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3 BEFORE THE BOARD OF PATENT APPEALS  
4 AND INTERFERENCES  
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7 *Ex parte* ROBERT J. SIMMONS  
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10 Appeal 2008-3604  
11 Application 10/750,708  
12 Technology Center 3600  
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15 Decided: September 23, 2008  
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18 *Before:* MURRIEL E. CRAWFORD, HUBERT C. LORIN, and  
19 JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

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21 CRAWFORD, *Administrative Patent Judge.*  
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25 DECISION ON APPEAL

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27 STATEMENT OF CASE

28 Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection  
29 of claims 3 to 6. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

30 Appellant's invention relates to a plural-story building structure, and  
31 more particularly features in a novel column structure which forms part of  
32 the frame in such a building structure. (Specification 1).

1 Claim 3 under appeal reads as follows:

2 3. A building method for fabricating a site-built, plural-story  
3 building comprising

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5 furnishing a column-and-beam structural building frame  
6 possessing a load-bearing portion which is defined by nodally  
7 interconnected columns and beams, where at least one column  
8 is formed as a hollow, tubular structure,

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10 providing in the at least one column, substantially  
11 immediately above a nodal connection between the mentioned  
12 one column and a beam, an upper-end utility region which  
13 extends above and beyond the frame's load-bearing portion, and  
14 which region terminates in a nominally open, upwardly facing  
15 mouth which opens to the hollow interior of the at least one  
16 column to define therewith a utility port,

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18 employing the defined utility port, inserting downwardly  
19 thereinto, for stabilized insertion, reception and use, a building,  
20 construction-extension instrumentality selected from the list  
21 consisting of (a) an installable/removable crane structure, (b) a  
22 column-like element provided for the addition of selected  
23 building superstructure, and (c) additional building  
24 infrastructure feedable downwardly through said port toward a  
25 selected elevation in said building structure, and

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27 at least for such a crane structure and superstructure,  
28 utilizing direct lateral engagement therebetween and the  
29 receiving column utility port to furnish fully all lateral  
30 stabilization of and support for the thus port-received structure.

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32 The Examiner rejected claim 3 under 35 U.S.C. § 112, second  
33 paragraph, as being indefinite for failing to particularly point out and  
34 distinctly claim the subject matter which Appellant regards as the invention.

35 The Examiner rejected claims 3 to 6 under 35 U.S.C. § 102(b) as

1 being anticipated by Uecker.

2 The prior art relied upon by the Examiner in rejecting the claims on  
3 appeal is:

4 Uecker 2,203,113 Jun. 4, 1940

5 In regard to the rejection under 35 U.S.C. § 112, second paragraph,  
6 the Examiner is of the opinion that recitation in claim 3 of “at least for such  
7 a crane structure and superstructure, utilizing direct lateral engagement  
8 therebetween and the receiving column utility port” is unclear because  
9 according to the preceding paragraph and the specification, there is no  
10 physical relationship between the crane and the superstructure.

11 Appellant contends that the recitation in claim 3 clearly recites the  
12 recitation between the crane structure, the superstructure and the receiving  
13 utility port.

14 In regard to the rejection under 35 U.S.C. § 102(b), Appellant  
15 contends that Uecker does not disclose an open column that furnishes the  
16 totality of the lateral stabilization and support for the crane.

#### 17 ISSUES

18 The issue is whether the Appellant has shown that the Examiner erred  
19 in holding that the recitation in the last paragraph of claim 3 is unclear in  
20 view of other recitations in the claim and the disclosure in the Specification.

21 The second issue is whether the Appellant has shown that the  
22 Examiner erred in finding that Uecker discloses that the seating of the crane  
23 base in the open column end furnishes the totality of lateral stabilization and  
24 support for the seated crane.

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## FINDINGS OF FACT

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Appellant discloses a hollow tubular structure 12 as part of a structural building frame. The tubular structure 12 forms a utility port for insertion, reception and use of (1) a crane structure 54, 56, 58 as depicted in Figure 1 (Specification 10), (2) a column like element 66, 68 as depicted in Figure 5 (Specification 11) or (3) an additional structure feedable downwardly through the utility port as depicted in Figure 4 (Specification 11). The crane is used prior to the final construction of the building (Specification 4). The superstructure and structure feedable downwardly through the utility port are used after completion of the building (Specification 5).

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Uecker discloses a hoist which includes a crane structure 25 that includes a beam 26 that is removable seated in a port 27 of hollow tubular structure 15 (Figure 1). The crane structure 25 is braced by a pair of tubular members 35, 36 which are connected to an angle iron 42 which is secured to the scaffold by a hook 43 (page 1, col. 2, l. 47 to page 2, col. 1, l. 4).

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## ANALYSIS

We will sustain the Examiner's rejection of claim 3 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. Claim 3 recites that the building construction-extension instrumentality is selected from the list consisting of three structures, i.e., a crane structure, a column-like element for addition of selected superstructure and an infrastructure feedable downwardly through

1 the port. As such, claim 3 recites that these instrumentality are alternative  
2 structures. Claim 3 does not recite that any of the three structures listed exist  
3 together. Rather, claim 3 recites that the instrumentalities are mutually  
4 exclusive. Therefore, if the crane structure is selected, there is no  
5 superstructure. As we found above, Appellant's disclosure likewise  
6 discloses that the crane and superstructure are mutually exclusive. In fact,  
7 the Specification teaches that the crane is used prior to completion of the  
8 building and the superstructure is used after completion of the building.  
9 Therefore, we agree with the Examiner that the recitation in the last  
10 paragraph of claim 3 "at least for such crane structure and superstructure,  
11 utilizing direct lateral engagement therebetween" is unclear. As such, we  
12 will sustain the Examiner's rejection of claim 3 under 35 U.S.C. § 112,  
13 second paragraph.

14 We enter a new rejection of claims 4 and 5 under 35 U.S.C. § 112,  
15 second paragraph as being indefinite for failing to particularly point out and  
16 distinctly claim the subject matter which Appellant regards as the invention.  
17 Claims 4 and 5 are unclear by virtue of their dependence on claim 3.

18 In regard to the rejection of claims 3 to 5 under 35 U.S.C. § 102(b),  
19 we note that we might speculate as to what is meant by the claim language  
20 found in claim 3, our uncertainty provides us with no proper basis for  
21 making the comparison between that which is claimed and the prior art as  
22 we are obliged to do. Rejections under 35 U.S.C. §102(b) should not be  
23 based upon "considerable speculation as to the meaning of the terms  
24 employed and assumptions as to the scope of the claims." *In re Steele*, 305  
25 F.2d 859, 862, (CCPA 1962). Accordingly, we are constrained to reverse,

1 pro forma, the examiner's rejections of claims 3 through 5 under 35 U.S.C. §  
2 102(b). We hasten to add that this is a procedural reversal rather than one  
3 based upon the merits of the section 102(b) rejection.

4 We will not sustain the Examiner's rejection of claim 6 because  
5 Uecker does not disclose that the column 15 provides the totality of  
6 stabilization and support for the seated crane 25. Rather, Uecker discloses  
7 that the tubular members 35, 36 which are connected to an angle iron 42  
8 which is secured to the scaffold by a hook 43 also provide stabilization for  
9 the crane 25.

10 Under 37 C.F.R. § 41.50(b) a new ground of rejection has been  
11 entered.

12 37 C.F.R. § 41.50(b) provides that, "[A] new ground of rejection  
13 pursuant to this paragraph shall not be considered final for judicial review."

14 Regarding the new ground of rejection, Appellant must, *WITHIN*  
15 *TWO MONTHS FROM THE DATE OF THE DECISION*, exercise one of the  
16 following options with respect to the new ground of rejection, in order to  
17 avoid termination of the appeal as to the rejected claims:

18 (1) *Reopen prosecution*. Submit an appropriate amendment of the  
19 claims so rejected or new evidence relating to the claims so rejected,  
20 or both, and have the matter reconsidered by the examiner, in which  
21 event the proceeding will be remanded to the examiner. . . ; or  
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23 (2) *Request rehearing*. Request that the proceeding be reheard under  
24 § 41.52 by the Board upon the same record. . . .  
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1                   No time period for taking any subsequent action in connection  
2                   with this appeal may be extended under 37 C.F.R. § 1.136(a).

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AFFIRMED-IN-PART

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