

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK S. PENKE and
DEBORA MARGARET HEJZA LITTWILLER

Appeal 2008-1388
Application 11/272,128
Technology Center 2800

Decided: October 31, 2008

Before EDWARD C. KIMLIN, CHARLES F. WARREN, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134 the final rejection of claims 28-34. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b).

We REVERSE and provide a new ground of rejection pursuant to 37 CFR § 41.50(b).

INTRODUCTION

Claim 28, the only independent claim on appeal, is illustrative:

28. A marking system and process which comprises in an operative arrangement at least one sensor, a marking station, a sheet(s) collection

station with a signal, a sheet conveyance and path, and at least one sensor, said sensor enabled to activate at least one signal including illumination at said collection station, said sheet conveyance enabled to convey said paper along said path extending from said marking station and ending at paper exit, said paper exit enabled to allow said sheets to pass therethrough into said collection station, located along said sheet conveyance path and before said collection station is at least one of said sensors, at least one of said sensors enabled along said conveyance path to activate said signal when a first sheet passes therethrough and enabled to inactivate said signal and shut off said signal at a predetermined or fixed period of time after said sensor is activated, said signal including a light that illuminates said collection station, said sensor located in said path of said sheet conveyance and before said collection station is enabled to activate a signal for said predetermined period of time when a first sheet enters said path, said signal including signals selected from the group consisting of light, color coded lights, audio signals, vibrating signals and mixtures thereof, said at least one sensor also enabled to shut off said signal in said collection station at a preset time after activation of a sensor.

OPINION

The plain language of claim 28 states that the subject matter being claimed is “A marking system and process which comprises. . . .” In other words, two statutory classes of invention (i.e., a system (apparatus) and a process) improperly are being recited in a single claim. Claiming two statutory classes within a single claim renders the claim indefinite. *IPXL Holdings, L.L.C. v. Amazon.com, Inc.*, 430 F.3d 1377, 1384 (Fed. Cir. 2005) (a case of first impression for the Federal Circuit regarding the inclusion of two statutory classes of invention in a single claim, which adopted the Board’s holding in *Ex parte Lyell*, 17 USPQ2d 1548 (1990) that held including a method of use in an apparatus claim renders a claim indefinite under 35 U.S.C. § 112, second paragraph). Cf. *Microprocessor Enhancement Corp. v. Texas Instruments Inc.*, 520 F.3d 1367, 1374-75 (Fed. Cir. 2008)

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(No ambiguity was found in the claim language of a method of use claim that recites structural features). Adopting the reasoning of the Board in *Lyell*, the *IPXL* court reasoned that the combination of apparatus and process statutory classes within a single claim renders the claim indefinite under 35 U.S.C. § 112, second paragraph, because a manufacturer or seller of the claimed apparatus would not know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed process of using the apparatus. *Id.*

For these same reasons, Appellants' claims fail to particularly point out and distinctly claim the subject matter which Appellants regard as the invention under 35 U.S.C. § 112, second paragraph, because it is unclear if a manufacturer or seller of the claimed marking system (i.e., apparatus) would know from the claim whether it might also be liable for contributory infringement because a buyer or user of the apparatus later performs the claimed process of using the markings system (i.e., apparatus).

Because we determine that claim 28, the only independent claim on appeal, fails to comply with the requirement of 35 U.S.C. § 112, second paragraph, to particularly point and distinctly claim the subject matter which applicant regards as the invention, any determination whether dependent claim 29 fails to comply with the written description requirement of 35 U.S.C. § 112, first paragraph, or whether any of the claims are obvious over the applied prior art improperly would be based speculation. *In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962).

Accordingly, we reverse *pro forma* the rejection of claim 29, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, the rejection of claims 28-30, 33, and 34 under 35

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U.S.C. § 103 over Tanaka¹ in view of Iizumi², the rejection of claim 31 under 35 U.S.C. § 103 over Tanaka in view of Iizumi and Matsumae³, and the rejection of claim 32 under 35 U.S.C. § 103 over Tanaka in view of Iizumi and Kim⁴.

NEW GROUND OF REJECTION

Claims 28-34 are rejected under 35 U.S.C. § 112, second paragraph, as failing to point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 28 recites that the subject matter of the claim is directed to “[a] marking system and process which comprises.” Plainly, claim 28 recites that the structure of the marking system “comprises in an operative arrangement at least one sensor, a marking station, a sheet(s) collection station with a signal, a sheet conveyance and path, and at least one sensor.” Claim 28 further recites a process of using the apparatus. For example, “said sensor enabled to activate at least one signal including illumination at said collection station” (claim 28). The inclusion of a process of use in an apparatus claim renders the claim indefinite under 35 U.S.C. § 112, second paragraph, for the reasons provided *supra*. *IPXL*, 430 F.3d at 1384.

DECISION

The Examiner’s decision is reversed and a new ground of rejection pursuant to 37 CFR §41.50(b) is provided.

¹ JP 6-191128 published July 12, 1994, as translated.

² US 6,003,861 patented December 21, 1999.

³ US 2005/0095014 A1 published May 5, 2005.

⁴ US 2006/0110198 A1 published May 25, 2006.

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This Decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 CFR § 41.50(b) also provides that the Appellants, 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 proceedings will be remanded to the Examiner, or
- (2) *Request rehearing.* Request that the proceedings be reheard under § 41.52 by the Board upon the same record.

REVERSED and NEW GROUND OF REJECTION 37 CFR § 41.50(b)

tc

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