

1 AFFIRM the rejections of claims 10-13. Pursuant to 37 C.F.R. § 41.50(c)
2 (2007), we include an explicit statement of how appealed claims 10, 12 and
3 13 may be amended to overcome the rejection of those claims under § 112,
4 ¶ 2. We REVERSE the rejection of claim 9.

5 The claims on appeal relate to an apparatus for elastically mounting a
6 hydraulic unit of a vehicle brake system in the engine compartment of a
7 vehicle. A preferred embodiment of the apparatus includes a mounting
8 bracket having two perpendicularly-extending legs. The hydraulic unit is
9 supported by means of elastomer elements. Each of the elastomer elements
10 is shaped as a hollow cylinder. Bolts passing through central lumens in each
11 of the elastomer elements have end portions received in a casing of the
12 hydraulic unit. (Spec. 1, ¶ 0004; 3, ¶ 0014; and 4, ¶ 0015).

14 ISSUES

15 The issue in this appeal is whether the Appellants have shown that the
16 Examiner erred in rejecting claims 9-13 under 35 U.S.C. § 112, ¶ 2 (2002) as
17 being indefinite for failing to particularly point out and distinctly claim the
18 subject matter which the Appellants regard as the invention. This issue turns
19 on whether the terms “the first bolt (15)” as recited in claim 9; “acting as
20 clamping means” as recited in claim 10; “wherein the portion (32) toward
21 the unit of the second of said bolts (16) and the bush (34) . . .” as recited in
22 claim 12; “the unshortened hollow-cylindrical elastomer element (18)” as
23 recited in claim 12; and “wherein the second of said bolts (16), the elastomer
24 element (18), which is slipped with its second end portion (38) onto the
25 portion (32), toward the unit, of the second bolt (16)” as recited in claim 13,
26 are indefinite.

1 FINDINGS OF FACT

2 Such findings of fact as may be needed to resolve the issues raised in
3 this appeal will be stated in the Analysis section of this opinion.

4
5 PRINCIPLES OF LAW

6 A claim is subject to rejection under section 112, ¶ 2, if the claim fails
7 in “particularly pointing out and distinctly claiming the subject matter which
8 the applicant regards as his invention.” Compliance with the definiteness
9 requirement of section 112, ¶ 2 ensures adequate notice to those of ordinary
10 skill in the art concerning the scope of issued claims; encourages others to
11 design around the claimed subject matter; and assists others in assessing
12 whether the claimed subject matter is patentable. *United Carbon Co. v.*
13 *Binney & Smith Co.*, 317 U.S. 228, 236 (1942); *General Elec. Co. v.*
14 *Wabash Appliance Corp.*, 304 U.S. 364, 369 (1942). In light of these
15 policies, the language of a claim satisfies § 112, ¶ 2 only if “one skilled in
16 the art would understand the bounds of the claim when read in light of the
17 specification.” *Exxon Research & Eng’ring Co. v. United States*, 265 F.3d
18 1371, 1375 (Fed. Cir. 2001). During examination, the definiteness of claims
19 is determined in light of both the specification and the prior art. *In re*
20 *Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

21 A claim may be subject to rejection under § 112, ¶ 2 even if the claim
22 is susceptible of some interpretation. The U.S. Patent & Trademark Office
23 does not construe claims under examination so as to avoid rejecting such
24 claims as indefinite. *Cf. In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir.
25 1997)(rejecting the contention that the Patent & Trademark Office should
26 interpret claims in the same manner as courts). Instead, pending claims are

1 interpreted as broadly as their language reasonably allows. “The reason is
2 simply that during patent prosecution when claims can be amended,
3 ambiguities should be recognized, scope and breadth of language explored,
4 and clarification imposed.” *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1990).
5 Where an attempt to interpret a claim as broadly as its language reasonably
6 allows exposes ambiguities which reasonably might prevent one of ordinary
7 skill in the art from understanding the bounds of the claim, the Patent and
8 Trademark Office has the authority to reject the claim under § 112, ¶ 2 and
9 to require the applicant to clarify the scope of the right the applicant seeks.
10 Accordingly, our reviewing court has suggested that claim language which
11 might be held definite under the standard applicable during infringement
12 litigation, namely, claim language amenable to construction and not
13 insolubly ambiguous, might be subject to rejection under § 112, ¶ 2 during
14 examination. *See Exxon Research & Eng’ring*, 265 F.3d at 1384.¹

15

16

ANALYSIS

17

A. *Claim 9*

18

19

20

21

Claim 9 depends from allowed independent claim 8. Claim 8 recites an apparatus including “a mounting bracket (12) having first (13) and second (14) legs extending at right angles to one another and on which the unit (11) is supported by means of elastomer elements (17, 18) through which bolts

¹ “If this case were before an examiner, the examiner might well be justified in demanding that the applicant more clearly define U_L, and thereby remove any degree of ambiguity. However, we are faced with an issued patent that enjoys the presumption of validity. In these circumstances, we conclude that a person of skill in the art would understand the scope of the term U_L, and that the degree of ambiguity injected into the claims by the patentee’s lack of precision is therefore not fatal.” *Id.*

1 (15, 16) pass” Claim 8 further recites that “one of said bolts (15)”
2 extends “in the mounting direction (45) of the unit (11) and into the
3 hydraulic unit” In addition, “a second of said bolts” extends “through
4 said hollow-cylindrical elastomer element and into the hydraulic unit”
5 Claim 9 recites that two spaced-apart recesses of the second leg are “located
6 symmetrically to a plane (23) in which the first bolt (15) extends.” The
7 Examiner concludes that the term “the first bolt (15)” is indefinite due to
8 insufficient antecedent basis for this limitation in claims 8 and 9. (Ans. 4).
9 We agree with the Appellant (App. Br. 11) that claim 9 is not indefinite due
10 to the use of the term “the first bolt (15).”

11 A claim is not indefinite merely because one of its terms lacks
12 sufficient antecedent basis if the term has a reasonably ascertainable
13 meaning in the context of the claim language and the specification.
14 *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366, 1370 (Fed.
15 Cir. 2006). Claims 8 and 9 appear to recite only two bolts, namely, bolts
16 corresponding to those identified by the reference numerals 15 and 16 in Fig.
17 1 of the Appellants’ Specification. Claim 8 refers to these bolts as “one of
18 said bolts (15)” and “a second of said bolts.” One of ordinary skill in the art
19 would recognize that the terms “the first bolt (15)” and “a second of said
20 bolts” do not refer to the same element. Therefore, by a process of
21 elimination, one of ordinary skill in the art would recognize that the terms
22 “the first bolt (15)” and “one of said bolts (15)” do refer to the same
23 element. This conclusion would be reinforced by the use of the same
24 reference numeral in both terms.

25 On the record before us, we conclude that the Examiner has not
26 articulated reasoning which would support a conclusion that one of ordinary

1 skill in the art would not understand the bounds of claim 9. Therefore, the
2 Appellants have shown that the Examiner erred in rejecting claim 9 under
3 § 112, ¶ 2.

4
5 *B. Claims 10 and 11*

6 The Appellants argue claims 10 and 11 as a group. (App. Br. 12-13).
7 We select claim 10 as being representative of the group for purposes of the
8 rejection under § 112, ¶ 2. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2007). Claim
9 10 depends from allowed independent claim 8. Claim 8 recites a hollow-
10 cylindrical elastomer element (18) which is “both radially widened and
11 axially shortened by clamping means (34, 35, 36) disposed on the second of
12 said bolts (16).” Claim 10 recites that the second of said bolts *16* has a
13 portion from which a smaller-diameter screw shaft begins. Claim 10 further
14 recites “a bush (34) with a flange (35) and a nut (36), acting as [a] clamping
15 means,” which are received on the smaller-diameter screw shaft. The
16 Examiner concludes that the term “clamping means” is indefinite due to
17 insufficient antecedent basis for this limitation in claims 8 and 10. (Ans. 4).
18 We agree.

19 In particular, we agree with the Examiner (Ans. 7) that the term
20 “acting as clamping means” does not imply that that the bush, the flange and
21 the nut together constitute the structure recited as “clamping means” in claim
22 8. Claim 10 does not recite that the bush, the flange and the nut are the
23 clamping means recited in claim 8 but merely that the three elements are
24 “acting as clamping means.” One of ordinary skill in the art reasonably
25 could read claim 10 as limited to apparatus including both a (1) “clamping
26 means” disposed in some manner on the second of the bolts and (2) a

1 separate combination of a bush, a flange and a nut which is received on the
2 smaller-diameter screw shaft and which acts in some capacity as clamping
3 means. The Appellants' Specification, particularly the passage at page 5,
4 lines 13-15 of the Specification cited by the Appellants (*see* App. Br. 12-13),
5 does not expressly exclude the existence of more than one clamping means
6 in the apparatus.

7 On the record before us, we conclude that the language "a bush (34)
8 with a flange (35) and a nut (36), acting as [a] clamping means," as used in
9 claim 10 does not have a single, readily ascertainable meaning. Therefore,
10 the Appellants have not shown that the Examiner erred in rejecting claims
11 10 and 11 under § 112, ¶ 2.

12

13 *B. Claims 12 and 13*

14 The Appellants formally argue claims 12 and 13 as a group. Since the
15 Examiner cites different language in each of the two claims in support of the
16 rejection of the two claims, we will consider claims 12 and 13 separately for
17 purposes of this ground of rejection. Claims 12 and 13 each depend from
18 claim 8 by way of claim 10.

19 We agree with the Examiner (Ans. 4) that the term "the portion (32)
20 toward the unit of the second of said bolts (16) and the bush (34)" of claim
21 12 is confusing and indefinite. The heart of the problem with this claim
22 language lies in the prepositional phrase immediately following the words
23 "the portion (32)." The Appellants contend that the word "unit" as used in
24 claim 12 refers back to the "hydraulic unit (11)" recited in the preamble of
25 claim 8. (App. Br. 13.) Since claim 8 refers to a "hydraulic unit" rather than
26 a "unit" and since no reference numeral immediately follows the word "unit"

1 as in parent claim 10, one of ordinary skill in the art reasonably could read
2 the word “unit” as reciting a combination of the second of said bolts and the
3 bush rather than as referring to the previously-recited hydraulic unit. It
4 would follow that one of ordinary skill in the art would construe the object
5 of the preposition “toward” to the unit (that is, the combination) of the
6 second of the bolts and the bush. This construction would be consistent with
7 Fig. 4 of the Specification, which shows the portion 32 of the bolt 16
8 adjacent to junction of the bolt 16 and the bush 34.

9 The prepositional phrase immediately follows the term “the portion
10 (32)” and appears to modify that term. Hence, construing the prepositional
11 phrase to read “toward the unit of the second of the bolts (16) and the bush
12 (34)” would imply that claim 12 recites an apparatus in which “the portion
13 (32) . . . have a length adapted to the end portions (38, 39) of the
14 unshortened hollow-cylindrical elastomer element (18).” Construing claim
15 12 in this manner would not limit the length of the bush as would the
16 construction advanced by the Appellants. Consequently, we conclude that
17 claim 12 is ambiguous. On the record before us, that Appellants have not
18 shown that the Examiner erred in rejecting claim 12 under § 112, ¶ 2.

19 Claim 13 suffers from a similar defect. In particular, claim 13 recites
20 “the portion (32), toward the unit, of the second bolt (16)” The
21 Appellants contend merely that “[c]laim 13 is also dependent on claim 10
22 and states that the second bolt (16), the elastomer element (18), the bush (34)
23 and flange (35) and the nut (36) form a component group (37). This feature
24 of the invention is shown in Fig. 5 and described at p. 4, ll. 19-25.” (App.
25 Br. 15). The Appellants’ arguments do not address the language cited by the
26 Examiner as being indefinite. On this basis, we conclude that the Appellants

1 have not shown that the Examiner erred in rejecting claims 13 under § 112,
2 ¶ 2.

3

4 EXPLICIT STATEMENT OF HOW
5 APPEALED CLAIMS 10, 12 AND 13 MAY BE AMENDED
6 TO OVERCOME THE REJECTION UNDER § 112, ¶ 2

7 Pursuant to 37 C.F.R. § 41.50(c) (2007), we state that the Appellants
8 may overcome the pending rejection of claims 10-13 under § 112, ¶ 2 by
9 amending claim 10 in the manner proposed by the Examiner (Ans. 4) and by
10 amending claims 12 and 13 as follows:²

11

12 10. The apparatus of claim 8, wherein the second of said bolts (16) is
13 press-fitted or screwed into the unit (11) and, adjacent to the unit (11), has a
14 portion (32) which engages the inside cross section of the hollow-cylindrical
15 elastomer element (18) and from which a smaller-diameter screw shaft (33)
16 begins, on which screw shaft a bush (34) with a flange (35) and a nut (36),
17 acting as said clamping means, are received.

18

19 12. The apparatus of claim 10, wherein the portion (32) ~~toward the unit~~ of
20 the second of said bolts (16) adjacent the unit (11) and the bush (34) have a
21 length adapted to the end portions (38, 39) of the ~~unshortened~~ hollow-
22 cylindrical elastomer element (18) when the hollow-cylindrical elastomer
23 element is in an unbraced state, and the portion (32) of the second bolt (16)
24 forms a stop for the bush (34).

25

² Underlining indicates additions; ~~strikethroughs~~ indicate deletions; and double square brackets “[. . .]” indicate short deletions.

1 13. The apparatus of claim 10, wherein the second of said bolts (16)[[,]];
2 the elastomer element (18), ~~which is slipped~~ with its second end portion (38)
3 slipped onto the portion (32), ~~toward the unit~~, of the second bolt (16)
4 adjacent the unit (11); the bush (34), ~~and~~ the flange (35) engaging the other
5 end portion (39) of the elastomer element (18); and the nut (36), the nut (36)
6 being screwed onto the screw shaft (33), ~~and~~ form a component group (37).

7

8

CONCLUSIONS

9 On the record before us, the Appellants have not shown that the
10 Examiner erred in rejecting claim 9 under § 112, ¶ 2. We conclude that
11 claims 10-13 are ambiguous and that the Appellants have not shown that the
12 Examiner erred in rejecting those claims under § 112, ¶ 2.

13

14

DECISION

15 We REVERSE the rejection of claim 9 and AFFIRM the rejections of
16 claims 10-13.

17

18 No time period for taking any subsequent action in connection with
19 this appeal may be extended under 37 C.F.R. § 1.136(a) (2007). *See* 37
20 C.F.R. § 1.136(a)(1)(iv) (2007).

20

21

AFFIRMED

Appeal 2008-2644
Application 10/333,718

1 hh

2

3 RONALD E. GREIGG
4 GREIGG & GREIGG P.L.L.C.
5 1423 POWHATAN STREET, UNIT ONE
6 ALEXANDRIA, VA 22314