

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. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARK ODACHOWSKI

Appeal No. 2002-0713
Application No. 09/494,935

HEARD: OCTOBER 8, 2002

Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 39. These claims constitute all of the claims in the application.

Appellant's invention pertains to a retractable tape measure and to an improved method of constructing a retractable tape measure (means). A basic understanding of the invention can be derived from a reading of exemplary claims 1, 7, and 14,

Appeal No. 200-0713
Application No. 09/494,935

respective copies of which appear in the APPENDIX to the main substitute appeal brief (Paper No. 24).

As evidence of obviousness, the examiner has applied the documents listed below:

Anderson	1,986,551	Jan. 1, 1935
Knispel et al (Knispel)	5,210,956	May 18, 1993
Hoffman	5,894,677	Apr. 20, 1999

The following rejections are before us for review.

Claims 1 through 5, 7 through 9, 11, 12, 14 through 35, 37, and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Knispel.

Claims 6, 10, 13, 36, and 39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Anderson in view of Knispel, as applied to claims 5, 9, 12, 35, and 38, further in view of Hoffman.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the answer (Paper

Appeal No. 200-0713
Application No. 09/494,935

No. 25), while the complete statement of appellant's argument can be found in the main substitute appeal brief and the reply brief (Paper Nos. 24 and 26).

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellant's specification and claims, the applied teachings,¹ the first (Nov. 21, 2001) and supplemental (Dec. 27, 2001) declarations of John M. Winter, Jr., and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We cannot sustain the rejections of the claims on appeal under 35 U.S.C. § 103(a).

¹ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Appeal No. 200-0713
Application No. 09/494,935

Each of appellant's independent claims 1, 4, 7, 8, 11, 14, 15, 16, 17, 34 and 37 sets forth, inter alia, the feature of an end stop (means) "for maintaining" the upward turn of the edges of a retractable measuring tape (means); dual recitations of "for maintaining" appear in claims 14 and 15.²

Clearly akin to appellant's retractable tape measure, the direct measurement steel rule of Anderson (Figs. 1 and 2) provides gradations and numbers on both sides of a convex-concave rule member 10, with the edges of the concave face of the rule member being turned upward toward a side of the tape casing. However, Anderson lacks the end stop feature "for maintaining" the upward turn of the edges. Instead, Anderson specifically provides a lever 32' (with a hook 32) that can be swung sideways to enable direct inside readings to be taken of an object, while direct outside readings can be taken when the hook 32 itself engages the edge of the object to be measured. It is quite apparent to us that the swingable lever 32 of Anderson is an essential component of the steel rule since it allows the direct

² This feature forms the basis of a new ground of rejection under 35 U.S.C. § 112, first paragraph (lack of descriptive support), infra.

Appeal No. 200-0713
Application No. 09/494,935

measurement objectives of the patentee to be achieved as to the taking of outside or inside readings. With the above in mind, this panel of the board readily perceives that the applied respective teachings of Knispel (Figs. 2 and 3; pull tab or end stop maintaining concave tape shape) and Hoffman (Fig. 7; T-shaped tab or end stop with hook or finger portions 450b), each reflecting non-swingable end stops, would not have been suggestive of replacing the swingable lever 32 of Anderson since such a modification would clearly defeat the patentee's intended operation for the steel rule. For the above reasons, each of the obviousness rejections is not sound and cannot be sustained.

NEW GROUND OF REJECTION

In accordance with 37 CFR 1.196(b), this panel of the board introduces the following new ground of rejection.

Claims 1 through 39 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon an original disclosure which lacks descriptive support for the claimed invention.³ A review

³ That one skilled in the art might realize from reading a
(continued...)

Appeal No. 200-0713
Application No. 09/494,935

of appellant's specification, claims, and drawing, as originally filed, reveals to us a lack of any descriptive support for the recitation in each of independent claims 1, 4, 7, 8, 11, 14, 15, 16, 17, 34 and 37 of the feature of an end stop (means) "for maintaining" the upward turn of the edges of a retractable measuring tape (means); dual recitations of "for maintaining" appear in claims 14 and 15. Further, it is apparent to us that the claimed lock located "at least partially" on a side of a retractable tape measure housing in each of claims 16, 26 through 30, and 32 likewise lacks descriptive support in the originally filed disclosure, since the lock is only revealed to be entirely on the side of the housing in Fig. 6(a).

³(...continued)

disclosure that something is possible is not a sufficient indication to that person that the something is part of an appellant's invention. See In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1064 (1970). The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Appeal No. 200-0713
Application No. 09/494,935

In summary, this panel of the board has not sustained the obviousness rejections on appeal and has introduced a new ground of rejection under 37 CFR § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

Appeal No. 200-0713
Application No. 09/494,935

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR 1.196(b)

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

ICC:pgg

Appeal No. 200-0713
Application No. 09/494,935

LARRY J. GUFFEY
WORLD TRADE CENTER - SUITE 1800
401 EAST PRATT STREET
BALTIMORE, MD 21202