

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID A. SILVA

Appeal No. 1999-2628
Application No. 08/652,723

ON BRIEF

Before CALVERT, ABRAMS, and JENNIFER D. BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 15-17, 23 and 24 as amended subsequent to the final rejection. Claims 1 and 4-14 stand allowed and claims 18-22 stand objected to as being dependent on a rejected claim. No other claims are pending in this application.

BACKGROUND

The appellant's invention relates to a haircutting guide-comb instrument for use in cutting hair of a human being. An understanding of the invention can be derived from a reading of exemplary claim 16, which appears in the appendix to the appellant's brief.

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

Wall	3,928,871	Dec. 30, 1975
Maggiore	4,520,565	Jun. 4, 1985

The following rejection is before us for review.¹

Claims 15-17, 23 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Maggiore in view of Wall.

Reference is made to the brief² and reply brief (Paper Nos. 12 and 14) and the answer (Paper No. 13) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

¹ The examiner (advisory action, Paper No. 6) indicated that the 35 U.S.C. § 112 rejection of claims 15-24 was overcome by the amendment filed December 8, 1997.

² Any references in this decision to the brief refer to the corrected appeal brief filed April 17, 1998 (Paper No. 12).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims³, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we shall sustain the examiner's rejection.

We note, at the outset, that the appellant's brief states, on pages 3 and 4, that claims 15-17, 23 and 24 stand or fall together. Therefore, in accordance with 37 CFR § 1.192(c)(7), we have selected claim 16 as the representative claim to decide this appeal, with claims 15, 17, 23 and 24 standing or falling therewith.

Maggiore, the primary reference relied upon by the examiner, discloses a hair cutting guide apparatus for clamping and holding a section of hair in spaced relationship from the scalp for cutting purposes. The hair cutting guide apparatus comprises two jaw members 10, 12, each including a clamping portion 16 and a handle member 36. A spring member 60 applies pressure to the handle members 36 to urge the clamping portions 16 together. The examiner (answer, pages 4-5) finds that Maggiore discloses the subject matter of claim 16, with the exception of a plurality of comb-teeth on the first elongated leg and an elongated channel on the second elongated leg superposed over the plurality of comb-teeth, as required by the claim.

³ In claims 1, 15 and 16, line 2, it appears that "being" should be deleted.

Wall discloses a similar device (barber's glove) for holding and clamping sections of hair for cutting. Wall, in particular, discloses provision of arcuate detents (51 in Figure 9 or the tapered versions 42 in Figure 10) on one of the confronting surfaces of the device and a channel (illustrated but unnumbered in Figure 10; corresponding element numbered 67 in Figure 12 and bounded by flanges 68, 69) on the other confronting surface which is superposed over the detents when the confronting surfaces are brought together. A foam cushion is contained in the channel and arranged to receive and conform about the detents so as to form mating surfaces, thereby engaging all the hair disposed between the confronting surfaces. The purpose of the detents and channel is to cause lifting of the distal ends of the hair a varying amount so as to provide a serrated cut edge (column 5, lines 59-61) to permit the hair ends to blend in with the remaining hair (column 1, lines 39-48). As explained, for example, in column 5, lines 62-67, strands of hair will end up being different lengths after cutting, depending on whether they pass across the crest of the narrow outer surface of a detent 42, between the detents or across a detent at a location offset from its crest. The examiner determines that it would have been obvious to provide the apparatus of Maggiore with comb teeth and a corresponding superposed groove on the hair engaging surfaces of the legs in view of the teachings of Wall in order to consistently and simply provide a uniform serrated edge to the distal ends of the cut hair (answer, page 5).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Indeed, a *prima facie* case of obviousness is established where the reference teachings would appear to be sufficient for one of ordinary skill in the art having those teachings before him to make the proposed combination or modification. See In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

The appellant's argument (brief, page 10) that it is difficult to imagine what one would have by combining Maggiore and Wall and that it is doubtful that it would be anything of value is not well taken, in our opinion. As we see it, the combined teachings of Maggiore and Wall would have suggested providing the hair cutting guide apparatus of Maggiore with a plurality of arcuate detents on the clamping face of one of the jaw members and a channel and cushion on the clamping face of the other jaw member in the manner taught by Wall so as to raise strands of hair engaged by the apparatus varying amounts in order to facilitate cutting of a serrated edge. The device so produced is a hair cutting guide apparatus specially adapted for

blending cut hair ends with the remaining hair, an application recognized as useful by Wall (column 1, lines 39-48, and column 2, lines 20-27).

The appellant's principal arguments against the rejection are based on the assertion that, even if the references were combined as proposed by the examiner, the detents taught by Wall are not "comb-teeth" in that, when used as disclosed, they hold some hair on their tops (the narrow outer surfaces) and, thus, do not have a top surface that will move through hair completely and without interruption (brief, pages 7-8; reply brief, pages 2-5). Consequently, according to the appellant, the hair cutting guide apparatus is not capable of penetrating through the hair positioned between the jaw members such that the hair is combed as the apparatus is then moved through the hair, as required in the last paragraph of independent claims 15 and 16.

In support of the position that the detents of Wall cannot be considered "comb-teeth," the appellant cites several patents which illustrate combs having teeth which are tapered throughout their free ends (see reply brief, page 2 and Exhibit 1). While many, if not all, of these patents do appear to illustrate comb-teeth having free ends which are tapered in the direction transverse to the stroke direction, the appellant has not pointed to any express definition of "comb-teeth" in any of these patents which requires such tapering. In fact, the

disclosures in Laing⁴ (Figure II), Schweizer⁵ (Figure 1) and Koppel⁶ (Figure 5; column 4, lines 7-15) of comb-teeth which are not tapered throughout their free ends in the direction transverse to the stroke direction belies any such notion. Laing (page 1, lines 49-53) and Koppel (column 4, lines 7-15) even express an intent to have the hair enter the gaps between the teeth. Accordingly, we are not persuaded by the appellant's arguments that the examiner's characterization of the detents taught by Wall as "comb-teeth" is unreasonable.

While we appreciate that neither Wall nor Maggiore teaches or suggests passing the hair cutting guide apparatus through a person's hair and that the detents taught by Wall, in cooperation with the channel and cushion on the other confronting face, are intended to lift a strand or two onto the crest of each detent⁷, the Maggiore apparatus, modified as proposed by the examiner in view of Wall, is inherently capable of the use recited in the "whereby . . ." clause. In particular, it is possible to position the hair of a human being intermediate the jaw members with the detents penetrating through the hair and to move the hair cutting guide apparatus through and along the length of that hair to a desired position at which the edges of the jaw members establish a guide for cutting the hair, such that the hair is combed by such

⁴ U.S. Patent No. 1,108,375, issued August 25, 1914 (copy appended).

⁵ U.S. Patent No. 2,397,696, issued April 2, 1946 (copy appended).

⁶ U.S. Patent No. 5,318,051, issued June 7, 1994 (copy appended).

⁷ It is well settled that the recitation of an intended use for an old product does not make a claim to that old product patentable. In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

movement. This is true even if "penetrating through" as used in the claims requires that each and every strand disposed between the legs (jaw members) lies between the comb-teeth, as the appellant's arguments on page 3 of the reply brief suggest. While we have carefully considered the appellant's argument on page 2 of the reply brief that the flat⁸ top surface of the detent will trap hair thereon as illustrated in Exhibit 2 of the reply brief, we observe, initially, that the appellant has provided no evidence that this would occur if the Maggiore apparatus were moved through the hair in a combing motion with the jaw members held in a non-clamping state, rather than merely clamped to hair at a particular location as disclosed.⁹ Moreover, even accepting the appellant's argument in this regard, there is nothing in the structure suggested by Wall which would preclude positioning of each and every strand of hair between the detents, albeit perhaps with some manipulation of the jaw member and/or the strands being necessary while the jaw members are held in a non-clamping position. Accordingly, we conclude that the "whereby . . ." clause does not in this instance serve to patentably distinguish the claims over the applied prior art .

The appellant also argues, on page 8 of the brief, that the channel taught by Wall carries a foam cushion which receives and conforms about the detents so as to form mating surfaces

⁸ By flat, we understand the appellant to mean that the outer surface of the detent is not tapered in the direction transverse to the stroke direction. It is rounded in the stroke direction.

⁹ An attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

and, thus, is not a "channel." We do not agree. As pointed out by the examiner (answer, page 6), the claims do not preclude the presence of an additional element received in the channel between it and the comb-teeth filling the volume defined by the channel.

The appellant's argument that the claims call for a structure for "one length" cutting (brief, pages 9 and 10) or "straight haircuts" (reply brief, pages 6 and 7) is simply not commensurate in scope with the claims. While we have carefully reviewed the claim terminology particularly alluded to by the appellant on pages 9 and 10 of the brief as requiring this feature, we see nothing therein which even suggests, much less requires, structure for one-length cutting. In any event, to the extent that use of the device in the manner recited in the final paragraph of claim 16 necessarily results in a "straight haircut or "one-length" cutting, the Maggiore apparatus, as modified in view of Wall, as discussed above, is fully capable of such use and, thus, inherently meets this limitation.

Accordingly, we sustain the examiner's rejection of representative claim 16, as well as claims 15, 17, 23 and 24 which stand or fall with claim 16.

CONCLUSION

To summarize, the decision of the examiner to reject claims 15-17, 23 and 24 under 35 U.S.C. § 103 is affirmed.

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

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
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