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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TRAVIS STEEN, CHAD SWIER, DAN RAAP,
GARY NEWMAN, and BRUCE HAGEMEYER

Appeal 2020-000661
Application 14/744,940
Technology Center 3600

BEFORE STEFAN STAICOVICI, JEREMY M. PLENZLER, and
BRANDON J. WARNER, *Administrative Patent Judges*.

PLENZLER, *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 29–31, 36–38, 42, and 43. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART and enter a NEW GROUND OF REJECTION in accordance with 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 the real party in interest as Amesbury Group, Inc. Appeal Br. 3.

CLAIMED SUBJECT MATTER

The claims are directed to a window balance. Claim 29, reproduced below, is illustrative of the claimed subject matter:

29. A shoe body for a coil spring inverted constant force window balance comprising:

an elongate shoe body comprising a plurality of side walls;

at least one curved surface disposed at a first end of the elongate shoe body;

a coil spring rotatably supported by the at least one curved surface, wherein at least a portion of the coil spring extends beyond at least one of the plurality of side walls;

an enlarged portion opposite the first end;

a groove defined at least partially in a front surface of the elongate shoe body and the enlarged portion, and between the plurality of side walls, wherein an upper end of the groove extends adjacent to at least a portion of the coil spring and is separated from the coil spring via the front surface; and

a cam rotatably disposed in the enlarged portion at a lower end of the groove, wherein the groove is configured to permit passage of a pivot bar therethrough.

REFERENCE

The prior art relied upon by the Examiner is:

Name	Reference	Date
Tuller	US 2008/0178425 A1	July 31, 2008

REJECTIONS

Claims 29, 31, 36–38, 42, and 43 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tuller.

Claim 30 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Tuller.

OPINION

Claims 29–31

The preamble of claim 29 recites “[a] shoe body for a coil spring inverted constant force window balance comprising,” but the body of the claim does not only recite features of a “shoe body.” For example, the body of claim 29 also requires “a coil spring rotatably supported by the at least one curved surface” “disposed at a first end of the elongate shoe body.” *See* Appeal Br. 37–38 (Claims App.). Accordingly, we know that each feature recited in claim 29 is not part of the “shoe body.” This is consistent with the description provided by Appellant’s Specification. *See* Spec. 5 (“Elements of the window balance include a shoe body 12, a coil spring 14, and a mounting bracket 16.”).

Claim 29 additionally recites “an enlarged portion opposite the first end” without additional context, other than the first end referenced is that of the “shoe body.” Appellant and the Examiner disagree as to what is required by the “enlarged portion” limitation. *See* Appeal Br. 28 (contending that “Tuller does not indicate anywhere within the specification that any part of the shoe body is ‘enlarged,’ as compared to any other component of the shoe body or otherwise”); Ans. 4 (explaining that “[s]ince appellant does not require that [the enlarged] portion be ‘enlarged’ as compared with any particular feature, examiner contends that this portion is enlarged as compared to other parts including bracket 50” in Tuller).

The claim does not recite what the “enlarged portion” is enlarged relative to, or even what structure defines the “enlarged portion” (e.g., it does not require that the “enlarged portion is part of the elongate shoe body”). The Specification explains that “[t]he shoe body 12 may

incorporate a generally T-shaped configuration” with “an elongate portion 18 having two side walls 20” and “[t]wo opposing projections 22 . . . extend[ing] beyond the side walls 20 of the elongate portion form the enlarged portion 24 at a distal end of the shoe body 12.” Spec. 5. Those features, however, are not required by the claim. We decline to read those limitations into the claim.

Based on the record before us, we determine that the “enlarged portion” recited in claim 29 adds an unacceptable level of ambiguity into the claim because we are unable to determine what structure is required for that limitation. Rather than speculate, or assign some meaning not required by the language of the claim, we determine that the most appropriate course of action is to enter a new ground of rejection under 35 U.S.C. § 112, second paragraph. *See In re Packard*, 751 F.3d 1307, 1310 (Fed. Cir. 2014) (per curiam) (A claim is properly rejected as indefinite if, after applying the broadest reasonable interpretation in light of the specification, the metes and bounds of a claim are not clear because the claim contains words or phrases whose meaning is unclear.); *see also Ex parte McAward*, Appeal No. 2015-006416, 2017 WL 3669566, at *5 (PTAB Aug. 25, 2017) (precedential) (adopting the approach for assessing indefiniteness approved by the Federal Circuit in *Packard*). Appellant has the opportunity to resolve ambiguities during prosecution. *See, e.g., McAward*, at *6–7.

Because we determine the claims to be indefinite, and addressing the “enlarged portion” recited in claim 29 would require speculation on our part, we do not reach the merits of the anticipation and obviousness rejections related to claims 29–31. Instead, we reverse those rejections *pro forma*. *See In re Aoyama*, 656 F.3d 1293, 1300 (Fed. Cir. 2011) (holding that the Board

erred in affirming an anticipation rejection of indefinite claims); *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (holding that the Board erred in affirming a rejection of indefinite claims under 35 U.S.C. § 103(a), because the rejection was based on speculative assumptions as to the meaning of the claims).

Claims 36–38, 42, and 43

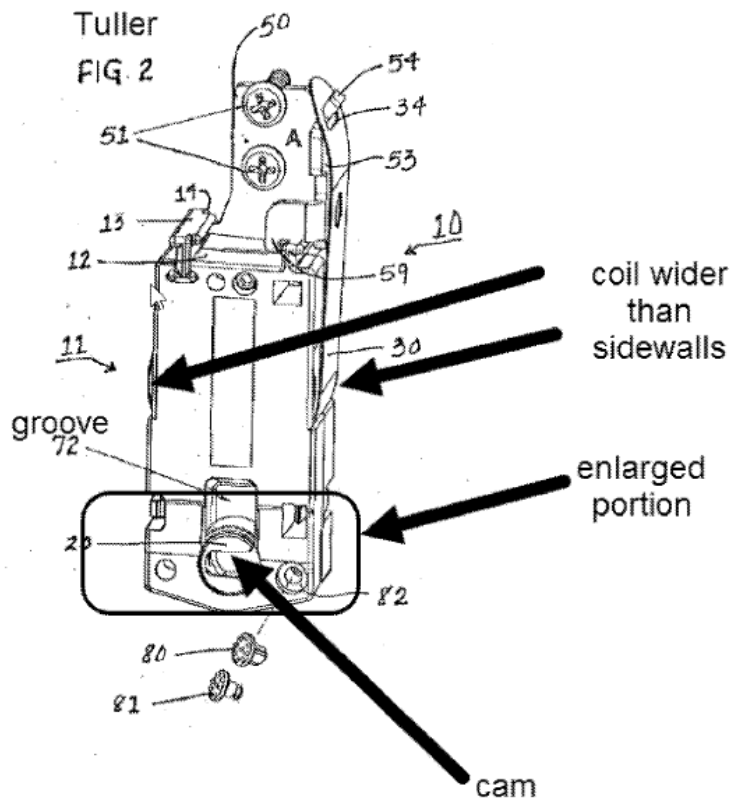
Claim 36 is independent and does not include the issues noted above with respect to the “enlarged portion,” as that feature is not recited. The Examiner finds that Tuller discloses each limitation of claim 36. Non-Final Act. 3–4. With respect to claim 36, Appellant disputes only whether Tuller discloses the “groove defined within a front surface of the elongate shoe body” that “terminates at a first end adjacent to at least a portion of the coil spring and is separated from the coil spring via the front surface,” as recited in the claim. Appeal Br. 31. Specifically, Appellant contends that Tuller’s “recess 72 appears to terminate at a location below the curl spring 30 at a rear surface that matches the upper surface of recess 72.” *Id.* That does not apprise us of Examiner error. There is no dispute that Tuller’s groove (recess 72) is defined within the front surface of Tuller’s shoe body 11, and Appellant offers no explanation as to why termination of Tuller’s groove (recess 72) immediately below the spring is not “terminat[ion] . . . adjacent to at least a portion of the coil spring” with the groove “separated from the coil spring via the front surface,” as required by the claim.

Claims 42 and 43 depend from claim 36. Appellant does not provide separate argument for those claims. For at least the reasons set forth above, we are not apprised of error in the rejection of claims 36, 42, and 43.

Claim 37 depends from claim 36 and further recites that “the elongate shoe body further comprises an enlarged portion disposed at a distal end, the

second end of the groove is disposed in the enlarged portion of the elongate shoe body that contains the cam.” Unlike claim 29, discussed above, the “elongate portion” recited in claim 37 is clearly part of the elongate shoe body and it is located at a distal end of the elongate shoe, and is “enlarged” relative to at least the portion of the elongated shoe body from which it extends. Although broad, this does not render claim 37 indefinite like the similar limitation does in claim 29.

The Examiner finds that Tuller discloses “the elongate shoe body . . . further comprises an enlarged portion (as annotated above) disposed at a distal end.” Non-Final Act. 5–6. The annotated figure referenced by the Examiner is reproduced below.



The figure reproduced above is Tuller’s Figure 2, which “is an isometric view of a shoe cassette, including a curl spring, a spring mount, and optional

locking pads to counter balance an opposite side of a window sash” (Tuller ¶ 5), with the Examiner’s annotations labeling the various portions corresponding to the claim elements, including a box around the “enlarged portion” (Non-Final Act. 4).

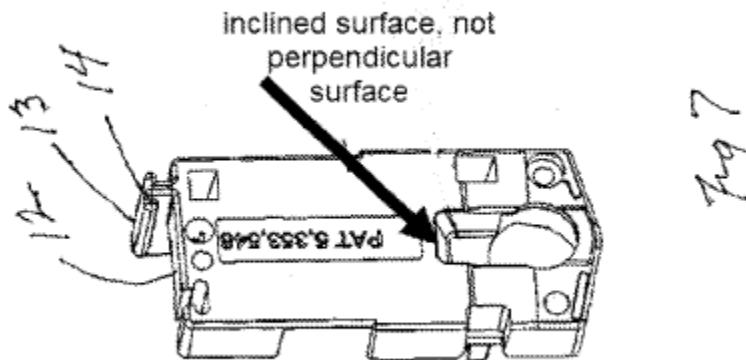
Appellant responds that the “boxed portion does not appear enlarged (at least relative to any other portion of the shoe body 11),” and “[m]ore accurately, the figures of Tuller appear to depict a shoe body 11 that is fairly uniform in width, depth, and height, along each of those dimensions.”

Appeal Br. 32. Appellant contends that “[t]he Examiner is entirely silent as to how the portion of the housing bounded by the box in annotated FIG. 2 is ‘enlarged’ *relative to anything*.” *Id.* at 33.

In the Answer, the Examiner explains that “[s]ince appellant does not require that this portion be ‘enlarged’ as compared with any particular feature, examiner contends that this portion is enlarged as compared to other parts including bracket 50.” Ans. 4. The portion of the Answer noted above addresses claim 29, and the Examiner references this same explanation for the discussion of claim 37. As noted above, however, claims 29 and 37 are different in scope. The Examiner makes no finding that Tuller’s “enlarged portion” is “enlarged” relative to at least the portion of the elongated shoe body 11 from which it extends, as required by claim 37, as we discuss above. Accordingly, the Examiner’s rejection of claim 37 fails.

Claim 38 depends from claim 36 and recites that “the groove is tapered along a longitudinal axis of the elongate shoe body.” The Examiner states that “Tuller discloses . . . the groove 72 is tapered along a longitudinal axis of the elongate shoe body,” without further explanation. Non-Final Act. 6. Appellant notes this lack of explanation and further responds that “Tuller

fails to teach or suggest that the recess 72 has such structure,” and “[e]very figure of Tuller . . . depicts the recess 72 having a constant wi[d]th from the top to the bottom thereof.” Appeal Br. 33–34. In the Answer, the Examiner provides an annotated figure from Tuller, reproduced below, to explain the finding noted above.



The figure reproduced above is a portion of Tuller’s Figure 7, which is an illustration of a “shoe half includ[ing] a . . . recess” (Tuller ¶ 10), and the Examiner’s annotation indicating where Tuller’s groove taper is located (Non-Final Act. 5). The claim does not specify an orientation of the taper (e.g., along the width or the depth of the groove). As seen above, the groove is tapered along its depth and along the longitudinal extent of the shoe body. Without further explanation from Appellant, we are not apprised of error in the rejection of claim 38.

CONCLUSION

The Examiner’s rejection of claims 36, 38, 42, and 43 is affirmed, and the rejection of claims 29–31, and 37 is reversed. We enter a new ground of rejection of claims 29–31 under 35 U.S.C. § 112 ¶ 2 as being indefinite.

DECISION SUMMARY

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
29, 31, 36–38, 42, 43	102(b)	Tuller	36, 38, 42, 43	29, 31, 37	
30	103(a)	Tuller		30	
29–31	112 ¶ 2	Indefiniteness			29–31
Overall Outcome			36, 38, 42, 43	29–31, 37	29–31

TIME PERIOD FOR RESPONSE

Section 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 that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds 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.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

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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)