

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL MARX

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Appeal 2008-2085  
Application 10/707,134  
Technology Center 3600

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Decided: December 18, 2008

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*Before:* WILLIAM F. PATE, III, JENNIFER D. BAHR, and STEVEN D.A.  
McCARTHY, *Administrative Patent Judges.*

BAHR, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Michael Marx (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 2-23 and 25-35 and 51. Claims 1 and 24 have been canceled, and claims 36-50 have been withdrawn from

consideration. We have jurisdiction over this appeal under 35 U.S.C. § 6 (2002).

*The Invention*

Appellant's claimed invention is directed to an apparatus for coupling a hydraulic ram to a frame deck. Spec. ¶ 2; fig. 1. Claims 8, 23, 27, and 51, reproduced below, are illustrative of the invention.

8. An anchor device for coupling an external device to a surface of a deck, said anchor device being received within an opening of the surface, said opening having an edge of the surface therein, said anchor device comprising:

an anchor body comprising a first body portion and a second body portion, said anchor body positioned at least partially within said opening so that a fixed-dimension notch in the first body portion receives the edge of the surface, said second body portion comprising a coupler extending outward from the opening, said coupler coupling to the external device, the second body portion being rotatably coupled to the first body portion.

23. An anchor device for coupling an external device to a surface of a deck, said anchor device being received within an opening of the surface, said opening having an edge of the surface therein, said anchor device comprising:

an anchor body positioned at least partially within said opening so that a notch receives the edge of the surface, said anchor body comprising a coupler extending outward from the opening, said coupler coupling to the external device, said coupler being trapezoidally-shaped.

27. An anchor device for coupling an external device to a surface of a deck, said anchor device

being received within an opening of the surface, said opening having an edge of the surface therein, said anchor device comprising:

a first body portion positioned at least partially within said opening so that a fixed-dimension notch receives the edge of the surface and partially positioned on said surface over said opening and a first member is positioned over the opening to engage a top surface of the deck; and

a second body portion having a coupler extending outward from the first body portion, said coupler coupling to the external device, the second body portion being rotatably coupled to the first body portion.

51. An anchor device for coupling an external device to a deck, said anchor device being received within an opening of the deck, said opening having an edge of the surface therein, said anchor device comprising:

an anchor body comprising a first body portion and a second body portion, said anchor body positioned at least partially within said opening so that a notch in the first body portion receives the edge of the deck, said first body portion having a unitary structure including a first planar member disposed adjacent to an upper surface of the deck and having at least one dimension larger than the opening, and a second planar member having the notch formed therein, said second planar member extending adjacent to the edge and a lower surface of the deck, said second body portion comprising a coupler extending outward from the opening, said coupler coupling to the external device.

*The Rejections*

Appellant seeks review of the Examiner's rejections of claims 8, 12, 15-20, and 25-35 under 35 U.S.C. § 102(b) as being anticipated by Morghen (US 5,823,588); claims 2-7, 9-11, 13, 14, 21, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Morghen; and claims 2-18, 20-23, 25-35, and 51 under 35 U.S.C. § 102(b) as being anticipated by Celette (US 4,519,236).

### SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 C.F.R. § 41.50(b).

### ISSUES

The issues presented in this appeal are:

1. Has Appellant demonstrated the Examiner erred in finding that Morghen teaches a fixed-dimension notch in the first body portion, as called for in claims 8, 12, 16, 20, and 26?
2. Does the claim language "so that a fixed-dimension notch receives the edge of the surface" render claim 27 indefinite?
3. Has Appellant demonstrated the Examiner erred in finding that Celette teaches a fixed-dimension notch in the first body portion, as called for in claims 8, 12, 16, 20, and 26, and a fixed-dimension notch formed in the lateral side of the anchor body, as called for in claim 3?
4. Has Appellant demonstrated the Examiner erred in finding that Celette teaches a trapezoidally-shaped coupler, as called for in claim 23?

5. Has Appellant demonstrated the Examiner erred in finding that Celette's bearing blocks 5a, 5b satisfy the requirements of the first body portion set forth in claim 51?

#### FACTS PERTINENT TO THE ISSUES

- FF1 Appellant's Specification describes an anchor 40 including a body 44 that can be formed as a unitary structure, such as by CNC machines out of a single piece of steel, or can be made of two separate body portions 60 and 62. Spec. ¶ 30.
- FF2 Appellant describes a notch 50 formed within one of the body portions 62. Fig. 3. The notch 50 has a height similar to the thickness of one surface (wall) 30A of the double-walled deck 30 so that the surface 30A may be received in the notch. Spec. ¶ 33. As illustrated in fig. 3, Appellant's notch 50 is entirely formed within one body portion, and its dimensions cannot be adjusted, as by threading or unthreading a fastener, contrary to the Examiner's contentions on page 14 of the Answer.
- FF3 The term "fixed" means "not movable" or "steady; unmoving; resolute." *Webster's New World Dictionary* 528 (David B. Guralnik ed., 2<sup>nd</sup> Coll. Ed., Simon & Schuster, Inc. 1984).
- FF4 The spacing between lower plate 16 and washer 41 in Morghen's shackle attachment device is not fixed in dimension, as its height can be adjusted by threading or unthreading the nut 43 along cap screw 40. Morghen, col. 3, ll. 56-65; fig. 2.
- FF5 Celette teaches a mounting arrangement for mounting a clamp 1 to a slide 6 comprised of two bars 7 by clamping a pair of opposed bearing

- blocks 5a, 5b against bars 7 by means of nuts 11a, 11b. Celette, col. 2, ll. 40 and 56-64; fig. 4. The spacing between the bearing blocks 5a, 5b is adjustable by tightening or slackening movement of nuts 11a, 11b along screw 2. Celette, col. 3, ll. 36-45. Consequently, the spacing between bearing blocks 5a, 5b is not fixed in dimension.
- FF6 The common meaning of “trapezoid” in this country is “a plane figure with four sides only two of which are parallel.” *Webster's New World Dictionary* 1513 (David B. Guralnik ed., 2<sup>nd</sup> Coll. Ed., Simon & Schuster, Inc. 1984).
- FF7 Neither movable jaw component 18 nor vertical flange 19 of Celette’s clamp is trapezoidally-shaped. Celette, figs. 1-4.
- FF8 Celette’s bearing blocks 5a and 5b are separate components, not a unitary (one-piece) structure. Celette, col. 2, ll. 50-55; fig. 4.
- FF9 The flange 29 extending downwardly from bearing block 5a does not extend to the lower edge of bar 7 of slide 6. Celette, col. 3, ll. 65-66; fig. 4.
- FF10 A “notch” is “a concave or V-shaped cut or indentation in an edge or across a surface.” *Webster's New World Dictionary* 973 (David B. Guralnik ed., 2<sup>nd</sup> Coll. Ed., Simon & Schuster, Inc. 1984).

#### PRINCIPLES OF LAW

To establish anticipation, every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001).

In interpreting claim language, we apply the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. *See In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

The Examiner cannot read a claim limitation so unreasonably broadly as to effectively ignore the limitation in determining whether to reject a claim under § 103(a). *See In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970).

The purpose of a patent claim is to define the precise scope of a claimed invention, thereby “giv[ing] notice both to the examiner at the U.S. Patent and Trademark Office during prosecution, and to the public at large, including potential competitors, after the patent has issued.” Allowing a patentee to argue that physical structures and characteristics specifically described in a claim are merely superfluous would render the scope of the patent ambiguous, leaving examiners and the public to guess about which claim language the drafter deems necessary to his claimed invention and which language is merely superfluous, nonlimiting elaboration. For that reason, claims are interpreted with an eye toward giving effect to all terms in the claim.

*Bicon Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) (citations omitted). *See also Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions which render phrases in claims superfluous).

We must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than

the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004) (“Though understanding the claim language may be aided by the explanations contained in the written description, it is important not to import into a claim limitations that are not a part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.”)

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015 (CCPA 1977). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *See In re Warmerdam*, 33 F.3d 1354, 1361 (Fed. Cir. 1994).

## ANALYSIS

*Claims 8, 12, 15-20, 25, 26, and 28-35 as anticipated by Morghen*

Each of independent claims 8, 12, 16, 20, and 26, and the claims depending therefrom, requires a “fixed-dimension” notch in the first body portion of the anchor body that receives the edge of the surface of the deck. In addressing this limitation, the Examiner states that the notch is “viewed as the notch formed by 16, 40 and 41, and fixed in dimension in as much as Applicant’s notch is.” Ans. 4. We understand this statement to mean that the Examiner considers the gap or spacing (in which structure 48 is received when assembled) between the lower plate 16 and washer 41 to be the notch. The Examiner contends that there is no indication in Appellant’s Specification or drawings that elements 72 and 74, which the Examiner

asserts fix the size of the notch, are welded or otherwise affixed together beyond being held by a threaded fastener. Ans. 14. Appellant argues that Morghen does not disclose a notch, much less a fixed-dimension notch as claimed, and that the Examiner misapprehends Appellant's disclosed notch 50. Appeal Br. 8. We agree with Appellant.

The Examiner's apparent reading of the "fixed-dimension notch" on the spacing or gap defined by the lower surface of lower plate 16, the cap screw 40, and the washer 41 of Morghen is ostensibly grounded on an unreasonable construction of the terminology "fixed-dimension." The ordinary and customary meaning of the modifier "fixed-dimension" is having dimensions which are fixed, that is, not movable. FF3. To read the claim terminology "fixed-dimension" on structure having a dimension that is adjustable effectively renders that limitation superfluous. As noted above, this type of claim construction has been denounced by our reviewing court. The Examiner's reliance (Ans. 14) on Appellant's disclosure to justify a reading of the "fixed-dimension notch" on a gap or spacing whose height is defined by the position of an adjustable washer and nut appears to be grounded on a misapprehension of Appellant's disclosed notch 50. As noted in our findings above, Appellant's notch 50 is entirely formed within one body portion, and its dimensions cannot be adjusted, as by threading or unthreading a fastener. FF2. The spacing between lower plate 16 and washer 41 in Morghen's shackle attachment device, on the other hand, is not fixed in dimension, as its height can be adjusted by threading or unthreading the nut 43 along cap screw 40. FF4. Thus, even assuming the spacing defined by the lower surface of lower plate 16, the cap screw 40, and the washer 41 of Morghen can reasonably be considered to be a notch, it is not a

“fixed-dimension notch,” as its height can be adjusted by threading or unthreading the nut and releasing the washer.

For the above reasons, the Examiner’s rejection of claims 8, 12, 15-20, 25, 26, and 28-35 is grounded on a flawed finding that the gap or spacing between the lower plate 16 and washer 41 of Morghen satisfies the claim limitation of a “fixed-dimension notch” in the first body portion.

Accordingly, the rejection cannot be sustained.

*Claims 2-7, 9-11, 13, 14, 21, and 22 as unpatentable over Morghen*

Claim 3 requires a “fixed-dimension notch” formed in the lateral side of the anchor body. Claims 2, 4-7, 9-11, 13, 14, 21, and 22 depend either directly or indirectly from claim 3 and thus also require a “fixed-dimension notch” formed in the lateral side of the anchor body. The rejection of claims 2-7, 9-11, 13, 14, 21, and 22 as unpatentable over Morghen is grounded in part on the Examiner’s flawed finding that the gap or spacing between the lower plate 16 and washer 41 of Morghen satisfies the claim limitation of a “fixed-dimension notch.” Accordingly, this rejection likewise cannot be sustained.

*Claims 2-18, 20-22, 25, 26, and 28-35 as anticipated by Celette*

Claims 2-18, 20-22, 25, 26, and 28-35 all require a “fixed-dimension notch” in the anchor body that receives the edge of the surface of the deck. The Examiner contends that the “fixed-dimension notch” is “viewed as the notch formed by elements 5a and 5b, and fixed in dimension in as much as Applicant’s notch is.” Ans. 6. Appellant argues that the bearing blocks 5a, 5b do not define a notch between them, much less a fixed-dimension notch. Appeal Br. 15. We agree with Appellant.

The spacing between the bearing blocks *5a*, *5b* is adjustable by tightening or slackening movement of nuts *11a*, *11b* along screw 2. Consequently, the spacing between bearing blocks *5a*, *5b* is not fixed in dimension. FF5. Thus, even assuming the spacing between the bearing blocks *5a*, *5b* can reasonably be considered a notch, it is not a “fixed-dimension notch” as called for in the claims. Accordingly, the rejection of these claims cannot be sustained.

*Claim 23 as anticipated by Celette*

Claim 23 requires a trapezoidally-shaped coupler. Referring to fig. 4, the Examiner contends that jaw component 18 and vertical flange 19 of Celette’s clamp 1 have a trapezoidal shape. Ans. 9. In support of this position, the Examiner states that “the definition of a trapezoid simply requires two sides of a four-sided shape to be parallel.” Ans. 15. Appellant, on the other hand, urges that a trapezoid is a quadrilateral shape that has four sides, two of which are parallel and two of which are not parallel. App. Br. 19, Reply Br. 4. Appellant has the better position on the definition of “trapezoidally-shaped.” As noted above, we find that the common meaning of “trapezoid” is “a plane figure with four sides only two of which are parallel.” FF6. The Examiner has not provided any evidence to support a broader definition of “trapezoid” allowing for more than two of the four sides to be parallel. Neither movable jaw component 18 nor vertical flange 19 of Celette’s clamp is trapezoidally-shaped. FF7.

In light of the above, Appellant persuades us that the Examiner erred in rejecting claim 23 as anticipated by Celette. The rejection cannot be sustained.

*Claim 51 as anticipated by Celette*

Claim 51 calls for a notch in the first body portion and further requires that the first body portion have a unitary structure including a first planar member disposed adjacent an upper surface of the deck and having at least one dimension larger than the opening [in the deck] and a second planar member, with the second planar member having the notch formed therein. Claim 51 further requires that the second planar member extend adjacent to the edge and a lower surface of the deck. Applying the Examiner's reading, bearing blocks 5a, 5b clearly are not a unitary member (FF8), as that terminology is used by Appellant. Specifically, Appellant's Specification describes an anchor 40 including a body 44 that can be formed as a unitary structure 44, such as by CNC machines out of a single piece of steel, or can be made of two separate body portions 60 and 62. FF1. Even if we considered the first body portion of claim 51 to read only on bearing block 5a, with the flange 29 being the second planar member, and having a notch formed therein by virtue of it having a smaller diameter than the upper portion of bearing block 5a, flange 29 does not extend adjacent to the edge and lower surface of the deck (the lower edge of bar 7 of slide 6), as also called for in claim 51. FF9.

For the above reasons, Appellant's arguments on pages 21 and 22 of the Appeal Brief persuade us the Examiner erred in rejecting claim 51 as anticipated by Celette. The rejection cannot be sustained.

*Claim 27*

Pursuant to our authority under 37 C.F.R. § 41.50(b), we reject claim 27 under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the invention.

Claim 27 requires “a first body portion positioned at least partially within said opening so that a fixed-dimension notch receives the edge of the surface,” but does not specify in what structure the “notch” is provided. A “notch” is “a concave or V-shaped cut or indentation in an edge or across a surface.” FF10. As such, a “notch” has no ascertainable meaning without association with some structure, having an edge or surface, in which the “notch” is formed. As noted above, we must be careful not to read a particular embodiment appearing in the written description into the claim if the claim language is broader than the embodiment. While we might speculate that the “notch” is formed in some surface or edge of the first body portion, as it is in the first embodiment of Appellant’s invention (FF2), another possible interpretation of the language of claim 27 is that the first body portion is positioned so that a notch in some unrecited element may receive the edge of the surface. Accordingly, claim 27 fails to set out and circumscribe a particular area with a reasonable degree of precision and particularity so as to reasonably apprise those of skill in the art of its scope. Claim 27 is therefore indefinite.

We shall not sustain the examiner's rejections of claim 27 under 35 U.S.C. § 102(b) as being anticipated by Morghen and by Celette. For the reasons expressed above, claim 27 is indefinite. Therefore, the prior art rejections must fall because they are necessarily based on speculative assumption as to the meaning of the claim. *See In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962). It should be understood, however, that our decision in this regard is based solely on the indefiniteness of the claimed subject matter, and does not reflect on the adequacy of the prior art evidence applied in support of the rejections.

### CONCLUSIONS OF LAW

1. Appellant has demonstrated the Examiner erred in finding that Morghen teaches a fixed-dimension notch in the first body portion, as called for in claims 8, 12, 16, 20, and 26, and the claims depending therefrom.
2. The claim language “so that a fixed-dimension notch receives the edge of the surface” renders claim 27 indefinite. Accordingly, we reject claim 27 under 35 U.S.C. § 112, second paragraph. We are also constrained to reverse the rejections of claim 27 as anticipated by Morghen and by Celette, because these rejections are necessarily based on speculative assumption as to the meaning of claim 27.
3. Appellant has demonstrated the Examiner erred in finding that Celette teaches a fixed-dimension notch in the first body portion, as called for in claims 8, 12, 16, 20, and 26 and the claims depending therefrom, and a fixed-dimension notch formed in the lateral side of the anchor body, as called for in claim 3 and the claims depending therefrom.
4. Appellant has demonstrated the Examiner erred in finding that Celette teaches a trapezoidally-shaped coupler, as called for in claim 23.
5. Appellant has demonstrated the Examiner erred in finding that Celette’s bearing blocks 5a, 5b satisfy the requirements of the first body portion set forth in claim 51.

### DECISION

The Examiner’s decision is reversed. We enter a new ground of rejection of claim 27 under 35 U.S.C. § 112, second paragraph, pursuant to 37 C.F.R. § 41.50(b).

This decision contains a new ground 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 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). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

JRG

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