

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NEIL L. CURRIE

Appeal No. 2001-0308
Application No. 09/188,701

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 1-9, which are all of the claims pending in this application.

BACKGROUND

The appellant's invention relates to a Robertson driver for driving a screw (claims 1-3 and 5-9) and a method for manipulating a wire by use of a Robertson driver (claim 4). In particular, appellant's invention is the placement of a slot in the end of the tip of a Robertson driver, enabling a user to manipulate a wire (specification, page 5). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references of record in rejecting the appealed claims:

Sloan	173,356	Feb. 8, 1876
Foshee	2,195,773	Apr. 2, 1940
Wingert	4,257,159	Mar. 24, 1981
Frazier	4,485,852	Dec. 4, 1984
Wilner	5,353,667	Oct. 11, 1994

Additionally, this panel of the Board relied upon the following prior art in entering a new ground of rejection: The admitted prior art in appellant's specification on page 5, lines 12-18 (AAPA).

The following rejections are before us for review.

(1) Claim 9 stands 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 appellant regards as the invention.

(2) Claims 1, 2 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Foshee.

(3) Claims 1-3 and 5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Sloan.

(4) Claim 4 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Frazier.

(5) Claims 1-3 and 5-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wilner.

(6) Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wingert.

(7) Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sloan.

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. 11) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper Nos. 10 and 12) 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, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The indefiniteness rejection

The basis of the examiner's rejection of claim 9 under the second paragraph of 35 U.S.C. § 112 is that "the side of the wire" lacks antecedent basis. Appellant does not contest that "the side of the wire" lacks express antecedent basis but urges that a wire, which has a clear definition, inherently has a side and that it is thus unnecessary to provide antecedent basis (brief, page 8).

We agree with the appellant. The failure to provide explicit antecedent basis for terms does not always render a claim indefinite; if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Inter. 1992). In this instance, while the term "diameter," as used in claim 6 from which claim 9 depends, might have been preferable to the term "side" used in claim 9, a person of ordinary skill in the art would have understood the "side" of the wire to be the surface of the wire extending from the top to the bottom. Accordingly, it would have been apparent to such a

person that the straight vertical sides recited in claim 9 extend down a distance of more than half the diameter of the wire with which it is used.

In light of the foregoing, we conclude that the scope of claim 9 would be reasonably ascertainable by those skilled in the art and, thus, we shall not sustain rejection (1).

The anticipation rejections

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).

We note, at the outset, that the examiner has erred in according no patentable weight to the recitation of a "Robertson driver" in the preamble of claims 1-9 (answer, page 5). As pointed out in appellant's specification (pages 2 and 5), "Robertson" screws and drivers are terms of art in the hardware field which refer to screws having square holes in the heads thereof and drivers having square tips. While it is true that the claims in a patent application are to be given their broadest reasonable interpretation consistent with the specification during prosecution of a patent application (see, for example, In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)), it is also well settled that terms in a claim should be construed as those skilled in the art would construe them (see Specialty Composites v. Cabot Corp., 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and In re Johnson, 558 F.2d 1008, 1016, 194 USPQ 187, 194 (CCPA 1977)). Consistent with its understanding in the art, we construe the term "Robertson driver" as used in the claims on appeal as requiring a square tip.

None of the three references, Foshee, Sloan and Frazier, discloses a "Robertson driver," as required by claims 1-5. In particular, the tip of the mandrel 24 of Frazier's tool is quite clearly not square. As for the wire working tool of Foshee and the screw driver of Sloan, there is no clear indication that the

tip of either is square. The tip area of the bending arm 11 of Foshee appears to be rectangular, not square, in Figures 2 and 3 and Sloan depicts only one side of the blade A. Thus, we cannot reasonably conclude with any certainty that either Sloan or Foshee discloses a square tip, as required of a "Robertson driver." It is well established that an anticipation rejection cannot be predicated on an ambiguous reference. Rather, disclosures in a reference relied on to prove anticipation must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining their meaning. In re Turlay, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962).

For the foregoing reasons, we do not share the examiner's view that any of claims 1-5 is anticipated by Foshee, Sloan or Frazier and thus we shall not sustain rejections (2) through (4).

The obviousness rejections

The examiner's position in rejecting claims 6-9 as being unpatentable over Sloan is that it would have been obvious to one skilled in the art at the time of appellant's invention to provide a slot having a width as claimed to handle a particular screw/wire (answer, page 5). Be that as it may, this would still not transform Sloan's screw driver into a "Robertson driver" having a square tip, as discussed supra. Therefore, we shall not sustain rejection (7).

Neither Wilner nor Wingert discloses a "Robertson driver" as required by the claims. The examiner asserts that, to the extent that the tip of either Wilner (Figures 5-7) or Wingert (Figure 12) is not square, it would have been obvious to make the tip square to correspond with the configuration of a particular screw (answer, page 4). In the alternative, the examiner contends that it would have been obvious to provide a slotted tip on a Robertson driver in order to provide a tool that can drive screws and manipulate wire (answer, page 4).

It is well established that the mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this instance, we fail to perceive any teaching, suggestion or incentive in the applied references which would have motivated an artisan to modify the tip of either Wilner or Wingert to provide a square cross section or to provide a slot in a "Robertson" driver tip. Neither reference discloses a screw head having a square or "Robertson" hole or suggests the desirability of providing a "Robertson driver" with a slot as claimed. From our perspective, the only suggestion for modifying the references in the manner proposed by

the examiner is found in the luxury of hindsight accorded one who first viewed the appellant's disclosure. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). Accordingly, rejections (5) and (6) will not be sustained.

NEW GROUND OF REJECTION

Pursuant to our authority under 37 CFR § 1.196(b), we enter the following new rejection.

Claims 1, 2, 4 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Wingert.

As admitted by appellant on page 5 of the specification, in lines 12-18, it was well known at the time of appellant's invention for electricians to use a Robertson driver to manipulate 14 gauge ground wire around a grounding screw. Wingert teaches the provision of a pair of notches (slots) in the tip of a head of a screw driver to facilitate engagement of a wire for looping a wire around a screw 42 of a screw terminal 44. In view of the combined teachings of AAPA and Wingert, it would have been obvious to one skilled in the art to provide a notch or slot in the tip of a Robertson driver to permit an electrician to more easily manipulate 14 gauge ground wire around a grounding screw. Further, it follows that it would have been obvious for an electrician to use such a slotted Robertson driver in the

manner called for in claim 4 to manipulate the grounding wire as illustrated by Wingert in Figure 12. As for claims 2 and 8, it would have been obvious to one skilled in the art to provide the slot of a size slightly larger than a 14 gauge wire, or at least 1.7 mm, in order to accommodate the 14 gauge ground wire.

CONCLUSION

To summarize, none of the examiner's rejections is sustained. The decision of the examiner is reversed. A new rejection of claims 1, 2, 4 and 8 is entered pursuant to 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 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. . . .

(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)

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
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