

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN L. WOLD, LANCE L. HOOD and DENNIS M. TERENCE

Appeal No. 1999-0627
Application No. 08/688,991¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, ABRAMS
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 1 and 3 through 10, which are all of the claims pending in this application.

¹ Application for patent filed August 1, 1996.

Appeal No. 1999-0627
Application No. 08/688,991

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a hand-held utensil comprising a tool head and an elongated handle. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Nunn et al. (Nunn)	GB 2,274,615	Aug. 3, 1994
(British document)		

The following rejections are before us for review.

1. Claims 1 and 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nunn.
2. Claims 4 through 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nunn.

Reference is made to the brief (Paper No. 9) and the final rejection (Paper No. 6) and answer (Paper No. 10) for the respective positions of the appellants and the examiner with regard to the merits of these rejections.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, 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 anticipation rejection

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). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met

by the reference. 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 examiner's findings are explained on pages 2 and 3 of the answer, with reference to the examiner's marked-up copy of Nunn's Figure 2 attached to the answer. Specifically, the examiner has divided the Nunn handle into three sections and considers the sections labeled by the examiner as F, I and R to respond to the forward, intermediate and rear sections, respectively, recited in claim 1. The examiner finds that the rear section (R) is round in cross-section and has a larger cross-sectional area than that of the forward section (F) and that the intermediate section (I) is of smaller cross-sectional area than both the forward and rear sections and smoothly blended into the contours of each to create a stretched hourglass handle shape. The appellants do not contest these findings. The examiner further finds that: (1) the rear section (R) is "slightly bulbous" and (2) the forward and intermediate sections are aligned to establish a longitudinal axis aligned with a tool head and the rear section is slightly angled down from the axis, at the boss

(18b). With regard to claim 3, the examiner finds that the rear section tapers up (see left-side contour of the rear section R) from the intermediate section to a maximum diameter (D1)² and thereafter tapers down (see right-hand contour of the section R) to a rounded end (16).

The appellants argue:

Claim 1 recites that the rear section is slightly bulbous and angled slightly downwardly from a handle axis, and is of a length and diameter to be easily grasped between the palm of the hand and the middle, ring and little fingers.

The rear section could not be deemed the sharply angled end of the '615 patent, as it is too short and may not be grasped by these fingers. The combination of the tail end and the next handle section could also not reasonably be deemed a slight downwardly angled bulbous rear section.

Claim 3 further recites a tapering shape of the rear section, which again cannot be reasonably read on the tail end or the combined next and tail sections, since they do not gradually taper up and then down from a point adjacent the smaller intermediate section to the handle end [brief, page 5].

We interpret the appellants' reference to "the sharply angled end" and "tail" of Nunn to denote the downwardly

² The examiner's reference to a maximum diameter "(D2)" of the rear section on page 3 of the answer appears to be an inadvertent error.

extending protrusion disposed generally at the location of the boss (18b). As the examiner finds that a section (R) of the handle comprising both that "tail" and a portion of the handle located forwardly thereof respond to the rear section recited in claim 1, the appellants' first argument that the "tail" is not of a length and diameter to be easily grasped as claimed is not relevant and is thus not persuasive. The appellants do not assert that the section (R) of the handle, considered by the examiner to respond to the claimed rear section, has such a deficiency.

As to the appellants' argument that the section (R) of the handle "could not reasonably be deemed a slight downwardly angled bulbous rear section," we note that "bulbous" is defined as "of, shaped like, or having a bulb or bulbs" and that a "bulb" is a "rounded thing or enlarged part."³ Accordingly, it is not apparent to us why the rear section (R) could not reasonably be considered "slightly bulbous" as claimed.

³ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

Regarding the "slightly angled" limitation of claim 1, it is axiomatic that, in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification, and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983). Moreover, limitations are not to be read into the claims from the specification. In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993) citing In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

The term "angled" is defined as "moved or bent at an angle."⁴ From our viewpoint, the rear section (R) of the Nunn handle is bent or angled downwardly from a longitudinal axis aligned with the tang of a tool mounted on the handle to the downwardly protruding portion disposed around the boss (18b).

⁴ Webster's New World Dictionary, Third College Edition (Simon & Schuster, Inc. 1988).

Therefore, the rear section (R) of the handle, as interpreted by the examiner, appears to us to also be "slightly angled down from said longitudinal axis" as claimed.

For the foregoing reasons, we shall sustain the examiner's rejection of claim 1 under 35 U.S.C. § 102(b).

With regard to claim 3, we have considered the appellants' argument that the rear section (R) of the Nunn handle, as interpreted by the examiner, does not "gradually taper up and then down from a point adjacent the smaller intermediate section to the handle end" but we do not find it persuasive. As we see it, the rear section (R), as defined by the examiner in the marked-up copy of Nunn's Figure 2 appended to the answer, tapers up from a smaller diameter intermediate section (I) to a maximum diameter, labeled D1 by the examiner, and then tapers down (and angles downwardly) to a rounded end (16).

Accordingly, we shall also sustain the examiner's rejection of claim 3 under 35 U.S.C. § 102(b).

The obviousness rejection

The examiner concedes that Nunn fails to disclose the diameter of the rear section recited in claim 4, the inclined

angle as recited in claim 9 and the lengths of each section as recited in claim 8. However, it is the examiner's position that these dimensions would have been obvious, as "[a] change in size is generally recognized as being within the level of ordinary skill in the art" (final rejection, page 2). As to claim 5, the examiner implicitly concedes that Nunn lacks a chamfer on the hang hole of the utensil handle, but contends that it would have been obvious to form a hang hole with a chamfer on the Nunn handle for the purpose of storage. As to claims 6 and 7, the examiner asserts that the specific shapes of the forward and intermediate sections recited therein would have been obvious matters of design choice, "since applicant has not disclosed that the specific shapes of the forward, rear and intermediate sections solve any stated problem and it appears that one of ordinary skill in the art would find it obvious to form the handle in numerous configurations for the purpose of providing mating surfaces to accommodate a user's hand" (final rejection, pages 2 and 3). Finally, as to claim 10, the examiner's position is that kitchen utensils having a rectangular cross-section are well known and the provision of a hole (or cavity 13) in rectangular shape to fit the utensils

would have been an obvious matter of design choice (final rejection, page 3).

As to claims 4, 5 and 10, the appellants state that "admittedly these claims do not add further distinguishing features to claim 1" (brief, page 5). Accordingly, these claims are treated as falling with claim 1. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987). As discussed above, we have sustained the examiner's 35 U.S.C. § 102(b) rejection of claim 1 as being anticipated by Nunn. Thus, it follows that the examiner's rejection of claims 4, 5 and 10 under 35 U.S.C. § 103 as being unpatentable over Nunn is also sustained.

As to claims 8 and 9, the appellants have argued that the specific length of the rear section recited in claim 8 "cannot be read on the tail end of [Nunn]" and that "[t]he tail of the [handle] shown in [Nunn] clearly is much more sharply angled" than the 10 degree angle recited in claim 9 (brief, pages 5 and 6), but have not responded to the examiner's assertions on page 2 of the final rejection that the modification of Nunn to provide a rear section (R) having such a dimension and angle of inclination would have been obvious.

Accordingly, as the appellants have not offered any specific argument or evidence rebutting the examiner's finding of obviousness, we shall sustain the examiner's rejection of claims 8 and 9 under 35 U.S.C. § 103.

As to claims 6 and 7, the appellants argue that Nunn does not show or suggest the claimed cross sectional shapes and further asserts that these features create a thumb rest on the handle (brief, page 5). We do not agree with the examiner that the flattened sides and rounded rectangular cross sections of the forward and intermediate sections of the appellants' handle solve no stated problem. As noted, for example, on page 3 of the appellants' specification, the top of the forward section is "flattened for secure engagement with a user's thumb." Accordingly, we cannot agree with the examiner that the cross sectional shapes of the forward and intermediate sections can be dismissed as mere design choice within the skill of the art.

In making a rejection under 35 U.S.C. § 103, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or

hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967).

As the examiner has not provided any factual basis for the position that the claimed cross sectional shapes of the forward and intermediate sections would have been obvious to one of ordinary skill in the art to provide mating surfaces to accommodate a user's hand, it appears that the examiner's conclusion of obviousness is based on impermissible hindsight reconstruction.

Accordingly, we cannot sustain the examiner's rejection of claims 6 and 7.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 under 35 U.S.C. § 102(b) and claims 4 through 10 under 35 U.S.C. § 103 is affirmed as to claims 1, 3 through 5 and 8 through 10 but reversed as to claims 6 and 7.

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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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