

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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER D. NEITZELL

Appeal No. 2003-1472
Application No. 09/606,955

ON BRIEF

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

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 6-11, 16-19, 21-25, 27, 34-36 and 76-97, as amended subsequent to the final rejection in a paper filed June 3, 2002 (Paper No. 13). No other claims are currently pending.

By way of background, the appealed subject matter of the instant application is related to appealed subject matter in Appeal No. 2002-1018 taken by appellant in Application No. 09/474,033, now

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Patent 6,508,151, which application is the parent of the present application. In rendering our decision here, we presume familiarity on the reader's part with the issues involved in the prior appeal.

The claims on appeal are drawn to a reciprocating saw having a spindle for supporting a saw blade, wherein the path of travel of the spindle is adjustable. A further understanding of the invention can be derived from a reading of exemplary claims 16 and 17, which appear in the appendix to appellant's supplemental main brief.

The references applied in the final rejection are:

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|------------------------------------|-----------|---------------|
| W. S. Brucker | 3,204,470 | Sept. 7, 1965 |
| S. G. Enders | 3,269,197 | Aug. 30, 1966 |
| Ketchpel, Jr. et al. (Ketchpel) | 3,802,079 | Apr. 9, 1974 |
| Palm | 5,079,844 | Jan. 14, 1992 |

Claims 6-11, 16-19, 21-25, 27, 34-36 and 76-97 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 6-8, 10, 11, 16-19, 21-25, 27, 35, 36, 76-83, 85-88 and 91-96 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Enders in view of Ketchpel.

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Claims 9, 34, 84 and 97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Enders in view of Ketchpel, and further in view of Palm.

Claims 89 and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Enders in view of Ketchpel, and further in view of Brucker.

Reference is made to appellant's supplemental main brief and reply brief (Paper Nos. 16 and 18) and to the examiner's answer (Paper No. 17) for the respective positions of appellant and the examiner regarding the merits of these rejections.

The 35 U.S.C. § 112, second paragraph rejection

The second paragraph of 35 U.S.C. § 112 requires that the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977). In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *Id.*

The examiner's focus during examination of claims for compliance with the requirements for definiteness under 35 U.S.C.

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§ 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. MPEP, § 2173.02.

In the present case, the examiner contends that the claims are replete with vague and indefinite language, and lists several examples. As a first example, the examiner asserts on page 3 of the answer that it is not clear what claim 17 encompasses because, in the examiner's view, "the structural line of distinction" between the claimed "motor" and the claimed "means for selectively changing" is not clear. As further explained on page 8 of the answer:

[T]he function of the "means" and the function of the "motor" overlap, since they both facilitate movement in the first path, first cutting stroke, and the first return stroke. Thus, the reason for raising the issue of indefiniteness. At most it is understood in light of the disclosure that the motor facilitates reciprocation of the spindle end. Moreover, it is understood from the disclosure that the track and follower allows the user to change the paths. . . . [T]he changing means do not perform both functions of changing the path *and* moving the spindle. The changing means simply allows or defines the paths of movement. The motor simply facilitates reciprocation.

With reference to claim 17, we appreciate that the claimed functions for the "motor" and the "means for selectively changing" overlap. In reviewing the indefiniteness issue raised by the examiner, we consider that the word "motor" as used here is a broad term that includes not only the electric motor itself (not shown), but also sufficient ancillary structure (e.g., guiding structure such as the track 62 and track follower 60) for effecting the functions attributed to the "motor."¹ Since the "means for selectively changing" of claim 17 also includes the track 62 and the track follower 60,² the terminology of claim 17 questioned by the examiner is, in effect, a double recitation of structural elements that are involved in each function. However, there is no *per se* rule prohibiting a double recitation of structural elements that are common to overlapping functions. See *Palmer v. United States*, 423 F.2d, 316, 320, 163 USPQ 250, 253, adopted 165 USPQ 88 (Ct. Cl.), *cert. denied*, 400 U.S. 951 (1970) ("[D]ouble recitation of elements of combination inventions does not necessarily render a

¹Claim 17 states that the "motor" functions "for moving said end during a first cutting stroke and during a first return stroke, said end being movable along a first path of travel relative to said housing during said first cutting stroke and during said first return stroke"

²Claim 17 expressly states that the changing means "includes a track and a track follower."

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claim vague and indefinite, particularly if the claim is drafted in terms of means clauses under 35 U.S.C. § 112, or if an element performs more than one function or overlapping functions."). See also, *In re Knowlton*, 481 F.2d 1357, 1368, 178 USPQ 486, 494 (CCPA 1973); *In re Kelley*, 305 F.2d 909, 914, 134 USPQ 397, 401 (CCPA 1962). In the present case, we consider that the meaning of the "motor for moving . . ." and "means for selectively changing . . ." terminology of claim 17 is reasonably clear, especially when the terminology in question is read in light of appellant's specification. Accordingly, we do not agree with the examiner's first reason for rejecting the claims under 35 U.S.C. § 112, second paragraph.

The examiner's next example of claim indefiniteness involves the last paragraph of claim 17 that begins with the word "wherein." According to the examiner (answer, pages 3-4), it is not clear what this limitation encompasses. More particularly, the examiner posits (answer, page 9):

The indefiniteness issue lies in having clear antecedent basis for the "means for selectively changing" to change into the "third path of travel" and not in the understanding of the "third path of travel" *per se*. . . . [T]he "means for selectively changing" clause as set forth in claim 17 only sets forth two different paths, i.e., first and second. It is not until the last "wherein" clause where the claim sets forth that the changing means adjusts to the third path. Since the

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first instance of the "means for selectively changing" did not include the functionality of changing to the third path of travel, it is the Examiner's opinion that this part of the claim is indefinite for lacking clear antecedent basis for the functionality. It is noted that if the "means for selectively changing" clause included details for adjustment of the third path, then this issue would be resolved. [Footnotes omitted.]

At the outset, we note that the examiner's rejection in this respect is *not* founded on any misunderstanding of what constitutes the "third path of travel." Our difficulty with the examiner's stated position is that it is based upon a piecemeal reading of claim 17 rather than a reading of the claim as a whole. While the examiner may be correct in noting that the clarity and readability of claim 17 might be improved by initially reciting the "third path of travel" function in the portion of the claim that first sets forth the "means for selectively changing," we again point out that the examiner's focus during examination with respect to definiteness should be on whether the claim meets the threshold requirements of clarity and precision, not on whether more suitable language or mode of expression is available. In the present instance, when claim 17 is read as a *whole*, it is clear that the "means for selectively changing" functions not only to change the first path of travel to a second path of travel, but also to adjust one of the first and second paths of travel to a third path of

travel. Indeed, claim 17 expressly sets forth both of these functions, albeit in different portions of the claim. In light of the foregoing, we cannot support the examiner's second reason for rejecting the claims under 35 U.S.C. § 112, second paragraph.

The examiner's third example of claim indefiniteness is similar to the first example discussed above. Here, the examiner cites to claim 18 and contends (answer, page 4) that the claim is vague and indefinite in that it is not clear what constitutes the structural line of distinction between the "means for moving" and the "means for selectively adjusting."

We agree with the examiner that the "means for moving" and the "means for selectively adjusting" of claim 18 overlap in the sense that they share certain common elements. However, as was the case with the examiner's first example, we do not share the examiner's view that this circumstance renders the claim vague and indefinite. As we stated above, there is no *per se* rule prohibiting the double recitation of such common elements. In the present case, we consider that the meaning of the "means for moving" and "means for selectively adjusting" terminology of claim 18 is reasonably clear, especially when read in light of appellant's specification. It follows that we do not agree with the examiner's third reason for rejecting the claims under 35 U.S.C. § 112, second paragraph.

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The examiner's final example of claim indefiniteness is refers to claim 35, which is directed to a reciprocating saw comprising, *inter alia*, a track defining a first path of travel during first cutting and return strokes and a second path of travel during second cutting and return strokes. The examiner considers that the claim is indefinite "in that it is not clear what the claim encompasses What of the 'track' defines these different paths of travel? In other words, what is the structural nexus that connects the 'track' to the different paths?" (answer, page 4). As further explained on page 10 of the answer:

[T]he Examiner concedes that the track allows changing of the paths of travel due to the fact that the track is adjustable. However, claim 35 does not set forth that the track is adjustable to define those paths. This is the requisite nexus that provides the basis for path definition. At present, the claim only states that the track defines first and second paths of travel, without any mention as to what feature of the track allows this to occur.

The examiner's position is not well taken. When the claim language questioned by the examiner is read in light of the supporting specification, its meaning is clear. More particularly, the track defines a first path of travel as called for in claim 35 when located in a first position corresponding to the upwardly inclined position for track member 56 shown in appellant's Figure 1, and a second path of travel as called for in claim 35 when

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located in a second position corresponding to the downwardly inclined position for track member 56 shown in appellant's Figure 11. Judging from the examiner's remarks on page 10 of the answer as quoted above, it appears that his concern is with the breadth of claim 35 rather than with any indefinite language therein. This is not a proper basis for rejecting claims under § 112, second paragraph, because the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 693, 169 USPQ 597, 600 (CCPA 1971).

In light of the foregoing, we shall not sustain the examiner's rejection of claims 6-11, 16-19, 21-25, 27, 34-36 and 76-97 under 35 U.S.C. § 112, second paragraph.

The 35 U.S.C. § 103(a) rejections

Each of the independent claims on appeal calls for, in one form or another, the following:

a spindle mounted for reciprocation and having an end for supporting a saw blade,

a saw blade selectively supported by said end in a first direction relative to the spindle to have a first cutting direction and in a second orientation relative to the spindle *to have a second cutting direction opposite the first cutting direction,*

a motor (or, means) for moving the end along a first path of travel, the first path of travel having a first cutting stroke and a first return stroke, and

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a track (or, means) for selectively changing the first path of travel of the end to another path of travel, said another path of travel having a second cutting stroke and a second return stroke,

wherein the first path of travel is characterized by movement *at least partially in the first cutting direction during the first cutting stroke*, and wherein said another path of travel is characterized by movement *at least partially in the second (opposite) cutting direction during the second cutting stroke*.

Thus, each of the independent claims on appeal in one way or another calls for a spindle that is capable of moving along a first path of travel and another path of travel, wherein the first path of travel is characterized by movement of the spindle end at least partially in a first cutting direction during a first cutting stroke, and wherein the said another path of travel is characterized by movement of the spindle end at least partially in a second *opposite* cutting direction during a second cutting stroke.

Enders, the examiner's primary reference in each of the rejections under 35 U.S.C. § 103(a), is directed to a jig saw wherein the spindle has an adjustable path of travel. More particularly, Enders discloses a spindle 28 mounted in a pivoting bearing 30 for allowing both sliding and pivoting motion of the spindle relative to the tool housing. Crank pin 25, 26 engages a transverse slot in yoke member 27 carried by the spindle so that when the crank is rotated, a reciprocating motion is imparted to

the spindle. The Enders jig saw further includes an adjustable guide channel 35, 35a which receives the yoke member for guiding the movement thereof. As can be seen from Figures 5A-5D, by changing the angle of inclination of the guide channel, the path of travel of the spindle can be adjusted. More particularly, Fig 5A illustrates a first position of the guide channel that causes the saw blade 31 to move along a first path of travel wherein the saw blade reciprocates with no movement in the cutting direction during the cutting and return strokes, whereas Figs 5B-5D illustrate gradually increasing angles of inclination of the guide channel wherein the saw blade reciprocates in second, third and fourth paths of travel, each characterized by movement of the saw blade toward the workpiece W during the cutting (ascending) stroke and away from the workpiece during the return (descending) stroke.

Ketchpel, the examiner's secondary reference in each of the rejections under 35 U.S.C. § 103(a), is directed to a reciprocating saw. An aim of Ketchpel is to provide a new and improved saw blade holder (generally, element 120) "for selectively holding a saw blade in a vertical position with the saw blade teeth at either the upper or lower edge of the saw blade or in a horizontal position with the saw blade teeth at either the right side or left side of the saw blade" (column 1, lines 17-21). Figure 4 shows the saw

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blade in solid lines in a first vertical position with the saw blade teeth facing downwardly, and in phantom lines in a second opposite vertical position with the saw blade teeth facing upwardly. Ketchpel does not provide for adjustment of the path of travel of the spindle.

The linchpin of the examiner's rejections under 35 U.S.C. § 103(a) is that (1) it would have been obvious to one of ordinary skill in the art in view of the teachings of Ketchpel to support the saw blade of Enders in a second orientation, wherein the saw blade has a second cutting direction opposite the cutting orientation shown in Figs. 5A-5D, and that (2) the resulting modified Enders saw would include all the claimed cutting directions, cutting strokes, return strokes, and paths of travel.

First, we do not agree with the examiner that it would have been obvious in view of Ketchpel to support the saw blade of Enders in a second orientation wherein the saw blade has a cutting direction opposite the cutting direction shown in Figs. 5A-5D. Notwithstanding the teachings of Ketchpel, which arguably teach that it is *generally* known in the art of hand held reciprocating saws to reorient the saw blade to achieve a different cutting direction, the issue is whether it would have been obvious to one of ordinary skill in the art in view of the applied reference

teachings to implement the saw blade reorientation proposed by the examiner *in Enders*. Based on the teachings of the applied references in their entirety, it is our opinion that it would not have been obvious to so modify *Enders*. In this regard, there are several structural features of *Enders* related to its operation that would act as disincentives to modifying *Enders* in the manner proposed. For example, in *Enders*,

[t]he yoke member 27 is urged into engagement with the guide channel 35 by means of a spring 36 which is disposed around the crank pin 25, and also, by means of the leverage exerted about the axis of the pivoted bearing 30 when the jig saw 10 is brought into engagement with a workpiece. [Column 3, lines 17-22.]

However, if the orientation of the blade is reversed as proposed by the examiner, the leverage exerted about the axis of the pivoted bearing when the jig saw is fed into engagement with the workpiece would tend to urge the yoke member out of engagement with the guide channel, the very antithesis of the method of operation described in the *Enders* specification. Moreover, reorienting the saw blade in the manner proposed by the examiner would result in the teeth of the blade being brought into engagement with the unnumbered blade support illustrated by *Enders* in Figures 1 and 2, with the likelihood of damaging the blade and/or the blade support. In addition, if the orientation of the saw blade in *Enders* is

reversed, the position of the shoe structure 14 and motor housing 11 would make it hard for the operator to see the workpiece being cut until after the cut was made, thereby making it, at best, very difficult to achieve an accurate cut. In light of the above, we consider that the modifications proposed by the examiner would make Enders unsuitable for its intended purpose, such that it would not have been obvious to one of ordinary skill in the art to modify Enders in the manner proposed by the examiner. *Ex parte Rosenfeld*, 130 USPQ 113, 115 (Bd. App. 1961).

Second, even if the saw blade of Enders was supported to cut in a direction opposite to that shown in the drawings, the claimed subject matter would not result. As noted above, each of the appealed claims, in one form or another, calls for adjusting the path of travel of the end of the spindle such that the end has a component of movement in the "cutting direction" of the saw blade during the "cutting stroke" of the spindle.³ While we appreciate that Enders provides for adjusting the path of travel of the spindle, it is not apparent to us that the range of adjustments

³Consistent with appellant's specification (page 3, lines 28-34) we understand the "cutting direction" to be the direction in which the saw teeth face, and the "cutting stroke" to be the direction of travel of the spindle (usually toward the saw housing) during which the saw blade cuts the workpiece.

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contemplated by Enders would result in the spindle having a component of movement in the "cutting direction" of the blade during the "cutting stroke" in the event the saw blade is reoriented. Stated differently, it appears to us that in order for the spindle of Enders to have a component of movement in the "cutting direction" during the "cutting stroke" upon reorientation of the saw blade in the reverse direction, the guide channel 35 of Enders would have to be repositioned such that its upper end is to the right (as viewed in Figure 3) of its lower end, so that when the spindle moves in the "cutting direction" (toward the housing), the front end of the spindle would have a rearward component of movement. As we see it, the path of travel for the spindle that would ensue from simply reversing the orientation of the saw blade in Enders would not result in a saw having the claimed paths of travel unless the saw of Enders is also modified to provide for a range of adjustment of the guide channel that is not taught or suggested by the applied reference, either singly or in combination. The examiner's position to the effect that a second path of travel characterized by movement at least partially in the second (opposite) cutting direction during the second cutting stroke would follow as a consequence of applying the saw blade reorienting teachings of Ketchpel to Enders appears to us to be a

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hindsight reconstruction of the claimed subject matter using appellant's own disclosure as an instruction manual or template to piece together the isolated disclosures and teachings of the applied prior art so that the claimed invention is rendered obvious. This, of course, is improper. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

In light of the foregoing, we shall not sustain the examiner's rejection of claims 6-8, 10, 11, 16-19, 21-25, 27, 35, 36, 76-83, 85-88 and 91-96 as being unpatentable over Enders in view of Ketchpel.

We have also carefully reviewed the teachings of Palm further applied in the § 103(a) rejection of claims 9, 34, 84 and 97, and the teachings of Brucker further applied in the § 103(a) rejection of claims 89 and 90, but find nothing therein that makes up for the deficiencies of Enders and Ketchpel discussed above. Accordingly, we also shall not sustain the examiner's rejections of these claims under 35 U.S.C. § 103(a).

Summary

Each of the examiner's rejections is reversed.

The decision of the examiner finally rejecting the appealed claims is reversed.

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REVERSED

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| Administrative Patent Judge |) | AND |
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