

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* JODY W. MILES

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Appeal 2006-2714  
Application 10/228,898  
Technology Center 3700

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Decided: April 10, 2007

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Before MURRIEL E. CRAWFORD, JENNIFER D. BAHR, and  
STUART S. LEVY, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Jody W. Miles (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision rejecting claims 5-9. Claims 1-4, the only other claims pending in the Application, stand allowed. We have jurisdiction over this appeal under 35 U.S.C. § 6.

Appellant invented a drywall sanding device comprising a V-shaped sanding pad for sanding corners of sheetrock, drywall, and the like (Specification 1). Claim 5 is illustrative of the invention and reads as follows:

5. A drywall sanding device for sanding drywall comers, comprising:

a V-shaped carrier that includes first and second support surfaces which lie in different planes and form an angle such that together the first and second support surfaces form a V-shape;

a V-shaped sanding pad having first and second outer sanding surfaces which lie in different planes and form an angle such that together the first and second sanding surfaces form a V-shape and a V-shaped back for attaching to the V-shaped first and second support surfaces of the carrier, the V-shaped back having first and second back surfaces which lie in different planes and form an angle such that together the first and second back surfaces form a V-shape;

hook and loop fasteners associated with the drywall sanding device for securing the V-shaped sanding pad to the V-shaped support surfaces of the carrier; and

wherein the hook fasteners are secured to one of the carrier or sanding pad and the loop fasteners are secured on the other one of the carrier or sanding pad such that when the V-shaped support surfaces of the carrier and V-shaped sanding pad are brought together, the hook and loop fasteners secure the sanding pad to the carrier.

The Examiner relies upon the following as evidence of unpatentability:

Sims	US 3,713,744	Jan. 30, 1973
Hurst	US 5,056,265	Oct. 15, 1991
Matechuk	US 5,605,500	Feb. 25, 1997
Evensen	US 5,921,854	Jul. 13, 1999
Carter	US 6,106,370	Aug. 22, 2000
Takizawa	US 6,186,878 B1	Feb. 13, 2001
Loveless	US 6,347,985 B1	Feb. 19, 2002
Nelson	US 6,524,173 B1	Feb. 25, 2003
Deware	US 6,648,737 B2	Nov. 18, 2003

Appellant seeks review of the Examiner's rejection of claim 7 under 35 U.S.C. § 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter Appellant regards as the invention;<sup>1</sup> rejection of claims 5-9 under 35 U.S.C. § 102(b) as anticipated by Sims, with Deware, Nelson, Carter, Evensen, and Hurst cited as evidence that Sims' steel wool pad is a "sanding pad" as recited in Appellant's claim 5; and rejection of claims 5-9 as unpatentable over Matechuk in view of any of Loveless, Takizawa, and Sims.

The Examiner provides reasoning in support of the rejections in the Final Rejection (mailed July 13, 2005) and Answer (mailed March 22, 2006). Appellant presents opposing arguments in the Brief (filed December 22, 2005) and Reply Brief (filed May 24, 2006).

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<sup>1</sup> Although the Examiner does not restate the indefiniteness rejection in the Answer, the Examiner's agreement (Answer 2) with Appellant's statement of the grounds of rejection to be reviewed (Br. 3) indicates the Examiner's intent to maintain the rejection.

## OPINION

The first issue before us is whether dependent claim 7 is indefinite. The Examiner contends that claim 7 appears to be directed to a method of assembly or forming the drywall sanding device and thus does not further limit the claim from which it depends, namely, claim 5, which is directed to a drywall sanding device (Final Rejection 2). Appellant, on the other hand, points out that claim 7 does not recite any steps of assembling and contends that claim 7 specifies that the sanding pad is V-shaped and that the V-shaped configuration of the sanding pad is not dependent on the support structure or carrier (Br. 12).

The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *See In re Warmerdam*, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). In determining whether this standard is met, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. *In re Johnson*, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

The claim language at issue in claim 7 is “wherein the V-shaped sanding pad is configured to assume the V-shape and assumes the V-shape prior to being secured to the V-shaped carrier.” Appellant’s Specification describes the sanding pad 12 as assuming “a generally V-shape” and as being “reinforced along the central area thereof” by a reinforcing corner member 46 of “a V-shaped or L-shaped configuration” secured by glue, adhesive, or other suitable means, to the interior corner 44 of the pad

(Specification 3:2-17). One skilled in the art would understand from this description, and the illustration in Fig. 1, that Appellant's sanding pad 12, reinforced by the reinforcing corner member 46, is stable in its V-shaped configuration and, thus, will maintain the V-shape regardless of whether it is secured to or separated from the V-shaped carrier. Consistent with that description in the Specification, a person possessing the ordinary level of skill in the art would understand claim 7 to be directed to the structure of the sanding pad, not a method of assembling the sanding device, as contended by the Examiner. Specifically, in light of Appellant's Specification, such a person would interpret the language at issue in claim 7 as defining the sanding pad as stable in its V-shape, regardless of whether it is secured to the V-shaped carrier. The rejection of claim 7 under 35 U.S.C. § 112, second paragraph, is reversed.

The second issue presented to us is whether Sims' steel wool pad is a "sanding pad" as called for in Appellant's claim 5. Appellant argues, in essence, that Sims discloses use of the device and included pad for cleaning, polishing, and waxing floors and walls, not for sanding or abrading the walls, and that, consequently, the Examiner has erred in reading the "sanding pad" of claim 5 on Sims' steel wool pad (Br. 4-7). Appellant also complains that the Examiner has erred in failing to explicitly construe the term "sanding pad" on the record (Br. 4, 7-8). Appellant further argues that the preamble language "drywall sanding device" recites essential structure necessary to give life, meaning, and vitality to claim 5 (Br. 8). The Examiner cites several references to support the Examiner's position that the steel wool pad of Sims meets the structural definition of a "sanding pad" (Answer 3). In response, Appellant argues that the Examiner's rejection of

claims 5-9 over multiple references under 35 U.S.C. § 102(b) is improper because the Examiner uses the secondary references to expand on the meaning of the term “steel wool” (Reply Br. 1-3).

Appellant may be technically correct that the Examiner has not expressly construed the claim terminology “sanding pad” on the record.<sup>2</sup> Implicit in the Examiner’s rejection, however, is a construction of “sanding pad” as being a pad having a surface recognized in the sanding art for use in sanding or abrading surfaces. In any event, such a construction is consistent with Appellant’s Specification. We therefore construe “sanding pad” in Appellant’s claim 1 as a pad having a surface recognized in the sanding art for use in sanding or abrading surfaces. The preamble language “drywall sanding device” further limits the claimed subject matter to devices that are capable of use in sanding drywall.

Appellant’s characterization of the Examiner’s use of the secondary references is not accurate. The Examiner clearly uses Deware, Nelson, Carter, Evensen, and Hurst, the secondary references cited in the statement of the rejection, as well as several other references cited on page 5 of the Answer, as evidence that “steel wool” is inherently capable of use as a sanding surface and recognized as such by those of skill in the art. Consequently, according to the Examiner (Answer 3, 5), Sims’ steel wool pad 88 (Sims, col. 3, ll. 40-41; col. 5, l. 13) meets the “sanding pad” limitation of claim 5. The secondary references are not used by the

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<sup>2</sup> It is noteworthy that Appellant has not offered a definition for the claim terminology “sanding pad,” either in the Specification or in the Brief or Reply Brief.

Examiner in support of any proposed modification to Sims to meet the claim language.

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.

*Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The Examiner's use of the secondary references as extrinsic evidence that steel wool is inherently capable of use in sanding and would be so recognized by persons of ordinary skill in the art is thus appropriate in the rejection of claims 5-9 as anticipated by Sims.

Moreover, we find that the secondary references cited by the Examiner do evidence that steel wool is recognized by persons of ordinary skill in the sanding art for use as a sanding surface for sanding many different types of surfaces (Deware, col. 1, ll. 16-17, col. 2, ll. 63-67; Evensen, col. 1, ll. 18-19, col. 6, ll. 11-19; Carter, col. 1, ll. 16-17). We therefore conclude that Sims' V-shaped steel wool pad 88 meets the "sanding pad" limitation of claim 5 and that Sims' cleaning, polishing, and waxing device, which is capable of sanding drywall surfaces by virtue of the abrasive steel wool pad, is a "drywall sanding device" as recited in the preamble of claim 5.

We appreciate that Sims does not expressly disclose use of the device for sanding, but claim 5 is directed to a device, not a method of using the device. The recitation of an intended use for an old product does not make a

claim to that old product patentable. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Anticipation does not require that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983). Further, while anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977).

For the foregoing reasons, Appellant has not demonstrated the Examiner erred in rejecting claim 5 as anticipated by Sims, citing Deware, Nelson, Carter, Evensen, and Hurst as extrinsic evidence that steel wool is an art-recognized sanding surface. The rejection of claim 5, as well as claims 6 and 8, which Appellant has not argued separately from claim 5, as anticipated by Sims is sustained.

The third issue presented to us is whether Sims' V-shaped pad 88 meets the limitation in claim 7 that the V-shaped sanding pad "assumes the V-shape prior to being secured to the V-shaped carrier" (Br. 8-9). While Sims clearly illustrates the removable pad 88 (Figs. 8 and 9) assuming a V-shape when secured to V-shaped auxiliary tool 86, Sims gives no indication as to whether pad 88 is stable in its V-shape when not secured to auxiliary tool 86. Therefore, to conclude that pad 88 is stable in its V-shape when not secured to auxiliary tool 86, as required by claim 7, and claim 9 depending from claim 7, would require speculation. As discussed above in our reversal of the indefiniteness rejection of claim 7, the Examiner erred in dismissing

the language of claim 7 as being directed to the method of assembly of the device and not a structural limitation of the claim (Answer 7). The rejection of claims 7 and 9 as anticipated by Sims is grounded in part on this erroneous determination and thus must also be reversed.

The fourth issue before us is whether the Examiner erred in rejecting claims 5-9 as unpatentable over Matechuk in view of any of Loveless, Takizawa, and Sims. More specifically, the issue raised by Appellant is whether it would have been obvious to replace the attachment means of Matechuk's sanding block 10 to either the carrier 20 or the attachment body 46 with a hook and loop fastening arrangement to arrive at the invention recited in Appellant's claim 5 (Br. 10-11). The Examiner contends that it would have been obvious to modify Matechuk "with hook and loop connection as taught by anyone of Loveless, [Takizawa] or Sims in adapting the tool with a simple, easy and fast means of detachably securing the pad, so that it may be replaced when worn out" (Answer 4).

As pointed out by Appellant (Br. 10), the Examiner has not adequately explained which securement, the securement of Matechuk's sanding block 10 to carrier 20 or the securement of sanding block 10 to attachment body 46, the Examiner proposes to replace with a hook and loop fastening. Furthermore, as also pointed out by Appellant (Br. 10-11), the Examiner has not provided any evidence or rationale to support the position that a hook and loop type fastening arrangement would have been an easier or faster means for attaching a sanding pad 10 to Matechuk's carrier 20 than Matechuk's self-aligning system of inserting carrier 20 into recess 26 of sanding pad 10 (Matechuk, col. 3, ll. 50-69 and Fig. 1). Accordingly, absent hindsight gleaned from Appellant's disclosure, it is not apparent why one of

ordinary skill in the art would have been motivated to replace the seemingly simple and self-aligning securement arrangement of Matechuk's pad 10 to carrier 20 with a hook and loop fastening arrangement. Likewise, for the reasons cited by Appellant (Br. 10), a hook and loop securement would not have been an obvious replacement for or accompaniment to either the frictional engagement between resilient sanding block 10 and end portions 50 of attachment body 46 under pressure caused by the block's resilience (Matechuk, col. 4, ll. 39-58) or the air-tight seal formed by butting of front edges of side walls 54 of central portion 48 of attachment body 46 against the resilient hypotenuse surface 18 of block 10 (Matechuk, col. 4, ll. 59-66). Matechuk utilizes the resilience of the sanding block 10 to advantage in creating a rectangular, air-tight, air receiving plenum chamber for the vacuum attachment of the sanding device and hook and loop fasteners would not appear to facilitate, and in fact would appear to hinder, such an arrangement.

In light of the above, we conclude that the Examiner erred in rejecting claim 5, and claims 6-9 depending from claim 5, as unpatentable over Matechuk in view of any of Loveless, Takizawa, and Sims. The rejection is reversed.

Appeal 2006-2714  
Application 10/228,898

### SUMMARY

The rejections of claim 7 under 35 U.S.C. § 112, second paragraph, and claims 5-9 as unpatentable over Matechuk in view of any of Loveless, Takizawa, and Sims are reversed. The rejection of claims 5-9 as anticipated by Sims is affirmed as to claims 5, 6, and 8 and reversed as to claims 7 and 9.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

### AFFIRMED-IN-PART

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