

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(2) is not binding precedent of the Board.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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENZIL E. WHITNEY

Appeal No. 1999-0718
Application 08/594,149¹

ON BRIEF

Before CALVERT, COHEN and FRANKFORT, Administrative Patent
Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed January 31, 1996.

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This is a decision on appeal from the examiner's final rejection of claims 1 through 6. Claims 8 and 9, the only other claims remaining in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b). Claim 7 has been canceled.

Appellant's invention relates to a pair of hand grips that can be used to handle and manipulate bulk materials, cartons and boxes. Each of the grips has on one side thereof an ergo-nomically designed handhold and on the opposite side a removable array of pointed projections. As noted on page 4 of the specification, an object of the invention is to pick up cartons and boxes without leaving significant damage to the carton, box or other lifted piece. This is achieved by having the array of pointed projections on each of the grips provided in the form of fine, almost needle-like points located on the contact side of the grip. A copy of claims 1 and 2 on appeal, as reproduced from appellant's Appendix to the brief, is attached to this decision.

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

Carley	568,237	Sept. 22, 1896
Donnelly	D-26,777	Mar. 16, 1897
Hanneman	2,116,928	May 10, 1938
Williams	2,607,988	Aug. 26, 1952
Carter	2,777,724	Jan. 15, 1957
Eramo	3,464,731	Sept. 2, 1969

Claims 1 and 4 stand rejected under 35 U.S.C. §
102(b) as being anticipated by either Hanneman or Eramo.

Claims 1, 2, 5 and 6 stand rejected under 35 U.S.C.
§ 102(b) as being anticipated by Carter.

Claims 1 and 4 additionally stand rejected under 35
U.S.C. § 103 as being unpatentable over Donnelly in view of
Carley.

Claims 2 and 3 stand rejected under 35 U.S.C. § 103
as being unpatentable over Donnelly in view of Carley as
applied to claim 1 above, and further in view of Williams.

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Rather than reiterate the examiner's full statement of 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. 13, mailed October 1, 1998) for the reasoning in support of the rejections and to appellant's brief (Paper No. 12, filed July 10, 1998) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, this panel of the Board has 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 find that we must reverse the examiner's rejections of claims 1 through 6 on appeal under both 35 U.S.C. § 102(b) and § 103 because we are unable to clearly understand the claimed subject matter due to language which we find renders appellant's claims

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indefinite. Our reasoning for the above determination follows.

Before addressing an examiner's rejections based on prior art, it is an essential prerequisite that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellant's independent claim 1 on appeal in an attempt to derive an understanding of the scope and content thereof.

Claim 1 is directed to a material handling grip comprising a handhold shaped on a first side to accommodate the fingers and thumb of a partially closed hand, with said handhold

further having a generally flat surface opposite said first side. Claim 1 goes on to recite "said flat surface having a uniform thickness and offset from said first side." The material handling grip of claim 1 is indicated as further

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including an array of needle-like, tapered pointed projections and fastening means for affixing said array to said handhold. Claim 1 also specifically sets forth the requirement that said projections be "angled from said flat surface."

In reviewing claim 1, we are at a complete loss to understand how a flat surface as recited in appellant's claim 1 can have "a uniform thickness," or exactly how appellant understands the recited flat surface to be "offset from said first side" of said handhold. Geometrically speaking, a surface has both length and breadth, but no thickness. Thus, the requirement in claim 1 on appeal that the recited flat surface have "a uniform thickness" clearly renders the claimed subject matter indefinite. As for the further requirement that the flat surface be "offset from said first side" of the handhold, we note that this limitation would seem to require nothing more than that the handhold itself have some thickness, thereby having the flat surface spaced from, or "offset" from, the first side of the

handhold. However, we note that in arguing the examiner's rejection based on Hanneman, appellant has urged (brief, page 4) that Hanneman discloses "no offset flat surface opposite the handhold," notwithstanding that the flat surface of the portion (12) of the gripping element in Hanneman (Fig. 1) facing the box (24) is clearly spaced from, or offset from, the handle portion (10) of the gripping element. Thus, given appellant's argument, we are at a loss to understand exactly what definite meaning should be ascribed to the "offset" language of claim 1 on appeal, and thus, for this additional reason, consider that the subject matter of claim 1 is indefinite.

As a further point, we observe that the needle-like, tapered pointed projections of the array set forth in claim 1 on appeal would not be "angled from said flat surface" (emphasis added) as the claim states, but would instead appear to be part of the array which is affixed to the flat surface of the handhold, thereby making the needle-like projections a part of

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the array and thus merely angled with respect to said flat surface, not from said flat surface.

Dependent claim 2 sets forth the further requirement that the pointed projections be "replaceably retained in said array" (emphasis added). It is unclear from this recitation as to whether the pointed projections and array as a whole are replaceably retained on the handheld, as is described in appellant's specification, or if the individual pointed projections are in fact each releasably retained in the array, a prospect for which we find no support in appellant's specification.

Given the foregoing, under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellant's claims 1 through 6:

Claims 1 through 6 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and

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distinctly claim that which appellant regards as the invention.

Turning to the examiner's rejections of the appealed claims under 35 U.S.C. § 102(b) and § 103, we emphasize again that these claims contain unclear language which renders the subject matter thereof indefinite for reasons stated supra as part of our new ground of rejection under 35 U.S.C. § 112, second paragraph. Accordingly, we find that it is not possible to apply

the prior art relied upon by the examiner to these claims in deciding the question of anticipation under 35 U.S.C. § 102(b) and obviousness under § 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned limitations in the claims. This being the case, we are constrained to reverse the examiner's rejections of the appealed claims in light of the holding in In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). We hasten to add that this reversal of the examiner's rejections is not based on the merits of the

rejections, but on technical grounds relating to the indefiniteness of the appealed claims.²

In summary, the examiner's rejections of claims 1 through 6 under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103 have been reversed. A new rejection of claims 1 through 6

² As mere guidance to the examiner and appellant, we note that it does not appear that Hanneman, Eramo or Carter discloses or teaches "needle-like, tapered pointed projections," as required in appellant's claim 1 on appeal. Hanneman describes the projections (14) pointed to by the examiner as "penetrating tangs or the like" struck-out from the flat portion (12). Nowhere in Hanneman do we see the lateral extent of the tangs (14). As for the projections (66) in Eramo, these elements are specifically described as being "dull pins" or teeth and as being larger and blunter in profile than the teeth of the tack strip (23). In Carter, it is clear from Figures 2 and 3 that the projections or jaw elements (16) are not "needle-like, tapered pointed projections." In addition, we point out that claim 1 requires "fastening means for affixing said array to said handhold," and that the examiner should treat such limitation in accordance with Sections 2181-2183 of the Manual of Patent Examining Procedure. For appellant's part, it should be noted that the claims on appeal are drafted using the transitional term "comprising," thus making the claimed subject matter more open-ended and not exclusive of other additional, unrecited elements such as those noted by appellant in the arguments on pages 3-6 of the brief. We also note the patent to Uccellini (4,226,349) of record, and that the carton grip seen therein would appear to differ from that set forth in appellant's claims 1, 3 and 4 on appeal only in that the projections (14a) of the grip are not "needle-like."

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under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 CFR § 1.196(b).

The decision of the examiner is reversed.

This decision contains a new ground 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. and 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 ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

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(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. . . .

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)

	IAN A. CALVERT)	
	Administrative Patent Judge)	
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)	BOARD OF
PATENT)	
	IRWIN CHARLES COHEN)	APPEALS AND
	Administrative Patent Judge)	INTERFER-
ENCES)	
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CHARLES E. FRANKFORT)
Administrative Patent Judge)

CEF:psb

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Coudert Brothers
4 Embarcadero Street
Suite 3300
San Francisco, CA 94111

APPENDED CLAIMS

1. A material handling grip comprising:

a handhold shaped on a first side to accommodate the fingers and thumb of a partially closed hand, said handhold having a generally flat surface opposite said first side, said flat surface having a uniform thickness and offset from said first side;

an array of needle-like tapered pointed projections, said projections angled from said flat surface; and

fastening means for affixing said array to said handhold.

2. The material handling grip according to Claim 1 wherein:

said pointed projections being replaceably retained in said array.