

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN L. PARSONS

Appeal No. 2002-1038
Application 09/122,022

ON BRIEF

Before STAAB, MCQUADE, and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Kevin L. Parsons appeals from the final rejection of claims 1 through 36, all of the claims pending in the application.¹

THE INVENTION

The invention relates to "expandable batons for use by law enforcement personnel and is specifically directed to a formed handle cover for such batons" (specification, page 2).

Representative claims 1 and 7 read as follows:

¹ Claims 1 and 7 have been amended subsequent to final rejection.

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1. A handle in combination with an expandable baton, the handle comprising:

a hollow cylindrical tube having a plurality of square-cut grooves about a portion thereof, each groove having a groove diameter less than an outer diameter of the tube adjacent said groove; and

a cover attached to the tube having an internal diameter approximately equal to the outer diameter of the tube, wherein the cover conforms to an outer surface of the tube;

whereby each groove of the tube cooperates with a ridge located on the internal diameter of the cover and having a diameter approximately equal to the groove diameter, and where the cover is constructed of a material such that the diameter of the ridge cannot stretch or expand to a size of the outer diameter of the tube thereby preventing the cover from moving relative to the tube during expanding or collapsing of the baton.

7. A handle in combination with an expandable baton having at least one member telescopingly mounted in the handle, wherein the telescoping member includes an enlarged outer end which is seated in the handle when the telescoping member is nestled in the handle, the handle comprising:

a hollow cylindrical tube;

a cover attached to the tube, the cover conforming to an outer surface of the tube; and

means for preventing the cover from moving relative to the tube during expanding or collapsing of the baton.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Zimmerman	1,165,484	Dec. 28, 1915
Hemming	1,685,588	Sep. 25, 1928
Parsons	5,110,375	May 5, 1992
Beere et al. (Beere)	5,551,323	Sep. 3, 1996

THE REJECTION

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Claims 1 through 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Parsons in view of Zimmerman, Hemming and Beere.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 17 and 19) and to the examiner's answer (Paper No. 18) for the respective positions of the appellant and the examiner with regard to the merits of this rejection.

DISCUSSION

Parsons, the examiner's primary reference, discloses an expandable baton 1 composed of a main section 2, which serves as a handle, and two telescoping sections 10 and 11 (see Figures 1 and 2). The main section 2 is formed from a hollow tube and "is covered by a padding material 3 to provide a comfortable, secure grip (column 3, lines 50 and 51).

Implicit in the examiner's explanation of the appealed rejection (see pages 4 and 5 in the answer) is the concession that Parsons fails to respond to a number of limitations in independent claims 1, 7 and 17. To cure these admitted deficiencies, the examiner turns to Zimmerman, Hemming and Beere. The threshold issue in the appeal is whether these secondary references are non-analogous art as urged by the appellant (see, for example, page 2 in the reply brief).

Zimmerman discloses a grip-enhancing covering for non-slip application to the handle of a baseball bat, which covering can also be adapted for application to the handles of tennis rackets, cricket bats, golf clubs, portable flag poles, cranks and all kinds of tools (see page 1, lines 79 through 86). The covering A consists of a rubber tube having a closed end and a diameter slightly smaller than that of the bat handle to which it is to be applied. Zimmerman teaches that

[i]n order to positively secure the tube upon the handle I provide a special fastening means which consists in circumferentially grooving the bat handle adjacent the heel thereof as shown at C and providing a circumferential lug D upon the inside of the tube adjacent the closed end thereof. When the tube is applied to the handle and the lug engages within the groove it will be impossible to withdraw the same unless cut [page 1, lines 58 through 67].

Hemming discloses a piece of cutlery composed of a blade 1 including a tang 2 about which is molded a bolster 3 having a tail piece 4, and a hard rubber handle 6 having a bore 5 adapted to receive the tang and bolster. According to Hemming,

[i]t will readily be seen that when the rubber handle is brought in contact with hot water, it will both soften and expand and lose its holding grip on the tail piece of the bolster.

To overcome this trouble, a properly shaped tool, not shown, is inserted in the bore 5, Figure 4, to form the circumferential grooves 8, see also Figure 2, larger than the bore 5. The tang 2 of the blade is then inserted in the bore of the handle 6, and said handle enclosed in the conventional two-part mold 9,

Figure 6. This mold has the opening 10 through which fusible metal is admitted to form the bolster 3, its tail piece 4 and the ribs 11, which ribs, filling the lateral branches or grooves 8, will, when the metal has cooled, form a perfect anchorage to prevent accidental withdrawal of said tail piece 4 from the handle [page 1, lines 53 through 72].

Beere discloses a surgical screwdriver handle 10 comprising a solid metallic core piece 19 and an elastomeric silicone rubber gripping cover 26. As explained by Beere,

[t]he cover 26 is applied to the core piece 19 in a molding process and of course molten form to where it hardens to a rubbery condition which adheres to the core 19. In the molding process, the elastomer is caused to flow into grooves 27 extending around and throughout the length of the core piece 19, as shown in FIG. 3. . . . As seen in FIG. 3, the groove 27 is actually one continuous spiral groove from the butt end 22 to the head or cylindrical end 21, and the width of the grooves 27 is approximately one third of the lands designated 28 and extending circularly between every two grooves 27. Thus, in the total length of the core piece 19, and that may be a length of approximately 4 inches, there are twenty grooves 27 seen on each of the side elevational view[s] of the core piece 19. FIGS. 9 and 10 show enlarged views of a fragment of the piece 19 and those views particularly show the grooves 27 which are shown to be undercut so that the groove base 29 is wider than the opening of the groove at the curved surfaces 23 and 24, as particularly seen in FIG. 10. Thus, the molten cover material 26 will flow into the groove 27 and fill the groove so that the undercut or wedge-shape groove 27 will trap the portion 31 of the cover material in the groove 27. With that arrangement, the cover is secured to the core piece 19 without the need of cement or the like. Thus, the cover 26 is completely secure and stable on the core 19 and the user can hand grip the cover 26 and apply rotation torque without having the cover 26 slip relative to the core piece 19 since the two become integral by means of the grooving 27 and particularly

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the undercut or extended dimension 29 of the groove 27 and the complete filling of the groove 27 by means of the cover material at 31 [column 2, line 64, through column 3, line 30].

In an obviousness determination under 35 U.S.C. § 103(a), art which is non-analogous is too remote to be treated as prior art. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). There are two criteria for determining whether art is analogous: (1) whether the art is from the field of the inventor's endeavor, regardless of the problem addressed, and (2) if the art is not within the field of the inventor's endeavor, whether it is reasonably pertinent to the particular problem with which the inventor was involved. Id.

The specification in the instant application indicates that the field of the appellant's endeavor is expandable batons and handle covers therefor (see page 1), and that the particular problem with which the appellant was involved was to prevent the cover from slipping relative to the handle (see pages 4 and 5). Although Zimmerman, Hemming and Beere are not within this field of endeavor, they certainly are reasonably pertinent to this particular problem. Thus, each constitutes analogous art which was properly considered by the examiner in combination with

Parsons in assessing the obviousness of the subject matter recited in the appealed claims.

One of the shortcomings of Parsons relative to the claimed subject matter is a lack of response to the limitation in independent claim 1, and the corresponding limitation in independent method claim 17, requiring the cover to be "constructed of a material such that the diameter of the ridge cannot stretch or expand to a size of the outer diameter of the tube." The examiner's reliance on Zimmerman as being suggestive of this feature (see pages 7 through 9 in the answer) is not well founded. As the diameter of Zimmerman's rubber tubular covering A is slightly smaller than that of the handle to which it is to be applied, the diameter of the covering, and more specifically the diameter of its ridge or lug D, necessarily must be capable of stretching or expanding to a size of the outer diameter of the handle in order to allow the covering to be properly positioned on the handle with the ridge or lug D in groove C. The examiner offers no evidence or cogent explanation in support of the assertion (see page 8 in the answer) that this capability would somehow vanish once the covering is disposed on the handle. It simply does not follow from Zimmerman's description of the covering as not being removable from the handle without cutting

that the covering "cannot stretch or expand" as recited in claims 1 and 17.

Since Hemming and Beere ostensibly do not overcome the foregoing flaw in the Parsons-Zimmerman combination, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of independent claims 1 and 17, and dependent claims 2 through 6 and 18 through 36, as being unpatentable over Parsons in view of Zimmerman, Hemming and Beere.

We shall sustain, however, the standing 35 U.S.C. § 103(a) rejection of claims 7 through 16 as being unpatentable over Parsons in view of Zimmerman, Hemming and Beere.

Parsons meets all of the limitations in independent claim 7 except for the one calling for "means for preventing the cover from moving relative to the tube during expanding or collapsing of the baton." This means-plus-function recitation, construed as it must be under 35 U.S.C. § 112, sixth paragraph,² covers the corresponding structure described in the appellant's specification, i.e., at least one groove on the tube and a mating

² 35 U.S.C. § 112, sixth paragraph, states in pertinent part that "[a]n element in a claim for a combination may be expressed as a means . . . for performing a specified function without the recital of structure . . . in support thereof, and such claim shall be construed to cover the corresponding structure . . . described in the specification and equivalents thereof."

ridge on the cover, and equivalents thereof. In this regard, the specification states that "[t]he grooves are designed to prevent the cover from slipping or moving relative to the baton handle during the extending or retracting actions" (page 6), and "[t]he mating relationship between the circumferential grooves 119 and the ridges 124 functions to prevent the cover 122 from slipping or moving relative to the baton handle during the extending or retracting actions" (specification, page 12). The specification says nothing about the grooves and ridges being "square," and thus does not support the appellant's contention that "[t]he 'means' [in claim 7] is the square ridges on the cover that mate with grooves of the tube to prevent the cover from moving" (main brief, page 10).

The collective teachings of Zimmerman and Beere that handle covers similar to the one disclosed by Parsons can be positively secured to their handles via interlocking grooves on the handle and ridges on the cover to avert slippage would have furnished the artisan with ample suggestion or motivation to provide Parson's baton handle tube and cover with such means for preventing the cover from moving relative to the tube during expanding or collapsing of the baton. Beere additionally would have suggested the provision of grooves at both ends of Parson's

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handle tube as recited in dependent claim 12 for the self-evident purpose of enhancing their movement-preventing function.

Although Beere's groove 27 is actually one continuous spiral groove, Beere makes it clear that this spiral groove in effect embodies a plurality (twenty) of grooves. Furthermore, while the appellant may be correct that the forces acting on Zimmerman's bat or Beere's screwdriver which tend to cause cover slippage differ from those acting on Parson's baton, it is not apparent, nor has the appellant persuasively pointed out, why this circumstance would have deterred the artisan from appreciating the non-slip benefits touted by Zimmerman and Beere as being applicable to Parsons' baton handle cover.

Hence, the appellant's position that the reference combination relied on by the examiner rests on impermissible hindsight and does not account for all the limitations in the claims is unconvincing, at least insofar as claims 7 and 12 are concerned. To the contrary, the combined teachings of these references support the examiner's determination that the differences between the subject matter recited in claims 7 and 12 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Dependent claims 8

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through 11 and 13 through 16 fall with parent claim 7 since the appellant has grouped them together for purposes of the appeal (see page 4 in the main brief).

SUMMARY

The decision of the examiner to reject claims 1 through 36 is affirmed with respect to claims 7 through 16, and reversed with respect to 1 through 6 and 17 through 36.

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

AFFIRMED-IN-PART

LAWRENCE J. STAAB)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
JOHN P. MCQUADE)	
Administrative Patent Judge)	INTERFERENCES
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)	

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JENNIFER D. BAHR)
Administrative Patent Judge)

JPM/kis
RICHARD L. WOOD, ESQ.
WELSH & KATZ, LTD.
120 SOUTH RIVERSIDE PLAZA
22 FLOOR
CHICAGO, IL 60606