

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEHEI KAGEYAMA, SHOUJI ANZAI and YOSHIHIDE MITSUYA

Appeal No. 2001-2353
Application No. 09/411,370

ON BRIEF

Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, all of the claims pending in the application.

Appellants' invention relates to a double-chuck mechanical pencil having an adapter (3) combined with the pencil's barrel (1) and lead tank (4) so that the back chuck (5) and front chuck (11) are able to slide axially within the barrel, but are restrained from rotation relative to the barrel and each other.

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The pencil also includes a restraining means (e.g., 3c, 13b), respectively provided on the adapter (3) and eraser support structure (17) to prevent rotation therebetween. A primary object of appellants' invention is to prevent the torsional breakage of a lead held by the front and back chucks, particularly when the eraser (E) is being used. In response to an election requirement set forth by the examiner in Paper No. 3 (mailed Dec. 30, 1999), appellants elected the species shown in Figure 11 of the drawings for prosecution in this application. A copy of claims 1 through 4 on appeal may be found in Appendix A of appellants' brief.

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

Torii	4,106,874	Aug. 15, 1978
Kageyama et al. (Kageyama)	5,683,191	Nov. 4, 1997

In making a provisional obviousness-type double patenting rejection of claims 1 through 4 in the final rejection (Paper No. 8), the examiner has additionally relied upon appellants'

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co-pending application No. 09/411,369, filed October 4, 1999.¹

Claim 1 stands provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of appellants' co-pending application No. 09/411,369.²

Claims 2 and 3 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 appellants regard as the invention.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kageyama.

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Torii.

¹ Appeal No. 2001-2361 in appellants' co-pending application No. 09/411,369 is being decided concurrently herewith.

² As indicated on page 4 of the examiner's answer, the provisional double patenting rejection of claims 2 through 4 "has been vacated in light of applicant's [sic] remarks in the Brief on Appeal, pp. 11-13."

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Rather than reiterate the details of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we refer to the final rejection (Paper No. 8, mailed October 17, 2000), the examiner's answer (Paper No. 13, mailed March 12, 2001) and to appellants' brief (Paper No. 12, filed March 2, 2001) and reply brief (Paper No. 14, filed May 1, 2001) for a full exposition thereof.

OPINION

After careful consideration of appellants' specification and claims, the teachings of the applied references and each of the arguments and comments advanced by appellants and the examiner, we have reached the determinations which follow.

Turning first to the examiner's provisional rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting, we observe that the examiner has not identified the differences between claim 1 of the present application and claims 1 through 3 of appellants' co-pending application No. 09/411,369, or provided reasons why any such differences

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would have been obvious to one of ordinary skill in the art at the time of appellants' invention. Instead, it appears that the examiner has merely asserted that claim 1 of the present application is not patentably distinct from claims 1 through 3 of the co-pending application, contending (final rejection, page 4) that

the broad limitations in the instant claims encompass the specific limitations of the same structure in the copending application, while the specific limitations in the copending claims anticipate the broad limitations of the same structure in the instant claims. If claim 1 of either application were allowable prior to allowance of the other claim 1, it would extend the right to exclude on both elements A and B identified above due to the overlap in scope.

Since the examiner has clearly not established a prima facie case of obviousness-type double patenting, we are constrained to reverse the examiner's rejection of claim 1 on that basis.

However, given that the examiner's comments above appear to relate to a nonstatutory double patenting rejection of the type made in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), we REMAND for the examiner to consider the guidelines set forth in MPEP § 804 (pages 800-26 to 800-28) regarding that type of rejection, and particularly to obtain proper authorization from

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the Technology Center (TC) Director if such a rejection were to be made in the present application. As an alternative, if the examiner is of the view that the original election requirement was, at least in-part, improper, then the examiner might wish to consider following the guidance in MPEP § 822 and, if appropriate, withdraw the requirement and require the conflicting applications to be joined. If a double patenting rejection is made or reimposed in the present application, the examiner also should provide a detailed explanation of why the protections afforded appellants by 35 U.S.C. § 121 are inapplicable. The examiner's mere assertion that the statute does not prohibit a double patenting rejection where the applications are claiming the same or substantially the same invention is of little value, especially given appellants' arguments in their brief (pages 9-13) and reply brief (pages 2-4).

Looking next to the examiner's rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph, the examiner asserts that the subject matter of these claims is specifically disclosed with respect to the species shown in Figure 10 and that the disclosure pertaining to the elected species of Figure 11 does not mention the "plurality of slits" of claim 2 or the engagement

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of the push cap (19) and the eraser support member as set forth in claim 3. Thus, the examiner concludes that because claims 2 and 3 are directed to a non-elected species, they cannot, by definition, read on the elected embodiment and are, therefore, indefinite.

A careful review of the specification appears to refute the examiner's assertion that the subject matter of claim 2 is limited to the embodiment of Figure 10. More particularly, page 18, lines 23-25, of the specification expressly state that the barrels (1) of the pencils "shown in Figs. 8, 9 and 11 may be provided in their back ends with recesses similar to the recesses 1b shown in Fig. 10." Thus, the embodiment of Figure 11 may be provided with such recesses or "slits" as they are termed in claim 2 on appeal. As for claim 3, we see no reason why this claim is not readable on the elected species of Figure 11 and the examiner has provided none. The push cap (19) seen in Fig. 11 is "detachably fitted in a rear portion of the support member" (17) and in order to prevent disengagement of the support member (17) and the adapter (3) each time the eraser is to be used, logic would dictate that the fit between the push cap and the support member would be looser than that between the support member and

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the adapter, as appellants have described in their specification.³

In light of the foregoing, we will not sustain the examiner's rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph.

Regarding the examiner's rejection of claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Kageyama, we find that we are in agreement with appellants' position as set forth in the brief and reply brief. According to the examiner, it would have been obvious for one of ordinary skill in the art to add a rear chuck to the mechanical pencil of Kageyama "in light of what applicant [sic] has admitted is prior art in this respect [i.e., in the specification, page 1, lines 10-12]" (answer, page 5). However, in our opinion, the mere fact that double-chuck mechanical pencils existed in the prior art provides no teaching,

³ We understand the requirement of the push cap being detachably fitted "in" a rear portion (claim 3) or "in" an upper portion (claim 4) of the support member, within the context of appellants' invention, to encompass the arrangement seen in Figures 8, 9, 10 and 11, wherein the cap is actually detachably fitted on the support member (17). Appellants may wish to clarify this aspect of their invention in any further prosecution of the application before the examiner.

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suggestion or incentive for the examiner's proposed modification of the single-chuck mechanical pencil of Kageyama. Nor does the fact that certain of the prior art double-chuck pencils included improvements to such pencils to reduce waste lead, as noted on page 1 of appellants' specification, provide any basis for modifying the single-chuck mechanical pencil of Kageyama in the manner urged by the examiner. Like appellants, we find that the examiner has failed to set forth a prima facie case of obviousness, and for that reason we will not sustain the rejection of claims 1 and 2 under 35 U.S.C. § 103 based on Kageyama.

The last of the examiner's rejections for our review is that of claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Torii. In this instance, the examiner contends, *inter alia*, that Torii discloses a double-chuck mechanical pencil having a front lead chuck (15) and a back lead chuck (7) connected to a lead tank (8). Appellants argue that the lead holding member (15) of Torii is not a chuck and clearly would not have been recognized as such by one of ordinary skill in the art. We agree with appellants and incorporate herein their arguments set forth in the brief (pages 17-23) and reply brief (pages 6-7) as our

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own. In that regard, it is clear to us that one of ordinary skill in the art would have understood that a "lead chuck" must actually clamp the lead and hold it in a fixed position during use of the pencil for writing, and that the member (15) of Torii performs no such function. Accordingly, the examiner's rejection of claims 1, 3 and 4 under 35 U.S.C. § 103 based on Torii will also not be sustained.

In summary:

The examiner's decision rejecting claim 1 under the judicially created doctrine of obviousness-type double patenting has not been sustained.

The examiner's decision rejecting claims 2 and 3 under 35 U.S.C. § 112, second paragraph, has likewise not been sustained.

In addition, the examiner's decision rejecting claims 1 and 2 under 35 U.S.C. § 103 as being unpatentable over Kageyama, and claims 1, 3 and 4 under 35 U.S.C. § 103 as being unpatentable over Torii have both been reversed.

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Thus, the decision of the examiner rejecting claims 1 through 4 of the present application is reversed.

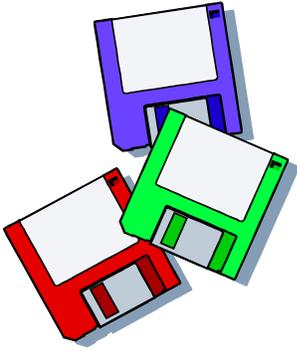
REVERSED & REMANDED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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DECISION: REVERSED & REMAND

Prepared: June 5, 2003

Draft Final

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