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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/035,878	05/11/2016	JAN BENNIK	2013P01597WOUS	6985
24737	7590	10/05/2020	EXAMINER	
PHILIPS INTELLECTUAL PROPERTY & STANDARDS 465 Columbus Avenue Suite 340 Valhalla, NY 10595			LEE, LAURA MICHELLE	
			ART UNIT	PAPER NUMBER
			3724	
			NOTIFICATION DATE	DELIVERY MODE
			10/05/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAN BENNIK, ROBBERT FREERK JOHAN VAN DER SCHEER,
MARTINUS BERNARDUS STAPELBROEK, ALBERT JAN AITINK,
and EVERHARDUS JOHANNES HOEXUM

Appeal 2020-000606
Application 15/035,878
Technology Center 3700

Before JAMES P. CALVE, WILLIAM A. CAPP, and
MICHAEL L. WOODS, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–15. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to our authority under 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(a). Appellant identifies Koninklijke Philips N.V., as the Applicant and real party in interest. Appeal Br. 1.

THE INVENTION

Appellant's invention is an electric hair trimmer. Spec. 1. Claim 1, reproduced below with paragraph indentation added, is illustrative of the subject matter on appeal.

1. A blade set of a hair cutting appliance, said blade set being arranged to be moved through hair in a moving direction to cut hair, said blade set comprising:

a stationary blade comprising at least one toothed cutting edge, and a lateral end, wherein the stationary blade further comprises a first surface that is arranged, when in use for shaving purposes, as a skin-contacting surface,

a movable blade comprising a toothed cutting edge, wherein the stationary blade and the movable blade are arranged to be reciprocally moved with respect to each other in a cutting or lateral direction (Y) that is perpendicular to the moving direction, and

a lateral protecting element associated with the lateral end that comprises a lateral end cap of the stationary blade,

wherein the lateral protecting element laterally shields a lateral edge of the lateral end, such that, when in use, skin contact of the lateral edge is prevented, and

wherein the lateral protecting element and the lateral end cooperate so as to prevent hairs from being trapped there between,

wherein the lateral protecting element further comprises a recess portion, and

wherein the stationary blade further includes a lateral opening at the lateral end,

wherein the lateral opening comprises as an extension of a guide slot in the stationary blade for the movable blade,

wherein (i) the recess portion of the lateral protecting element and (ii) the lateral opening of the stationary blade at least partially overlap each other, and

wherein the recess portion exposes at least a portion of the lateral opening to enable a removal of hair cutting particles and debris through the lateral end, further

wherein the recess portion in the lateral protecting element comprises a hole portion provided at a side thereof facing away from

the skin when in use, and wherein the lateral protecting element further comprises, at a skin-facing side thereof, a bar portion adjacent to the recess portion, and

wherein the stationary blade and the movable blade comprise at least steel, and the lateral protecting element comprises a plastic material.

THE REJECTIONS²

The Examiner relies upon the following as evidence in support of the rejections:

NAME	REFERENCE	DATE
Sussman	US 2,242,405	May 20, 1941
Hanley	US 2,246,586	June 24, 1941
Trichell	US 4,899,444	Feb. 13, 1990

The following rejections are before us for review:

1. Claims 1–11 and 13–15 are rejected under 35 U.S.C. § 103 as being unpatentable over Hanley and Sussman.
2. Claim 12 is rejected under 35 U.S.C. § 103 as being unpatentable over Hanley, Sussman, and Trichell.

OPINION

NEW GROUND OF REJECTION Indefiniteness Under 35 U.S.C. § 112(b)

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 under 35 U.S.C. § 112, is whether “those skilled in the art would understand

² A rejection under 35 U.S.C. § 112(a) for lack of written description support has been withdrawn by the Examiner. Ans. 10.

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). “If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

Section 112 places the burden of precise claim drafting on Appellant. *In re Morris*, 127 F.3d 1048, 1056–57 (Fed. Cir. 1997). Appellant is in the best position to resolve the ambiguity in patent claims, and it is highly desirable that patent examiners demand that Appellant do so in appropriate circumstances so that the patent can be amended during prosecution rather than attempting to resolve the ambiguity in litigation. *Halliburton Energy Servs., Inc. v. M-I LLC*, 514 F.3d 1244, 1255 (Fed. Cir. 2008) (cited with approval in *Nautilus*, 572 U.S. 898, 910 (2014)). 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). Rigorous application of the statutory standard to particularly point out and distinctly claim the subject matter regarded to be the invention serve an important public notice function. *Predicate Logic, Inc. v. Distributive Software, Inc.*, 544 F.3d 1298, 1300 (Fed. Cir. 2008).

With the foregoing legal principles in mind, we turn our attention to Appellant’s claims.

Claim 1

Appellant discloses and claims a hair cutting appliance (hereinafter “shaver”). Claims App. The shaver has two blades, a stationary blade and a

movable blade, which move in a reciprocal manner with respect to each other. *Id.* Each blade has cutting edges and “lateral” ends. *Id.* A plastic cap or “protecting element” is disposed over each lateral end of the stationary blade. *Id.* The plastic cap has a “recess” that is substantially aligned with an opening at each lateral end of the stationary blade. *Id.* This part of the claim is reasonably clear enough, however, the remainder of the claim is quite confusing.

The claim refers to “removal” of hair cutting particles and debris. *Id.* However, such removal is in reference to the “lateral end,” which is a structural element of the stationary blade. *Id.* The “recess” portion of the plastic cap comprises a “hole” portion. *Id.* However, it is unclear whether the “hole” penetrates all of the way through the plastic cap so as to create an aperture. Such ambiguity is attributable to claim language that only appears to require a hole portion at “a” side of the plastic cap and, more specifically, to the side that faces away from the skin.

We confess to be confused over whether and to what extent hair and debris is removed from the entire shaving apparatus via a “hole” in the plastic cap as opposed to being removed from just the stationary blade and then captured and retained in the “recess” in the plastic cap. Normally, we would expect the word “hole” to refer to some sort of aperture that penetrates both sides of a surface such as in the phrase “hole in the wall.” Our confusion stems, in part, by claim language that refers to a “hole” being provided “at” a side of the cap instead of being provide “through” a side of the cap. It is unclear to us whether Appellant uses the word “hole” to refer to the rim or lip of an otherwise substantially enclosed recess or receptacle. If it is, we would consider this to be an inartful use of the word “hole,” when

the English language offers so many better alternatives. Thus, it is unclear to us if the “hole” is part of the claimed “recess” or is supposed to be a separately identifiable element that is distinct from the “recess.”

Appellant’s Specification and drawings provide little, if any, clarity to the issue. The Specification teaches that – “The lateral protecting element 56d illustrated therein [referring to Fig. 12] comprises a recess portion 80 that may be shaped as a deepening or a hole portion.” Spec. 20, ll. 14–15. We cannot reliably determine whether “deepening or a hole portion” refers to a redundancy, i.e., two ways of saying the same thing (“deepening = hole”); or whether it refers, in the alternative, to two different structures: (1) a deepening; or (2) a hole. Recess portion 80 is illustrated only in Figure 12. Figure 12 is a flat, two dimensional drawing in the x, z plane. *Id.* We cannot tell, from the drawing, whether element 80 is an aperture that allows debris to pass through or whether element 80 is merely an entrance to a recess/receptacle that includes additional, enclosing structure at a “deepening” that resides in the y axis outside of the x, z plane. The Specification states that a portion of lateral opening 38 is “accessible” so that hair and debris can be removed therefrom. Spec. 20, ll. 22–23. However, it remains unclear to us whether such access is gained through a hole or aperture in the plastic cap or by some other means, such as temporary removal of the plastic cap to empty a receptacle formed by a recess in the plastic cap.

The foregoing confusion and uncertainty in the claim language needs to be cleared up before we can reasonably expect the Examiner to search for prior art and then apply the appropriately clarified claim language to the prior art for purposes of formulating a prior art rejection. To the extent that

the Examiner may need to propose modifications to one or more pieces of prior art to satisfy the claim language, we cannot reasonably expect the Examiner to articulate whether appropriate modifications fall within or without the ambit of ordinary skill in the art for purposes of an obviousness analysis unless the extent of the modifications required are evaluated in terms of precise, properly construed, claim recitals.

In view of the foregoing discussion, we hereby enter a NEW GROUND OF REJECTION rejecting claim 1 under 35 U.S.C. § 112(b) for failing to particularly point out and distinctly claim the subject matter which the inventor(s) regard as the invention.

Claims 2–15

These claims all depend from claim 1 and are hereby rejected under 35 U.S.C. § 112(b) by reason of their dependency from claim 1. We leave to the Examiner, upon resumption of prosecution, whether additional or more specific rejections should be applied to these claims.

Prior Art Rejections of Claims 1–15

Because we have concluded that claims 1–15 are indefinite, the prior art rejection of these claims 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).

Thus, we reverse, without reaching the merits, of the Section 103 prior art rejections of claims 1–15.

CONCLUSION

Claims Rejected	§	References/Basis	Affirmed	Reversed	New Ground
1-15	112	Indefiniteness			1-15
1-11, 13-15	103	Hanley, Sussman		1-11, 13-15	
12	103	Hanley, Sussman, Trichell		12	
Overall Outcome					1-15

FINALITY OF DECISION

This decision contains new grounds 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.” 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 evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

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

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REVERSED; 37 C.F.R. § 41.50(b)