

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 37

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JAMES A. MARTIN

Appeal No. 2003-1476
Application No. 09/291,983

HEARD: NOVEMBER 19, 2003

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-9, 16 and 23. Claims 10-15 and 17-22 stand withdrawn from consideration as not being directed to an elected species. No other claims are pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a low profile hacksaw, the hacksaw having a frame assembly comprising a rigid I-beam frame member and an arcuate portion extending substantially the entire length between a forward end portion and the maximum height portion of the frame member. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

Wells	679,653	Jul. 30, 1901
David	3,329,186	Jul. 4, 1967

The following is the sole rejection before us for review.¹

Claims 1, 3-9, 16 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over David in view of Wells in further view of Official Notice.^{2,3}

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 30) for the examiner's complete reasoning in support of the rejection and to

¹ The double patenting rejection has been withdrawn (answer, page 2).

² Although the examiner did not include "official notice" in the statement of the rejection, it is apparent from the explanation of the examiner's rejection that Official Notice is relied upon.

³ The references cited by the examiner on page 7 of the answer have not been considered in deciding this appeal because they have not been included in the statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n. 3, 166 USPQ 406, 407 n. 3 (CCPA 1970).

the brief and reply brief (Paper Nos. 29 and 31) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. For the reasons which follow, we cannot sustain the examiner's rejection.

David, the jumping off point of the examiner's obviousness rejection, discloses a saw having a frame 22 having a handle portion 24 and spaced shank or leg members 25 and 26 between which a blade 28 is stretched. As best illustrated in Figure 1, David's frame is of I-beam construction as called for in claim 1 but lacks an "arcuate portion extending substantially the entire length between said forward end portion and the maximum height portion" as also called for in claim 1.

Wells discloses a handsaw having a blade *c* attached at one end to a curved tubular reach *b* and at the other end to a handle *a*. The reach is attached to the handle.

According to Wells (lines 25-40),

[i]t is of the essence of this improvement that this reach should be both curved and tubular, and preferably it should be constructed of wrought-iron piping. It contains a maximum of strength for the purpose in hand with a minimum of weight, and at the same time the curved characteristic and the tubular characteristic combined give the reach just that degree of elasticity which, along with the

requisite strength, is admirably adapted for the straining of the saw for actual work.”

The examiner further takes Official Notice (answer, page 4) that

it is old and well known in the art, particularly the mechanical arts, that corners or sharp bends or the like create stress risers wherein stress is concentrated in a relatively small area of a component which may lead to premature failure of the component in that area. It is further known that to alleviate this problem, the material in that area must either be “overdesigned” (i.e., designed with stronger material or enough additional material to provide the needed extra strength and endurance for a sufficiently long life for the component) or designed more “efficiently” without such corners or sharp curves to eliminate the stress concentration areas which usually provides benefits such as requiring less material resulting in a lighter weight component.

According to the examiner, it would have been obvious to one having ordinary skill in the art at the time of appellant’s invention “to provide the frame member of David with the claimed arcuate portion for providing an efficient design along with the other well known benefits described above as well as those taught by Wells” (answer, page 4).

Appellant argues that the examiner has not pointed to any evidence suggesting the combination of David and Wells to arrive at appellant’s invention and, in particular, argues that Wells teaches away from the combination of the I-beam of David with the arcuate frame of Wells (brief, pages 4-6). Appellant also argues that the Official Notice relied upon by the examiner is apparently not derived from any specific knowledge of

hacksaws and thus is entitled to less weight than the teaching away in Wells, which is directed to the field of handsaws (brief, page 6).

As pointed out above, Wells explicitly emphasizes that the curved characteristic and the tubular characteristic of the reach in combination are required to achieve the degree of elasticity and strength which is the objective of Wells' invention. Thus, we agree with appellant that Wells would have suggested provision of an arcuate and tubular frame member on a saw and would not have suggested provision of an arcuate portion in combination with an I-beam construction on David's hacksaw. The examiner may not pick and chose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art (Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve Inc., 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986), cert. denied, 484 U.S. 823 (1987) and In re Kamm, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972)).

As for the examiner's taking of Official Notice that it was well known in the art to alleviate the problem of stress concentrations at corners or sharp bends by either overdesigning by using a stronger material or additional material or designing the component without sharp corners or bends to eliminate stress concentrations, this is insufficient to provide suggestion to modify David's saw frame to provide an arcuate portion from the forward end portion to the maximum height portion as called for in

claim 1. First, David provides local arcuate portions, not sharp bends or corners at the bases of the shanks 25, 26 and the examiner has not pointed to any evidence, either in David or elsewhere, that one of ordinary skill in the art at the time of appellant's invention would have recognized stress concentrations at the bases of the shanks as a problem. Moreover, even if such a problem in David's frame construction were recognized in the prior art, the examiner has supplied no evidence that one skilled in the art would have solved such problem by providing an arcuate portion as called for in claim 1.

In light of the above, we cannot sustain the examiner's rejection of claim 1 as being unpatentable over David in view of Wells and Official Notice. It also follows that we cannot sustain the like rejection of claims 3-9, 16 and 23 depending therefrom.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3-9, 16 and 23 under 35 U.S.C. § 103(a) is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Pillsbury Winthrop, LLP
P.O. Box 10500
McLean, VA 22102