

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte LAWRENCE O. BODDY

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Appeal No. 96-3022  
Application 08/278,012<sup>1</sup>

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ON BRIEF

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Before MEISTER, STAAB and McQUADE, Administrative Patent Judges.  
McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1 and 4 through 10.<sup>2</sup> Claims 12 and 13, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

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<sup>1</sup> Application for patent filed July 20, 1994.

<sup>2</sup> Claims 1, 4 and 10 have been amended subsequent to final rejection (see Paper No. 23).

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The subject matter on appeal relates to "interchangeable spinning machine tools which mount on a drill press" (specification, page 1). Claim 1 is illustrative and reads as follows:

1. An interchangeable spinning tool assembly comprising:
    - a spinning drive shaft having an axis of rotation and a distal end;
    - a spinning receiver having a horizontal surface and affixed to the spinning drive shaft at the distal end;
    - a machining tool holder;
- means for removably connecting the machining tool holder to the spinning receiver perpendicular to the axis of rotation, functioning to enable the removal of the machining tool holder without moving it distally from the distal end;
- said means for removably connecting the machining tool holder to the spinning receiver further comprising a dovetail assembly;
- said dove tail assembly further comprising a movably dovetail member and a stationary dovetail member mounted on the spinning receiver, and a matching slot on the machining tool holder functioning to secure both dovetail members; and
- said movable dovetail member being movable in a direction perpendicular to the horizontal surface of the spinning receiver, thereby self-centering the machining tool holder.

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The claims on appeal stand rejected as follows:

a) claims 1, 9 and 10 under 35 U.S.C. § 102(b) as reciting subject matter which was in public use or on sale in this country more than one year prior to the filing date of the instant application; and

b) claims 4 through 8 under 35 U.S.C. § 102(b), or in the alternative under 35 U.S.C. § 103, as reciting subject matter, or an obvious variation thereof, which was in public use or on sale in this country more than one year prior to the filing date of the instant application.<sup>3</sup>

In support of these rejections, the examiner relies on Disclosure Document No. 355,188, filed in the Patent and Trademark Office by the appellant, Lawrence O. Boddy, in May 1994, and on the 37 CFR § 1.132 declarations of the appellant and his son, Ronald L. Boddy, filed in the instant application on December 27, 1994 (Paper No. 7). According to the examiner, these items demonstrate "that Applicant and his son were

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<sup>3</sup> In the final rejection, claims 1 and 4 through 10 were also rejected under 35 U.S.C. § 112, second paragraph. The examiner has since withdrawn this rejection in view of the amendments made subsequent to final rejection (see the advisory action dated August 16, 1996, Paper No. 24).

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profiting financially from using the invention at least as early as October, 1989, which is over four years before the filing date of this application" (final rejection, Paper No. 9, pages 4 and 5). The examiner contends that "Applicant is not permitted to commercially exploit his invention for more than the one-year time period of 35 U.S.C. 102(b) and thus should not be permitted to receive a patent for the invention" (answer, Paper No. 31, page 6).

The appellant, on the other hand, submits that the activity described in the disclosure document and in the 37 CFR § 1.132 declarations does not constitute a public use or on sale bar within the meaning of 35 U.S.C. § 102(b) because it was conducted primarily for experimental purposes (see pages 4 through 7 in the brief, Paper No. 30). The appellant does not dispute that the device described in the disclosure document and in the 37 CFR § 1.132 declarations fully anticipates the claimed spinning tool assembly or would have rendered such assembly obvious by its addition to the prior art.

Issues arising under the "public use" and "on sale" bar provisions of 35 U.S.C. § 102(b) must be analyzed in light of the

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totality of the circumstances. In re Brigance, 792 F.2d 1103, 1107, 229 USPQ 988, 991 (Fed. Cir. 1986). If the use or sales activity in question was associated with primarily experimental procedures conducted during the course of completing the invention, a 35 U.S.C. § 102(b) bar does not vest. Baker Oil Tools, Inc. v. Geo Vann, Inc., 828 F.2d 1558, 1563, 4 USPQ2d 1210, 1213 (Fed. Cir. 1987). Determining whether the activity was primarily for purposes of experimentation or testing requires consideration of a variety of factors such as the necessity for the testing, the amount of control retained over the testing, the extent and length of the testing, whether any payment was made, whether there was a secrecy obligation, whether progress records were kept, who conducted the testing, and the degree of commercial exploitation during the testing. Baker Oil Tools, 828 F.2d at 1564, 4 USPQ2d at 1214.

It is apparent from the statements contained in the § 1.132 declarations that the appellant and his son used the subject device, at least to some degree, in connection with commercial activity. Thus, although the record does not indicate that the device itself was in public use or on sale, this distinction,

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which has not been raised by the appellant, would not appear to be of any consequence given the forfeiture principle set forth in D.L. Auld Co. v. Chroma Graphics Corp., 714 F.2d 1144, 219 USPQ 13 (Fed. Cir. 1983) citing Metallizing Eng'g Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516, 68 USPQ 54 (2d Cir. 1946). Nonetheless, the statements in the declarations pertaining to (1) the activity engaged in by the appellant and his son and (2) the relationship between the two indicate that the activity was primarily for the purpose of experimenting with and testing the subject device. Indeed, the examiner does not specifically dispute that the activity was primarily experimental in nature. Instead, the examiner appears to have focussed on the commercial aspect of the activity as if it were the sole dispositive consideration. As indicated above, however, the commercial aspect is but one factor which must be weighed and does not per se establish a 35 U.S.C. § 102(b) bar. Baker Oil Tools, 828 F.2d at 1564, 4 USPQ2d at 1214. Moreover, although the declarations do indicate that the activity in question did involve a commercial aspect, they do not support the examiner's speculative contention that the appellant and his son profited financially from the activity.

In light of the foregoing, we shall not sustain the standing

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35 U.S.C. § 102(b) rejection of claims 1 and 4 through 10 or the  
standing alternative 35 U.S.C. § 103 rejection of claims 4  
through 8.

The decision of the examiner is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
LAWRENCE J. STAAB	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
JOHN P. McQUADE	)	
Administrative Patent Judge	)	

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Rick Martin  
Patent Law Offices of Rick Martin  
609 Terry Street  
Longmont, CO 80501