2017) (precedential) (adopting the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*).

The section in Appellant’s Appeal Brief that is devoted to the indefiniteness issue is a single, six-line paragraph. Appeal Br. 5. The section in Appellant’s Reply Brief devoted to the indefiniteness issue is a single, seven-line paragraph. Reply Br. 3–4. The briefing is remarkably abbreviated, vague, and conclusory. The phrase “*independently of other shift elements*” does not appear, in so many words, in Appellant’s Specification. *See generally* Spec. More significantly, Appellant makes no genuine effort to explain what it actually means for the first shaft to be held against rotation “*independently of other shift elements.*” *See generally* Appeal Br., Reply Br. Furthermore, Appellant does not direct us to any language in the Specification that purportedly provides guidance as to the meaning of the term to a skilled artisan with the requisite definiteness. Finally, Appellant makes no effort to rebut or refute the Examiner’s position that “*independently of other shift elements*” does not necessarily mean, in so many words, “*regardless of whether or not other shift elements are engaged.*” Ans. 6.

During prosecution, the Examiner’s indefiniteness rejection begins what is intended to be an interactive process in which Appellant has the opportunity to respond to the Examiner by amending the claims or by providing evidence or explanation that shows why the claims are not indefinite. *McAward, supra* at \*2 (citing *Packard*, 751 F.3d at 1311-12). However, section 112 places the burden of precise claim drafting on Appellant, not the Examiner. *See In re Morris*, 127 F.3d 1048, 1056–57 (Fed. Cir. 1997). Thus, we will not attempt to import limitations from the Specification or speculate as to the meaning of the claim language,

particularly where Appellant has not attempted to provide us with any clarification or explanation.

Appellant admits that the phrase “*independently of other shift elements*” was added by amendment to distinguish over the prior art. Appeal Br. 6. Appellant currently relies on such claim language to distinguish over the Ohnemus reference in the prior art rejection before us. *Id.* Appellant’s inability or unwillingness to offer a reasonably definite construction of the claim term effectively hamstrings our ability to consider and evaluate the art rejection. *See In re Montgomery*, 677 F.3d 1375, 1379 (Fed. Cir. 2012) (explaining that anticipation involves a two-step analysis, the first step of which involves construction of the claims). In the instant case, rather than engage the Examiner in a meaningful dialog to resolve ambiguity in the claim language, Appellant merely asserts in conclusory fashion that the Examiner has not established that a person of ordinary skill in the art would be “unable to determine the metes and bounds of” the claim language at issue. Reply Br. 4. Appellant’s approach to the definiteness inquiry, declining to present substantive arguments or evidence in response to the Examiner’s rejection, is not in accord with prevailing law. *Packard, supra*; *McAward, supra*. Indeed, as the *Packard* Court held:

[W]hen the USPTO has initially issued a well-grounded rejection that identifies ways in which language in a claim is ambiguous, vague, incoherent, opaque, or otherwise unclear in describing and defining the claimed invention, and thereafter the applicant fails to provide a satisfactory response, the USPTO can properly reject the claim as failing to meet the statutory requirements of § 112(b).

*Packard*, 751 F.3d at 1311.

Given the record before us, the phrase “*independently of other shift elements*” is sufficiently vague that we sustain the Examiner’s Section 112 indefiniteness rejection of claim 14. For similar reasons, we sustain the rejection of claims 15–19 which are rejected based on their dependency from claim 14. Final Act. 6–7.

*Written Description*

In the Final Office Action, the Examiner focuses on the following limitation in claim 14:

*a first shift element configured to selectively hold a first shaft against rotation independently of other shift elements.*

Final Act. 2. According to the Examiner, Appellant’s Specification allegedly splits shift elements into either a brake or clutch based on their function. *Id.* Furthermore, the first shift element as recited, appears to incorporate aspects of both a clutch and brake and therefore pertains to subject matter not described in the Specification. *Id.* at 2–3.

Appellant argues that the specified function, holding a shaft against rotation independently of other shift elements, is the normal function of a transmission brake. Appeal Br. 4. Although, Appellant’s Specification associates a brake with a housing (*See Spec.* ¶ 11),<sup>3</sup> Appellant contends that the written description requirement does not require the claim language to recite the definition of brake from the Specification. Appeal Br. 4.

In response, the Examiner states that the first shift element is not necessarily a brake. Ans. 5. The Examiner further states that neither the definition of “brake,” nor the definition of “clutch,” in the Specification

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<sup>3</sup> “A shift element that holds a rotating element against rotation by selectively connecting it to the housing is called a brake.” *Spec.* ¶ 11.

applies to a shift element that selectively holds a shaft against rotation independently of other shift elements. *Id.*

In reply, Appellant argues that the possibility that the first shift element is not a brake does not demonstrate that Appellant was not in possession of the subject matter of claim 14 at the time of filing.

Applicants are free to use generic terms as long a representative number of species are disclosed in the written description. M.P.E.P § 2163. Here, Appellant in Figure 2 and the associated text discloses a brake 64' that is configured to selectively hold a first shaft against rotation independently of other shift elements. The brake 64' is a representative species of shift elements.

Reply Br. 3. Appellant directs our attention to paragraph 20 of the Specification as providing the requisite written description support. Reply Br. 2.

The written description requirement of 35 U.S.C. § 112, ¶ 1 provides, in pertinent part, that “[t]he specification shall contain a written description of the invention.” That requirement is satisfied only if the inventor “convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate[s] that by disclosure in the specification of the patent.” *Centocor Ortho Biotech, Inc. v. Abbott Labs.*, 636 F.3d 1341, 1348 (Fed. Cir. 2011) (quoting *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008)). “The essence of the written description requirement is that a patent applicant, as part of the bargain with the public, must describe his or her invention so that the public will know what it is and that he or she has truly made the claimed invention.” *AbbVie Deutschland GmbH & Co. v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1298 (Fed. Cir. 2014);

*Nuvo Pharmaceuticals (Ireland) Designated Activity Company v. Dr. Reddy's Labs Inc.*, 923 F.3d 1368, 1377 (Fed. Cir. 2019).

The Figure 2 embodiment of Appellant's invention is described, in part, in paragraph 20 the Specification. That paragraph provides, in pertinent part, as follows:

Intermediate shaft 74, brake 64', and clutches 62', 66', and 68' form a four shift element module. Intermediate shaft 74 is selectively held against rotation by brake 64', selectively coupled to carrier 42 by clutch 62', selectively coupled to ring gear 39 by clutch 66', and selectively coupled to input shaft 10 by clutch 68'. Applying two of the three clutches selectively couples the corresponding two rotating elements.

Spec. ¶ 20. Taking into account our previous determination that the claim language - "*independently of other shift elements*" - renders claim 14 indefinite, the foregoing passage, taken in the context of the remainder of Appellant's Specification, is insufficient to demonstrate that Appellant was in possession of the invention, as best understood, as of the filing date. In particular, it fails to demonstrate possession of a transmission that has a first shift element configured to selectively hold a first shaft against rotation "*independently of other shift elements.*"

Consequently, we sustain the Examiner's Section 112 written description rejection of claim 14. For the same reasons, we sustain the rejection of claims 15–19 which are rejected based on their dependency from claim 14. Final Act. 2–3.

*Anticipation of Claim 14  
by Ohnemus*

In traversing the Examiner's rejection, Appellant argues that Ohnemus element B03 holds shaft IHW against rotation only when it is engaged at the same time as K38. Appeal Br. 6. Therefore, according to

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Appellant, it does not hold the shaft against rotation “*independently of other shift elements.*” *Id.*

However, because we have concluded that the phrase “*independently of other shift elements*” renders claim 14 indefinite, the prior art rejection of claim 14 must fall because it is necessarily based on a speculative assumption as to the meaning of the claims. *In re Steele*, 305 F.2d 859, 862 (CCPA 1962).

Consequently, we reverse, *pro forma*, the Examiner’s anticipation rejection of claim 14.

#### CONCLUSION

<b>Claims Rejected</b>	<b>§</b>	<b>Reference/Basis</b>	<b>Aff’d</b>	<b>Rev’d</b>
14-19	112	Indefiniteness	14-19	
14-19	112	Written Description	14-19	
14	102	Ohnemus		14
<b>Overall Outcome</b>			14-19	

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) (2018).

AFFIRMED