

1 The opinion in support of the decision being entered  
2 today is *not* binding precedent of the Board.

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5 UNITED STATES PATENT AND TRADEMARK OFFICE

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8 BEFORE THE BOARD OF PATENT APPEALS  
9 AND INTERFERENCES

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12 *Ex parte* KEVIN J. GREEN

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15 Appeal No. 2007-2875  
16 Application No. 10/447,732  
17 Technology Center 3700

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20 Decided: September 19, 2007

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23 Before WILLIAM F. PATE, III, TERRY J. OWENS, and JOSEPH A.  
24 FISCHETTI, *Administrative Patent Judges*.

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26 PATE, III, *Administrative Patent Judge*.

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29 DECISION ON APPEAL

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32 STATEMENT OF THE CASE

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34 This is an appeal from the final rejection of claims 1-9 and 16-20. Claims  
35 10-15 stand withdrawn from consideration. We have jurisdiction under 35 U.S.C.  
36 §§ 134 and 6.



1 112, first paragraph; whether the Appellant has established that the Examiner erred  
2 in rejecting claims 1-4 under 35 U.S.C. § 102(b); and whether the Appellant has  
3 established that the Examiner erred in rejecting claims 5-9 and 16-20 under 35  
4 U.S.C. § 103.

#### 5 FINDINGS OF FACT

6 The following are our findings of fact with respect to the scope and content  
7 of the prior art and the differences between the prior art and the claimed subject  
8 matter. Grünbichler discloses a tamper-proof bolt. As shown in Figure 1,  
9 Grünbichler shows a permanent head portion 2, a threaded shaft section or shank 1  
10 and an engagement portion 6 located on the end of the shank portion. Grünbichler  
11 also discloses a torque head formed on the permanent clamping head of the  
12 fastener. The torque head 3 is supplied with a circular hole 5 that extends down  
13 through the torque head. As the fastener is tightened the torque head 3 detaches  
14 from the permanent head 2 leaving the permanent head which is shaped so as to  
15 prevent the permanent head from being tampered with or removed with pliers or  
16 the like. (Grünbichler, col. 3, ll. 11-25). When it is desired to remove the tamper-  
17 proof fastener, a drill bit is placed in the slight indentation left from the removal of  
18 the cylindrical aperture 5 of torque head 3 and a hole is drilled through the shank  
19 portion whereby a tool engages the engagement portion 6 and the fastener is  
20 removed. (Grünbichler, col. 3, ll. 26-28).

21 We note the specific language of Grünbichler which states that a torque head  
22 is “formed on the permanent clamping head” (Grünbichler, col. 2, l. 7 or col. 5, l.  
23 46).

24 Manning discloses a stump cutting machine having a circular cutting wheel  
25 12. Cutting teeth 42, 44 are placed along the periphery of the cutting wheel. The  
26 cutting teeth are held in position by first and second holder members 46 and 48

1 which clamp the allochiral cutting teeth 42 and 44 to the respective sides of the  
2 cutting wheel 12. Each holder 46, 48 has two through bores with one bore being  
3 threaded and the other bore being countersunk for the reception of a bolt head of  
4 bolt 130, 132. Manning makes no provision for the removal of a broken bolt 130  
5 or 132. Presumably, if only the bores in the holder are threaded, when one bolt  
6 130 or 132 is sheared, the other bolt can be removed and the two holders would  
7 come away from the wheel. However, there would be no mechanism to remove  
8 the fastener 130 from the holder 46 or 48. Manning differs from the prior art in  
9 that it does not show an engagement portion located at the end of the shank portion  
10 of bolts 130 and 132 to cooperate with a tool used to engage and extract the bolt  
11 130 or 132.

#### 12 PRINCIPLES OF LAW

13 Whether a specification complies with the written description  
14 requirement of § 112, ¶ 1, is a question of fact, which we review for clear  
15 error on appeal from a bench trial. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d  
16 1555, 1563, 19 USPQ2d 1111, 1116 (Fed.Cir.1991); *Ralston Purina Co. v.*  
17 *Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179  
18 (Fed.Cir.1985). To fulfill the written description requirement, a patent  
19 specification must describe an invention and do so in sufficient detail that  
20 one skilled in the art can clearly conclude that “the inventor invented the  
21 claimed invention.” *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565,  
22 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012,  
23 10 USPQ2d 1614, 1618 (Fed.Cir.1989) (“[T]he description must clearly  
24 allow persons of ordinary skill in the art to recognize that [the inventor]  
25 invented what is claimed.”). Thus, an applicant complies with the written  
26 description requirement “by describing the invention, with all its claimed  
27 limitations, not that which makes it obvious,” and by using “such descriptive  
28 means as words, structures, figures, diagrams, formulas, etc., that set forth  
29 the claimed invention.” *Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.  
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31 *Regents of Univ. of Cal. v. Eli Lilly and Co.*, 119 F.3d 1559, 1566, 43 USPQ2d  
32 1398, 1404 (Fed. Cir. 1997), *cert. denied*, 523 U.S. 1089 (1998).

1           It is important to note that "[t]he invention is, for purposes of the 'written  
2 description' inquiry, *whatever is now claimed.*" *Vas-Cath*, 935 F.2d at 1564, 19  
3 USPQ2d at 1117.

4           The prior art may anticipate a claimed invention, and thereby render it  
5 non-novel, either expressly or inherently. *In re Cruciferous Sprout Litig.*, 301 F.3d  
6 1343, 1349, 64 USPQ2d 1202, 1206 (Fed. Cir. 2002), *cert. denied*, 538 U.S. 907  
7 (2003). Express anticipation occurs when the prior art expressly discloses each  
8 limitation (i.e., each element) of a claim. *Id.* In addition, "[i]t is well settled that a  
9 prior art reference may anticipate when the claim limitations not expressly found in  
10 that reference are nonetheless inherent in it." *Id.*

11           In *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467  
12 (1966), the Supreme Court set out a framework for applying the statutory language  
13 of § 103:

14           [T]he scope and content of the prior art are to be determined; differences  
15 between the prior art and the claims at issue are to be ascertained; and the  
16 level of ordinary skill in the pertinent art resolved. Against this background  
17 the obviousness or nonobviousness of the subject matter is determined. Such  
18 secondary considerations as commercial success, long felt but unsolved  
19 needs, failure of others, etc., might be utilized to give light to the  
20 circumstances surrounding the origin of the subject matter sought to be  
21 patented." [*Id.*, at 17-18, 148 USPQ at 467.]

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23           "While the sequence of these questions might be reordered in any particular case,  
24 the factors continue to define the inquiry that controls. If a court, or patent  
25 examiner, conducts this analysis and concludes the claimed subject matter was  
26 obvious, the claim is invalid or unpatentable under § 103." *See KSR Int'l v.*  
27 *Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). "To facilitate  
28 review this analysis should be made explicit." *Id.* at 1741, 82 USPQ2d at 1396. It  
29 can be important to identify a reason that would have prompted a person of

1 ordinary skill in the relevant field to combine the elements in the way the claimed  
2 invention does. This is so because inventions in most, if not, all cases rely upon  
3 building blocks long since uncovered. *Id.*

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5 ANALYSIS

6 Turning first to the rejection based on 35 U.S.C. § 112, for lack of written  
7 description support, we agree that one of ordinary skill would clearly conclude  
8 from Appellant's Specification that Appellant was in possession of the subject  
9 matter of a fastener with a head that was not intended to be removed from the  
10 shank. That circumstances exist in which the head is removed due to unintended  
11 consequences of use does not show that Appellant lacks written descriptive support  
12 for a permanent fastener head. The rejection of claims 1-9 and 16-20 under § 112,  
13 first paragraph, is reversed.

14 Turning to the anticipation rejection of claims 1-4, we quoted the language  
15 from the Grünbichler patent which states that Grünbichler has a permanent  
16 clamping head 2 with a torque head 3 being "formed" thereon. It is noted that  
17 Appellant's claims refer to a permanent head portion having a "configuration"  
18 suitable for receiving a drive tool. Appellant's Specification does not define the  
19 term "configuration." Accordingly, we give this term its broadest reasonable  
20 interpretation. As such, in our view "configuration" is extremely broad in that it  
21 refers to something that has been configured, shaped, or formed. We believe that  
22 the torque head shown by Grünbichler has been configured or formed and can be  
23 considered a "configuration", since Grünbichler states the permanent head portion  
24 has a torque head suitable for receiving a driving tool "formed" thereon.  
25 Consequently, we find that Grünbichler anticipates claims 1-4.



