

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KATHY L. NICOLOSI

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Appeal No. 97-2939  
Application No. 08/431,798<sup>1</sup>

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ON BRIEF

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Before THOMAS, HAIRSTON, and KRASS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed April 21, 1995. According to the appellant, this application is a continuation of Application No. 08/128,832, filed September 29, 1993, now abandoned; which is a continuation of Application No. 07/675,507, filed March 27, 1991, now abandoned.

This is a decision on appeal from the final rejection of claims 1 through 3, all of the claims remaining in the application. A prior decision regarding similar subject matter was rendered by this Board in grandparent application Serial No. 07/675, 507 on August 27, 1993.

The invention is directed to a percussion implement, viz., a drum stick.

Independent claim 1 is reproduced as follows:

1. A percussion implement, which comprises:

a bundle of a plurality of wooden outer rod members of a diameter of about 1/4 inches radially disposed about a centrally-disposed wooden inner rod member of a diameter of about 1/4 inches, each of said outer rod members being in contact with said centrally-disposed inner rod member and adjacent ones of said outer rod members along said bundle;

a hollow handle member positioned about an end of said bundle; and

a sleeve member positioned about said bundle and having an inner diameter dimensioned for axial movement on said bundle, said inner diameter of said sleeve member dimensioned to develop a frictional force with outer surface portions of said radially disposed outer rod members to prevent slippage of said sleeve member from said bundle in use of said percussion instrument, said sleeve member being movable along said bundle from said handle member to a distal end of said bundle for providing a different sound during usage of said percussion instrument selective positioning of said sleeve member about

said bundle, said distal end of said bundle being formed with a rounded configuration.

The examiner relies on the following references:

Cordes 1969	3,420,134	Jan. 7,
Pruitt 1986	4,570,527	Feb. 18,
Liedtke et al. (Liedtke) 27, 1986	4,590,839	May

Claims 1 through 3 stand rejected under 35 U.S.C. 103 as unpatentable over Liedtke in view of Pruitt.

Reference is made to the briefs and answer for the respective positions of appellant and the examiner.

OPINION

We reverse.

At the outset, we note that the final rejection contained a rejection against claims 1 through 3 under 35 U.S.C. 103 based on a combination of Liedtke, Stromberg and Pruitt. However, the examiner has not repeated this rejection in the

answer. Accordingly, the rejection of claims 1 through 3 under 35 U.S.C. 103, based on Liedtke, Stromberg and Pruitt, is not before us and we make no decision as to its propriety. The presence or absence of a rejection is not dependent on whether or not it is argued by appellant but, rather, whether the examiner maintains the rejection in the answer.

We now turn to the rejection that is before us, that is, the rejection of claims 1 through 3 under 35 U.S.C. 103 over Liedtke and Pruitt.

While we sustained the rejection of the claims in our earlier decision based on these same references, the claims of the instant case are not the same as the previous claims. The instant claims are of narrower scope.

Instant claim 1 specifies that the plurality of rod members are "wooden" with "a diameter of about 1/4 inches" and that "each of said outer rod members being in contact with said centrally-disposed inner rod member and adjacent ones of said outer rod members..." Instant claim 1 also more specifically

defines the sleeve member as being "dimensioned to develop a frictional force with outer surface portions..."

With regard to the rod members being "wooden," it is clear that Pruitt teaches rod members of such material and suggests that these rods would replace those of the wire type, such as taught by Liedtke. Accordingly, we still think the artisan would have found it obvious to provide Liedtke with wooden rod members in place of the wire members. With regard to the dimension of the rods, i.e., a diameter of "about 1/4 inches," we agree with the examiner that Pruitt's teaching of a range of diameters from "0.100" to "0.187" inches suggests a diameter of "about 1/4 inches" since the upper range of Pruitt's diameter and 0.25 inches differ by only 0.063 inches, well within a reasonable meaning ascribed to "about."

With regard to the "frictional force," we find the examiner's argument of inherency to be not unreasonable since Liedtke clearly discloses a sleeve, 6, which serves a similar purpose to the sleeve of appellant and if there was not sufficient frictional force in Liedtke (as modified by Pruitt

to include wooden rods), between the rods and the sleeve, the sleeve would slip during the use of the percussion implement, making it less than desirable for its intended use.

In any event, we will not sustain the rejection of claims 1 through 3 because claim 1 calls for "each of said outer rod members being in contact with said centrally-disposed inner rod member and adjacent ones of said outer rod members..." This recitation is clearly descriptive of appellant's Figure 2. If one were to take a cross-section of the rods in Liedtke, no such structure would result.

The examiner cites language from our earlier decision, at page 9 of the answer. While the citations are accurate, we find no relevance of that language in our previous decision to the instant claim language. We still contend that the wire bristles of Liedtke are "rod members" and that the wire bristles having the middle pellet on the upper row constitute a "centrally-disposed inner rod member" about which a plurality of rod members are disposed. However, the language of claim 1 now before us requires that *each* of the outer rod members be in

contact with *the* centrally-disposed inner rod member *and* adjacent ones of the outer rod members. This is not true in the Liedtke device. This language would also not be met by Pruitt. Pruitt shows, in Figure 2, a cross-section of the wooden rods but it is not seen that if the rods of Figure 2 were forced together by application of a sleeve pushed distally from the handle 12 that the language of instant claim 1 would be met. Rather, it would appear that Pruitt's device would, at best, result in three centrally-disposed inner rod members surrounded by six outer members. While the six outer members might be in contact with adjacent ones of the outer members, each of them would not also be in contact with the same, single "centrally-disposed inner rod member," as required by instant claim 1.

Since independent claim 1 recites structure which is neither disclosed nor suggested by the applied references or any combination thereof, we will not sustain the rejection of claim 1, or of claims 2 and 3 which depend therefrom, under 35 U.S.C. 103.

We also note that the examiner appears to rely, to some extent, on a U.S. Patent reference to Cordes. However, the statement of the rejection does not include Cordes and we will not consider this reference. Where a reference is relied on to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

The examiner's decision rejecting claims 1 through 3 under  
35 U.S.C. 103 over Liedtke in view of Pruitt is reversed.

REVERSED

JAMES D. THOMAS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
KENNETH W. HAIRSTON	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ERROL A. KRASS	)	
Administrative Patent Judge	)	

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