

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MANFRED HUBER, KLAUS JUENGLING  
and BRUCE W. BEHLING

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Appeal No. 1997-0234  
Application 08/219,540<sup>1</sup>

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ON BRIEF

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Before URYNOWICZ, MARTIN and RUGGIERO, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 8-11, all of the claims pending in the present application. Claims 1-7 have been canceled. An amendment after final rejection was filed

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<sup>1</sup> Application for patent filed March 29, 1994.

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February 22, 1996 but was denied entry by the Examiner.

The claimed invention relates to a process and a device for monitoring the position of objects. More particularly, Appellants indicate at pages 2 and 3 of the specification that the device includes a feeler pin which is rotated in first and second directions of rotation until it contacts objects such as machine tools. A zero position of the feeler pin, instead of being defined by a mechanical stop, is determined by a microcomputer during a learning cycle.

Claim 8 is illustrative of the invention and reads as follows:

8. A process for monitoring the position of objects comprising the steps of:
  - providing an electric motor;
  - providing a shaft rotatably driven by said electric motor;
  - providing an encoder for detecting a degree of rotation of said shaft;
  - providing a microcomputer for storing and interpreting data received from said encoder and for controlling said electric motor;
  - providing a feeler pin connected to said shaft;
  - mounting said feeler pin in proximal relationship to a first and a second object;
  - rotating said shaft in a first direction until said feeler pin contacts said first object;
  - measuring a first degree of rotation of said shaft with said encoder during said rotation in said first direction;
  - storing said first degree of rotation of said shaft in said microcomputer;
  - rotating said shaft in a second direction until said feeler pin contacts said second object;

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measuring a second degree of rotation of said shaft with said encoder during said rotation in said second direction;

storing said second degree of rotation of said shaft in said microcomputer;

calculating a hypothetical zero position for said feeler pin in between said first and second objects with said microcomputer based on said first and second degrees of rotation of said shaft;

rotating said shaft to said hypothetical zero position.

No prior art is relied on by the Examiner.

Claims 8-11 stand finally rejected under the second paragraph of 35 U.S.C. § 112 as failing to particularly point out and distinctly claim the invention.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the Examiner's rationale in support of the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that claims 8-11 do not particularly point out the invention in a manner which complies with 35 U.S.C. § 112, second paragraph.

Accordingly, we affirm.

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The general rule is that a claim must set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the disclosure as it would be by the artisan. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed in light of the specification. Seattle Box Co. v. Industrial Crating & Packing, Inc., 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984).

The Examiner's 35 U.S.C. § 112, second paragraph, rejection raises several issues as to the clarity of the claim language of the appealed claims. Initially, the Examiner asserts (Answer, page 4) the impropriety of using "providing" steps in a method claim to recite a structural working environment for a process. In response, Appellants, citing Ex parte Dammers, 155 USPQ 284 (Bd. App. 1961), argue (Brief, page 6) that structural limitations in method claims are not inherently objectionable, an argument with which we agree. The Examiner has provided no support on the record for the position that the step of "providing" a structure is not permissible language in a method claim. The Examiner's comments in the first paragraph of page 4 of the Answer suggest a lack of weight be given to such language. The breadth of a term, however, should not be equated with indefiniteness. In re Miller, 441 F. 2d 689, 169 USPQ 597 (CCPA 1971).

With regard to the claim language "mounting said feeler pin in proximal relationship to a first and second object", it is again our view that the Examiner's concern is a question of breadth and not

indefiniteness. The language “proximal relationship” and “object” are admittedly broad terms; however, it is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of this particular phraseology. We reach a similar conclusion with respect to the “monitoring” language in the preamble. Contrary to the Examiner’s contention, it is our view that the skilled artisan would recognize from Appellants’ specification that the claimed “monitoring” operation encompasses a step of rotating a motor shaft, at the very least during a learning cycle to establish a reference zero position for future machining operations.

Although, as discussed above, we find no ambiguity or lack of clarity in much of the claim language questioned by the Examiner, we do agree with the Examiner that the term “hypothetical” as used in the present claimed context of “calculating a hypothetical zero position” is indefinite. As pointed out by the Examiner (Answer, page 5), the term “hypothetical” is not used in the specification leaving it up to the reader to determine the meaning of the phraseology. While the mere fact that a term used in a claim has no antecedent basis in the specification does not necessarily mean that such term is indefinite, applicants for patent are, nonetheless, under a burden to ensure that terms used to define an invention do so with a reasonable degree of clarity and precision. Considering the present factual situation, we are of the view that Appellants have not satisfied this burden.

In addition, we note that, while the Examiner and Appellants have offered differing definitions of the term “hypothetical”, we agree with the Examiner that the accepted meaning of the term

“hypothetical” is “conjectural or suppositional” (Answer, page 5). While a term used in the claims may be given a special meaning in the description of the invention, generally no term may be given a meaning repugnant to the usual meaning of the term. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Further, Appellants have made no showing that the definition of “hypothetical” offered in the Brief, i.e. “conditional” (Brief, page 8) is accepted usage in the art of machine tool positioning. When there is more than one definition for a term, it is incumbent upon applicant for patent to make clear which definition is being relied on to claim the invention. In re Barr, 444 F.2d 588, 170 USPQ 330 (CCPA 1971). It is our view that, considering the entire context of the claimed invention, there is nothing “hypothetical” about a zero position calculated from values representing angular degrees of rotation of a shaft. Accordingly, the Examiner’s 35 U.S.C. § 112, second paragraph, rejection of independent claim 8, as well as claims 9 and 10 dependent thereon, is sustained.

With respect to independent claim 11, after considering the respective positions of Appellants and the Examiner, we will sustain the indefiniteness rejection of this claim as well. While we do not agree with the Examiner’s contention that “monitoring” would not encompass the determination of an angular rotational relationship of a shaft in different directions, we do agree that the last recited means statement in claim 11 does not define the invention in a manner consistent with the description in the specification. Although the terms of a claim may appear to be definite, inconsistency with the specification disclosure or prior art teachings may make an otherwise definite claim take on an

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unreasonable degree of uncertainty. In re Cohn, 438 F.2d 989, 169 USPQ 95 (CCPA 1971); In re Hammack, 427 F.2d 1378, 166 USPQ 204 (CCPA 1970). We agree with the Examiner's analysis at page 6 of the Answer that concludes that the numerical value produced as a result of the differencing operation recited as the last function in claim 11 is not indicative of the relative position of monitored objects. In any case, this differencing operation is inconsistent with anything described in the specification that would be related to the determination of a zero reference position. As such, we fail to see how the skilled artisan would be able to determine the metes and bounds of the invention from the presently recited language of claim 11.

In summary, we have sustained the Examiner's 35 U.S.C. § 112, second paragraph, rejection of appealed claims 8-11. Therefore, the Examiner's decision rejecting claims 8-11 is affirmed.

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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).

AFFIRMED

STANLEY M. URYNOWICZ, JR.)  
Administrative Patent Judge )  
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) BOARD OF PATENT  
JOHN C. MARTIN ) APPEALS  
Administrative Patent Judge ) AND  
) INTERFERENCES  
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