

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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK BRIAN O'BERRY

Appeal No. 2004-2286
Application 09/960,193

ON BRIEF

Before KIMLIN, WARREN and WALTZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal

This is an appeal under 35 U.S.C. § 134 from the decision of the examiner finally rejecting claims 1, 3 through 5, 7 and 8, all of the claims in the application.

Claim 1 illustrates appellant's invention of a double pitch screw, and is representative of the claims on appeal:

1. A double pitch screw with a head and a barrel adapted to join two pieces of material tightly together, comprising:

- (a) the double pitch screw having a head at a first end of the barrel and a drive point at a second end of the barrel;
- (b) the first end being oppositely disposed from the second end;
- (c) the double pitch screw having a first set threads and a second set of threads on the barrel;
- (d) the first set of threads being adjacent to the head;

- (e) the second set of threads being adjacent to the drive point;
- (f) the first set of threads of a high pitch number relative to the second set of threads;
- (g) a break score being on the barrel between the first set of threads and the head;
- (h) the break score being adapted to assist the separation of the barrel and the head; and
- (i) a clear shank being on the barrel between the first set of threads and the second set of threads.

The references relied on by the examiner are:

Wilson	2,292,557	Aug. 11, 1942
Habermehl et al. (Habermehl)	6,074,149	Jun.
13, 2000		

The examiner has rejected appealed claims 1, 3, 5 and 7 under 35 U.S.C. § 102(b) as clearly anticipated by Wilson, and appealed claims 4 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Wilson as applied to claims 1, 3, 5 and 7 above, and further in view of Habermehl.¹

Appellant states the grounds of rejection under “Grouping of Claims” but does not select a claim for consideration with respect to either ground of rejection (brief, page 5). Thus, we decide this appeal based on appealed claims 1 and 4. 37 CFR § 1.192(c)(7) (2002); *see also* 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

We affirm.

Rather than reiterate the respective positions advanced by the examiner and appellant, we refer to the answer and to the brief for a complete exposition thereof.

Opinion

We have carefully reviewed the record on this appeal and based thereon find ourselves in agreement with the supported finding advanced by the examiner that as a matter of fact, *prima facie*, appealed claim 1 is anticipated by Wilson (Paper No. 5, page 2; answer, pages 4-6); and, that as a matter of law, *prima facie*, one of ordinary skill in this art would have found in the combined teachings of Wilson and Habermehl the reasonable suggestion to modify the double pitch screw of Wilson by using the square drive socket in the head of the double pitch screw by

¹ The examiner states in the answer (page 3) that the grounds of rejection are set forth in the final action mailed October 7, 2002 (Paper No. 5; page 2).

Habermehl in place of the slot drive socket in the head of the screw of Wilson as required by appealed claim 4, in the reasonable expectation of successfully driving the screw into material with square drive mechanism drivers (Paper No. 5, page 2; answer, pages 6-7).

Accordingly, since the examiner has established a *prima facie* case of anticipation over Wilson, and a *prima facie* case of obviousness over the combined teachings of Wilson and Habermehl, we have again evaluated all of the evidence of anticipation and non-anticipation and all of the evidence of obviousness and nonobviousness based on the record as a whole, giving due consideration to the weight of appellant's arguments in the brief. *See generally, In re Spada*, 911 F.2d 705, 707 n.3, 15 USPQ2d 1655, 1657 n.3 (Fed. Cir. 1990); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984).

We have again read the double pitch screw disclosed in cols. 1 and 2 of page 1 and, e.g., **Figs. 1 and 4** of Wilson on all of the limitations of the "double pitch screw" set forth in appealed claim 1 and thus, agree with the examiner's findings that the so disclosed screw satisfies all of the limitations of appealed claim 5 (answer, page 5), because limitations "(a)" through "(i)" of claim 1 correspond to limitations "(c)" through "(k)" of claim 5. Thus, Wilson in fact expressly describes a double pitch screw that meets each and every element arranged as required by appealed claim 1, placing the claimed screw in the possession of a person of ordinary skill in the art, which is all that is required to establish anticipation within the meaning of § 102(b). *See generally, In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

Based on this substantial evidence in Wilson, we cannot agree with appellant's arguments that "the Wilson structure is substantially different" because the double pitch screw of the reference is "tapered" and the pitch of the two sets of threads is reversed (brief, pages 6-8). Indeed, as the examiner points out (answer, page 6), there is no claim limitation with respect to the "taper" of the claimed screw, and the allegation that "[a]ppellant is showing a substantially straight, untapered barrel" (brief, page 8), apparently based on the specification figures, will not be read into the appealed claims as a limitation because there is no basis in the written description, including the drawings, of the specification or in the claim language to do so. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); *In re Priest*, 582 F.2d 33, 37, 199

USPQ 11, 15 (CCPA 1978). Indeed, appellant supplies no evidence in support of his arguments that the “taper” of Wilson’s screw requires “a hole to be pre-drilled,” or that one of ordinary skill in the art would recognize that “the very existence of the drive point in appellant’s claims requires that limitation of the substantially straight, untapered barrel and permits no other structure” (brief, pages 7-8).

Furthermore, there is no basis in Wilson for appellant’s allegation that the screw of the reference has a first set of threads adjacent the head having a low pitch number relative to the second set of threads adjacent the drive point, for indeed, it is clear from col. 1, lines 35-42, of page 1 of the reference that the first set of threads has a “fine pitch” and the second set of threads has a “coarse pitch,” which satisfies limitation “(f)” of appealed claim 1, as the examiner points out (answer, pages 4-5). *Cf.* specification, page 4, lines 16-21.

With respect to the ground of rejection under § 103(a), appellant contends that Wilson’s screw requires a pre-drilled hole and thus “[a]ppellant’s advantages are undisclosed” by the reference (brief, page 9); that Habermehl does not overcome the alleged differences between the claimed screw and that of Wilson; and that Habermehl alone does not establish obviousness because the nail of Habermehl does not have a “score break” and thus “the only purpose thereof is to show a square drive for the screw” (brief, page 10). We cannot agree,

We considered appellant’s pre-drilled hole allegations above. With respect to Habermehl, we agree with appellant that the double pitch screw of this reference differs solely from the claimed double pitched screw of appealed claim 4 in the absence of a score line. However, we determine that one of ordinary skill in this art would have interchanged the slot drive socket of Wilson with the square drive socket of Habermehl in the reasonable expectation of driving the screw. *See generally, In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981)(“The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.”); *In re Siebentritt*, 372 F.2d 566, 567-68, 152 USPQ 618, 619 (CCPA 1967) (express suggestion to interchange methods which achieve the same or similar results is not necessary to establish obviousness). The fact that the screw of Habermehl is not disclosed to have a “break

score” does not detract from the teaching of the square socket drive therein, for indeed, we find that one of ordinary skill in this art would have added a break score to the double pitch screw of Habermehl in view of the break score on the double pitch screw of Wilson for the advantages shown in Wilson.

Accordingly, based on our consideration of the totality of the record before us, we have weighed all of the evidence of anticipation and of obviousness found in the applied prior art with appellant’s countervailing evidence of and argument for non-anticipation and nonobviousness, and conclude that the claimed invention encompassed by appealed claims 1, 3, 5 and 7 would have been anticipated as a matter of fact under 35 U.S.C. § 102(b), and that the claimed invention encompassed by appealed claims 4 and 8 would have been obvious as a matter of law under 35 U.S.C. § 103(a).

The examiner’s decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

AFFIRMED

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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CHARLES F. WARREN)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
THOMAS A. WALTZ)	
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