

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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 MARCO E. DEVECCHIS and DANIEL M. EGGERT

Appeal No. 2002-1035
Application No. 09/333,166

HEARD: APRIL 16, 2003

Before FRANKFORT, STAAB 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 1-16. Appellants have withdrawn the appeal of the rejection of claim 15 (brief¹, page 1). Accordingly, this appeal involves only claims 1-14 and 16.

¹ All references to the brief in this decision are to the supplemental brief filed February 26, 2002 (Paper No. 15).

BACKGROUND

The appellants' invention relates to an insulating hand tool and a method of making an insulating hand tool. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Rosenburg	2,804,894	Sep. 3, 1957
Steiner et al. (Steiner)	5,105,648	Apr. 21, 1992
Markwart et al. (Markwart)	5,309,798	May 10, 1994
Habermehl et al. (Habermehl)	5,351,586	Oct. 4, 1994
Kruesi	5,359,911	Nov. 1, 1994
Gringer	5,638,727	Jun. 17, 1997
Pearson (UK patent specification)	1,251,419	Oct. 27, 1971

The following rejections are before us for review.

Claim 6 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that appellants, at the time the application was filed, had possession of the claimed invention.

Claims 1-6, 10 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Kruesi.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Kruesi and Pearson.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Kruesi and either Markwart or Habermehl.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Kruesi and Gringer.

Claims 11 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg in view of Kruesi and Steiner.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kruesi in view of Rosenberg.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kruesi in view of Rosenberg and Steiner.

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. 16) for the examiner's complete reasoning in support of the rejections and to the brief and reply brief (Paper No. 17) 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, to the Eggert declaration (Paper No. 8) 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 written description rejection

The examiner's basis for rejecting claim 6 under the first paragraph of 35 U.S.C. § 112 is that the application as originally filed did not provide written descriptive support

for the limitation in claim 6 “a maximum depth at least one-half of the radius.”

Appellants rely on the illustration in Figure 16 of the application for support for this claimed feature (see brief, pages 5-6 and Appendix B to the brief).

We initially observe that the description requirement found in the first paragraph of 35 U.S.C. § 112 is separate from the enablement requirement of that provision. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1560-64, 19 USPQ2d 1111, 1114-17 (Fed. Cir. 1991) and In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1238 (1978). As the court stated in Vas-Cath, 935 F.2d at 1563-64, 19 USPQ2d at 1117:

35 U.S.C. 112, first paragraph, requires a "written description of the invention" which is separate and distinct from the enablement requirement. The purpose of the "written description" requirement is broader than to merely explain how to "make and use"; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession **of the invention**. The invention is, for purposes of the "written description" inquiry, **whatever is now claimed**.

. . . drawings alone **may** be sufficient to provide the "written description of the invention" required by § 112, first paragraph.

In this case, while we agree with appellants that Figure 16 appears to illustrate a flute depth of greater than one-half the radius of the anchor portion, this illustration of a single ratio of the depth of the flutes to the radius of the anchor portion falling within the claimed range is insufficient to provide support for the **entire range** of “at least one-half of the radius” now recited in claim 6, which is an open-ended range from a minimum of

one-half ***on up*** (see, e.g., Quantum Corp. V. Rodime PLC, 65 F.3d 1577, 1581, 36 USPQ2d 1162, 1165 (Fed. Cir.1995) cert. denied, 116 S.Ct. 1567 (1996)). The claimed range includes ratios outside the scope of the single relationship disclosed in appellants' Figure 16 (see In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) and we find nothing in appellants' original disclosure which contemplates flute depths to anchor portion radius ratios outside of that illustrated and over the entire range now claimed.

For the foregoing reason, the examiner's rejection of claim 6 under the first paragraph of 35 U.S.C. § 112 is sustained.

The obviousness rejections

Each of appellants' independent claims 1, 13 and 16 calls for a shank and a working tip having a mounting portion having a radius and angularly spaced flutes each having a maximum radial depth which is a substantial portion of the radius of the mounting portion, the flutes being substantially filled with the material of the shank. In rejecting claims 1 and 16 as being unpatentable over Rosenberg in view of Kruesi and claim 13 as being unpatentable over Kruesi in view of Rosenberg, the examiner appears to concede that neither Rosenberg nor Kruesi discloses a working tip having flutes having a maximum depth which is a substantial portion of the radius of the mounting portion of the tip. The examiner's conclusion of obviousness of the subject matter of claims 1 and 16 relies in part on a determination that the radially outwardly extending blades or protrusions near the handle end of the blade 11 illustrated in

Rosenburg's Figure 1 would have suggested forming the depth of the flutes² of the knurling 16 of Rosenberg's tip member 12 as a substantial portion of the radius of the anchor portion of the tip member "to provide a more firm connection as inherently taught by figure 1 of Rosenberg" (answer, page 4). Likewise, the examiner's determination of obviousness of the subject matter of claim 13 depends in part upon a determination that it would have been obvious to one having ordinary skill in the art to form the device of Kruesi with angularly spaced flutes to mount the tip to the shank in an embedded manner as taught by Rosenberg in Figure 1 (answer, page 6) and further to form the radial depth of the flutes "as a substantial portion of the radius of the anchor portion to provide a more firm connection as inherently taught by Rosenberg" (answer, page 7). Even assuming that the spacings between what appear to be radially outwardly extending protrusions near the handle end of the blade 11 of Rosenberg's screw driver as illustrated in Figure 1 form flutes having a maximum radial depth which is a substantial portion of the radius of the blade, with the flutes being substantially filled with material of the handle, we find no suggestion therein to provide such deep flutes on either the tip member 12 of Rosenberg or the tip 14 of Kruesi.

Rosenburg discloses provision of knurling 16 or suitable roughening (column 2, lines 23-24) on the tip member 12 so that it will bite into the shank of the blade 11 as it is driven into the bore of the shank (column 1, lines 67-70). The illustration in Rosenberg's Figure 1 of what appear to be radial protrusions on the blade 11 as

² The examiner does take the position, on page 8 of the answer, that the knurling 16 on the tip member 12 of Rosenberg forms "shallow flutes" and appellants do not appear to dispute this position.

embedded within³ the handle 10 conveys an indication that the blade 11 is molded within the handle 10 rather than press-fitted or driven thereinto. Thus, it is not apparent to us why the formation of the handle end of the blade 11 would have provided any suggestion to one of ordinary skill in the art with regard to the formation of the tip member 12, which is to be driven into the working end of the blade 11, not molded therein. In any event, we find nothing in the teachings of Rosenberg or Kruesi which would have led one of ordinary skill in the art to apply the teachings with regard to the handle end of the blade to the tip member of Rosenberg's screw driver.

Kruesi's self-insulating composite tool is made by braiding reinforcing filaments F forming the tool shank 16 about the outer periphery of a mandrel 12 and the outer periphery of the tip shank 14B of a metal tip 14 followed by impregnation of the fibers with resin R and compression molding. The tip shank 14B has a polygonal profile. While Kruesi's tip shank could perhaps be formed with flutes having a substantial depth, we find nothing in either Kruesi or Rosenberg which would have suggested such a profile.⁴ 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).

³ The protrusions do not appear to extend longitudinally to the end of the handle.

⁴ In fact, such a profile would appear to render more difficult the step of braiding the filaments F forming the tool shank 16 about the tip shank 14B as disclosed by Kruesi.

For the foregoing reasons, we shall not sustain the examiner's obviousness rejections of claims 1 and 16 as unpatentable over Rosenberg in view of Kruesi and claim 13 as unpatentable over Kruesi in view of Rosenberg. It follows that we shall also not sustain the rejections of dependent claims 2-6 and 10 as unpatentable over Rosenberg in view of Kruesi.

The above-noted deficiencies of the combination of Rosenberg and Kruesi find no cure in the additional references applied by the examiner to reject the remaining claims. Thus, we also shall not sustain the examiner's rejections of claim 8 as unpatentable over Rosenberg in view of Kruesi and Pearson, claim 7 as unpatentable over Rosenberg in view of Kruesi and either Markwart or Habermehl, claim 9 as unpatentable over Rosenberg in view of Kruesi and Gringer, claims 11 and 12 as unpatentable over Rosenberg in view of Kruesi and Steiner and claim 14 as unpatentable over Kruesi in view of Rosenberg and Steiner.⁵

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-14 and 16 under 35 U.S.C. § 103 is reversed and the decision to reject claim 6 under 35 U.S.C. § 112, first paragraph, is affirmed.

⁵ In that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness of the subject matter of the appealed claims, it is unnecessary to discuss the Eggert declaration filed by appellants.

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

CHARLES E. FRANKFORT
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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