

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT DEMARCO, ANTHONY YODICE
and WILLIAM J. HRUBES

Appeal No. 2001-1898
Application No. 08/835,945

ON BRIEF

Before CALVERT, ABRAMS and NASE, Administrative Patent Judges
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 47 to 57 and 59 to 62. The other claims remaining in the application, 63, 64 and 68 to 70, have been allowed.

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Appellants' invention involves a means for securing a parking meter housing, lamp fixture, coin or collection box or other electrical or mechanical device to a hollow post, pipe or conduit (specification, page 1). The claims on appeal are reproduced in the appendix of appellants' brief.¹

The references applied in the final rejection are:²

Fox	1,096,235	May 12, 1914
Guthrie	4,693,656	Sept. 15, 1987
Stenberg (French patent)	890,023	Oct. 25, 1943
Cure (French patent)	1,386,323	Dec. 14, 1964

An additional reference, applied herein in a rejection pursuant to 37 CFR § 1.196(b), is:

Snap-on Tools Corp. 1991-1992 Catalog, page 233.

The appealed claims stand finally rejected as follows:

- (1) Claims 55 and 56, unpatentable for failure to comply with 35 U.S.C. § 112, second paragraph;
- (2) Claims 47 to 56, anticipated under 35 U.S.C. § 102(b) by (i) Fox [and (ii) Guthrie;

¹ References herein to appellants' brief are to the brief filed on July 20, 2000 (Paper No. 25).

² Translations of the two cited French patents, prepared for the PTO, are forwarded to appellants herewith. References herein to these two patents are to the translations.

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(3) Claims 47, 49, 52, 54 and 55, anticipated by Cure, under 35 U.S.C. § 102(b);

(4) Claims 57 and 59 to 62, unpatentable over Stenberg in view of Fox, under 35 U.S.C. § 103(a).

Rejection (1)

Claim 55, and its parent claims 52 and 54, read:

52. A device for securing an object having a secured access to its interior to an end of a hollow post or pipe, comprising a bar capable of being transversely disposed in the hollow post or pipe and attachable to the object by a removable threaded fastener which has been passed through the secured access in the object and axially disposed in the hollow post or pipe, the bar capable of being further disposed so that its rotation is substantially impeded before it is attached by the fastener.

54. A device according to claim 52 wherein the bar is further comprised of a transverse bore to receive the fastener.

55. A device according to claim 54 wherein rotation of the bar is substantially impeded by a sleeve placed over the hollow post or pipe.

The examiner asserts that claim 55 (and claim 56 dependent thereon) are indefinite because, as we understand it, the scope of the claim is unclear in that it is not clear whether the sleeve is being claimed. Appellants contend that the scope of claim 55 is reasonably ascertainable, and that (brief, page 6):

Claims 55 and 56 recite that the "rotation of the bar is substantially impeded by a sleeve." This describes a bar which, if it is disposed in a post as described in claim 52, would not be able to rotate if a sleeve were to be placed over the post.

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The test for compliance with the second paragraph of § 112 is "whether a claim reasonably apprises those of skill in the art of its scope." In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). We do not consider that claims 55 and 56 meet this test. Claim 55 does not recite that rotation of the bar is substantially impeded when a sleeve is placed over the hollow part or pipe (as claim 49 does), but rather that such rotation is substantially impeded by a sleeve; contrary to appellants' argument, supra, this language seems to imply that a sleeve is present, i.e., is being claimed as part of the combination. On the other hand, parent claim 52 recites a device for securing an object to an end of a hollow post or pipe, which would seem to exclude the combination of the device with a sleeve. In view of this discrepancy, and the language of claim 55 itself, we do not consider that claim 55 reasonably apprises one of ordinary skill of its scope, in that it would not be clear to one of ordinary skill whether or not a sleeve was being claimed as part of the combination.

The case of In re Stencel, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987), cited in appellants' reply brief, does not mandate a contrary conclusion. Appellants argue that (reply brief, page 2):

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Appellants' claims 55 and 56 are analogous to the claim approved in Stencel, where the driver is claimed in terms of the structure of the collar in which it is intended to operate. As in Stencel and in Smith Corona,^[3] appellants have described their invention, the bar, in terms of its intended environment, a hollow post or pipe over which has been placed a sleeve. The claims are clear as written, without including the functional sleeve as an element of the claim.

This argument is not persuasive. We do not regard claim 55 as analogous to the claim in Stencel, because in claim 55 the bar is not claimed in terms of the sleeve, but rather it is recited that the bar's rotation "is substantially impeded by a sleeve." As discussed above, we do not consider that it is clear whether or not claims 55 and 56 are claiming a sleeve.

Rejection (1) therefore will be sustained.

Rejection (2)

"It is well settled that a claim is anticipated if each and every limitation is found either expressly or inherently in a single prior art reference." Celeritas Technologies, Ltd. v. Rockwell Int'l Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522 (Fed. Cir. 1998), cert. denied, 119 S.Ct. 874 (1999). However, the law of anticipation does not require that the reference "teach" what the subject matter of the application teaches,

³ Smith Corona Corp. v. Pelikan, Inc., 784 F.Supp. 452 (M.D. Tenn. 1992), aff'd mem., 1 F.3d 1252 (Fed. Cir. 1993).

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but only that the claims "read on" something disclosed in the reference. Id.

The Fox patent discloses a universal joint which includes a pin 10 positioned in a bore through fork 5. Another pin 12 passes through a bore in the center of pin 10, which is secured to fork arms 7 by set screws 14 in holes 16. The examiner takes the position that claims 47 to 56 are anticipated by Fox in that pin 10 corresponds to the bar recited in these claims. We do not agree. Independent claims 47 and 52 both require that the bar be "attachable to the object by a removable threaded fastener . . . axially disposed in the hollow post or pipe." Assuming that Fox's fork 5 might be considered the hollow post or pipe, and item 9 corresponds to the "object," it is not evident how the quoted "attachable" limitation is met, since there is no threaded fastener axially disposed in fork 5. While the object and the hollow post or pipe are not positively recited as part of the claimed apparatus, limitations concerning the relationship of the bar to them cannot be ignored. Cf. In re Attwood, 354 F.2d 365, 374, 148 USPQ 203, 210-11 (CCPA 1966) with In re Collier, 397 F.2d 1003, 1006, 158 USPQ 266, 268 (CCPA 1968).

We likewise do not consider that claims 47 and 52 are anticipated by Guthrie. While bar (element) 26 has an axial bore

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which receives a threaded shaft 16, the bar is not attachable to any object by the threaded shaft (fastener), as required by both of these claims.

Accordingly, we will not sustain rejection (2) as to claims 47 and 52, nor, it follows, as to claims 48 to 51 and 53 to 56, dependent thereon.

Rejection (3)

Cure discloses apparatus in which an object 1 is attached to the end of a hollow post 2 by a bar 4 which is transversely disposed in the post 2 by passing the entire length of the bar through an opening 3 in the side of the post, and a removable threaded fastener 6 which is axially disposed in the hollow post (as disclosed by Cure at page 8, lines 18 and 19, the screw 6 can be on the axis of the tube, and at page 11, lines 3 and 4, the threaded hole 5 can be in the middle of bar 4).

We conclude that claims 47 and 52 are anticipated by this disclosure of Cure. Appellants argue that the claims are not anticipated because Cure does not disclose that the fastener be accessible only through a secured port in the object, but the claims are not drawn to such a combination of elements. Claims 47 and 52 each recite that the object has "a secured access to its interior," and a fastener "which has been passed

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through the secured access in the object," but since these recitations concern, respectively, the structure of the object to be secured and the method by which the fastener is placed in position, rather than any structure, function or capability of the device being claimed, i.e., of the bar per se, they have no bearing on whether the claimed bar is readable on the apparatus disclosed by Cure.

We therefore will sustain rejection (3) as to claims 47 and 52, as well as to claims 49, 54 and 55, which appellants have not argued separately.

Rejection (4)

Claim 57 reads:

57. A device comprising a bar having a threaded transverse bore substantially perpendicular to a longitudinal axis of the bar, wherein at least a first end of the bar is cylindrically curved such that a radius of a curve of the first end is measured from a first axis substantially perpendicular to the longitudinal axis of the bar and wherein a second end of the bar is cylindrically curved such that a radius of a curve of the second end is measured from a second axis substantially perpendicular to the longitudinal axis of the bar.

Stenberg discloses in Figs. 1 and 2 a means of attaching a tool, such as a file 1, to a handle 2, in which a bar 6 having a threaded transverse bore is positioned in a hole through the handle, and the threaded tang 3 of the file is screwed into the bore (pages 2 and 3). The examiner acknowledges that Stenberg

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does not disclose that the bar 6 has "cylindrically curved" ends, as claimed, but takes the position that (answer, page 6):

Fox (US Patent 1,096,235), discussed above, teaches a similar device wherein the bar 10 having a transverse bore 11 for receiving a fastener 12 therethrough is provided with the cylindrically curved first and second ends (see Fig. III) for conforming to and flushing with the cylindrical outer surface of the member 7 to prevent snagging thereon.

Therefore, as evidenced by Fox, in the event a cylindrical handle is to be utilized, it would have been well within the purview and obvious to one of ordinary skill in the art at the time the invention was made to enhance the overall effectiveness of the device of [Stenberg] by providing the bar with the corresponding cylindrically curved first and second ends to conform to and flush with the outer surface of the cylindrical handle to prevent snagging thereon.

Appellants argue, first, that this rejection was improperly made for the first time in the final rejection. This question can be given no consideration by this Board, since it is not within our jurisdiction; rather, it is reviewable by petition under 37 CFR § 1.181. MPEP § 706.07(c); Ex parte Jackson, 1926 C.D. 102, 104 (Comr. 1924).

Appellants further argue that Stenberg and Fox are non-analogous art. As stated in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992):

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem

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addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.

According to appellants (brief, page 12), Stenberg and Fox do not meet these criteria:

The Steinberg [sic] patent is in the field of tool handles while the Fox patent is for a universal joint. Neither reference is within the field of the appellants' invention, i.e., that of providing a vandal-resistant connection device which secures a valuable object to the end of a hollow post or pipe. Both Steinberg [sic] and Fox are non-analogous art since they are clearly not within appellants' field of endeavor and are not reasonably pertinent to the particular problem with which appellants were involved.

We do not agree with appellants. In the first place, claims 57 to 62 are simply drawn to a bar, which is used as part of a connection device. Thus, the field of endeavor as far as the rejected claims are concerned is connection devices, and the first criterion of In re Clay is met. Moreover, Stenberg and Fox also both meet the second criterion in that they are both reasonably pertinent to the problem with which appellants are involved, namely, as the examiner states on page 12 of the answer, "coupling two axially disposed and interfitted members by a transverse bar."

Another argument made by appellants is that neither Stenberg nor Fox refers to snagging (brief, page 11). This may be correct

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insofar as Fox is concerned, but not as to Stenberg, which does disclose that since the ends of bar 6 "have shapes which join [sic] end surface of the handle 2, the shaft cannot injure the hand that grasps the handle" (page 3, last two lines).

On pages 11 to 12 of the brief, appellants argue that snagging is not relevant to their invention, and that the ends of their disclosed bar are curved for other reasons. This is not persuasive of unobviousness, however, because "[a]s long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor." In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

Nevertheless, we will not sustain rejection (4). As is evident from the above-quoted paragraphs from page 6 of the examiner's answer, the rejection is predicated on the assumption that "in the event a cylindrical handle is to be utilized," but the examiner has cited no reference which would have suggested to one of ordinary skill utilization of a cylindrical tool handle; Fox would not do so, since it relates to universal joints, not tool handles. The mere fact that the tool handle of Stenberg could be modified to be cylindrical does not make the

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modification obvious unless the desirability thereof was suggested by the prior art. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

Rejection Pursuant to 37 CFR § 1.196(b)

Pursuant to 37 CFR § 1.196(b), claims 57 and 59 to 62 are rejected under 35 U.S.C. § 103(a) as unpatentable over Stenberg in view of the Snap-on Catalog. Stenberg is discussed above in relation to rejection (4). The Snap-on Catalog at page 233 discloses, as item Q, a file handle which is cylindrical, with a 1" diameter. It would have been obvious to one of ordinary skill, in view of the Snap-on Catalog, to use a cylindrical shape for the file handle 2 of Stenberg, the Catalog suggesting that such a handle is desirable because it "[p]rovides a large, comfortable grip for all bastard cut files." With a cylindrical handle, the ends of the bar 6 of Stenberg would be made cylindrical so that they would "join" (conform to) the surface of the handle and not injure the user's hand, as disclosed at page 3, last two lines.

Conclusion

The examiner's decision to reject claims 55 and 56 under § 112, second paragraph, is affirmed; to reject claims 47 to 56 under § 102(b) is affirmed as to claims 47, 49, 52, 54 and 55,

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and reversed as to claims 48, 50, 51, 53 and 56; and to reject claims 57 and 59 to 62 under § 103(a) is reversed. Claims 57 and 59 to 62 are rejected pursuant to 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision. . . .

37 CFR § 1.196(b) also provides that the appellants, 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 (37 CFR § 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. . . .

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(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellants elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellants elect prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

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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; 37 CFR § 1.196(b)

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Administrative Patent Judge)	
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