

**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(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** THOMAS S. PILCHOWSKI

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Appeal No. 98-0584  
Application 08/238,948<sup>1</sup>

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ON BRIEF

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Before MEISTER, ABRAMS and CRAWFORD, **Administrative Patent Judges.**

MEISTER, **Administrative Patent Judge.**

**DECISION ON APPEAL**

Thomas S. Pilochowski (the appellant) appeals from the final rejection of claims 1-39, the only claims present in the application.<sup>2</sup>

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<sup>1</sup> Application for patent filed May 6, 1994.

<sup>2</sup> Claims 4 and 39 have been amended subsequent to final

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We REVERSE and, pursuant to our authority under the provisions of 37 CFR § 1.196(b), we will enter new rejections of claims 4, 13, 17, 28 and 35 under 35 U.S.C. § 112, first and second paragraphs, and claims 1, 2, 6, 7, 32, 33 and 37 under 35 U.S.C. § 103.

The appellant's invention pertains to a power tool safety device for a power tool and to a power tool having such a safety device. Independent claims 1 and 32 are further illustrative of the appealed subject matter and copies thereof may be found in APPENDIX A of the brief.

The prior art relied on by the examiner is:

Lieber 1977	4,060,160	Nov. 29,
Hewitt 1993	5,181,447	Jan. 26,

Delta Instruction Manual, "10" Tilting Arbor Unisaw", Part No. 422-04-651-0024, ppg. 1-30 (Feb. 1990)

The claims on appeal stand rejected in the following manner.<sup>3</sup>

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rejection.

<sup>3</sup> Page 3 of the answer states that the final rejection of claim 39 under 35 U.S.C. § 112, first paragraph, is withdrawn.

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Claims 1-25, 27, 28 and 31-39 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 appellant regards as the invention.

Claims 1, 5-7, 14, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hewitt.

Claims 1-39 as being unpatentable over the Delta instruction manual in view of Hewitt and Lieber.

The rejections are explained on pages 2-9 of the Office action mailed on August 28, 1996 (Paper No. 11). The arguments of the appellant and examiner in support of their respective positions may be found on pages 8-23 of the brief, pages 3-12 of the reply brief and pages 4-26 of the answer.

#### **OPINION**

Considering first the rejection of claims 1-25, 27, 28 and 31-39 under 35 U.S.C. § 112, second paragraph, the examiner on pages 2-5 of Paper No. 11 and pages 3-6 of the answer sets forth a very lengthy list of recitations appearing in the claims which purportedly renders them indefinite. Having carefully reviewed each recitation identified in the

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lengthy list (including those not specifically mentioned below), we will not support the examiner's position.

The legal standard for indefiniteness is whether a claim **reasonably** apprises those of skill in the art of its scope.

**In re Warmerdam**, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed.

Cir. 1994). A degree of **reasonableness** is necessary. As the court stated in **In re Moore**, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971), the determination of whether the claims of an application satisfy the requirements of the second paragraph of § 112 is

merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a **reasonable** degree of precision and particularity. It is here where the definiteness of language employed must be analyzed -- not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. [Emphasis added; footnote omitted.]

In other words, there is only one basic ground for rejecting a claim under the second paragraph of § 112 as being indefinite,

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namely, the language employed does not set out and circumscribe a particular area sought to be covered with a **reasonable** degree of precision and certainty when read in light of the specification.

Most of the examiner's criticisms are based on the view that the "structural relationships" or "structural cooperation" of various elements is unclear. For example, on page 3 of Paper No. 11 the examiner inquires "[w]here is the proximity detector in relation to the rest of the apparatus?" and questions whether "working surface" refers to the table or insert. Such criticisms, however, **all** go to the breadth of the structure set forth, and just because a claim is broad does not mean that it is indefinite. **See In re Johnson**, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977); **In re Miller**, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971); **In re Gardner**, 427 F.2d 786, 788, 166 USPQ 138, 140 (CCPA 1970) and **Ex parte Scherberich**, 201 USPQ 397, 398 (Bd. App. 1977). Apparently, the examiner has analyzed the various recitations that have been criticized

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in light of the appellants' disclosure and then decided what specific elements should be recited. Such an approach is improper. As explained by the court in *In re Steppan*, 394 F.2d 1013, 1019, 156 USPQ 143, 148 (CCPA 1967):

The problem, in essence, is thus one of determining who shall decide how best to state what the invention *is*. By statute, 35 U.S.C. 112, Congress has placed no limitations on *how* an applicant claims *his invention*, so long as the specification concludes with claims which particularly point out and distinctly claim that invention.

On page 5 of Paper No. 11, the examiner states that "coupled to respond" and "being connected to enable" are not positive statements of structural cooperation of the relevant elements. While such statements are functional in nature, we must point out that there is nothing wrong in describing the recited elements in

terms of the function that they perform. As the court in *In re Swinehart*, 439 F.2d 210, 213, 169 USPQ 226, 229 (CCPA 1971) stated:

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there is no support, either in the actual holdings of prior cases or in the statute, for the proposition, put forward here, that "functional" language, in and of itself, renders a claim improper [under 35 U.S.C. 112, second paragraph].

See also *In re Hallman*, 655 F.2d 212, 215, 210 USPQ 609, 611 (CCPA 1981): "It is well settled that there is nothing intrinsically wrong in defining something by what it does rather than what it is."

Pages 9 and 10 of the answer, the examiner questions how the magnetic field intensity detector<sup>4</sup> can be considered to detect "relative proximity." However, taking claim 3 as exemplary, it is set forth therein that the "proximity detector" includes at least one permanent magnet (e.g., magnet 126) and a magnetic field intensity detector (e.g., normally open reed switch 136). It is apparent from the disclosure that the permanent magnet and reed switch are movable relative to one another and, as explained on page 14 of the

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<sup>4</sup> Consistent with the specification, one of ordinary skill in the art would recognize that "magnetic field intensity detector" is used in the sense that a mechanism (i.e., a switch) is actuated in response to a predetermined magnetic field intensity, as distinguished from a detector which actually senses varying degrees of magnetic field intensity.

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specification, the nature of the reed switch and the strength of the magnetic field from the permanent magnet are such that the reed switch will be closed "when the permanent magnet is **approximately one inch away**" (emphasis added). This being the case, the magnetic field intensity detector (e.g., reed switch 136) can be fairly considered to "detect the predetermined relative proximity" as claimed.

We also observe that the examiner on page 8 of the answer states that

claim 1 does not set forth the limitation of a "proximity detector" in a manner that warrants coverage under 35 U.S.C. § 112, sixth paragraph.

We are at a complete loss to understand such a contention inasmuch as claim 1 has no limitation which is drafted in a means-plus-function format.

In view of the foregoing, we will not sustain the rejection of claims 1-25, 27, 28 and 31-39 under 35 U.S.C. § 112, second paragraph.

Turning to the rejection of claims 1, 5-7, 14, 18 and 19 under 35 U.S.C. § 102(b) as being anticipated by Hewitt, the examiner has taken the position that Hewitt's detector is a

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"proximity detector." In our view the examiner is attempting to expand the meaning of "proximity detector" beyond all reason. It is well settled that terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (*see In re Bond*, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), *Specialty Composites v. Cabot Corp.*, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). As we have noted above with respect to the § 112 rejection, the appellant on page 14 of the specification the appellant has described the nature of the proximity detector wherein the relative position of a permanent magnet and reed switch is such that the intensity of the magnetic field of permanent magnet is sufficient to move the reed switch from the open position to the closed position. In Hewitt, however, a locking rod 82 is secured to a pivotally mounted housing 28 which in turn indirectly supports a guard 8. The locking rod is provided with a dog 94 on one end thereof which actuates a **contact switch** (i.e., a tang 108 on a stationary micro switch 98) when

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the guard is in the lower or active position. Consistent with the appellant's specification, we can think of no circumstances under which the artisan would construe such structure to correspond to the claimed "proximity detector." Indeed, the reference to Lieber (which the examiner has relied on in the § 103 rejection) even teaches that the art recognizes the difference between a "contact switch" and a "proximity switch" (see column 4, line 23). Accordingly, we will not sustain the rejection of claims 1, 5-7, 14, 18 and 19 under 35 U.S.C.

§ 102(b) as being anticipated by Hewitt.

Considering now the rejection of claims 1-39 under 35 U.S.C. § 103 as being unpatentable over the Delta instruction manual in view of Hewitt and Lieber, the examiner considers that it would have been obvious to provide the saw of the Delta instruction manual with a safety device as taught by Hewitt in order to prevent undue harm to an operator. Additionally, the examiner is of the opinion that it would have been obvious to provide the modified saw with a proximity switch in lieu of the contact switch utilized Hewitt's safety device in view of the teachings of Lieber. We do not support

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the examiner's position. The Delta instruction manual teaches a table saw of the type having a splitter mounted directly behind the saw blade and a guard that is supported on the splitter by pivoted links in such a manner that the guard is movable toward and away from the surface of the saw table. Thus, Delta instruction manual teaches a table saw which (1) has a movably mounted guard that is supported on a splitter and which is of rather simple construction and (2) does not have a safety device which includes detector and interlock system. Hewitt, while teaching a table saw which has a movable guard and safety device that includes both a detector and interlock system, does so in the context of a relatively complicated mechanism for mounting the guard and the actuator for the safety device. That is, in Hewitt, rather than being supported on a splitter by pivoted links (Hewitt has no splitter whatsoever), the guard is suspended from a telescoping arm 16 that extends over the top of the table saw by a bracket 46, and this bracket is in turn attached to a pivotally mounted "superstructure" 28 in order that the guard may be pivoted from an active position over the saw blade and work supporting surface of the table saw to an inactive

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position away from the saw blade and work supporting surface. As we have noted above in the § 102 rejection, locking rod 82 is mounted on the pivotally mounted superstructure or housing 28 and is provided with a dog 94 on one end thereof for the purpose of actuating a contact switch (i.e., a tang 108 on a stationary micro switch 98) when the guard is in the lower or active position. Both the contact switch and interlock system 64 are mounted on the telescoping arm in a position adjacent the pivotally mounted housing 28 and, thus, the detector and interlock system are both remotely positioned from the guard and the work supporting surface of Hewitt's table saw. From our perspective, the examiner has improperly relied upon the appellant's own teachings for a suggestion to combine the teachings of the Delta instruction manual and Hewitt in the manner proposed. Lieber has only been relied on by the examiner for a teaching of a proximity switch. Accordingly, we will not sustain the rejection of claims 1-39 under 35 U.S.C. § 103 based on the combined teachings of the Delta instruction manual, Hewitt and Lieber.

Under the provisions of 37 CFR § 1.196(b) we make the following new rejections:

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Claims 4, 13, 17, 28 and 35 are rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-enabling disclosure. Each of these claims set forth that "the magnetic intensity detector **generates** an electrical proximity signal indicating **whether or not** the guard is within the predetermined relative proximity to the working surface" (emphasis added). In the first place, the appellant has not disclosed any structure whatsoever that **generates a signal**. That is, in the appellant's device reed switches 136, 138 are merely closed thus allowing current to simply flow, as distinguished from "generating a signal." In the second place, even if the simple flow of current through the reed switches were considered to be "generating a signal," this "signal" or current flow does not take place when the guard is "not" within the predetermined relative proximity inasmuch as these reed switch are once again open.

Claims 4, 13, 17, 28 and 35 are rejected under 35 U.S.C. § 112, second paragraph. In order to satisfy the second paragraph of § 112, a claim must accurately define the invention in the technical sense. **See In re Knowlton**, 481

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F.2d 1357, 1366, 178 USPQ 486, 492-93 (CCPA 1973). Moreover, while the claim language of claims 4, 17, 28 and 35 may appear, for the most part, to be understandable when read in abstract, no claim may be read apart from and independent of the supporting disclosure on which it is based. **See In re Cohn**, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971).

Applying these principles to the present case, we fail to understand how magnetic field intensity detector (i.e., reed switches 136, 138) can be considered to "generate" an electrical proximity signal indicating "whether or not" the guard is within the predetermined relative proximity to the working surface for the reasons we have stated above in the rejection under the first paragraph of § 112. Thus, the language in these claim, when read in light of the specification, results in an inexplicable inconsistency that renders them indefinite.

Claims 1, 6, 7, 32, 37 and 38 are rejected under 35 U.S.C.

§ 103 as being unpatentable over Hewitt in view of Lieber. Hewitt discloses a power tool safety device for a power tool

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having a table 6 defining a working surface, a cutting tool 12 and a guard 8 wherein the safety device comprises a contact-type detector in the form of a tang 108 on a stationary micro switch 98 which detects the presence or absence of dog 24, an interlock system 80 which inherently includes a starting circuit and a bypass circuit 74, 78 having a bypass switch 74 (see Figs. 10 and 11). Although the detector of Hewitt is of the contact type, Lieber discloses a safety guard 12 and interlock system (Fig. 1) for a power tool 11 wherein, with respect to the detector 10, it is stated that this detector can be

a limit switch, contact switch, magnetic proximity switch, or any other arrangement of switches and sensors . . . . [Column 4, lines 22-24]

Accordingly, Lieber teaches that in the art of providing a safety guards and interlocks for power tools, contact switches and magnetic proximity switches are art-recognized alternatives and the artisan would have been well aware of the advantages and disadvantages of each. **See, e.g., In re Heinrich**, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959). In our view, the above-noted statement by Lieber would have

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provided an ample suggestion to one of ordinary skill in this art to substitute in Hewitt for his contact-type detector a magnetic proximity-type detector as taught by Lieber.

Claims 2 and 33 are rejected under 35 U.S.C. § 103 are rejected as being unpatentable over Hewitt in view of Lieber as applied in claims 1, 6, 7, 32, 37 and 38 above and in further view of the Delta instruction manual. Hewitt does not teach an insert for the blade aperture; however, the Delta instruction manual clearly teaches that the provision of an enlarged blade aperture and insert are well known expedients in the art of table saws (see, e.g., Fig. 46). In our view, one of ordinary skill in this art would have found it obvious to provide the table saw of Hewitt, as modified by Lieber, with an enlarged aperture and insert as taught by the Delta instruction manual in order to achieve the self-evident advantage of easy access to the saw blade.

In summary:

The examiner's rejections are all reversed.

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New rejections of claims 4, 13, 17, 28 and 35 under 35 U.S.C. § 112, first and second paragraphs, and claims 1, 2, 6, 7, 32, 33, 37 and 38 under 35 U.S.C. § 103 have been made.

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, ***WITHIN TWO MONTHS FROM THE DATE OF THE DECISION***, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

**REVERSED**  
**37 CFR § 1.196(b)**

	JAMES M. MEISTER	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	NEAL E. ABRAMS	)	BOARD OF
PATENT	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	MURRIEL E. CRAWFORD	)	
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