

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDREA GARUGLIERI

Appeal No. 1998-2700
Application No. 08/722,452¹

HEARD: November 17, 1999

Before STONER, Chief Administrative Patent Judge, FRANKFORT,
and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

¹ Application for patent filed October 10, 1996.
According to appellant this application is a continuation of
Application No. 08/289,597, filed August 12, 1994, now
abandoned.

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DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 15, 16, 19, 21, 22, 24, 26 and 27, which are all of the claims remaining in the application.² Claims 1 through 14, 17, 18, 20, 23 and 25 have been canceled.

Appellant's invention relates to a combination chop and table saw, otherwise known as a flip-over saw. More particularly, the invention relates to such a saw which is capable of making bevel cuts in both its table saw mode and its miter saw mode, and to a pointer and gearing arrangement for accurately and easily identifying the angle which the saw blade makes to the vertical. Claims 15 and 21 are representative of the subject matter on appeal, and a copy of those independent claims may be found in the Appendix to appellant's brief.

² Claim 24 was amended subsequent to the final rejection in a paper filed September 29, 1997 (Paper No. 17). As noted in the advisory action mailed October 10, 1997 (Paper No. 18), the rejection of claim 24 under 35 U.S.C. § 112, second paragraph, made in the final rejection, was overcome by this amendment.

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

Cox 1935	2,000,926	May 14,
Briskin 1951	2,543,486	Feb. 27,

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Garuglieri DE4106636
1992 (German)(translation attached)

Jun. 4,

Claims 26 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 appellant regards as the invention.

Claims 15, 16, 19, 21, 22, 24, 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Briskin in view of Garuglieri and Cox.³

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (Paper No. 23, mailed April 28, 1998) for the reasoning in support of the rejections, and to appellant's brief (Paper

³ A review of PTO records reveals that the provisional double patenting rejection of claims 15, 16, 19, 21, 22, 24, 26 and 27 set forth on page 3 of the final rejection (Paper No. 16) is now moot in view of the abandonment of Application Serial No. 08/722,453 on which that rejection was based.

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No. 22, filed February 23, 1998) for the arguments
thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

Looking first at the examiner's rejection of claim 26 under 35 U.S.C. § 112, second paragraph, we note that we see nothing indefinite about appellant's use of the language in claim 26 specifying that the "pointer is disposed on said pinion." In this regard, we agree with appellant's comments and arguments found on pages 21 and 22 of the brief. While it is true, as the examiner notes on pages 14 and 15 of the answer, that the specification (page 6) indicates that the pointer (56) seen in Figure 2 is provided on the sleeve (52), we observe that the specification, at page 6, lines 1 and 2, also indicates that "[t]he forward end of the sleeve 52 is formed as a toothed pinion 54," thus making the pinion and the sleeve part of the same component in appellant's system. In

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essence, we view the sleeve (52) as forming the body of the pinion (54) which carries teeth that cooperate with the teeth on rack (50), whereby movement of the pivot support (26) relative to the pivot block (27) about the bevel axis (92), as seen in Figures 2 and 3, causes the pinion (54) to advance along the rack (50) and rotate the pinion (54) and sleeve (52) relative to the fixing pin (44), the pivot support (26) and the pivot block (27), thereby causing the pointer (56) on the sleeve/pinion to rotate relative to the scale (58) and provide an indication of the selected bevel angle of the saw blade.

In light of the foregoing, it is our opinion that claim 26 on appeal reasonably apprises those of skill in the art of its scope and defines appellant's invention with a reasonable degree of precision and particularity adequate to satisfy the requirements of 35 U.S.C. § 112, second paragraph. Thus, we will not sustain the examiner's rejection of claim 26 under 35 U.S.C. § 112, second paragraph.

Regarding the examiner's rejection of claims 15, 16, 19, 21, 22, 24, 26 and 27 under 35 U.S.C. § 103 as being

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unpatentable over Briskin in view of Garuglieri and Cox, we share appellant's view that the protractor of Cox for measuring and reading the angular setting of aircraft propeller blades with relation to their hub is far removed from appellant's field of endeavor involving a combination chop and table saw and a system for indicating the angle of the saw blade relative to the vertical. Moreover, even if one skilled in the art would have viewed Cox as being reasonably pertinent to the problem confronted by appellant (a point of view which we find to be highly questionable), we must agree with appellant that there is no teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to combine the teachings of Cox with those of Briskin and Garuglieri in the manner urged by the examiner. Unlike the examiner (answer, page 7), we do not view the protractor of Cox and the angular adjustment mechanism of Briskin (Figures 14, 15, 17 and 18) as being "equivalent structures" which "perform equivalent functions in substantially the same way to achieve substantially the same result." Indeed, given the disparate nature of the devices and functions performed thereby in Cox and Briskin, it is our

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view that in searching for an incentive for modifying the power saw of Briskin, the examiner has impermissibly drawn from appellant's own teachings and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellant's own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not

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sustain the examiner's rejection of appealed claims 15, 16, 19, 21, 22, 24, 26 and 27 under 35 U.S.C. § 103 as being unpatentable over Briskin in view of Garuglieri and Cox.

In view of the foregoing, the examiner's decision rejecting claim 26 under 35 U.S.C. § 112, second paragraph, and claims 15, 16, 19, 21, 22, 24, 26 and 27 under 35 U.S.C. § 103 based on Briskin in view of Garuglieri and Cox is reversed.

REVERSED

BRUCE H. STONER, JR.)	
Chief)	Administrative
Patent Judge)	
)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS
)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

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CEF/sld

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REVESED

Prepared: December 15, 2000