

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-3370
Application No. 10/444,736

ON BRIEF

Before THOMAS, RUGGIERO, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 5-7, and 9-12, which are all the claims remaining in the application.

We affirm.

BACKGROUND

The invention relates to a tool for placing furring strips during construction.

Representative claims 1 and 7 are reproduced below.

1. A precision strapping device comprising:

an elongated body member having a first end, a second end and a middle portion;

wherein said first end of said elongated body has an abutment shoulder;

wherein said abutment shoulder has a first arm extending perpendicular to said longitudinal direction of said elongated body member;

wherein said abutment shoulder has a second arm extending half a width of a standard furring strip in a same longitudinal direction of said elongated body member beyond said first arm of said abutment shoulder;

wherein said second end has a cradle having a middle point, a primary arm, and a secondary arm;

said primary arm and said secondary arm extend perpendicular to said longitudinal direction of said elongated member

wherein a distance between said middle point of said cradle and the end of said second arm of said abutment shoulder is equal to a standard distance between standard furring strips;

wherein a distance between said primary and said secondary arm of said cradle is equal to said distance of said standard furring strip.

7. Device of claim 1 wherein:

said elongated body has a handle extending perpendicular to said longitudinal direction of said elongated body.

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The examiner relies on the following references:

Jondole	US 2,744,334	May 8, 1956
Williams	US 4,237,614	Dec. 9, 1980
Payne	US 5,490,334	Feb. 13, 1996

I. Claims 1, 5-7, 9, 11, and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Payne and Williams.

II. Claims 7, 9, and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Payne, Williams, and Jondole.

We refer to the Final Rejection (mailed Jul. 14, 2004) and the Examiner's Answer (mailed Dec. 9, 2005) for a statement of the examiner's position and to the Brief (filed Aug. 17, 2005) for appellant's position with respect to the claims which stand rejected.

OPINION

At the outset, we observe that instant claim 1 (with claims 5-7, 9, and 10 depending) could have been rejected under 35 U.S.C. § 112, second paragraph as being indefinite, in that "said distance of said standard furring strip" lacks proper antecedent basis in the claim. The error appears to have been introduced by an amendment filed June 1, 2004, in which appellant changed the claim 1 recitation of "half a distance of a standard furring strip" to "half a width of a standard furring strip," without changing the last occurrence of "said distance" in the claim. In this decision on appeal, however, we will consider all of, but only, the arguments that appellant provides in

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support of the position that the examiner has erred in the applied rejections over the prior art.

Further, for reasons that are not apparent in this record, appellant seems to use the terms “furring strip” and “furring strap” interchangeably in the written description and in the claims. For example, instant claim 11 recites “placing a proximal furring strip within said cradle” in one line, and in the next recites “securing said proximal furring strap [sic] onto support structure,” which would appear to raise another issue regarding lack of antecedent basis in the claims. For the purposes of this appeal, we will assume that “furring strip” and “furring strap” are synonymous, but we will refer to the structure by the commonly accepted term of “furring strip.”

In response to the rejection of claims 1, 5-7, 9, 11, and 12 under 35 U.S.C. § 103 as being unpatentable over Payne and Williams, appellant begins (Brief at 5-6) by contesting the examiner’s finding that the top flanges of the Payne device as depicted in the drawings meet the requirements of a “handle” as claimed. Appellant does not allege error in the finding of a motivation to combine the references¹ ; i.e., that the artisan would have been motivated to apply the standard furring strip dimensions as taught by Williams to the orthogonal framing tool as taught by Payne.

¹ The presence or absence of a motivation to combine references in an obviousness determination is a pure question of fact. In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

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Appellant's general argument concerning the "handle," in the claims that are rejected over Payne and Williams, only corresponds to the requirements of dependent claim 7. Claim 7 also stands rejected over Payne, Williams, and Jondole, in the second ground of rejection. Jondole teaches a handle 27, even if we were to find that Payne fails to teach a handle.

In any event, we agree with the examiner that the topmost flanges of the Payne tool, as shown in Figures 3 and 4, is a handle for all that claim 7 requires. We disagree with appellant's assessment (Brief at 6) that Figures 1 and 2 of Payne show the operator's hands wrapped entirely around the elongated body member, and not utilizing the "top flanges" in any manner whatsoever. In view of the examiner's reading of the claims on the Payne device, the operator's hands in Figures 1 and 2 of the reference do not contact the recessed portions of the elongated body member, but contact the flanges that extend perpendicular to the longitudinal direction of the elongated body, the flanges being consistent with the structural requirements of instant claim 7.

Appellant's only additional argument in response to the first ground of rejection is that both Payne and Williams disclose tools that require a predecessor member (e.g., an existing stud or furring strip) while appellant's invention does not. Although appellant submits this to be an "important structural aspect" of the invention (Brief at 7-8), the device set forth by representative claim 1 is silent with respect to the existence or non-existence of predecessor members. Appellant does not point out, in response to the

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examiner's rejection, language that might be thought to limit the scope of the claims to the argued feature.

The claims measure the invention. SRI Int'l v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (en banc). We conclude that appellant's argument is based on an unclaimed feature, and thus not relevant in the determination of whether a prima facie case of obviousness has been established with respect to representative claim 1.

With respect to the second ground of rejection, appellant argues that the dimension of eight inches is critical in instant claim 10, which specifies dimensions of the handle set forth by claim 7. For support, appellant refers to the instant specification (at 4, ll. 13-15), which recites that "exact lengths are essential to the invention."

We find that the specification does state that "[t]he exact lengths are essential to the invention" at the noted section, but that the "exact lengths" are not referring to the handle dimensions. Appellant has not demonstrated error in the conclusion of prima facie obviousness of the subject matter of representative claim 10, nor shown any criticality with respect to handle dimensions.

We have considered all of appellant's arguments but are not persuaded of error in the rejections. We therefore sustain the rejection of claims 1, 5-7, 9, 11, and 12 under 35 U.S.C. § 103 as being unpatentable over Payne and Williams and the rejection of claims 7, 9, and 10 under 35 U.S.C. § 103 as being unpatentable over Payne, Williams, and Jondole.

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CONCLUSION

The rejection of claims 1, 5-7, and 9-12 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). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

JAMES D. THOMAS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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