

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERRY SALVATORE TRAINELLO

Appeal 2008-6277
Application 11/141,224
Technology Center 2841

Decided: January 8, 2009

Before BRADLEY R. GARRIS, CATHERINE Q. TIMM and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 13-20, the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention relates to “a measuring and marking instrument that can measure and mark accurately and quickly without depending on the skill of the person using the ruler.” (Spec. 3:1-3.) Claim 13 is illustrative of the invention and is reproduced below:

13. A method of using an improved conventional ruler that eliminates the skill required to measure and mark material quickly and accurately, comprising the steps of:
- (a) providing said conventional ruler including, a recognizable shape made of a common rigid material of a predetermined size, said conventional ruler having the usual indicia lines along each edge, one said edge having a row of v-grooves centered on said indicia lines, said v-grooves sized to fit the point of a marking instrument,
 - (b) positioning said conventional ruler on said material,
 - (c) selecting a portion of said v-grooves enable a human to measure and mark said material quickly and accurately at each corresponding said indicia line, whereby with the inclusion of said v-grooves on said conventional ruler, the skill required to measure and mark said material quickly and accurately is eliminated.

The Examiner relies on the following prior art references to show unpatentability:

Kurtz, Jr.	1,877,341	Sep. 13, 1932
Owen, Jr.	1,808,705	Jun. 2, 1931

Appellant requests review of the following grounds of rejection:

1. claims 13 and 14 under 35 U.S.C. § 102(b) as anticipated by Kurtz; and
2. claims 15-20 under 35 U.S.C. § 103(a) as unpatentable over Kurtz in view of Owen.

Appellant does not present arguments which are reasonably specific to any particular claim. Accordingly, we decide the first ground of rejection on the basis of independent claim 13 and the second ground of rejection on the basis of independent claim 16.

ISSUES

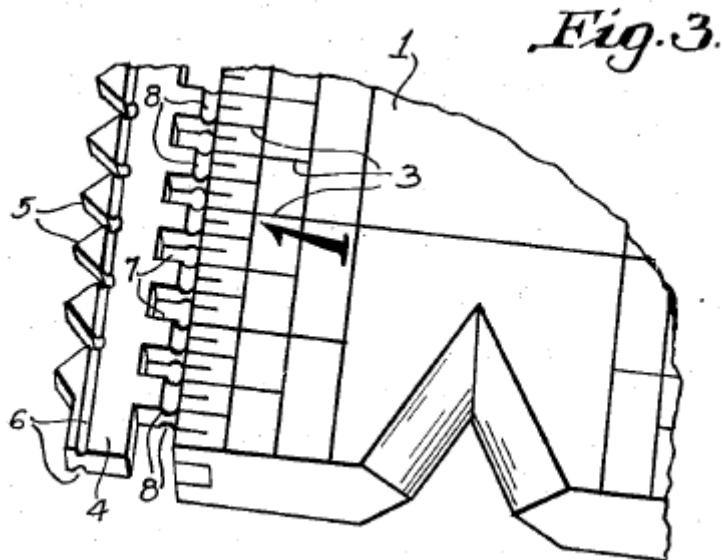
Has Appellant shown that the Examiner reversibly erred in finding that Kurtz discloses v-grooves which are “centered” on indicia lines as claimed in appealed claim 13 and holes which are “centered” on indicia lines as claimed in appealed claim 16?

Has Appellant shown that the evidence of non-obviousness, including Appellant’s evidence of commercial success, outweighs the Examiner’s evidence of obviousness?

We answer both of these questions in the negative for the reasons discussed below.

FINDINGS OF FACT

1. Kurtz discloses a drafting ruler “adapted to emphasize the transverse marginal indicia of the ruler” (ll. 2-7).
2. Figure 3 of Kurtz is reproduced below.



Kurtz Figure 3 shows one end of the ruler (ll. 20-21). The ruler includes “the usual transverse measuring indicia 3 . . . with suitable numerals 9” (ll. 26-29). A metallic strip 4 is positioned along one edge of body 1 of the ruler (ll. 31-32). Strip 4 includes a plurality of uniform notches 5 along its outer edge (ll. 32-33). Strip 4 further includes “a plurality of spaced rectangular holes 7 arranged in predetermined relationship to the transverse indicia 3 and the notches 5” (ll. 39-42). The holes 7 are uniformly spaced apart (l. 68) and “provide four points each spaced with respect to both the notches and the indicia” (ll. 43-45).

3. Appellant concedes that Kurtz discloses v-grooves 5 which are “**uniform** meaning they are all the same shape or appearance.” (Br. 10.) However, Appellant contends that Kurtz fails to anticipate the claimed method because Kurtz does not state that the v-grooves 6 or

- holes 7 align with the indicia, which is critical to allowing marking of a material quickly and accurately at each indicia line. (Br. 10, 11.)
4. The Examiner contends that because Kurtz' "holes 7 are in a predetermined relationship to the transverse indicia 3 and the notches 5 . . . these three features must be aligned in some manner. Furthermore, the indicia lines, holes and notches are clearly illustrated as being aligned in Fig. 3 of the Kurtz, Jr. device" (Ans. 4-5, referencing Fig. 3 of Kurtz). The Examiner maintains that Kurtz' ruler is "capable of the same functions" (Ans. 6) claimed by Appellant.
5. Appellant points out that Kurtz' v-grooves 5 are spaced from the indicia 3 by an intervening longitudinal groove 6, space 4, rectangular holes 7, and longitudinal groove 8. Appellant maintains that because of the spacing created by these intervening features, Kurtz' v-grooves are not "precisely centered on the indicia" in a manner that allows the user to accurately mark and measure at each indicia line in accordance with the claimed method. (Br. 10.)
6. Fig. 2 of Appellant's Application is reproduced below:

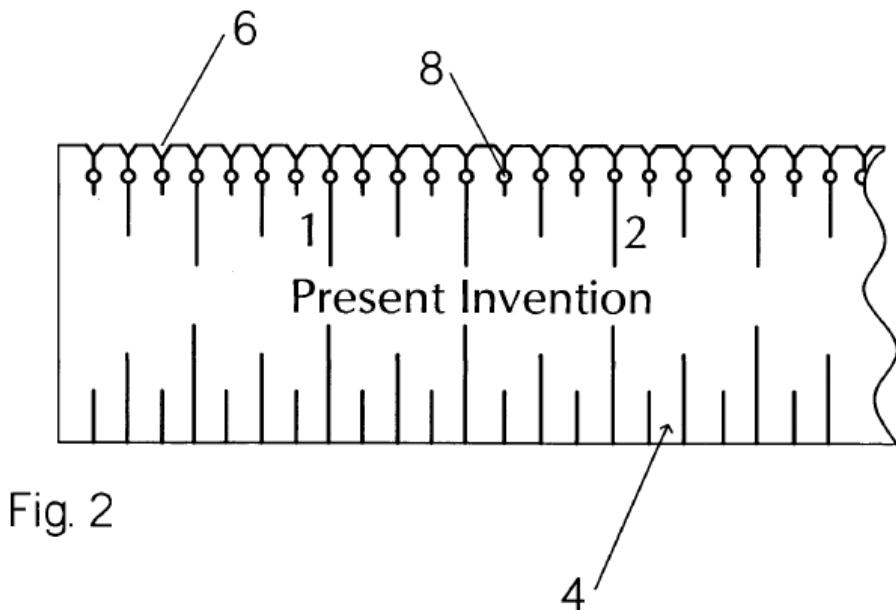


Fig. 2

4

Application Fig. 2 illustrates a preferred embodiment of the invention (Spec. 7:1) in which one edge of ruler 4 includes “a series of v-grooves 6 that are . . . equally spaced longitudinally at each inch and fraction of an inch or millimeter” (Spec. 5:8-10). The Specification states that “[t]he advantage of having the v-grooves 6 and through holes 8 on the present invention 4 is it enables a person to repeatedly and quickly make an accurate mark at each division on the ruler” (Spec. 6:1-3).

7. The Specification does not explicitly use the claim language “v-grooves centered on said indicia lines.”
8. The Examiner concedes that Kurtz fails to disclose that the holes are round as claimed in claims 15-20. (Ans. 4.) The Examiner relies on Owens for a disclosure of using round holes with a measuring and marking instrument for the purpose of accommodating a marking

implement, such as a pencil. (Ans. 4.) The Examiner contends that it would have been obvious to the ordinary artisan at the time of the invention to have replaced Kurtz' rectangular holes 7 with Owens's round holes for the purpose of accommodating an ordinary pencil. (Ans. 4.)

9. Appellant argues that Owens and Kurtz both disclose complete tools which, unlike Appellant's ruler, are complicated and difficult to understand. (Br. 12.)
10. Appellant also relies on evidence of commercial success to establish non-obviousness. (Br. 13.) Specifically, Appellant relies on a single email dated August 8, 2007, from Chris Edwards, Director of Procurement for General Tools & Instruments, New York, NY. In the email, Mr. Edwards states: "We will accumulate the information on what we would like to do with an Easy-Mark program over the next few weeks. We will present it to our executive review board in early September and then we should be ready to talk in mid September."
11. The record on Appeal contains no evidence of whether Mr. Edwards was expressing interest in a ruler which falls within the limitations of Appellant's claimed method and whether his interest related to the specifically claimed features of Appellant's ruler.

PRINCIPLES OF LAW

During examination, claim terms must be given their broadest reasonable construction consistent with the specification. *In re Icon Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007).

The proper test of a publication as a § 102(b) bar is "whether one skilled in the art to which the invention pertains could take the description of

the invention in the printed publication and combine it with his own knowledge of the particular art and from this combination be put in possession of the invention on which a patent is sought.” *In re Elsner*, 381 F.3d 1125, 1128 (Fed. Cir. 2004) (*citing In re LeGrice*, 301 F.2d 929, 936 (CCPA 1962)).

Description for the purposes of anticipation can be by drawings alone as well as by words. *In re Bager*, 47 F.2d 951, 953 (CCPA 1931). *See also, In re Reynolds*, 443 F.2d 384, 389 (CCPA 1971) (“[W]e think a person skilled in the art would suspect that there was some reason for the relationships shown in the drawing and would not regard such disclosure as accidental or arbitrary.”).

The test for obviousness is what the collective teachings of the prior art would have suggested to one of ordinary skill in the art. *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991).

When there is motivation to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under § 103.

KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1740 (2007).

Commercial success or other secondary considerations of non-obviousness may be attributed to the patented invention only where “the marketed product embodies the claimed features, and is coextensive with them.” *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311-12 (Fed. Cir. 2006) (*quoting Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*,

229 F.3d 1120, 1130 (Fed. Cir. 2000)). *See also, Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n. 42 (Fed. Cir. 1985) (“Case law requires that a nexus be established between the merits of the claimed invention and the evidence proffered on secondary considerations, if the evidence on secondary considerations is to be given substantial weight in the calculus of obviousness/nonobviousness.”).

ANALYSIS

Appellant and the Examiner disagree over whether Kurtz discloses v-grooves which are positioned on a ruler in a manner which allows a person to perform the claimed method step of measuring and marking material quickly and accurately at the indicia lines on the ruler (FF 3, 4). More specifically, Appellant and the Examiner disagree over whether Kurtz’ v-grooves are centered on the indicia lines (claim 13, step (a)). Appellant maintains that Kurtz’ v-grooves are not “centered on said indicia lines” as claimed because Kurtz’ indicia lines are separated from, or not sufficiently close to, the base of the v-grooves (FF 5) as illustrated, for example, in Fig. 2 of the Application (FF 6).

Interpreting the claim language in light of the Specification, we find that the broadest reasonable interpretation of “v-grooves centered on said indicia lines” reads on Kurtz’ Fig. 3 configuration in which the v-grooves are separated from each other in a manner which corresponds to the spacing of the indicia, even though the v-grooves are spaced from the indicia lines and separated therefrom by holes and grooves (*see* FF 2). Stated differently, we find no basis for interpreting this claim language as precluding a separation between the v-grooves and indicia, or requiring a configuration in

which the indicia lines extend to the base of the v-groove as illustrated in Fig. 2 of the Specification. (*See, e.g.*, FF 6, 7.)

Appellant indicates that it is the centering of the v-grooves which enables one to perform the step of measuring and marking. Because Kurtz clearly discloses an arrangement in which the v-grooves are centered on the indicia lines in the manner claimed, it would be expected that the claimed step could likewise be performed using Kurtz' ruler (*see* FF 1). Appellant has not otherwise provided persuasive arguments to refute the Examiner's finding of anticipation for the reasons explained in the Answer (*see* Ans. 4-6).

We are likewise in agreement with the Examiner that the claim 16 feature "round holes centered on said indica lines" is suggested by the Examiner's proposed combination of Kurtz and Owens (FF 8). Appellant has not provided persuasive arguments to refute the facts and reasons relied on by the Examiner in concluding that claims 15-20 would have been obvious within the meaning of 35 U.S.C. § 103(a) for the reasons well-stated in the Answer (*see* FF 9; Ans. 4-6). Moreover, we are in agreement with the Examiner that Appellant's evidence of commercial success (FF 10) does not present persuasive evidence of non-obviousness. As noted by the Examiner, at best, Mr. Edwards' email establishes evidence of commercial intent (Ans. 6). In addition, Appellant has not shown the requisite nexus between the alleged commercial success and the claimed features (FF 11).

CONCLUSION

Appellant has not shown that the Examiner reversibly erred in rejecting claims 13 and 14 under 35 U.S.C. § 102(b) as anticipated by Kurtz;

Appeal 2008-6277
Application 11/141,224

and claims 15-20 under 35 U.S.C. § 103(a) as unpatentable over Kurtz in view of Owen.

The decision of the Examiner rejecting claims 13-20 is 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)(1)(iv).

AFFIRMED

tc

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