

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte NICHOLAS E. ACHTERBERG, ROBERT P. WELSH  
and FRANK A. MANNARINO

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Appeal No. 2006-2406  
Application No. 10/745,113  
Technology Center 3700

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HEARD: October 18, 2006

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Before GROSS, LEVY, and NAPPI, Administrative Patent Judges.  
LEVY, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-5, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a hook for a band saw (specification, page 1).

Claim 1 is representative of the invention, and is reproduced as follows:

1. A band saw comprising:

a housing having a pair of wheel covering portions separated by a motor covering portion;

a motor in said housing motor covering portion;

a handle coupled with said housing;

an activation member coupled with said motor and a power source, said activation member on said housing;

an output member coupled with said motor, said output member coupled with a blade; and

a hook member coupled with said housing, said hook member cantilevered from said housing and having an engaging surface for supporting said band saw with respect to a support member for suspending said band saw off the ground enabling a user to hang said band saw between use in a convenient way for repeated use.

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

Bennett	1,453,335	May 1, 1923
Dean	6,442,848	Sep. 3, 2002

Claims 1-5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Bennett.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer (mailed April 3, 2006) for the examiner's complete reasoning in support of the rejections, and to the brief (filed February 22, 2006) and reply brief (filed May 31, 2006) for the appellants' arguments thereagainst.

Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered. See 37 CFR § 41.37(c)(1)(vii) (eff. Sept. 13, 2004).

#### OPINION

In reaching our decision in this appeal, we have carefully considered the subject matter on appeal, the rejection advanced by the examiner, and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

Upon consideration of the record before us, we make the determinations which follow. We note at the outset that appellants argue the claims as a group. Accordingly, we select claim 1 as representative of the group. By way of background, we note that in rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343. The examiner "cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the

examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F. 3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative

persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976).

The examiner's position (answer, page 3) is that Dean does not disclose a hook member having an engaging surface. To overcome this deficiency of Dean, the examiner turns to Bennett for a teaching of a hook member for the saw when not in use.

Appellants' position (brief, page 3) is that Dean discloses pulley covers which are manufactured from a high impact polymeric material, and that the covers protect the blade as well as the pulleys from damage which may occur when the saw is dropped or placed on the ground. It is argued (brief, pages 3 and 4) that Dean does not disclose or suggest the need or desirability for any type of hanging mechanism to support the saw off the ground during non-use of the saw. Appellants assert (brief, page 4) that

In fact, Dean discloses high impact covers which absorbs force when the saw is dropped or is positioned on the ground. Thus, Dean, by disclosing the high impact covers, teaches away from supporting the saw off the ground since the covers protect the saw when it is positioned on the ground.

With regard to Bennett, appellants assert (id.) that "Bennett neither discloses nor suggests the desirability of support the band saw in between use during constant operation." It is argued that there is no mention in either of the references of the desirability to have a hook which enables suspension of a band saw in between use. Appellants further argue (brief, page 5) that the examiner has failed to show any nexus between the two references to suggest the combination, and that there is no suggestion or motivation in either of the references to combine them together. Appellants lastly argue (id.) that "[o]nly through the Examiner's hindsight reconstruction, picking and choosing isolated elements from the Bennett reference to combine it with the Dean reference is the Examiner enabled to come up with his rejection."

The examiner responds (answer, page 4) that Bennett clearly suggests the desirability of hanging the band saw when not in use. From this teaching of Bennett, the examiner takes the position (id.) that an artisan would have been motivated to provide a hook as taught by Bennett on the device of Dean to arrive at the claimed invention.

Appellants assert (reply brief, page 2) that “[t]here is no suggestion, since the covers protect the blade as well as the pulleys when it is contact with the ground, to hang the Dean saw above the ground. To do so would combine a teaching which Dean clearly teaches away from.” It is argued (id.) that the examiner totally ignores the entire teaching of Bennett and zeros in on one particular item. It is additionally argued that there is no motivation to combine the two references because the two references do not address the same problem.

From our review of we find, for the reasons which follow, that the combined teachings of Dean and Bennett would have suggested to an artisan the invention of claim 1. From our review of Dean, we find that the reference is directed to a coping saw that has either reciprocating saw blades or a continuous loop blade. Dean discloses that the saw blade is a continuous loop blade (col. 4, line 51). It is further disclosed that the saw blade, instead of being a continuous loop, can be independent blade segments that reciprocate (col.14, lines 44-49). From the disclosure of a continuous loop blade we find that Dean discloses, in at least one embodiment, a band saw. Dean further discloses that the housing is preferably formed from

injection molded, high impact plastic (col. 3, lines 66 and 67 and col. 7, lines 21-24). Bi-symmetrical housing 112 can be designed to provide mounting points for the internal components while at the same time provide areas of increased strength where needed to accommodate bending moments and internal stresses (col. 7, lines 33-36). It is further disclosed that the pulley covers protect the pulleys and the guide bearings from direct impact (col. 10, lines 56-58). From the disclosure of Dean, we find that the high impact material provides increased strength where needed to accommodate bending moments and internal stresses and protect the pulleys and the guide bearings from direct impact. However, we find no reference to protection from dropping the saw or placing it on the ground, as asserted by Appellants (answer, pages 3 and 4). Turning to Bennett, we find that the reference, like Dean, is directed to a portable saw with a continuous loop blade (page 1, lines 6, 7 and 67. Bennett additionally discloses (page 1, lines 92-95) that "I also provide a suitable eye or hook 20 at the end of the frame opposite the handle for hanging the saw up when not in use." From the disclosure of Bennett that a portable, motor powered band saw have a hook for hanging up the saw when not in use, we find that an artisan would have been motivated to place a hook on other portable motor-driven band

saws when not in use. Specifically, we find that this disclosure of Bennett would have motivated an artisan to have placed a hook on the band saw of Dean, as advanced by the examiner.

We are not persuaded by appellants' assertion (brief, page 4) that Dean teaches away from supporting the saw off of the ground since the covers protect the saw when the saw is placed on the ground. From our review of Dean, we find no disclosure, and none has been pointed to by appellants, relating to the covers protecting the saw when it is placed on the ground. Nor do we find any mention of the saw being placed on the ground. The covers will protect the saw whether or not the saw is on the ground. Nor do we find in Dean any lack of desire to suspend the saw from a hook when not in use. Rather, we find that supporting the saw from a hook when not in use and providing a high-impact cover are both useable at the same time because even if the saw has a supporting hook, it could still be dropped by a user. In addition, we note that even if dropped, the impact resistant cover will serve to protect the internal components of the saw. Because a portable saw would benefit from having both a support hook and an impact resistant cover, we do not agree with

appellants that Dean teaches away from having a support hook. Nor are we persuaded by appellants' assertion (id.) that there is no mention in either reference of the desirability of having a hook which suspends a band saw in between use because Bennett discloses a portable, motor driven band saw that has a hook for supporting the saw between use. Nor are we persuaded by appellants' assertion (brief, page 5) that there is no logical nexus between the references to suggest the combination. From Bennet's disclosure of a portable, motor powered band saw that has a support hook, we find the nexus to provide a support hook on the portable, motor powered band saw of Dean. Nor are we persuaded by appellants' assertion (id.) that the examiner ignores the teachings of Bennett as a whole and chooses a small piece of Bennett to combine with Dean. Bennett is directed to a portable, motor driven band saw. An object of the invention is to provide the arrangement described and shown (page 1, lines 19-22). Described by Bennett is the hook 20 for hanging the saw up when not in use (page 1, lines 92-95). Thus, we find no convincing evidence that the examiner is picking and choosing isolated elements as part of a hindsight reconstruction of appellants' claims. Nor are we persuaded by appellants'

assertion (reply brief, page 2) that "[t]here is no motivation to combine the two references because the two references do not address the same problem." Dean is directed to, inter alia, providing an impact resistant cover to protect the saw components from damage. Bennett provides a support hook which we find will inherently help protect the saw from damage by keeping it suspended when not in use. Because both references generally address the problem of protecting the portable, motor driven band saw, we are not persuaded by appellants' assertion that the references address different problems and that there is therefore no motivation to combine the teaching of the two references as advanced by the examiner.

From all of the above, we hold that the combined teachings of Dean and Bennett would have suggested to an artisan the invention of claim 1, and are not convinced of any error on the part of the examiner. The rejection of claim 1, and claims 2-5 which fal with claim 1, is sustained.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1-5 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)(1)(iv).

AFFIRMED

ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
STUART S. LEVY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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ROBERT E. NAPPI	)	
Administrative Patent Judge	)	

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