

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 WILLIAM R. GIESE

Appeal 2007-1212
Application 10/278,319
Technology Center 1725

Decided: April 30, 2007

Before EDWARD C. KIMLIN, CHUNG K. PAK, and PETER F. KRATZ,
Administrative Patent Judges.

KIMLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-9 and 28-45.

Claims 1, 29, 34, and 39 are illustrative:

1. A securing system for securing a welding implement neck to a threaded connector, the securing system comprising:

a retaining nut having a plurality of wrench-flat surfaces to enable the retaining nut to be tightened onto the threaded connector with a wrench; and

a hand operator adapted to be releasably-secured to the retaining nut preventing axial separation therebetween, and to enable the retaining nut to be tightened onto the threaded connector by hand, the hand operator further having an internal peripheral surface configured to engage with wrenched-flat surfaces to transfer torque applied to the hand operator to the retaining nut.

29. The securing system as recited in claim 28, wherein the inner and outer peripheral surfaces are generally non-deformable under manual actuation.

34. A securing system for securing a welding implement neck to a threaded connector, the securing system comprising:

a hand operator having an inner peripheral surface configured to at least partially circumscribe a wrench-actuatable retaining nut such that actuation of the hand operator transfers torque to the wrench-actuatable retaining nut to secure the wrench-actuatable retaining nut to the threaded connector, wherein the hand operator includes a resilient member cantilevered with respect to the inner peripheral surface and configured to selectively block separation of the hand operator with respect to the wrench-actuatable retaining nut.

39. A securing system for securing a welding implement neck to a threaded connector, the securing system comprising:

an operator configured to snap-fit with respect to a retaining nut, wherein the operator is configured to transfer torque to a retaining nut upon actuation of the operator to tighten the retaining nut with respect to the threaded connector, the operator having a plurality of walls that define peripheral surfaces of the operator, the plurality of walls being more rigid than a blocking member configured to block axial separation of the operator with respect to the retaining nut.

The Examiner relies upon the following references in the rejection of the appealed claims:

Espey	US 5,350,266	Sep. 27, 1994
Raloff	US 5,384,447	Jan. 24, 1995
Conway	US 6,713,711 B2	Mar. 30, 2004

Appellant's claimed invention is directed to a system for securing a welding implement neck to a threaded connector. The system comprises a retaining nut that is tightened onto the threaded connector and a hand operator or sleeve member secured to the retaining nut. The hand operator or sleeve allows the retaining nut to be tightened onto the connector by hand.

Appealed claims 34-45 stand rejected under 35 U.S.C. § 112, first paragraph, description requirement. Claims 34-45 also stand rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. Claims 1-4 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Raloff. Claims 39-41, 44, and 45 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Espey. In addition, the appealed claims stand rejected under 35 U.S.C. § 103(a) as follows:

- (a) claims 5 and 6 over Raloff in view of Conway,
- (b) claims 42 and 43 over Espey in view of Conway,
- (c) claims 7-9, 28-41, 44, and 45 over Raloff in view of Espey, and
- (d) claims 42 and 43 over Raloff in view of Espey and Conway.

In reaching our decision, we have thoroughly reviewed the arguments advanced by Appellant in the principal and Reply Briefs on appeal, as well as the Examiner's rationale and rebuttal to Appellant's arguments set forth in the Answer.

We will sustain the Examiner's § 112, first paragraph, rejection of claims 34-45 inasmuch as we fully concur with the Examiner that the claim recitations "a resilient member cantilevered with respect to the inner peripheral surface" (claim 34) and "the plurality of walls being more rigid than a blocking member" (claim 39) do not find original descriptive support in Appellant's Specification. Appellant has accepted the Examiner's dictionary definition of the term "cantilever" as "a projecting member supported at only one end," but Appellant has not rebutted the Examiner's analysis that Appellant's structure 78 "flexible fingers," although qualifying as the claimed projecting member, is supported at *both* ends and, therefore, is not cantilevered. Appellant erroneously states in the Reply Brief that "the Examiner has, in the contrary, pointed out the ability to recognize the claimed subject matter by suggesting a potential 'pivot point' located 'near the end of the line from which reference number 64 is directed in Figure 6'" (page 4, Reply Br., first para.). In fact, the relevant portion of the Answer reads "[i]t is also noted that each of the fingers does *not* have a pivot point at its base (near the end of the line from which reference number 64 is directed in Figure 6)" (page 12 of Answer, second para., emphases added). Appellant has simply not explained how his Specification or drawings clearly supports a resilient member cantilevered with respect to the inner peripheral surface of the hand operator 60.

We also agree with the Examiner that there is no original descriptive support for the claim 39 recitation of "a blocking member configured to block axial separation of the operator with respect to the retaining nut." The original Specification does not describe a blocking member and it is not

clear from the Specification drawings, particularly Figure 6, which feature or features the claim term is referring too. As explained by the Examiner, catch portion 82 of the resilient member might be considered a blocking member, as could securing groove 80 of retaining nut 50, surface 84 of the securing groove, as well as fingers 78 of the resilient member. In the absence of a clear indication in the original Specification of what constitutes the blocking member, we must agree with the Examiner that the breadth and scope of claim 39 is not originally described in appellant's Specification.

We will also sustain the Examiner's § 112, second paragraph, rejection of claims 34-45 for the reason that Appellant has not adequately explained how the resilient member is cantilevered with respect to the inner peripheral surface of the hand operator and, as set forth above, Appellant has not reasonably defined the scope of the blocking member of claim 39. In our view, the Examiner has raised reasonable questions regarding the ambiguity of claims 34 and 39. While Appellant maintains that an applicant can be his/her own lexicographer, this does not relieve an applicant of the duty to reasonably circumscribe the scope of the claims.

We will also sustain the Examiner's § 102 rejection of claims 1-4 over Raloff. Appellant contends that Raloff "does not disclose a hand operator 'adapted to be *releasably secured* to the retaining nut,' as recited in independent claim 1 (emphases added)" (page 16 of principal Br., first sentence). However, as explained by the Examiner, the outer element 70 can be, alternatively, molded as a separate piece onto inner element 68 and "secured thereto by means of a mechanical or chemical fastening system" (col. 7, ll. 16-18). Since a screw is a common mechanical fastening system

that is releasably securable, we agree with the Examiner that the reference reasonably describes a hand operator that is releasably-secured to the retaining nut. As set forth by the Examiner, one of ordinary skill in the art may select one of only two options, namely, a releasably-secured fastening system or a permanent one. We find that such a limited choice presents a fair description of both.

We will not sustain the Examiner's § 102 rejection of claims 39-41, 44, and 45 over Espey, or the § 103 rejections of claims 42 and 43, claims 7-9, 28-41, 44, and 45, and claims 42 and 43, all of which involve Espey. Espey, as acknowledged by the Examiner, is not directed to a system for securing the neck of a welding implement to a threaded connector but, rather, is directed to a nut and cap assembly wherein a plastic cap is used to provide protection and decoration for nuts and to guard against injury caused by the sharp edges of nuts. Espey discloses that "[t]his is particularly important in the case of nuts used on the front wheel fork shaft of a bicycle where the normally tubular shaft is journaled in a generally vertical sleeve forming part of the frame of the bicycle" (col. 1, ll. 21-24). The basis for the Examiner's rejection is the rationale that "there is no claim language that is specific to a 'welding' securing system in claim 39, only the 'intended use' of the securing system" (page 18 of answer, penultimate full sentence). However, we find that the claim 39 recitation "for securing a welding implement neck to a threaded connector," as well as similar language in the other independent claims, imparts a function to the claimed securing system that must be considered in the Examiner's rejections. The rejections employing Espey must include a finding that the cap and nut assembly of

Espey is at least capable of securing a welding implement neck to a threaded connector. Since the Examiner has made no such finding, the § 103 rejections based on Espey cannot stand.

Finally, we will sustain the Examiner's § 103 rejection of claims 5 and 6 over Raloff in view of Conway. Appellant has not rebutted the Examiner's legal conclusion that it would have been obvious for one of ordinary skill in the art to modify the securing system of Raloff by fabricating the hand operator out of a polymeric material including glass-filled nylon or glass-filled polycarbonate, as suggested by Conway, "in order to provide a non-conductive, light-weight, flexible and durable polymeric material for use as a hand tightening securing system" (page 7 of Answer, last para.). Appellant relies solely upon the purported deficiency of Raloff regarding the features of independent claim 1 discussed above.

In conclusion, based on the foregoing, the Examiner's rejections of claims 1-6 and 34-45 are sustained, whereas the Examiner's rejections of claims 7-9 and 28-33 are reversed. Consequently, the Examiner's decision rejecting the appealed claims is affirmed-in-part.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(iv)(effective Sept. 13, 2004).

AFFIRMED-IN-PART

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