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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JENS BLUM, HEIKO ROEHM,
JOERG WELKE, and TOBIAS HERR

Appeal 2019-006594
Application 15/535,359
Technology Center 3700

Before EDWARD A. BROWN, WILLIAM A. CAPP, and
LEE L. STEPINA, *Administrative Patent Judges*.

Opinion for the Board filed by BROWN, *Administrative Patent Judge*

Opinion Concurring filed by CAPP, *Administrative Patent Judge*

BROWN, *Administrative Patent Judge*.

DECISION ON APPEAL

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–10 and 12–17. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Robert Bosch GmbH. Appeal Br. 2.

CLAIMED SUBJECT MATTER

Claim 1, reproduced below, is representative of the claimed subject matter:

1. A machine tool system, comprising:
at least one portable machine tool including:
at least one tool receptacle having a tool receiving face configured for attachment of a machining tool; and
at least one receiving interface;
at least one energy storage apparatus configured to be removably mounted to the at least one receiving interface of the at least one portable machine tool,
wherein, at least in a state when the at least one energy storage apparatus is arranged on the at least one receiving interface, at least 80% of a volume of the at least one energy storage apparatus is arranged within a boundary region that is defined by an outer extent of the tool receiving face extended in a direction perpendicular to the tool receiving face.

Appeal Br. 19 (Claims App.).

REJECTIONS ON APPEAL

Claims 1–10 and 12–16 are rejected under 35 U.S.C. § 102(a)(2) as anticipated by Kiss (US 2006/0068689 A1, published Mar. 30, 2006).

Claim 17 is rejected under 35 U.S.C. § 103 as unpatentable over Kiss.

ANALYSIS

Claims 1–10 and 12–16 as anticipated by Kiss

As to claim 1, the Examiner finds that Kiss discloses a grinding machine tool assembly (grinder 10) comprising a machine tool including a tool receptacle (vibrating bodies 20/22) having a tool receiving face

(grinding disk 18), a receiving interface (printed circuit board 33), and a removable energy storage unit (battery 26) received on the receiving interface. Final Act. 2. The Examiner explains that the “Kiss device is formed from two half shells 14, 16 that mate together and are kept together by screws [0044]. The battery is clearly removable when the shell halves are separated.” *Id.* at 4 (citing Kiss ¶ 44).

In contrast, Appellant contends that Kiss does not disclose an energy storage apparatus that is removably mounted to the receiving interface, as claimed. Appellant contends that the Examiner’s finding is based on an unreasonably broad interpretation of “removable” that is contrary to the interpretation that a person of ordinary skill in the art would reach. Appeal Br. 5–6. Appellant contends that the plain meaning of “removable” is “inclined or given to the action of being moved from a place or position occupied.” *Id.* at 7. Appellant also contends that persons skilled in the art of power tools would understand that a removable energy storage apparatus refers to one that is easily removed, without having to disassemble the power tool to charge or replace the energy storage apparatus. *Id.* Thus, Appellant contends, “a ‘removable energy storage apparatus’ is an energy storage apparatus that is removable (inclined or given to the action of being moved from a place or position occupied) from the power tool *without disassembling* the power tool.” *Id.* at 8.

Appellant contends that the Specification confirms the plain meaning of a removable energy storage apparatus. Appeal Br. 7. Particularly, Appellant points out the Specification describes that the energy storage apparatus is “arranged removably on the receiving interface of the portable machine tool” (citing Spec. 1:26–30, 15:6–11, 15:19–23), and “[t]he

receiving interface preferably includes at least one contact element that electrically connects to a counter-contact element of the energy storage apparatus” (citing *id.* at 3:31–4:2). *Id.*

Appellant further contends that the Examiner’s interpretation of a “removable energy storage apparatus” as encompassing Kiss’s batteries is unreasonable. Appeal Br. 8. Appellant points out that, in Kiss, “five screws (40–45) would need to be unscrewed to decouple the upper half shell (16) from the lower half shell (14), and then the two half-shells (16, 14) would be separated from one another to expose the batteries.” *Id.*

Further, Appellant contends, the Examiner has not established that Kiss’s battery would actually be removable even after separating the housing shells from each other. *Id.* at 9. Appellant contends that Kiss does not explicitly disclose such removability (*id.*), and the Examiner has not provided evidence that Kiss’s batteries are necessarily (i.e., inherently) removable when the housing is disassembled (*id.* at 10). To the contrary, Appellant contends, Kiss’s batteries do not appear to be removable. *Id.* First, Appellant notes that the batteries are “positionally secured, without play, and tensed in the upper region of the grip,” and are “integrated into the strength structure of the grip, and the battery increases the dimensional stability of the grip.” *Id.* (citing Kiss ¶ 18). Appellant submits that the Kiss’s batteries “are actually *necessary for the structural integrity of the grip*, and may in fact be fixed to the housing in such a way that they are not removable even with the housing disassembled.” *Id.* Second, Appellant contends that Kiss’s battery 26 is electrically connected, with fixed electrical connections, to an electronics unit 32 mounted on a printed circuit board 33. *Id.* (citing Kiss ¶ 46; *see* Kiss annotated Figure 1). Appellant contends that

because Kiss contemplates a battery that is rechargeable via the charging plug without removing the battery, there is no reason that the battery needs to be “easily removable.” *Id.* at 11 (citing Kiss ¶¶ 17, 46).

The Examiner responds that paragraphs 17 and 18 of Kiss do not describe that the battery is *not* removable. Ans. 5. The Examiner submits that “the battery [of Kiss] merely needs to be capable of being removed to anticipate the claim limitation,” and “[i]t is also reasonable, if not inherent, that the battery [of Kiss] is capable of being replaced when they cease to charge so that they can be replaced instead of throwing away the entire machine.” *Id.* The Examiner also disagrees that “removable means ‘without disassembling.’” *Id.*

Appellant’s position is more persuasive. As for the meaning of “removably mounted,” “[t]he correct inquiry in giving a claim term its broadest reasonable interpretation in light of the specification is . . . an interpretation that corresponds with what and how the inventor describes his invention in the specification, *i.e.*, an interpretation that is ‘consistent with the specification.’” *In re Smith Int’l, Inc.*, 871 F.3d 1375, 1382–83 (Fed. Cir. 2017) (citing *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997) (citation and internal quotation marks omitted)). Consistent with Appellant’s definition of “removably mounted,” Appellant’s Specification and drawings do not disclose that the claimed removable mounting arrangement of the energy storage apparatus on the receiving interface requires first disassembling any structure that fully encases the energy storage apparatus. In this regard, Figures 1 and 3 show the energy storage apparatus 18a as exposed, and thus, directly accessible externally of the machine tool assembly 10a (*i.e.*, from the right side of energy storage

apparatus). This arrangement of the energy storage apparatus 18 allows access to it without first disassembling the surrounding housing of the machine tool, as is required by Kiss's machine tool construction. Further as to the machine tool system depicted in Appellant's Figures 1 and 3, the Specification describes that the energy storage apparatus 18a is "arranged removably on the receiving interface of the portable machine tool." Appeal Br. 7. The arrangement of energy storage apparatus 18a shown in Figures 1 and 3 and described in the Specification is consistent with Appellant's position that the energy storage apparatus is removable from the receiving interface "without disassembling" the machine tool system. Appeal Br. 8.

In contrast to the arrangement of the energy storage apparatus disclosed by Appellant, to even potentially be able to access battery 16 in Kiss's arrangement, the half-shells 14, 16 must first be detached and separated from each other. *See* Kiss ¶ 44. Additionally, Appellant's disclosed removable mounting arrangement of the energy storage apparatus on the receiving interface does not involve severing electrical connections. Even assuming Kiss's battery 26 would be accessible after the half-shells have been separated from each other, the Examiner does not establish with evidence that battery 26 would then be capable of being removed without having to destroy electrical connections, for example. Construing the phrase "removably mounted" to encompass such separation that would destroy the claimed receiving interface and/or energy storage apparatus would be unreasonable, as it would be inconsistent with the disclosure and not give appropriate weight to the term "removably." *See, e.g., Stumbo v. Eastman Outdoors, Inc.*, 508 F.3d 1358, 1362 (Fed. Cir. 2007) (denouncing claim constructions that render claim language superfluous). The Examiner's

finding that battery 26 is removably mounted to the “receiving interface” is premised on speculation and not on evidence. Thus, the Examiner does not establish that Kiss discloses all limitations of claim 1 under a proper construction of “removably mounted.”

Furthermore, the Examiner has not asserted that modifying Kiss by making battery 26 removably mounted, as claimed, would have been obvious to a person of ordinary skill in the art.

For the foregoing reasons, we do not sustain the rejection of claim 1, and dependent claims 2–10 and 12–16, as anticipated by Kiss.

Claim 17 as unpatentable over Kiss

Claim 17 depends from claim 1. The Examiner’s proposed modification of Kiss to include the limitations recited in claim 17 does not cure the deficiency in Kiss as to claim 1. Final Act. 3–4. Accordingly, we do not sustain the rejection of claim 17 as unpatentable over Kiss.

DECISION SUMMARY

In summary:

Claim(s) Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–10, 12–16	102(a)(2)	Kiss		1–10, 12–16
17	103	Kiss		17
Overall Outcome				1–10, 12–17

REVERSED

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OPINION CONCURRING

CAPP, *Administrative Patent Judge*

I concur in the result reached by the majority. However, I write separately to offer my own personal comments regarding the battery in a hand-held tool being “removable.”

The last decade or so has witnessed a sea-change in how hand-held tools are powered. A generation ago, hand-held tools, in the main, received electrical power through a wire from a wall plug/socket arrangement or, in some cases, were powered by small, two-stroke gasoline engines. Now, however, with recent technological advances in batteries that have paved the way for hybrid vehicles and electric cars, our economy is seeing more and more hand-held tools that are powered by batteries. Some of these tools are for indoor use, such as sanders, drills, and saws, etc. Other hand-held tools are for outdoor use, such as leaf blowers, hedge clippers, and chain saws, etc. The batteries that tend to power this new generation of tools generally slide into a battery receptacle on the exterior housing of the tool and, when

the battery is discharged, it is slid out of the receptacle and then slid into a similar receptacle in a battery recharging unit that plugs into an electrical wall outlet.

This trend has changed the way we think when we think of a “removable battery.” A generation ago, we might have considered a car battery, flashlight battery, or smoke alarm battery to be “removable” in the sense that an enclosure or housing could be opened to gain access to a storage compartment that holds the battery and then the battery could be disconnected from battery terminals and then removed from the housing. Today, however, we might still consider such batteries to be “replaceable,” but not necessarily “removable” in the way that we now use the term in everyday parlance. I would add that this is not just a matter of the evolution of a “term of art” within the glossary of technical terms used by a person of ordinary skill in the art. Rather, it is matter of how even lay persons think of and use the term when they go to the hardware store to purchase a hand-held tool.

In my opinion, the Examiner has hearkened back to a by-gone era to construe “removable” in an archaic manner that should, in our more modern times, be considered inappropriate and overbroad. Under the broadest reasonable interpretation standard that we use during patent prosecution, claim terms are given their ordinary and customary meaning as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). Notably, it is the use of the words in the context of the written description and as customarily used by those of skill in the relevant art that accurately reflects both the ‘ordinary’ and ‘customary’ meaning of the terms

in the claims.” *Ferguson Beauregard/Logic Controls, Div. of Dover Res., Inc. v. Mega Sys., LLC*, 350 F.3d 1327, 1338 (Fed. Cir. 2003). Thus, construing the terms of a claim without considering the context in which those terms appear is not reasonable. *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1062 (Fed. Cir. 2016).

Here, the Examiner construes the word “removable” in a manner that is inconsistent with how such term is used and understood in the contemporary culture that surrounds the time of invention, whether by lay persons or those of ordinary skill. In this, the Examiner commits reversible error and, for the reasons expressed in the majority decision as augmented by the foregoing remarks, I am fully in accord with the decision to reverse the Examiner’s rejection.