

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RICHARD J. SHAW and MARK R. SHAW

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Appeal No. 97-2483  
Application 08/575,830<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge, and  
FRANKFORT and NASE, Administrative Patent Judges.

McCANDLISH, Senior Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal from the examiner's final rejection of claims 1 through 8.<sup>2</sup> No other claims are pending in the application.

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<sup>1</sup> Application for patent filed December 20, 1995.

<sup>2</sup> Of all the amendments filed after the final rejection, only the last-filed amendment (filed September 17, 1996) involving only claims 4 and 8 has been entered. See page 2 of the examiner's answer.

Appeal No. 97-2483  
Application 08/575,830

Appellants' claimed invention relates to an automobile gas cap removal tool having a housing (3), channel-defining walls (4) in the housing, a handle (1) and a shaft (2) connecting the handle to the housing. According to the invention as disclosed in appellants' specification, a gas cap ridge 6 is received in a channel defined by walls 4 when the housing is placed over the gas cap to permit the user to turn the gas cap by grasping the handle.

A copy of claim 1, which is illustrative of the claimed subject matter, is appended to this decision.

The following references are relied upon by the examiner in support of his rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103:

Grote	3,186,263	Jun. 1, 1965
Rosenberg	5,439,338	Aug. 8, 1995

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Grote, and claims 2, 3 and 5 through 8

Appeal No. 97-2483  
Application 08/575,830

stand rejected under 35 U.S.C. § 103 as being unpatentable over Grote in view of Rosenberg. Claim 7 additionally 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 appellants regard as their invention.

Considering first the rejection of dependent claim 7 under the second paragraph of § 112, the examiner's difficulty with the claim language centers on the recitation in parent claim 2 that there are two channels in the tool housing and on the conflicting recitation in claim 7 that there is "at least one said channel" such that the language of claim 7 is broad enough to encompass a tool having just one channel.

Appellants' arguments traversing the examiner's rejection under the second paragraph of § 112 as set forth on page 8 of the brief are unpersuasive. In the first place, the amendments made to claim 7 after the final rejection were not entered by the examiner. Thus, contrary to appellants' contention, claim 7 was not amended in the manner stated.

Appeal No. 97-2483  
Application 08/575,830

With regard to the only other argument challenging the rejection under the second paragraph of § 112, the issue is not whether there is descriptive support for the subject matter of claim 7 in the original disclosure. Instead, the issue under the second paragraph of § 112 is whether claim 7 defines the metes and bounds of the invention with a reasonable degree of precision. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In the present case, it is not clear how the tool can be limited to two channels (parent claim 2) and yet have no more than one channel (dependent claim 7). The recitation in claim 2 that the tool "comprises two channels" and the recitation in claim 7 that the tool "comprises at least one said channel," and thus may have no more than one channel, simply amounts to a contradiction of terms. In short, it is not possible to have two channels, on the one hand, and yet have no more than one channel, on the other hand. Furthermore, dependent claim 7 cannot be viewed independently of claim 2 because, by statute, "[a] claim in dependent form shall be construed to incorporate by reference all of the limitations

Appeal No. 97-2483  
Application 08/575,830

of the claim to which it refers." 35 U.S.C. § 112, fourth paragraph.

For the foregoing reasons, claim 7 does not define the metes and bounds of the invention with a reasonable degree of precision as required in Venezia. We will therefore sustain the rejection of claim 7 under the second paragraph of § 112.

With regard to the § 102(b) rejection of claims 1 and 4, the only arguments supporting patentability of these claims as set forth on page 12 of brief are as follows:<sup>3</sup>

In view of above citations, the disclosure in the patent of Grote, should be compared to the claims 1 and 4 of this present application.

**TABLE 1**

<b>GROTE DISCLOSES (see G1 et seq.)</b>	<b>APPLICATION CLAIMS (CLAIMS 1 &amp; 4)</b>
Col. 1, lines 30-33; -tool	No resilient member

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<sup>3</sup> The shape of the housing recited in claim 1 has not been argued as a difference over the Grote patent. In any event, this limitation, when given its broadest reasonable interpretation, does not distinguish from Grote.

Appeal No. 97-2483  
Application 08/575,830

provides a **resilient** member forming a - - for receiving an automotive radiator cap having ears extending therefrom.

claimed or mentioned

No ears extending therefrom; ridge of gas cap fits in channel

No channel walls disclosed Col. 1, line 37 - skirt is flexible.

Channel walls claimed  
No flexible skirt.

No shaft connecting housing to handle.

Shaft connecting handle to housing.

Col. 2, line 56-57; - A handle 39 extends from the backing member 31 and is attached thereto by fasteners such as screws 40.

Handle attached to shaft

Appellants' first and third arguments regarding the absence of a "resilient member" and a "flexible skirt" in their claimed invention are without merit. By reciting that the tool comprises various elements, claims 1 and 4 are open to the inclusion of elements not recited in the claims. See In re Fenton, 451 F.2d 640, 642, 171 USPQ 693, 695 (CCPA 1971) and In re Hunter, 288 F.2d 930, 932, 129 USPQ 225, 226 (CCPA 1961). Consequently, claims 1 and 4 do not exclude the

presence of other elements such as a resilient member or a flexible skirt.

Appellants' second argument regarding the particular construction of the gas cap itself is also without merit. In the first place, claims 1 and 4 are directed to the removal tool per se and therefore are not limited to a particular gas cap construction. Furthermore, there is no recitation in claim 1 of any "channels." Instead, this claim merely calls for "channel walls."

Contrary to appellants' additional position, Grote's pockets 35 are in the form of two diametrically aligned, open ended channels which are delimited by structures in the form of walls to meet the limitation in claim 1 of "channel walls" and also the limitation in claim 4 of "said channels."<sup>4</sup> With further regard to claim 4, the recitation that a gas cap ridge is "more narrow" than the channels does not distinguish from

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<sup>4</sup> The recitation of "said channels" lacks antecedent basis. For reviewing the examiner's art rejection, we have interpreted claim 4 to mean that the channels are defined by the channel walls of claim 1.

Appeal No. 97-2483  
Application 08/575,830

Grote inasmuch as Grote's members 18, 19 define radially projecting ridges on the Grote's cap is a radiator cap periphery and are more narrow than Grote's channels.

Furthermore, the argument that the "ridge of [the] gas cap fits in channel [sic]" is equally unavailing inasmuch as neither claim 1 nor claim 4 recites that the gas cap ridge "fits" in one or more channels. In this regard, it is well established patent law that features not claimed may not be relied upon to support patentability. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982) and In re Richards, 187 F.2d 643, 644-45, 89 USPQ 64, 66 (CCPA 1951).

With regard to appellants' arguments about the shaft and the handle, our reviewing court stated in In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) that "[d]uring patent examination the pending claims must be interpreted as broadly as their terms reasonably allow." It also has been held that words in a claim are to be given their ordinary and accustomed meaning unless it appears that the inventor used them differently in his specification. Lantech,

Appeal No. 97-2483  
Application 08/575,830

Inc. v. Keip Machine Company, 32 F.3d 542, 546-47, 31 USPQ2d 1666, 1670 (Fed. Cir. 1994). See also In re Barr, 444 F.2d 588, 597, 170 USPQ 330, 339 (CCPA 1971).

According to its applicable, common ordinary meaning in Webster's Third New International Dictionary (G. & C. Merriam Company, 1971), the word "handle" is defined as "a part that is designed esp. to be grasped by the hand or that may be grasped by the hand." According to this dictionary authority, a shaft is "a long slender part." According to these definitions, the handle recited in claim 1 is broad enough to read on the free end portion of Grote's member 39, and the claimed shaft is broad enough to read on the portion of Grote's member 39 extending from the free end portion to the back of the housing 31. It is noted that neither claim 1 nor claim 4 requires the handle to be disposed at an angle with respect to the shaft in the manner shown in the application drawings. The claimed subject matter is therefore broad enough to read on Grote's structure.

Based on the foregoing analysis of the Grote patent, we

Appeal No. 97-2483  
Application 08/575,830

are satisfied that this reference meets all of the limitations in claims 1 and 4 to thus anticipate the subject matter of claims 1 and 4. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). We will therefore sustain the § 102(b) rejection of these claims.

We will also sustain the § 103 rejection of claims 5 and 6. Appellants' argument on page 17 of the brief that their invention lacks a flexible skirt akin to Grote's skirt 38 is without merit. Like claims 1 and 4, claims 5 and 6 do not exclude the presence of other elements such as a resilient member or a flexible skirt. Furthermore, appellants have not taken issue with the examiner's finding on page 7 of the answer that the properties of the claimed materials are known in the art. Therefore, the choice of any of these materials would have been prima facie obvious. See In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 567 (CCPA 1971).

Unlike claims 1 and 4, claims 2, 3 and 8 recite that the tool comprises two channels which cross at their centers.

Appeal No. 97-2483  
Application 08/575,830

Grote does not teach this feature. Furthermore, we cannot agree with the examiner that one of ordinary skill in the art would have been motivated by the teachings of Rosenberg to incorporate the crossing channels of Rosenberg into Grote's tool inasmuch as Grote's modified tool would then be incapable of removing a cap of the type shown in Grote's drawings. Accordingly, we will not sustain the § 103 rejection of claims 2, 3 and 8. In addition, we will not sustain the § 103 rejection of claim 7 since this claim is dependent on claim 2.

In summary, we have affirmed the rejection of claims 1 and 4 under § 102(b), we have affirmed the rejection of claims 5 and 6 under § 103, we have affirmed the rejection of claim 7 under the second paragraph of § 112, and we have reversed the rejection of claims 2, 3, 7 and 8 under § 103.

The examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR

Appeal No. 97-2483  
Application 08/575,830

§ 1.136(a).

**AFFIRMED-IN-PART**

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HARRISON E. McCANDLISH, Senior	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	APPEALS AND
	)	
	)	INTERFERENCES
	)	
JEFFREY V. NASE	)	
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Appeal No. 97-2483  
Application 08/575,830

**APPENDIX**

1. An automobile gas cap removal tool comprised of a handle and a bell shaped housing and a shaft connecting said handle to said housing and channel walls inside of said bell shaped housing and extending downward for a distance less than the height of said bell shaped housing.