

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 MARK W. THOMPSON

Appeal 2007-1167
Application 10/784,056
Technology Center 3700

Decided: 25 July 2007

Before TEDDY S. GRON and CAROL A. SPIEGEL, *Administrative Patent Judges*, and FRED E. McKELVEY, *Senior Administrative Patent Judge*.

GRON, *Administrative Patent Judge*.

DECISION ON APPEAL

Introduction

This is a decision on appeal under 35 U.S.C. § 134 from an Examiner's final rejection of Claims 1-9, 11-14, and 16 of Application 10/784,056, filed February 20, 2004. Claims 1 and 2 stand rejected under 35

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U.S.C. § 102(b) as described by Watkins, U.S. Patent 6,324,765, patented December 4, 2001. Claims 1, 3-9, 11-14, and 16 stand rejected under 35 U.S.C. § 103(a) as unpatentable in view of the combined teachings of Blevins, U.S. Patent 6,327,782, patented December 11, 2001, Wright, U.S. Patent 5,107,665, patented April 28, 1992, and Bridgers, U.S. Design Patent 373,712, patented September 17, 1996. The claims on appeal are the only claims pending in this application. Claims 2-5 depend on independent Claim 1. Claims 7-9 and 16 depend on independent Claim 6. Claims 12-14 depend on independent Claim 11.

Not having been argued separately from their respective independent claims, dependent Claims 2-5 stand or fall with Claim 1, dependent Claims 7-9 and 16 stand or fall with Claim 6, and dependent Claims 12-14 stand or fall with Claim 11. Therefore, we decide this appeal on the basis of independent Claims 1, 6, and 11. 37 CFR § 41.37(c)(1)(vii) (2006).

Independent Claims 1, 6, and 11 are transcribed below (Br. App. A):

1. A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end, comprising:
 - a releasable clamp slidably connected to the shaft;
 - a support member slidably connected within the releasable clamp; and

a guard member connected to and extending outwardly from a second end of the support member to deflect grass clippings projected from the head of the grass trimming device.

6. A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end, comprising:

a releasable clamp slidably connected to the shaft;

a support member slidably connected within the releasable clamp;

a flexible brush member connected to and extending outwardly from a second end of the support member to deflect grass clippings projected from the head; and

a means for adjusting the distance between the guard member and the shaft of the grass trimming device;

wherein the flexible brush member is positioned at a 90 degree angle to the shaft.

11. A guard for a grass trimming device having a shaft with a head at one end and a handle at the opposite end, comprising:

a support member connected to the shaft at a first end of the support member;

a flexible brush member connected to a second end of the support member to deflect grass clippings projected from the head; and

wherein the flexible brush member is positioned at a 90° angle to the shaft.

In deciding this appeal, we have considered the following: (1) the Final Rejection, mailed September 20, 2005, (2) the Appeal Brief, filed

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March 3, 2006, (3) the Examiner's Answer, mailed April 20, 2006, and (4) the Reply Brief, filed May 15, 2006. We have also studied Applicant's Specification and Drawings and the disclosures of Watkins, U.S. Patent 6,324,765, Blevins, U.S. Patent 6,327,782, Wright, U.S. Patent 5,107,665, and Bridgers, U.S. Design Patent 373,712.

Discussion

Claim Construction

A rejection of claimed subject matter under 35 U.S.C. § 102/103 should not be based upon speculation and assumptions as to the scope of the claims. *In re Steele*, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). Accordingly, we determine first the scope and content of the claimed subject matter in order to completely explore the relationship of the invention Applicant claims to the prior art.

“During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.” *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). “The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.” *Id.* “An essential purpose during patent examination is to fashion claims that are precise, clear, correct, and unambiguous.” *Id.* at 322, 13

USPQ2d at 1322. “Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.” *Id.*

Both Claims 1 and 6 require “a support member slidably connected within the releasable clamp” (Br. App. A). The key word is “within.” This term is not defined in Applicant’s specification. Thus, it must be given the broadest reasonable interpretation consistent with Applicant’s specification. “[I]n proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification.” *In re Sneed*, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

Applicant’s specification discloses the use of “a releasable clamp **22** that wraps around the shaft **14** and is tightened to lock the support member **20** in place at a desired location on the shaft” (Spec., p. 3). Applicant’s Figure 1 appears to show that the support member **20** is connected within an appendage of the releasable clamp **22** (Spec., Fig. 1). Thus, the broadest reasonable interpretation consistent with the specification is that the phrase “within the releasable clamp” means within the clamp or within any appendage thereto.

35 U.S.C. § 102(b) Rejections

“For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of a claimed invention must be identically shown in a single reference.” *In re Bond*, 910 F.2d 831, 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). Anticipation can be found when a claim limitation is inherent or otherwise implicit in the relevant reference. *Standard Havens Products, Inc. v. Gencor Industries, Inc.*, 953 F.2d 1360, 1369, 21 USPQ2d 1321, 1328 (Fed. Cir. 1991). To affirm the Examiner’s § 102(b) rejection in this case, we must find that Watkins describes each and every element of the subject matter defined by Applicant’s Claim 1, either explicitly or implicitly.

Claims 1 and 2 stand rejected as anticipated by Watkins. Claim 1 is directed to a guard having (1) a releasable clamp slidably connected to the shaft of a grass trimming device, (2) a support member slidably connected within the clamp, and (3) a guard member connected to and extending outwardly from the support member (Br. App. A). Watkins contains a releasable clamp slidably connected to the shaft of a grass trimming device (Watkins’ clamp **5**) and a guard member (Watkins’ protector plate **19**) connected to a support member. Appellant argues that Watkins does not

describe a support member slidably connected *within* the releasable clamp (Appeal Br., p. 4). Claim 1 requires “a support member slidably connected within the releasable clamp” (Br. App. A).

However, Appellant concedes that Watkins discloses “an inner arm section **13** that is *slidably received within* the telescoping arm **4**” (Appeal Br., p. 4; emphasis added). Nevertheless, Appellant argues, “the connection between clamp **5** and the telescoping member **4** is rigid,” and “the inner arm **13** does not slide within clamp **5**,” it slides within telescoping arm **4** (Appeal Br., p. 4). Appellant asserts that Watkins’ inner arm **13** does not describe the support member of Claim 1 because Watkins’ inner arm **13** is slidably received within telescoping arm **4** rather than clamp **5**, and, additionally, the combination of inner arm **13** and telescoping arm **4** does not describe the support member of Claim 1 because telescoping arm **4** is rigidly attached to clamp **5** rather than being slidable within clamp **5**.

In contrast, the Examiner states that “the clamp of Watkins consists of both parts ([telescoping arm] **4** and [clamp] **5**) because they are rigidly attached” (Answer, p. 4). “Therefore, the support (**13**) is slidably connected within the clamp (**4** and **5**)” (Answer, pp. 4-5). The Examiner finds that telescoping arm **4** is rigidly attached to clamp **5** and an appendage of clamp **5**. Because inner arm **13** is slidably received within outer arm **16** of

telescoping arm **4**, and outer arm **16** is an appendage of clamp **5**, inner arm **13** is slidably received within clamp **5**.

The broadest reasonable interpretation of the claim language consistent with Applicant's specification is consistent with the Examiner's finding. Applicant's Figure 1 appears to show a support member **20** slidably received within an appendage of releasable clamp **22** (Spec., Fig. 1).

Watkins also contains a support member (inner arm **13**) that is slidably received within an appendage (outer arm **16** of telescoping arm **4**) of a releasable clamp (clamp **5**). Accordingly, we find that Watkins reasonably describes each and every claim limitation in Applicant's Claim 1 and the claimed subject matter as a whole.

35 U.S.C. § 103(a) Rejections

To establish the obviousness of the claimed subject matter, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Claims 1, 6, 11, and claims dependent thereon, stand rejected as obvious over Blevins, Wright, and Bridgers. Blevins discloses a flexible

brush guard and a releasable clamp slidably connected to the shaft of a grass trimming device (Blevins, col. 2, ll. 39-50; col. 3, ll. 47-51). Wright discloses a support member slidably connected within a clamp connected to the shaft of a grass trimming device (Wright, col. 6, ll. 5-31). Bridgers concerns aspects of dependent Claims 3, 8, and 14 that we need discuss in reaching our decision.

Appellant argues that the prior art fails to meet two limitations. First, Appellant argues that the prior art fails to disclose “a support member slidably connected within the releasable clamp” as required by Claims 1 and 6 (Br. App. A). Second, Appellant argues that the prior art fails to disclose that “the flexible brush member is positioned at a 90 degree angle to the shaft” as required by Claims 6 and 11 (Br. App. A).

First, we address whether the prior art discloses “a support member slidably connected within the releasable clamp” as required by Claims 1 and 6 (Br. App. A). Wright discloses a spatial guide **20** (support member) that slides within a pair of bolts **62** and a rigid block **28** (clamp) (Wright, col. 6, ll. 5-16). The rigid block can be adjusted to slide up and down the shaft of a weed trimming device. Appellant argues that “the device **20** however does not slide within the rigid block **28** and instead slides on bolts **62** that are attached to rigid block **28**” (Br., p. 9). Appellant, however, does not take

into account the broadest reasonable interpretation of the word “within” that is consistent with Applicant’s own specification. As previously stated, “support member slidably connected within the releasable clamp” encompasses a support member that is slidably connected within an appendage of a clamp. Here, the support member (spatial guide **20**) lies within an appendage (pair of bolts **62**) and the clamp (rigid block **28**).

Second, we address whether the prior art discloses that “the flexible brush member is positioned at a 90 degree angle to the shaft” as required by Claims 6 and 11 (Br. App. A). Blevins discloses that its brush member “may be mounted on handle **36** by suitable bracket means **39** as shown by the dotted outline in FIG. 1” (Blevins, col. 3, ll. 49-51). Blevins’ Figure 1 appears to show the brush member mounted at a 90 degree angle to the shaft. Drawings are evaluated “on the basis of what they reasonably disclose or suggest to one skilled in the art.” *In re Aslanian*, 590 F.2d 911, 914, 200 USPQ 500, 503 (CCPA 1979). Appellant argues that, in Blevins, “the brush member itself is not at a 90 degree angle to the shaft” (Br., p. 10). However, Claims 6 and 11 do not state that the brush bristles must be 90 degrees to the shaft; they state that the brush member must be 90 degrees to the shaft. Thus, under the broadest reasonable interpretation of “brush member,” Blevins’ Figure 1 appears to show a brush member positioned at a 90 degree

angle to the shaft. Accordingly, each claim limitation is taught by the prior art.

“Section 103 forbids issuance of a patent when the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which [the] subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). “If a person of ordinary skill in the art can implement a predictable variation, and would likely see the benefits of doing so, § 103 likely bars its patentability.” *Id* at 1740, 82 USPQ2d at 1396. Moreover, “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond that person’s skill.” *Id*.

Appellant argues that there is no motivation to combine the prior art references, stating (Br., p. 7):

At best the prior art suggests two separate ways of moving an implement that is attached to a shaft of a weed trimmer. The prior art does not teach or contemplate having two different adjusting means associated with a single weed trimming device. The only way based on the teachings of the prior art, to arrive at the claimed invention, is to use the claim as a frame, taking individual, naked parts of separate

prior art references were employed as a mosaic to recreate a facsimile of the claimed invention.

The motivation or incentive to combine Blevins with Wright is provided by their similar uses. Both devices provide a means for guarding weed trimming devices from other objects. Blevins discloses a guard with a clamp that is movable up and down the shaft of a weed trimmer, but the guard is unable to move perpendicular to the shaft. Thus, the device in Blevins can only guard the weed trimmer at one distance. Wright discloses a guard with a clamp that is movable both along the shaft of a weed trimmer, and the guard has a spatial guide that allows movement perpendicular to the shaft of the weed trimmer. The perpendicular movement allowed by the spatial guide in Wright solves the problem that Blevins can only guard at one distance.

Furthermore, Blevins discloses that its guard “may be mounted on handle **36** by suitable bracket means **39**” (Blevins, col. 3, ll. 49-50). However, without the ability to move the guard perpendicular to the shaft of the weed trimming device, the guard would not be useful at other positions along the shaft. The spatial guide in Wright solves this problem by allowing the guard to be adjusted to different positions as the bracket is repositioned up and down the shaft.

“Common sense teaches ... that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. at 1742, 82 USPQ2d at 1397. “[W]hen a patent claims a structure already known in the prior art that is altered by mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id* at 1740, 82 USPQ2d at 1395. Accordingly, it would have been obvious to one of ordinary skill in the art, at the time Applicant’s invention was made, to combine Wright’s spatial guide with Sheldon’s weed trimmer guard.

Conclusion

Having considered all the evidence of record for and against the patentability of Claims 1-2 of Application 10/784,056 under 35 U.S.C. § 102(b) and Claims 1, 3-9, 11-14, and 16 under 35 U.S.C. § 103(a), we affirm all the appealed final rejections.

Order

Upon consideration of the appeal, and for the reasons given, it is ORDERED that the decisions of the Examiner rejecting Claims 1-2 of Application 10/784,056 under 35 U.S.C. § 102(b) and rejecting Claims 1, 3-9, 11-14, and 16 under 35 U.S.C. § 103(a) are affirmed; and

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FURTHER ORDERED that the time for taking future action in this appeal cannot be extended under 37 CFR § 1.136(a)(2006).

AFFIRMED

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