

The opinion in support of the decision being entered today  
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* MARCO LANG, STEFANO MONZANI, and FRANC KOLJAKA

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Appeal 2007-1195  
Application 10/381,340  
Technology Center 3700

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Decided: September 25, 2007

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Before WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and DAVID B. WALKER, *Administrative Patent Judges*.

PATE, III, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Marco Lang *et al.* (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-5 and 7, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appeal 2007-1195  
Application 10/381,340

The Appellants' claimed invention is to a flat chisel for working stone (Specification 1:3-6). The object of the invention is to develop a flat chisel that has a low tendency to jam in the stone being worked (Specification 1:19-21). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An insertion chisel for power-driven hammers for working stone comprising:

a chisel head having a main lip disposed transversely to a chisel longitudinal axis, a front and a rear striking face, and at least one side face connecting the striking faces; and

a shank attached to the chisel head having means for attaching the insertion chisel to a power-driven hammer;

wherein the side face includes a side lip and the side lip prevents the tendency of the insertion chisel to jam in the stone while the power-driven hammer causes the insertion chisel to work the stone.

## THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Jenny	EP 0 497 307 A2	Aug. 5, 1992
Hauptmann (as translated) <sup>1</sup>	EP 0 925 881 A1	Jun. 30, 1999

The following rejections are before us for review:

1. Claims 1-3, 5 and 7 stand rejected under 35 U.S.C. § 102(b) as anticipated by Jenny.

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<sup>1</sup> The Examiner refers to the Hauptman disclosure as Batliner throughout.

2. Claim 4 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Jenny in view of Hauptmann.

## ISSUES

The Appellants contend that the claimed side lip must be interpreted to necessarily including a cutting edge, and using this interpretation, Jenny does not disclose a side lip as claimed, because Jenny does not teach a cutting or sharp edge present on a longitudinal side of the working portion of the tool (Appeal Br. 5-6).

The Appellants further contend that Jenny does not teach an insertion chisel wherein the main lip and side lip have cutting edges which lie in a common plane, as recited in claim 3 (Appeal Br. 7). The Appellants further contend that the combination of Jenny and Hauptmann does not render obvious the subject matter of claim 4, because the combination does not disclose a side lip having a cutting edge, and because the Examiner provides no motivation to combine Jenny with Hauptmann (Appeal Br. 11).

The Examiner found that Figures 1 and 2 of Jenny “clearly show side cutting edges of the blade 1” and because a blade is the cutting part of an instrument, “the blade 1 of Jenny is determined to have a main cutting edge 2 and two side cutting edges as the cutting part of the chisel” (Answer 4). The Examiner further found that “Fig. 1 and 2 of Jenny clearly show the main cutting edge 2 and two side cutting edges lie on a common plane” (*Id.*). Finally, the Examiner determined that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the chisel head of Jenny with a side lip having a

Appeal 2007-1195  
Application 10/381,340

gable-shape in cross section as disclosed by Hauptmann in order to increase ripping power of the chisel” (*Id.*).

The issue before us is whether the examiner erred in rejecting the claimed subject matter under §§ 102 and 103.

#### FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427, 7 USPQ2d 1152, 1156 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Jenny discloses a chisel for a power hammer comprising a head 1, having a main lip 2, disposed transversely to a chisel longitudinal axis, a front and rear striking faces, one side connecting the striking faces, and a shank 3 attached to the chisel head 1 having a means for attaching the chisel to a power driven hammer. Jenny also discloses a side lip on the side face wherein the side lip merges with the front lip.

The Examiner states that the side lips of Jenny having cutting edges thereon. The Examiner has provided a drawing purporting to illustrate the cutting edges. We agree that this drawing is one possible configuration of the tool of Jenny which is shown only in elevation, e.g., Figure 1, and plan, e.g., Figure 2. However, the Appellant has provided two other interpretations of the shape of the tool of Jenny equally consistent with the Figures of Jenny. The burden of proof with respect to the Examiner’s rejection is by a preponderance of the evidence. In order to satisfy

Appeal 2007-1195  
Application 10/381,340

this standard, the evidence must demonstrate that it is more likely than not that the alleged fact is the case. *See Bosies v. Benedict*, 27 F.3d 539, 541-42, 30 USPQ2d 1862, 1864 (Fed. Cir. 1994) (the preponderance of the evidence standard requires the finder of fact to believe that the existence of a fact is more probable than its nonexistence). In this instance it is impossible to know the shape of Jenny to a preponderance of the evidence, and thus the Examiner has failed to sustain his burden of proof with respect to *cutting edges*.

Claims 1, 3, and 4 are argued separately. Claims 2, 5 and 7 fall with claim 1.

## ANALYSIS

Turning first to the scope of claim 1, we note that Appellants argue that Jenny does not disclose a side lip with a cutting edge. However, this argument is not commensurate in scope with the claimed subject matter in that the side lips as recited in claim 1 are not required to possess cutting edges in the claim. The argument in the Brief at page 5 is merely an attempt to import material from the specification into the independent claim on appeal. While we agree with Appellants' argument that the Examiner has not shown by a preponderance of the evidence that Jenny discloses side lips *with cutting edges*, claim 1 does not so require and thus is seen to lack novelty over the Jenny reference, as do claims 2, 5 and 7. The rejection of claim 3 on the lack of novelty ground is reversed, inasmuch as claim 3 actually requires cutting edges.

With respect to claim 4, we are in agreement with the Appellants that the Examiner has articulated no reason why one of ordinary skill would have used the

Appeal 2007-1195  
Application 10/381,340

gable-shaped side lip disclosed by Hauptmann on the chisel of Jenny. The Examiner merely states a conclusion that the motivation to combine is found in the knowledge available to one of ordinary skill. This statement is devoid of any explanation or detail as to obviousness.

#### CONCLUSIONS OF LAW AND ORDER

We conclude that the examiner has established that claims 1, 2, 5, and 7 lack novelty over the Jenny reference. The rejection of these claims is affirmed. The rejections of claims 3 and 4 under §§ 102 and 103, respectively, are not affirmed.

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) (2006).

AFFIRMED-IN-PART

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