

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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIELE BROTTTO,
DARNELL SMITH and DANH TRINH

Appeal No. 2003-1301
Application No. 09/782,539

HEARD: October 9, 2003

Before HAIRSTON, DIXON, and SAADAT, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 25-28 and 30-32, which are all of the claims pending in this application.¹ Claims 1-24, 29 and 33-36 have been canceled.

We AFFIRM.

¹ The examiner has withdrawn the rejection under 35 USC § 103(a) over Bauer.

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Appellants' invention relates to a power tool with means for obtaining product use information . An understanding of the invention can be derived from a reading of exemplary claim 25, which is reproduced below.

25. A power tool comprising:

a memory for storing use profile information about the tool, wherein the stored information is downloadable into a reader apparatus.

The prior art of record relied upon by the examiner in rejecting the appealed claims is as follows:

Wagner et al. (Wagner)	5,903,462	May 11, 1999 (Filed Oct. 17, 1997)
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Claims 25-28 and 30-32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed Jan. 2, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 14, filed Nov. 12, 2002) for appellants' arguments thereagainst.

OPINION

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

At the outset, we note that appellants have elected to group claims 25,27, 28, 31 and 32 together as a first group and claims 26 and 30 as a second group.

From our review of the claimed invention, the teachings of Wagner and the content of the examiner's rejection and response to arguments, we find that the examiner has set forth a *prima facie* case of anticipation of the claimed invention along with a *prima facie* case of obviousness for independent claim 25. (See answer at pages 2-4.)

The examiner maintains that it would have been obvious to one of ordinary skill in the art that the temperature of the power supply would provide information about the power tool temperature. (See answer at page 3.) While we agree with the examiner's decision to reject independent claim 25, we need not reach a specific finding regarding temperature since this limitation is found only in the dependent claims. Independent claim 25 merely requires "a memory for storing use profile information about the tool,

wherein the stored information is downloadable into a reader apparatus.” Here, we agree with the examiner that Wagner teaches a memory for storing profile information about the tool, wherein the information is downloadable to a reader. The examiner maintains that the computer of Wagner “inherently functions as **a reader apparatus**, since it accesses and acquires data stored in the memory.” (See answer at page 3.) We also agree with the examiner that an apparatus that reads or downloads the stored data is a reader apparatus.

Additionally, appellants admit that Wagner teaches monitoring a power tool and storing the profile data, but that Wagner does not disclose downloading the records to a reader apparatus for later analysis. (See brief at page 5.) Appellants draw a distinction between their disclosed embodiment having a reader and computer and their embodiment having just a computer. (See brief at pages 5-6.) Appellants argue that there is no suggestion to modify the direct connection of the computer with a separate reader apparatus. (See brief at page 6.) We agree with appellants that the examiner has not addressed such an embodiment and Wagner does not specifically address such a configuration, be we need not address such a limitation since the language of the claim does not specifically detail the physical or functional structure of the reader apparatus or that the reader is an intermediate storage device to a separate computer or the manner that the stored information is downloaded from the memory.

Appellants argue that a person skilled in the art would recognize a reader apparatus as different from a computer. (See brief at page 7.) We disagree with appellants. While there may be a distinction in additional functionalities of the two, we find no such limitations in the instant claim language. We find no express definition in the specification of a reader apparatus and no discernible distinction has been identified by appellants. Therefore, we find that appellants have not rebutted the *prima facie* case of obviousness (here, anticipation) of independent claim 25.

With respect to dependent claims 26 and 30, appellants argue that Wagner does not disclose the storage of “length of use” information as recited in dependent claim 30. (See brief at page 8.) We disagree with appellants and agree with the examiner that Wagner does describe at col. 5 lines 19-20 the storage of the “**total turns counts since the tool was assembled . . .**” (See answer at page 3.) Therefore, we will sustain the rejection of dependent claim 30 and need not address the specific grouping recited in dependent claim 26 since appellants have grouped dependent claim 26 with dependent claim 30.

CONCLUSION

To summarize, the decision of the examiner to reject claims 25-28 and 30-32 under 35 U.S.C. § 103(a) is affirmed.

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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).

AFFIRMED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOSEPH L. DIXON)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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MAHSHID D. SAADAT)	
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