

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte SHANE D. WOLF

Appeal No. 2005-0911
Application No. 09/923,113

ON BRIEF

Before MCQUADE, 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 14 and 17-24. Claim 11, the only other claim pending in this application, stands withdrawn from consideration as not being directed to an elected specie.

BACKGROUND

The Invention

The appellant's invention relates to beauty salon and spa tools and, in particular, to shears, provided with a grip material that is deformable by a user's fingers or hand.

Further understanding of the invention may be obtained from claim 14 which reads as follows:

14. Shears comprising:

a head that contains one or more elements adapted to be directed toward the hair;

a handle comprising finger loops, each finger loop having an inner diameter; and

deformable grips located on each inner diameter, each grip having:

a deformable outer surface capable of receiving at least a portion of the inner diameter into itself; and

a viscous medium enclosed by the outer surface.

The Prior Art

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

Tindall	970,406	Sept. 13, 1910
McCall	5,000,599	Mar. 19, 1991

The Rejection

Claims 14 and 17-24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Tindall in view of McCall.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer for

the examiner's complete reasoning in support of the rejection and to the brief and reply brief 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 shall sustain the rejection of claims 14 and 17-24 as being unpatentable over Tindall in view of McCall.

Tindall discloses shears comprising handle loops 6, 7 provided with tubular cushions each including a tube 5 composed of elastic material, such as india rubber. According to Tindall (the sentence bridging pages 1 and 2), the tubular cushions "may be filled with air at atmospheric pressure, or at any greater pressure, as may be desired, thus giving the cushion tubes any desired resistance, the same as pneumatic tires, or air tubes for other purposes." The purpose of the cushions is to "protect the hands of the user" (page 1, lines 22-23). The examiner concedes that Tindall lacks a viscous medium enclosed by the outer surface (tube 5) as called for in claim 14.

McCall discloses a deformable grip for a writing instrument responsive to user fingertip pressure to assume a highly comfortable and low fatigue geometric configuration. The deformable grip 16 comprises a cylindrical sleeve 28 of a thin rubber-based or deformable plastic or other elastomer material enclosing a recessed cavity 22 filled with a relatively viscous putty substance 30 for accommodating fingertip

pressure induced shape deformation of the sleeve 28 during normal use of the writing implement. According to McCall, such putty advantageously conforms relatively easily upon light fingertip pressure during normal gripping of the implement and maintains its deformed shape for a substantial period of time after release. The grip can then be grasped by a different user for deformation to a different customized shape (see column 4, lines 40-51). This results in “a unique or novelty feel while further providing significant enhancements in writer comfort during use and a corresponding reduction in writer fatigue” (column 5, lines 47-50). McCall teaches that

the deformable grip 16 may be applied to any of a wide range of different types of pens, pencils, and other types of writing implements, as well as other manual implements with working tips, for example, paint brushes, jeweler’s tools, and other devices [column 4, lines 7-12].

In an alternative form of the invention illustrated in Figures 6 and 7, McCall discloses a grip 16' comprising an outer resilient sleeve component 34 integrally molded with interior radially extending webs 36 joined in turn with an inner sleeve component 38 to define a plurality of spaced chambers 40 which intercommunicate with each other through small vent openings 42 in the webs 36. The chambers 40 are adapted to receive and contain a flowable substance 44 of relatively viscous physical characteristics, such as silicone-based grease or lubricant. When the writing implement is grasped, the writer’s fingertips apply light manual pressure to the outer sleeve component 34 to cause the flowable material to express through the vent openings 42

in a manner allowing the grip to assume a revised shape. Once the revised shape is achieved, however, the vent openings 42 tend to restrict rapid return of the flowable substance through the opening toward a balanced equilibrium condition, whereby the grip tends to retain the revised shape for a substantial time period (column 5, lines 1-43).

In the background of the invention, McCall discusses the proposed use in the prior art of air chambers between resilient sleeves for an increased overall cushioning effect. McCall explains that, while such an approach may achieve some improvements in user comfort, the resilient sleeve is unable to undergo significant shape change when gripped, whereby the sleeve cannot accommodate a truly customized geometry tailored to the individual user. According to McCall,

[t]he resilient nature of the sleeve results in reaction forces applied to the user's fingertips urging the sleeve to spring substantially immediately back toward a relaxed or nondeformed state, wherein these reaction forces can themselves contribute to writer's fatigue over a prolonged period of time [column 1, lines 60-65].

We agree with the examiner that McCall would have provided ample suggestion to one of ordinary skill in the art at the time of appellant's invention to modify the tubular cushions of Tindall by filling the tubes 5 thereof with a viscous medium as taught by McCall to permit the cushion to deform to the anatomical contours of the individual user in a customized manner while further enhancing user comfort and a corresponding reduction in fatigue. For the reasons which follow, we do not find the appellant's arguments persuasive of the nonobviousness of the examiner's proposed combination.

With respect to the appellant's argument as to the different applications of McCall's grip and Tindall's tubular cushion, we note first that McCall's teachings are expressly not limited to writing implements. As discussed above, McCall points out that the deformable grip may be applied to, *inter alia*, "other manual implements with working tips, for example, paint brushes, jeweler's tools, and other devices" (column 4, lines 7-12). Shears having working cutting tips would certainly appear to fall within the confines of these applications. Further, the appellant's characterization on page 6 of the brief that writing instruments are gripped with steady pressure during use while shears are repeatedly opened and closed, alternately applying pressure to the finger loops and then relaxing that pressure, at best, overstates the differences between the manners of gripping these implements. In using a writing implement, a user directs the movement of the implement in part by applying varying amounts of pressure from the thumb, index and middle fingers contacting the implement. The gripping pressure is thus not necessarily as steady as the appellant would have us believe. Likewise, the opening and closing motion of using shears does not result in a full release of pressure alternating with pressure application. In any event, while we appreciate that the gripping action of a user of shears differs from that of a user of a writing implement, much as the gripping action of a user of a writing implement differs from that of a user of the other manual implements with working tips to which McCall contemplates applicability of the disclosed deformable grip, McCall's teaching of the advantages of a customized contour and reduction in user fatigue provided by McCall's deformable grip,

filled with viscous putty or grease, over simple air chamber cushions, such as that of Tindall, would certainly have commended the use of such a viscous medium in the tubular cushion of Tindall to achieve said advantages.

Finally, the appellant's argument on page 6 of the brief that Tindall's teaching that the tubular cushions may be filled with air at atmospheric or greater pressure as desired to give the cushions any desired resistance teaches away¹ from the proposed modification to fill Tindall's tubular cushions with viscous medium is not well taken. The ability of a deformable grip filled with viscous medium to maintain its deformed shape for a period of time as taught by McCall is in no way inconsistent with Tindall's teaching of a desired resistance.

¹ "A reference may be said to teach away when a person of ordinary skill, upon [examining] the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." In re Gurley, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Simply that there are differences between two references is insufficient to establish that such references "teach away" from any combination thereof. See In re Beattie, 974 F.2d 1309, 1312-13, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

CONCLUSION

To summarize, the decision of the examiner to reject claims 14 and 17-24 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JOHN P. MCQUADE)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 2005-0911
Application No. 09/923,113

Page 10

Peter Giancana
Estee Lauder Companies, Inc.
125 Pinelawn Road
Melville, NY 11747