

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte JEFFREY F. SCHMITZ

Appeal No. 2004-1207
Application No. 09/759,411

HEARD: DECEMBER 8, 2004

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

DECISION ON APPEAL

Appellant originally appealed from the examiner's rejection of claims 1-21, which are all of the claims pending in this application. At the oral hearing, appellant's counsel, Mr. Steven C. Schnedler, withdrew the appeal of the rejections of claims 18-21. In accordance with Manual of Patent Examining Procedure (MPEP) § 1215.03, such withdrawal operates as an authorization to cancel those claims from the application and the appeal continues with respect to claims 1-17. Claims 18-21 will be

canceled from the application by direction of the examiner at the conclusion of the appeal proceedings without further action by appellant (MPEP § 1215.03).

BACKGROUND

The appellant's invention relates to a washer feeding apparatus for a fastener driver. 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 of record in rejecting the appealed claims:

Pitkin	3,595,460	Jul. 27, 1971
Butler	4,033,499	Jul. 5, 1977
Young et al. (Young)	5,014,876	May 14, 1991
Beach et al. (Beach)	5,056,684	Oct. 15, 1991
Lamb	6,302,310	Oct. 16, 2001 (filed Nov. 12, 1999)

The following rejections are before us for review.

Claims 1, 4-12, 14 and 16-20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lamb in view of Young.

Claims 2, 3 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lamb in view of Young and Pitkin.

Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lamb in view of Young and Butler.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Lamb in view of Young and Beach.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed August 26, 2003) for the examiner's complete reasoning in support of the rejections and to the brief (filed July 21, 2003) 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. As a consequence of our review, we make the determinations which follow.

We turn our attention first to appellant's claim 1. We observe, at the outset, that, although the preamble of claim 1 is directed to washer feeding apparatus for a fastener driver having a stroke axis and an exit barrel, recitation in the body of the claim of "said retention chamber having an exit aperture aligned with the exit barrel and arranged such that a washer retained therein is in alignment with the fastener driver exit barrel and with said exit aperture" indicates that the claim is in fact directed to a washer feeding apparatus in combination with a fastener driver.¹ In reviewing this appeal, therefore, we consider claim 1 to be directed to such combination. Further, consistent

¹ We leave it to the examiner and appellant to consider whether amendment of the preamble of claim 1 to be consistent with the scope of the body of the claim is in order.

with appellant's underlying disclosure, we interpret "by gas contact" in the final paragraph of claim 1 as requiring direct contact of the pressurized gas with the washers.

Lamb discloses a staple or nail gun assembly 10 provided with a staple or nail gun 20, and a cap feeding device 40 including a cap container 60, a base 50 and a shuttle 80. The base 50 includes a cap feeding chamber 52 and a cap holding chamber 54 and a channel 56 connecting the two chambers. The shuttle 80 is movably disposed in the channel 56 of the base 50 and is adapted to move a cap at the cap feeding chamber 52 toward the cap holding chamber 54 through the holding chamber. As best illustrated in Figure 5, the shuttle 80 is moved by a piston-cylinder arrangement 100 powered by compressed air.

The examiner concedes that Lamb lacks a supply of pressurized gas for propelling washers by gas contact from the acceleration chamber (the cap feeding chamber 52 of Lamb) to the retention region (the cap holding chamber 54 of Lamb), as called for in claim 1. The examiner finds suggestion to provide Lamb with such a gas contact arrangement in the teachings of Young. See page 5 of the answer.

Young discloses a fastener feed assembly wherein fasteners F are fed from a vibrating hopper 12 along a chute 13 to a discharge tube 18. At the junction of the chute 13 and the tube 18 is a body member 21 having a slide 30 therein, the slide 30 provided with a notch 35 for receiving the shank of a fastener therein. The body member also includes a discharge opening 26 aligned with the discharge tube 18. The slide 30 is transversely slideable between a first position wherein the notch is aligned

with the chute to a second position wherein the notch is aligned with a vertical discharge opening 26 (see Figure 6). A first air line means supplies air through air line 45 for moving the slide toward the second position against the force of a spring 42 and directs an air stream via line 51 through an air passage 50 including an inclined segment 53 (Figure 7) which communicates with the discharge opening 26. The fastener feed assembly further includes a second air line means for directing a stream of air into contact with the head of a fastener positioned in the notch 35 when the slide is in the second position to positively move the fastener laterally into the discharge opening 26. It is in this second air line means that the examiner finds suggestion to provide a gas contact arrangement for moving the fasteners of Lamb from the cap feeding chamber 52 to the cap holding chamber 54. According to the examiner, such a modification would have been obvious "for the purpose of reducing cost and increasing reliability by decreasing complexity as [taught] in column 1, lines 23-29 [of Young]" (answer, page 5).

We recognize that Young teaches that

the known feed or escapement assemblies are complex, in that they utilize mechanical mechanisms to feed the fasteners into the discharge tube leading to the screwdriver. This complexity increases the cost of the assembly and reduces its reliability [column 1, lines 24-29].

Given the substantial structural differences between the types of fastener driving apparatus discussed by Young and the cap feed apparatus of Lamb, we find no suggestion, however, in Young's teaching of an air puff to move fasteners in a fastener feed device laterally from a notch in a slide toward a gravity-fed discharge tube, in a

direction perpendicular to the direction of movement of the slide, to modify Lamb so as to move caps from the cap feeding chamber 52 toward the cap holding chamber 54 of Lamb by gas contact rather than by contact with the shuttle 80.

As stated by our reviewing court in In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant [citations omitted].

While Young does evidence that the use of direct gas contact to move objects in dispensing apparatus was known at the time of appellant's invention, the applied references provide no teaching or suggestion to use such a propulsion technique in Lamb to move nail or staple caps from the cap feeding chamber to the cap holding chamber.

In light of the above, we cannot sustain the examiner's rejection of independent claim 1, or claims 4-12, 14, 16 and 17 depending therefrom, as being unpatentable over Lamb in view of Young. Further, the examiner's application of the additional references Pitkin, Butler and Beach provides no cure for the above-noted deficiency of the combination of Lamb and Young. Consequently, we also cannot sustain the rejections

of claims 2, 3 and 21 as being unpatentable over Lamb in view of Young and Pitkin,
claim 13 as being unpatentable over Lamb in view of Young and Butler and claim 15 as
being unpatentable over Lamb in view of Young and Beach.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-17 under 35 U.S.C. § 103 is reversed and the appeal has been withdrawn with respect to claims 18-21.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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STEVEN C. SCHNEDLER
CARTER & SCHNEDLER, PA
56 CENTRAL AVE., SUITE 101
PO BOX 3985
ASHEVILLE, NC 28802