

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS M. LUEBKE

Appeal No. 2004-1168
Application 09/884,518

ON BRIEF

Before FLEMING, RUGGIERO and GROSS, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-16.

INVENTION

Appellant's invention relates to a subsurface object locator accessory device 12 for a hand drill 10 having a drill housing 14. See Appellant's specification, page 2, lines 22-24. The locator 12 includes an accessory housing 16 having a substantially flat surface and an attachment member 46 for detachably mounting the accessory housing 16 to the drill housing 14. The locator 12 has sensing circuitry contained within the accessory housing 16 for detecting a subsurface object 61, 62 and an object indicator 24 connected to the sensing circuitry for indicating the presence of the subsurface object 61, 62. See Appellant's specification, page 2, lines 24-31.

Claim 1 is representative of the claimed invention and is reproduced as follows:

A subsurface object locating accessory for use with a hand drill having a drill housing, the accessory comprising:

an accessory housing having a substantially flat surface for sliding across a wall surface and an attachment member for detachably mounting the accessory housing to the drill housing;

sensing circuitry contained within the accessory housing for detecting subsurface objects probed by said accessory; and

an object indicator connected to the sensing circuitry for indicating the presence of a subsurface object.

REFERENCES

The references relied on by Examiner are as follows:

Hibbard	4,797,040	Jan. 10, 1989
Hubscher	5,170,545	Dec. 15, 1992
Heger	5,352,974	Oct. 04, 1994

REJECTIONS AT ISSUE

Claims 1-6 stand rejected under 35 U.S.C. § 102 as being anticipated by Hubscher. Claims 1-16¹ stand rejected under 35 U.S.C. § 103 as being obvious over Hibbard in view of Heger.

OPINION

With full consideration being given to the subject matter on appeal, Examiner's rejections and the arguments of Appellant and Examiner, for the reasons stated *infra*, we affirm the Examiner's rejection of claims 1-6 under 35 U.S.C. § 102 and reverse the rejection of claims 1-16 under 35 U.S.C. § 103.

Rejection under 35 U.S.C. § 102

At the outset, we note that Appellant does not clarify whether claims 1-6 stand or fall together. See Appellant's statement "[n]o special grouping is required" on page 3 of the brief. Furthermore, we note that Appellant does not separately argue the patentability of claims 1-6. See pages 3-5 of the brief and the reply brief. 37 CFR § 1.192 (c)(7) (July 1, 2003) as amended at 62 Fed. Reg. 53196 (October 10, 1997), which was controlling at the time of Appellant's filing the brief, states:

For each ground of rejection which [A]ppellant contests and which applies to a group of two or more claims, the Board shall select a single claim from the group and shall decide the appeal as to the ground of rejection

¹ Page 3 of the answer states "[c]laims 1-11 are rejected under 35 U.S.C. 103(a) . . ." However, the Examiner sets forth the rejection of claims 12-16 in the last paragraph on page 4 of the answer. Therefore, claims 1-16 stand rejected under 35 U.S.C. 103(a).

on the basis of that claim alone unless a statement is included that the claims of the group do not stand or fall together and, in the argument under paragraph (c)(8) of this section, [A]ppellant explains why the claims of the group are believed to be separately patentable. Merely pointing out differences in what the claims cover is not an argument as to why the claims are separately patentable.

We will, thereby, consider Appellant's claims 1-6 as standing or falling together with respect to the rejection under 35 U.S.C. § 102. We will treat claim 1 as a representative claim of that group. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002) ("If the brief fails to meet either requirement [of 37 CFR § 1.192 (c)(7)], the Board is free to select a single claim from each group of claims subject to a common ground of rejection as representative of all claims in that group and to decide the appeal of that rejection based solely on the selected representative claim."). See also *In re Watts*, 354 F.3d 1362, 1367, 69 USPQ2d 1453, 1457 (Fed. Cir. 2004).

Anticipation of a claim under 35 U.S.C. § 102(b) requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) citing *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). In addition, our reviewing court states in *In re Zletz*, 893 F.2d 319, 321, 13 USPQ 1320, 1322 (Fed. Cir. 1989) that "claims must be interpreted as broadly as their terms reasonably allow." Our reviewing court further

states, “[t]he terms used in the claims bear a ‘heavy presumption’ that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Tex. Digital Sys. Inc. v. Telegenix Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 1058 (2003).

Appellant’s claim 1 recites “an accessory housing having a substantially flat surface for sliding across a wall surface and an attachment member for *detachably* mounting the accessory housing to the drill housing.” (emphasis added).

Appellant argues that Hubscher fails to teach the limitation “a substantially flat surface” as recited in Appellant’s claim 1. Appellant argues that the Examiner’s interpretation that Hubscher’s second end 15 is the substantially flat surface is erroneous since Hubscher’s specification does not describe so, and since the end 15 is shown only in one-dimensional cutaway side view, thus, it is impossible from the angle shown to determine whether the surface is flat. See pages 4 and 5 of the brief.

The Examiner responds that Hubscher shows a cross-section which is “flat” at least in the vertical direction, and moreover, Hubscher’s accessory is designed to cut holes in a flat wall, thus, a protruding surface at 15 on Hubscher’s accessory would only interfere in the operation of such a device. See page 5 of the answer.

We find that the housing 11 of Hubscher's adaptor 10 has a cylindrical cross section as seen in Fig. 2 or 3. Therefore, Hubscher's housing 11 is similar to the housing 13 of Ferris (US Patent No. 3,274,889) cited in column 1, line 12 of Hubscher. Consequently, Hubscher's housing 11 has a flat surface 15 or 13 at its end in the same manner as Ferris's flat surface 16 or 17. Therefore, the limitation "a substantially flat surface" in claim 1 is "read on" or "fully met" by Hubscher's substantially flat surface 15 or 13.

Appellant further argues that Hubscher fails to teach the functional limitation "for sliding across a wall surface" as recited in claim 1. Appellant argues that even if the end 15 were flat, it could not be slid along a wall surface as the saw blade 65 and associated coupling devices extending from the end 15 prevent the surface 15 from being positioned proximate the surface to be probed. See page 5 of the brief.

The Examiner responds that claim 1 does not positively require the claimed "accessory" is to be in contact with the wall. The Examiner further speculates that one could place Hubscher's surface 15 on the wall adjacent a corner where the blade 65 would pass around the corner of the wall to allow the surface 15 to slide along the wall. See page 5 of the answer.

We find that Hubscher teaches in column 3, lines 46-52:

In the use of the electronics, when the housing 11 is placed in *adjacency* with a wall surface and the switch 71 is closed, when metal is sensed such as, for example, a metal

electrical box hidden behind drywall, the indicator light 75 will illuminate so that the user will know where sawing operations are required. (Emphasis added).

As quoted above, Hubscher explicitly teaches one having ordinary skill in the art to place the housing 11 such that the housing 11 is touching or abutted with a wall surface. On the one hand, one can place Hubscher's surface 15 on a wall adjacent a corner where the blade 65 would pass around the corner of the wall and slide the surface 15 along the wall as the Examiner pointed out. On the other hand, one having ordinary skill in the art also can detach Hubscher's adaptor 10 off the screw gun shown in phantom in Fig. 1, then place the adaptor 10 in adjacency with the wall surface and slide the surface 13 along the wall surface. In this case, the surface 13 is free to slide on the wall surface. We note that Appellant's claim 1 does not preclude the detachment of the accessory from the hand drill as evidenced by the recitation "an attachment member for detachably mounting the accessory housing to the drill housing." Therefore, we find that Hubscher's surface 15 or 13 performs the functional limitation "for sliding across a wall surface" recited in claim 1.

Appellant further argues that Hubscher does not teach "an attachment member for detachably mounting the accessory housing to the drill housing" required by the claim. Appellant argues that the Examiner's reliance on the "elongated bore" 31 as the

attachment member is erroneous because the bore 31 is used to attach the adaptor to the tool bit, not to the screw gun. See page 5 of the brief.

We find that Hubscher's coupling mechanism 20 includes a series of stepped surfaces 21, 23, and 25, a generally frustoconical surface 29, and an elongated bore 31. These surfaces 21, 23, 25, 29 and 31 receive corresponding external surfaces on an existing screw gun shown in phantom in Fig. 1. See Hubscher, column 2, lines 28-41. Hubscher's chuck shown by dashed lines in phantom in Fig. 1 is a part of the drill housing because the chuck holds or protects the tool bit. Accordingly, Hubscher's coupling 21, 23, 25, 29, and 31 for detachably mounting the accessory housing 11 to the chuck of the drill reads on the limitation "an attachment member for detachably mounting the accessory housing to the drill housing" as recited in claim 1.

In summary, we find that Hubscher does teach each and every limitation recited in claim 1. Therefore, we will sustain the Examiner's rejection of independent claim 1.

Appellant has not made any other further argument as to claims 2-6. 37 CFR

§ 1.192(a) states:

Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be

accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which [A]ppellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

Thus, 37 CFR § 1.192(a) provides that only the arguments made by Appellant in the brief will be considered and that failure to make an argument constitutes a waiver on that particular point. Support for this rule has been demonstrated by our reviewing court in *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002), wherein the Federal Circuit Court stated that because the Appellant did not contest the merits of the rejections in his brief to the Federal Circuit court, the issue is waived. Our reviewing court has stated that the court has “frequently declined to hear arguments that the applicant failed to present to the Board.” *Watts*, 354 F.3d at 1367-68, 69 USPQ2d at 1457-58.

In the instant case, we have addressed Appellant’s arguments above as per claim 1 and Appellant has chosen to make no further argument as to claims 2-6. Applying the rule above, we will sustain the Examiner’s rejection of claim 1 and its dependent claims 2-6 under 35 U.S.C. §102 based on Hubscher.

Rejection under 35 U.S.C. §103

We now turn to the rejection under 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met, does the burden of coming forward with evidence or argument shift to Appellant. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788. An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. “In reviewing the [E]xaminer’s decision on appeal, the Board must necessarily weigh all of the evidence and argument.” *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. “[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.” *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

Returning to this case, Appellant argues that Hibbard teaches a strap receiving a cylindrical base in which drill bits are stored but does not teach a subsurface object

locator or stud finder. See page 7 of the brief. The Examiner responds that the use of a stud sensor and drill in combination is a matter of common knowledge and common sense of the person of ordinary skill in the art.

We find that Hibbard teaches an accessory for temporary storage and retrieval of drill paraphernalia comprising bits, screw bits, and an assortment of products made for drills. See Hibbard, column 1, lines 12-15. Hibbard's accessory comprises an accessory housing 1 and an attachment member 14-16 for detachably mounting to the drill housing 17 as seen in Fig. 4. However, Hibbard does not teach or suggest other accessories besides bits that would be used in the Hibbard's drill chuck. The Examiner has not provided any evidence as to why one of ordinary skill would have modified Hibbard's bit holding accessory to be able to hold other accessories such as the Heger's stud sensor. Without an objective teaching or suggestion of the combination of Hibbard and Heger, the Examiner has not satisfied the initial burden of establishing a *prima facie* case of obviousness. Therefore, we will not sustain the Examiner's rejection of claims 1-16 under 35 U.S.C. § 103.

In view of the foregoing, we have affirmed the Examiner's rejection of claims 1-6 under 35 U.S.C. § 102 and reversed the rejection of claims 1-16 under 35 U.S.C. § 103.

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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

MICHAEL R. FLEMING)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	APPEALS AND
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