

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte MINGLUN QIU and LEANDRE ADIFON

---

Appeal No. 2004-0906  
Application No. 09/571,896

---

ON BRIEF

---

Before WARREN, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the primary examiner's final rejection of claims 1 and 3 through 10, which are all of the claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to an elevator system that includes a pair of elevator car guide rails, a separate counterweight guide rail, an elevator car and a counterweight in a certain specified relationship (Brief, page 2). Appellants state that the claims do not stand or fall together and

group the claims in four groups (Brief, page 4).<sup>1</sup> Appellants have presented reasonably specific, substantive reasons for the separate patentability of claims 1, 4, 7 and 8 (i.e., one claim from each grouping; see the Brief, pages 6-13). Therefore, to the extent each claim has been argued, we consider claims 1, 4, 7 and 8 separately. See 37 CFR § 1.192(c)(7)(2000) and *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002).

Representative independent claim 1 is reproduced below:

1. An elevator system comprising:

a pair of elevator car guide rails that is supported by and is substantially parallel planar to a single wall;

a separate counterweight guide rail supported by and adjacent to the single wall and spaced laterally from said elevator car guides rails;

an elevator car mounted for movement along said elevator car guide rails in a first path; and

a counterweight mounted for movement along said counterweight guide rail in a second path, the first path of said elevator car and the second path of said counterweight being oriented laterally and parallel to one another along the single wall.

---

<sup>1</sup>We note that claim 10 appears in two groups, i.e., Groups I and III. This error is harmless in view of our consideration of the claims as discussed below.

Appeal No. 2004-0906  
Application No. 09/571,896

The examiner has relied upon the following references in support of the rejections on appeal:

Bumgarner	1,352,500	Sep. 14, 1920
Crispen	2,088,690	Aug. 03, 1937

The claims on appeal stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite (Answer, page 2). Claims 1, 3, 5-7 and 9 stand rejected under 35 U.S.C. § 102(b) as anticipated by Bumgarner or Crispen (Answer, page 3). Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Bumgarner or Crispen (Answer, page 4). Claim 10 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Crispen (*id.*).<sup>2</sup> We affirm the rejection based on section 112, ¶2, as well as the section 102(b) rejections over Bumgarner or Crispen and the rejection of claim 10 under section 103(a) over Crispen essentially for the reasons stated in the Answer and those reasons set forth below. We reverse

---

<sup>2</sup>The examiner states that "the rejection based upon White under 35 U.S.C. § 102 and the portion of the rejection based upon Bumgarner under 35 U.S.C. 103 have been withdrawn." Answer, page 2, ¶(3). In addition, we determine that the rejections of claims 4 and 8 under section 103(a) over White and of claim 10 under section 103(a) over White in view of Black (see the final Office action dated Dec. 3, 2002, Paper No. 12) have not been repeated in the Answer, while Bumgarner has been applied under section 103(a) against claims 4 and 8. Any rejections not repeated in the Answer are considered as withdrawn. See *Paperless Accounting v. Bay Area Rapid Transit Sys.*, 804 F.2d 659, 663, 231 USPQ 649, 652 (Fed. Cir. 1986).

Appeal No. 2004-0906  
Application No. 09/571,896

the rejections of claims 4 and 8 over Bumgarner or Crispen for reasons stated in the Brief, Reply Brief, and reasons set forth below. Accordingly, the decision of the examiner is affirmed.

#### **OPINION**

##### *A. The Rejection under § 112, ¶2*

The examiner finds that the term "substantially parallel planar" as recited in claims 1 and 7 on appeal is indefinite since it is unclear as to which elements are considered as parallel and which elements have to be in a plane (Answer, paragraph bridging pages 2-3; page 4, ¶(13)). Appellants argue that the subject of the clause is the "pair" of rails which "is" substantially parallel planar to a single wall (Brief, page 6; Reply Brief, page 2). Therefore appellants submit that the claim is definite and clearly indicates that it is the pair of rails which is substantially parallel to the wall, with the pair of rails substantially defining a plane, as does the wall (*id.*).

The examiner and appellants do not contest the meanings of "parallel" or "planar" (see the Answer, the Brief and Reply Brief in their entirety). The issue involves which elements of the claim must be "substantially parallel planar" (*id.*). We agree with appellants that the subject of the first clause of claim 1

Appeal No. 2004-0906  
Application No. 09/571,896

on appeal is "a pair" of elevator car guide rails that "is substantially parallel planar" to a single wall (Brief, page 6; Reply Brief, page 2). However, we agree with the examiner that the clear and unambiguous language of this clause does not require that the wall is planar, merely that the pair of car guide rails is substantially parallel and in a plane (Answer, page 4). Since appellants have indicated that they intend the claim to be of a different scope, i.e., that the wall must, like the rails, substantially define a plane (Brief, page 6; Reply Brief, page 2), we conclude that the claims on appeal do not meet the requirements of the second paragraph of section 112. In other words, the claims do not set forth what the appellants regard as their invention. See *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1377, 55 USPQ2d 1279, 1282 (Fed. Cir. 2000); *In re Cormany*, 476 F.2d 998, 1000-02, 177 USPQ 450, 451-53 (CCPA 1973) (A properly construed claim of such scope as to include what appellants said they did not intend to include does not comply with section 112, ¶2).

Furthermore, we note that another requirement of the second paragraph of section 112 is that the claim must be sufficiently definite. See *Solomon v. Kimberly-Clark Corp.*, *supra*. In determining whether the claim is sufficiently definite, we must analyze whether one skilled in the art would understand the bounds

Appeal No. 2004-0906  
Application No. 09/571,896

of the claim when read in light of the specification. See *In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The word "substantially" in the phrase "substantially parallel planar" is a "word of degree" or an imprecise term. Claims which include such terms or words of degree must provide some standard for measuring that degree, when read in light of the specification as understood by one of ordinary skill in the art. See *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 826, 221 USPQ 568, 574 (Fed. Cir. 1984). The phrase "substantially parallel planar" was added to the claims in an amendment (see the amendment dated Sep. 26, 2002, Paper No. 11). Appellants have not identified any original disclosure that defines or sets forth guidelines for the word "substantially," nor have appellants identified whether "substantially" modifies "parallel" or "planar" or both. Therefore we conclude that, on this record, one of ordinary skill in this art would have to use surmise and conjecture to determine the metes and bounds of the claims when read in light of the specification. See *Ex parte Anderson*, 21 USPQ2d 1241, 1249 (Bd. Pat. App. & Int. 1991); *cf.*, *York Products Inc. v. Central Tractor Farm & Family Center*, 99 F.3d 1568, 1572-73, 40 USPQ2d 1619, 1622-23 (Fed. Cir. 1996).

Appeal No. 2004-0906  
Application No. 09/571,896

For the foregoing reasons, we determine that the examiner has *prima facie* established that the claims on appeal are indefinite, and appellants' arguments have not sufficiently rebutted the examiner's conclusion. We therefore conclude that appellants have failed to meet the requirements of the second paragraph of 35 U.S.C. § 112 and affirm the examiner's rejection.

*B. The Rejections under 35 U.S.C. § 102(b)*

Although we have concluded as a matter of law that the claims are indefinite, we analyze and review the rejections on appeal which are based on prior art since the indefinite phrase "substantially parallel planar" does not affect our review. Our review does not involve any speculations and assumptions regarding this phrase, as discussed below. *Compare In re Steele*, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962).

We adopt the examiner's findings of fact from Bumgarner (Answer, page 3). Appellants note that the outcome of this issue (the rejection under section 102(b) over Bumgarner) appears to depend on the outcome of the issue under section 112, second paragraph (Reply Brief, page 2). Appellants' sole argument regarding this rejection over Bumgarner is that the silo of this reference has a substantially cylindrical wall, which does not "substantially define a plane." Brief, page 7. This argument

is not persuasive. Implicit in any analysis of a rejection under section 102(b) is that the claim must first have been correctly construed to define the scope and meaning of any contested limitation. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). As discussed above, we have construed claim 1 on appeal as requiring that the "pair" of guide rails "is substantially parallel planar" to a single wall but that there is no explicit or implicit requirement in claim 1 on appeal that the wall also substantially defines a plane.

Additionally, we note that the point at which the beam 4 crosses the silo wall may be considered as a plane tangential to the silo wall (see the Answer, page 3, and page 5, first paragraph). Accordingly, even assuming *arguendo* that appellants' claim construction is correct, we determine that the wall of the silo in Bumgarner defines a plane that is parallel planar to the plane defining the pair of guide rails.

With regard to the rejection of claim 7 on appeal, appellants argue that Bumgarner fails to disclose or suggest that the pair of guide rails is supported by and substantially parallel planar to one wall, and the counterweight guide rail is supported by and adjacent to the wall (Brief, page 9). This argument is not persuasive for reasons discussed above with respect to the wall,

Appeal No. 2004-0906  
Application No. 09/571,896

and by the examiner's finding that the separate counterweight guide rail (9) is supported by and adjacent the single wall of the silo (Answer, page 3).

Appellants further argue that there is nothing in Bumgarner to suggest that the rails 2,9 support the beam 4 (Brief, page 10; Reply Brief, page 4). Appellants assert that the disclosure by Bumgarner that the rails 2,9 can be either cables or bars supports the conclusion that the beam supports the "rails" rather than the converse (*id.*). This argument is not persuasive since, as noted by the examiner (Answer, paragraph bridging pages 5-6), the beam 4 of Bumgarner extends beyond the side of the silo and is attached at its end to the bars 2, with the bars 2 supported at member 14, and therefore the beam is at least partially supported by the bars or rails 2 as required by claim 7 on appeal.

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of anticipation which has not been adequately rebutted by appellants. Therefore we affirm the examiner's rejection of claims 1, 3, 5-7 and 9 under section 102(b) over Bumgarner.

We also adopt the examiner's findings from Crispen (Answer, pages 3-4). Appellants argue that Crispen discloses a single

rail 3, not a pair of guide rails as required by claim 1 on appeal (Brief, page 8). This argument is not well taken since the examiner has pointed to the drawing of Crispen (Fig. 2) where the single rail 3 is constructed in two parts, with a rear wall 6 and a side wall 7, to form a channel formation which acts as the guide rail (Crispen, page 1, right column, ll. 21-24).

Even assuming that the rail 3 can be considered a pair of rails, appellants argue that there is no disclosure in Crispen that the rail 3 and/or the counterweight enclosure 5 are supported by a single wall, much less to a wall to which the alleged pair of rails is substantially parallel planar (Brief, page 8; Reply Brief, page 3). Appellants disagree that the post 4 can be considered a "wall" (Reply Brief, page 5). Appellants present similar arguments against the rejection of claim 7 (Brief, pages 11-12; Reply Brief, pages 4-5).

Appellants' arguments are not persuasive. Although Crispen discloses, as an example, that the post 4 is anchored to the floor of the building, it is clear from the drawings that the elevator rests along a stairway with the guide rail allowing the elevator car to reach the floor landing 21 (see Figure 1). Accordingly, to firmly anchor the elevator assembly at such heights, a skilled artisan would have known to attach the wood post at least partially

Appeal No. 2004-0906  
Application No. 09/571,896

to the stairway wall, thus allowing the artisan to be in possession of the invention as now claimed. See *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995) (a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention).

Appellants argue that Crispen fails to disclose or suggest that the paths of the elevator car and the counterweight are oriented laterally and parallel to one another along the single wall (Brief, page 8). This argument is not persuasive since Crispen clearly discloses that the path of the elevator car and the counterweight are oriented laterally (i.e., side by side) and parallel to one another along the stairway wall (see Figure 3 and the Answer, page 5, third and fourth full paragraphs).

For the foregoing reasons and those stated in the Answer, we determine that the examiner has established a *prima facie* case of anticipation which has not been adequately rebutted by appellants. Therefore we affirm the examiner's rejection of claims 1, 3, 5-7 and 9 under section 102(b) over Crispen.

*C. The Rejections under 35 U.S.C. § 103(a)*

We adopt the examiner's findings of fact from Crispen regarding the rejection of claim 10 (Answer, page 4). Since appellants have not separately argued the rejection of this claim (see the Brief and Reply Brief in their entirety), we summarily affirm the examiner's rejection.

With regard to the rejection of claims 4 and 8 under section 103(a) over Bumgarner or Crispen, the examiner concludes that substituting a steel core belt for the ropes shown by the references "would have been an obvious substitution of equivalents" (Answer, page 4). Appellants argue that the examiner offers no support for this assertion that coated steel belts were considered equivalent to elevator ropes (Brief, page 13; Reply Brief, page 6). We agree with appellants that, since the examiner has not offered any support for this assertion of equivalency, the examiner has not met the initial burden of establishing a *prima facie* case of obviousness. See *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-45 (Fed. Cir. 2002). Therefore we reverse the examiner's rejection of claims 4 and 8 under section 103(a) over Bumgarner or Crispen.<sup>3</sup>

---

<sup>3</sup>In the event of further or continuing prosecution before  
(continued...)

Appeal No. 2004-0906  
Application No. 09/571,896

*D. Summary*

The rejection of claims 1 and 3-10 under 35 U.S.C. § 112, ¶2, is affirmed. The rejections of claims 1, 3, 5-7 and 9 under 35 U.S.C. § 102(b) as anticipated by Bumgarner or Crispen are affirmed. The rejection of claim 10 under 35 U.S.C. § 103(a) over Crispen is affirmed.

The rejections of claims 4 and 8 under 35 U.S.C. § 103(a) over Bumgarner or Crispen are reversed.

The decision of the examiner is affirmed.

---

<sup>3</sup>(...continued)  
the examiner, the examiner and appellants should determine if there was evidence, before the date of appellants' invention, that elevator safety codes required the use of coated steel belts for elevator systems (see PCT/US00/22943 (of record), page 1, but published after appellants' filing date).

Appeal No. 2004-0906  
Application No. 09/571,896

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**AFFIRMED**

CHARLES F. WARREN	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	

TAW/jrg

Appeal No. 2004-0906  
Application No. 09/571,896

OTIS ELEVATOR COMPANY  
INTELLECTUAL PROPERTY DEPARTMENT  
10 FARM SPRINGS  
FARMINGTON, CT 06032