

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ARIEL KRASIK-GEIGER and MICHAEL KRASIK

Appeal No. 2001-2589
Application No. 09/072,911

ON BRIEF

Before ABRAMS, FRANKFORT, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-4, as amended after the final rejection, which are all of the claims pending in this application.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a device for cutting sheet material such as paper or cloth to a desired depth and angle. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

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

Herman	3,885,306	May 27, 1975
Go <u>et al.</u> (Go)	4,901,440	Feb. 20, 1990
Rotax (French Patent)	969,731	Dec. 26, 1950 ¹

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 the applicants regard as the invention.

Claims 1 and 2 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotax in view of Herman.

Claims 3 and 4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rotax in view of Herman and Go.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper No. 20) for the examiner's complete reasoning in support of the rejections, and

¹Our understanding of this reference has been obtained from a PTO translation, a copy of which is enclosed.

to the Substitute Brief (Paper No. 19) and Reply Brief (Paper No. 21) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, 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 Examiner's Refusal To Enter Amendments

In the course of the prosecution the appellants have attempted to amend the application by filing a substitute specification and a new drawing. Both were refused entry by the examiner, and the appellants urge that these decisions of the examiner are matters for review by the Board of Patent Appeals and Interferences in this appeal. However, as the examiner has pointed out, they are not, but are matters for petition under Rule 181. In this regard, our reviewing court long has been of the view that entry of an amendment is a discretionary action on the part of the examiner and, if discretion is abused, is remedied by petition to the Commissioner and not by appeal to the Board of Patent Appeals and Interferences. See, for example, In re Mindick and Reven, 371 F.2d 892, 894, 152 USPQ 566, 568 (CCPA 1967). We note also that the examiner has agreed to give favorable consideration to the entry of the substitute specification upon resolution of this appeal (Answer, page 6).

We therefore will not consider the matters listed by the appellants as issues 1 and 2 on page 4 of the Substitute Brief.

Claim 1

A device for cutting sheet material to a desired depth and angle, comprising:

a scissors having a rearwardly positioned handle and, forwardly positioned first and second blades defining a cutting plane and being pivotally connected together about a pivot point for arcuate movement; and

a planar angle mensuration device connected to the first blade substantially perpendicularly to the cutting plane so as to be substantially parallel to the sheet material to be cut, the angle mensuration device having a plurality of visible radial indications thereon having an origin positioned forwardly of the pivot point.

The Rejection Under Section 112, Second Paragraph

The examiner has rejected claims 2 and 3 as being “vague and indefinite” on the basis that it is not clear what the “means” refers to or where it is shown. We shall sustain this rejection.

Claim 2, which depends from claim 1, further defines the device for cutting sheet material as having “means for moving the angle mensuration device with respect to the first blade.” It is our opinion that structure allowing the mensuration device to be moved with respect to the blade cannot be seen in the drawing as originally filed, and the appellants have not directed us to where support for it is found in the original disclosure. Instead, they have based their arguments entirely upon the amended

specification and the amended drawings (Substitute Brief, page 8), which were refused entry by the examiner and therefore are not before us for consideration.

Further with regard to the proposed amendments, and particularly the “friction fit” mentioned on page 8 of the Supplemental Brief, we feel obliged to point out that failure to establish that the information sought to be added to the specification and drawings finds support in the original disclosure raises the specter that entry would present issues under the first paragraph of 35 U.S.C. § 112.

The Rejections Under Section 103

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Claim 1 stands rejected as being unpatentable over Rotax in view of Herman. The examiner finds that Rotax discloses all of the subject matter recited in claim 1 except for having “a plurality of visible radial indications” on the planar angle mensuration device. However, the examiner further finds that such a feature is taught by Herman, and concludes that it would have been obvious to add it to the Rotax device to facilitate reading the angle (Answer, page 4). The appellants present a number of arguments in opposition, including lack of recognition of the problem to which the appellants have directed their inventive efforts, lack of suggestion to combine the references in the manner proposed by the examiner, and failure of the teachings of the references, even if combined, to result in the claimed invention.

Rotax is directed to a cutter useful to cut moldings of the type used with electrical wires, with the stated objective being to “significantly increase the force exerted manually” upon the article to be cut (translation, page 1). The device comprises first and second spaced parallel arms (4 and 6-7) which are pivotally joined together (at 1), and are caused to operate by squeezing together a pair of handles (4 and 11). Attached to the end of the first arm is a support member (5) and to the end of the second a cutting blade (8). Force multiplication is provided by the manner in which the handle that operates the blade is attached to the arms that support the blade. In operation, the molding to be cut is placed between the support member and the blade, whereupon the handles are moved towards one another, causing the molding to be

squeezed between the surface of the support member and the blade and severed. The cutting blade is essentially parallel to the surface of the support member, and cutting is not accomplished by a pair of blades crossing through a cutting plane; the appellants have aptly described the device as a “chopper” (Reply Brief, page 4). In addition, attached to the first blade is a square (15) upon which a guide (13) having upstanding sides (see Figure 1) is mounted for rotation about an axis (14) by means of a knurled screw (16). The molding to be cut is held and oriented at the desired angle to the cutting blade by the guide. Owing to the fact that the blade spans the entire width of the guide and the presence of upstanding sides on the guide, it is clear that this device is not intended, in normal usage, to cut less than the full width of the molding. No mention is made in the reference that the device is intended to cut sheet material, much less sheet material such as paper or cloth, and there is no evidence from which to conclude that it is capable of cutting such. In fact, the device is described as usable “to replace the saw and miter box which is usually employed when cutting electric moldings” (translation, page 5).

From our perspective, and considering the arguments put forth by the appellants, Rotax is not responsive to the invention as recited in claim 1 in a number of ways. First, Rotax is not directed to a device for cutting sheet material, nor does it appear that it is capable of cutting sheet material. We base this conclusion on the fact that its cutting is accomplished by a single blade that presses the article to be cut against the surface of

the support member, an arrangement that in our view would not be conducive to cutting sheet material, particularly paper, cloth or the like. Further in this regard, it would appear that the upstanding sides of the guide (13) would inhibit insertion of sheet material into the cutting position in such a manner as to allow accurate alignment with the blade. Second, owing to the fact that the blade is longer than the guide is wide and the device is described as a substitute for a miter box, it certainly is not contemplated that the Rotax device cut less than the full width of an article, that is, to a “desired depth” in the context of this terminology as explained on page 1 of the appellants’ specification.² Third, considering that the common definition of “scissors” is “a cutting instrument having two blades whose cutting edges slide past each other”³ (emphasis added), Rotax fails to disclose “a scissors” as is required in line 2 of claim 1. Fourth, the claim requires that there be a “planar angle mensuration⁴ device,” that is, a device that measures a planar angle, and while the Rotax guide (13) is pivotable to align the article to be cut at an angle to the blade, it does not measure that angle and therefore, as disclosed, is not a mensuration device. Fifth, even if the guide and its support are

²Referring to the appellants’ specification, it is clear that the “depth” of the cut is intended to mean the distance from the edge of the sheet material to the end of the cut, and that “desired depth” is intended to mean a selected depth which can be short of the entirety..

³See, for example, Webster’s New Collegiate Dictionary, 1976, page 1035.

⁴The common definition of “mensuration” is the act of measuring. See, for example, Webster’s New Collegiate Dictionary, 1976, page 718.

considered to be a mensuration device, the “plurality of visual radial indications” required by claim 1 is not disclosed or taught.

In the specification, the appellants have described their invention as relating to the cutting of sheet material such as paper and cloth to a desired depth and at a desired angle. The result of the shortcomings in Rotax is that, as is argued by the appellants on pages 9 and 10 of the Substitute Brief and pages 3 and 4 of the Reply Brief, this reference does not recognize the problem solved by the appellants’ invention and does not provide structure that is capable of accomplishing the tasks to which the invention is directed.

Herman is directed to scissors which, for purposes of cutting hair at a desired angle to the horizontal, is provided with a gravity operated angle indicator in a housing (14) attached to one of the handle portions. Fluid in a U-shaped tube indicates the vertical orientation of the housing and, owing to the visible radial indications on the indicator, the scissors can be aligned to establish the desired hair cutting angle. To the extent it might be contended that the artisan would not, on the basis of common knowledge and common sense in the art, have recognized the advantage of providing a device used for making cuts with a visible indication of the angle to which the device is oriented with respect to the article being cut in order to insure that the angle of the cut is

accurate,⁵ it is our view that one of ordinary skill in the art would have been so taught by Herman.

However, even if the Rotax device were modified by providing visual radial indications on the guide or its support member, as proposed by the examiner, such would not overcome other shortcomings which we have set forth above. In particular, the modified Rotax cutter still would not be a scissors and, absent evidence to the contrary, would not be capable of cutting sheet material to a “desired depth.” This being the case, it is our conclusion that the evidence adduced by the examiner, that is, the combined teachings of Rotax and Herman, fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection. It follows that we also will not sustain the like Section 103 rejection of dependent claim 2.

Dependent claim 3 adds to claim 2 the requirement that the first blade have visual linear mensuration markings thereon for determining the depth of a desired cut in the sheet material. This claim stands rejected on the basis of Rotax and Herman, taken further with Go, which was cited for its teaching of providing one of the blades of a

⁵While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves; a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See In re Bozak, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Further, in an obviousness assessment, skill is presumed on the part of the artisan, rather than the lack thereof. In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

scissors with visual indicia indicating the depth of the cut. Be this as it may, Go does not overcome the deficiencies in the combination of Rotax and Herman. The Section 103 rejection of claim 3 therefore is not sustained.

Claim 4, also rejected on the basis of Rotax, Herman and Go, adds the same limitation to claim 1. This rejection is not sustained on the basis of the same reasoning as claim 3.

SUMMARY

The rejection of claims 2 and 3 under 35 U.S.C. § 112, second paragraph, is sustained.

The rejection of claims 1 and 2 under 35 U.S.C. § 103(a) as being unpatentable over Rotax in view of Herman is not sustained.

The rejection of claims 3 and 4 under 35 U.S.C. § 103(a) as being unpatentable over Rotax in view of Herman and Go is not sustained.

The decision of the examiner is affirmed-in-part.

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

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
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NEA/LBG

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RETURN TO LESLEY

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APJ BAHR

APJ FRANKFORT

DECISION: AFFIRMED-IN-PART

Prepared By: LESLEY GORDON

DRAFT TYPED: 04 Jun 03

FINAL TYPED: