

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PAUL F. CIRONE

Appeal No. 1999-2725
Application No. 08/763,087

ON BRIEF

Before ABRAMS, CRAWFORD, and GONZALES, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a method for collating tools (claims 1-5 and 11-15), and to a kit for collation of tools (claims 6-10). An understanding of the invention can be derived from a reading of exemplary claims 1 and 6, which appear in the appendix to the appellant's Brief.

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

Kupfer	5,079,978	Jan. 14, 1992
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Claims 1-5 and 10-15 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

Claims 6-9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kupfer.

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. 9) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 8) 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, the applied prior art reference, the respective positions articulated by the appellant and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

In this rejection, the examiner raises three issues. The first is that it is unclear what type of method is being claimed in that the steps include “a method of making a tool by applying indicia, a method of determining size by applying a tool to a workpiece, and a method of ‘collating’ or sorting by size of different tools” (Answer, page 3). Independent claims 1 and 11 clearly state that they are directed to “[a] method for [of] collating . . .

comprising the steps of.” This is followed in the body of the claim by the recitation of a number of steps, none of which can be categorized, in our view, as a separate method. The specification makes clear exactly what problem the invention solves, the method it utilizes to solve the problem, and what is encompassed by each of the steps. We do not share the examiner’s view that claims 1 and 11 would be indefinite to one of ordinary skill in the art.

The second issue raised by the examiner is that it is unclear how the method of determining the size of a tool is pertinent, since all of the tools of the same size are marked with the same indicia. It is clear from the specification that the step of “determining a correct fit,” as it is stated in claim 1, means determining which size wrench fits the nut or bolt on the workpiece for, once having done so, others of the selected tools of the same size can quickly be gathered by way of the matching indicia for that particular size. This step is not indefinite. The same can be said of the “comparing” step of claim 11.

The final issue is with regard to the limitation in claims 5, 10 and 15 that the indicia “is describable in verbal terms.” This is explained on page 9 of the specification. It does not mean that the wrenches “talk” to the user of the method, as the examiner has alluded, but that the indicia are elements that can verbally be described, such as the “blue plaid” example given in the specification. Indefiniteness does not exist here.

The rejection under 35 U.S.C. § 112, second paragraph, is not sustained.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See In re Paulsen, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994) and In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990).

Independent claim 6 is directed to a kit for collation of commonly sized tools. It stands rejected as being anticipated by Kupfer. This reference teaches using different indicators on wrenches in sets in order to indicate whether the set is of metric or English size and marking each wrench in a series of three wrenches so that the sizes can be differentiated. Colored vinyl or identifiable grooves are used to accomplish these purposes. Claim 6 requires that the kit comprise “at least two marking appliques,” which are cutout decorations applied to a larger article.¹ While Kupfer teaches marking the sets of wrenches, there is no disclosure or teaching of doing so by means of appliques, and therefore anticipation fails on this basis. The examiner has not responded to this issue, which was raised by the appellant on page 18 of the Brief. The rejection of claims 6-9 is not sustained.

¹See, for example, Merriam Webster’s Collegiate Dictionary, Tenth edition, 1996, page 57.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

JOHN F. GONZALES
Administrative Patent Judge

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Appeal No. 1999-2725
Application No. 08/763,087

Page 7

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