

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 13

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte MICHAEL ANTHONY DAVIES

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Appeal No. 2001-1493  
Application No. 09/109,016

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10-12, 14-17, 20, 21, 24<sup>1</sup> and 25. Claims 1-9, 22 and 23, the only other claims pending in this

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<sup>1</sup> We interpret the examiner's explanation of the status of amendments after final on page 2 of the answer as indicating that appellant's amendment to claim 24 filed June 14, 2000 (Paper No. 7) has been approved for entry by the examiner. We also note, however, that this amendment has not been clerically entered. Upon return of this application to the Technology Center, the examiner should take appropriate action to have the amendment entered.

application, stand withdrawn from further consideration under 37 CFR § 1.142(b) as being directed to a non-elected invention.

BACKGROUND

The appellant's invention relates to a punch for adapting oversized (e.g., legal sized) paper for storage in standard sized (e.g., letter sized) ring binders. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Yerkes	3,073,199	Jan. 15, 1963
Piazzè	3,274,869	Sep. 27, 1966
Szanto et al. (Szanto)	4,354,405	Oct. 19, 1982

The following rejections are before us for review.

- (1) Claim 10 stands rejected under 35 U.S.C. § 102(b) as being unpatentable over Yerkes.
- (2) Claims 12, 14, 15, 17, 20, 21, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yerkes in view of Szanto.
- (3) Claims 11 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yerkes in view of Szanto and Piazzè.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 11) for the examiner's complete reasoning in support of the rejections and to the brief (Paper No. 10) for the appellant's arguments thereagainst.

### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. After reviewing all of the evidence before us, we have determined that none of the examiner's rejections is sustainable. Our reasons for these determinations follow.

Claim 10 requires first and second punch out punch heads and corresponding punch out dies which in cooperation make punch outs in a sheet through which a ring of a ring binder can pass and at least one cutout punch head and corresponding cutout die which in cooperation form at least one cutout in a sheet, the punch out punch heads and cutout punch head being positioned in a substantially collinear orientation. In proceedings before it, the PTO applies to the verbiage of claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). In this case,

appellant has expressly set forth definitions on pages 5 and 6 of his specification which distinguish a “punch out” from a “cutout.” In particular, appellant’s specification informs us that a “punch out” is an area in a sheet of paper from which the paper has been removed so that a ring of a standard ring binder can pass therethrough to bind the sheet in a standard ring binder and that a “cutout” is an area in an oversized piece of paper from which the paper has been removed and can be any shape that extends to the edge of the paper that will be bound within a ring binder and allows a non-standard size portion of an oversized sheet of paper to be folded 90 degrees relative to the binding edge and unfolded without interference from a ring of a ring binder or without the necessity of opening a binder ring. As it is well established that an applicant can be his own lexicographer provided the applicant's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification (Beachcombers Int’l, Inc. v. WildeWood Creative Prods., Inc., 31 F.3d 1154, 1158, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994)), we must accept the above-mentioned definitions of “punch out” and “cutout” in interpreting appellant’s claims.

Yerkes discloses a hand punch having a plurality of head assemblies 25, each including a punch pin 27, adapted to form a plurality of round punch outs in a sheet of paper which are spaced from the binding edge of the sheet. The number of active head assemblies may be varied as desired so that the sheet may be perforated in selected patterns to fit various types of ring binders, pin files and the like (column 1, lines 7-12).

While we appreciate the examiner's position that Yerkes is thus not intended to be limited to a "standard three-hole puncher" (answer, page 4), we do not find in Yerkes any head assembly (cutout punch head and corresponding cutout die) which forms at least one "cutout" as that term is defined in appellant's specification and used in claim 10, as discussed *supra*.

Having determined that Yerkes does not disclose each and every element recited in appellant's claim 10, we conclude that the subject matter of claim 10 is not anticipated<sup>2</sup> by Yerkes. It follows that rejection (1) is not sustained.

Turning to rejection (2), we note that independent claim 15 requires three punch<sup>3</sup> heads and dies which form punch outs in a sheet thus enabling said sheet to be bound by the rings of a three ring binder and a cutout punch head and die which make a cutout in an oversize sheet and that independent claim 24<sup>4</sup> recites three punches which create punch outs in a sheet of material and a cutout punch which creates a cutout in the sheet of material. Claims 12 and 14 depend from claim 10, discussed *supra*, claims 17, 20 and 21 depend, either directly or indirectly, from claim 15, and claim 25 depends from claim 24.

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<sup>2</sup> Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

<sup>3</sup> The "punch out punch heads" referred to in the fourth paragraph of claim 15 lack strict antecedent basis. We presume that "said punch out punch heads" refer to the first outer, middle and second outer punch heads recited in the first paragraph of claim 15. However, the inconsistency in claim language is deserving of correction. Additionally, in the fifth paragraph of claim 15, "to" (second occurrence) should be deleted.

<sup>4</sup> In the seventh paragraph of claim 24, "body" should apparently be --handle--.

Yerkes, as discussed *supra*, fails to disclose a cutout punch or cutout punch head and die assembly which forms a “cutout” as that term is defined in appellant’s specification and used in the claims.

Szanto also does not disclose a punch having a cutout punch assembly which forms a “cutout” in a sheet of paper and, thus, does not cure the deficiency of Yerkes, noted *supra*. In this regard, we find error in the examiner’s determination that Szanto “teaches a fold line indicator punch head that forms a cut-out that acts as a gage, allowing the sheet to straddle a pin” (answer, page 3). There is no disclosure in Szanto that the slots 37a in the gage sheet 36 are formed by structure of Szanto’s punch. Rather, these slots are provided, along with a plurality of holes 37, in the gage sheet 36 used with Szanto’s punch to properly position the edge guide 18 (see column 3, lines 1-25). Szanto is silent with regard to how the gage sheet 36 is formed. Moreover, the slots 37a are not used as a fold line indicator as the examiner contends, but, rather, are used to straddle the pins 17 of the punch to accurately position the gage sheet 36, so that the edge guide 18 may be properly positioned by abutting the left edge of the gage sheet 36.

For the foregoing reasons, we conclude that the combined teachings of Yerkes and Szanto are insufficient to establish a *prima facie* case of obviousness of the subject matter of claims 12, 14, 15, 17, 20, 21, 24 and 25. Accordingly, rejection (2) is not sustained.

Finally, with regard to rejection (3), we note, at the outset, that the examiner’s statement that Yerkes fails to teach “a punch head that may encompass various shapes”

suggests that the examiner has misinterpreted claims 11 and 16. Claims 11 and 16 do not require a punch head that may encompass various shapes or even a plurality of interchangeable punch heads of various shapes. Rather, these claims limit the shape of the cutout to one of the seven shapes enumerated therein. In any event, we find no suggestion in the plastic bag punch apparatus of Piazza, which comprises punch members 54 for forming spindle receiving openings, such as openings 14, and punch members 53 for forming cutouts 18, for modifying any of the shapes of the punch pins 27 of the Yerkes punch. The cutouts 18 are formed in the plastic bags by Piazza's apparatus for the particular purpose of reducing the amount of material between the spindle receiving openings 14 and the edge of the bag so that the bag can be easily removed from the spindle by tearing. As the paper sheets perforated by the Yerkes punch apparatus are intended to be stored in ring binders or pin files and not to be carried on spindles and removed therefrom by tearing, an artisan would have found no incentive to provide the Yerkes punch with structure for forming such cutouts in the sheets of paper. Thus, the teachings of Piazza with respect to the cutouts 18 would not have commended themselves to such an artisan in designing the punch heads of the Yerkes punch.

As claims 11 and 16 depend from claims 10 and 15, respectively, and as the above-noted deficiency of the combination of Yerkes and Szanto finds no cure in the teachings of Piazza, for the reasons just discussed, the rejection of dependent claims 11

and 16 as unpatentable over Yerkes, Szanto and Piazze also must fail. Rejection (3) is not sustained.

CONCLUSION

To summarize, the decision of the examiner to reject claims 10-12, 14-17, 20 21, 24 and 25 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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