

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FERNANDO FISCHBACH
and
ROSS I. STILLWAGON

Appeal No. 2000-0289
Application No. 08/753,542

ON BRIEF

Before ABRAMS, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 8 to 16. Claims 1 to 7 have been withdrawn from consideration under 37 CFR § 1.142(b) as being drawn to a nonelected invention. No claim has been canceled.

We AFFIRM-IN-PART.

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BACKGROUND

The appellants' invention relates to an implement for cutting and fusing synthetic, hair-like braids. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Caneavri 1923	1,465,838	Aug. 21,
Griffin et al. 10, 1925 (Griffin)	1,526,063	Feb.
Harvey 1934	1,957,589	May 8,

Claims 9 to 16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 8 to 10 and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Caneavri or Griffin.

Claims 11 to 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caneavri or Griffin in view of Harvey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed July 10, 1998) and the answer (Paper No. 15, mailed May 10, 1999) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 14, filed February 22, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

We sustain the rejection of claims 9 to 16 under 35 U.S.C. § 112, second paragraph.

In the final rejection (p. 1) and the answer (pp. 4-5), the examiner set forth his rationale as to why claims 9 to 16 were indefinite.

The appellants have not specifically contested this rejection in the brief. The only argument raised in the brief (p. 10) concerning this rejection relates to the examiner's refusal to enter the appellants' amendment after final (Paper No. 11). The examiner's refusal to enter that amendment relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review that issue. Since that appellants have not pointed out any error in the examiner's rejection of claims 9 to 16 as being indefinite, we summarily sustain the rejection of claims 9 to 16 under 35 U.S.C. § 112, second paragraph.

The anticipation issue

We will not sustain the rejection of claims 8 to 10 and 14 under 35 U.S.C. § 102(b).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

The appellants argue (brief, pp. 11-12) that both Caneavri and Griffin fail to disclose the claimed first and second blade members which each have "narrow, non-shearing flattened edges." We agree. In that regard, the term "narrow" must be given its broadest reasonable interpretation consistent with the specification. See In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). The American Heritage Dictionary, Second College Edition, (1982) defines "narrow" as "of small or slender width." As shown in Figure 2, for instance, the appellants disclose that flattened inner edges 34, 36 extend only a small distance from the bottom of

the blades 20, 22 toward the top of the blades. From this we conclude that the broadest reasonable interpretation of the term "narrow" as used in claim 8 consistent with the specification is that the flattened edges extend only a small portion of the distance between the top and bottom of the blades. Clearly the flattened edges disclosed in Caneavri (see e.g., Figure 5) and Griffin (see e.g., Figure 5) are not "narrow" flattened edges as required by claim 8.

Since all the limitations of claims 8 to 10 and 14 are not disclosed in either Caneavri or Griffin for the reasons set forth above, the decision of the examiner to reject claims 8 to 10 and 14 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejection

We will not sustain the rejection of 11 to 13 under 35 U.S.C. § 103.

We have reviewed the reference to Harvey but find nothing therein which makes up for the deficiencies of Caneavri and Griffin discussed above. That is, the combined teachings of

the applied prior art would not have suggested the claimed first and second blade members which each have "narrow, non-shearing flattened edges." Accordingly, we cannot sustain the examiner's rejection of appealed claim 11 to 13 under 35 U.S.C. § 103.

CONCLUSION

To summarize, the decision of the examiner to reject claims 9 to 16 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claims 8 to 10 and 14 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 11 to 13 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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