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CLIFFORD G. FRAYNE 136 DRUM POINT RD SUITE 7A BRICK, NJ 08723			LEE, LAURA MICHELLE	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* BERNARD MERLINO

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Appeal 2010-011128  
Application 11/899,944  
Technology Center 3700

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Before: CHARLES N. GREENHUT, BRETT C. MARTIN,  
and JEREMY M. PLENZLER, *Administrative Patent Judges*.

MARTIN, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF CASE

Bernard Merlino (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's rejection of claims 1, 4, and 5. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

Appellant's invention is directed generally "to scissors and other scissor-like implements, and in particular to scissors designed for trimming nose hair, which scissors would include an illumination means mounted thereon." Spec. 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A scissor assembly for trimming nose hair with attached illumination means comprising:  
a scissor assembly for trimming nose hair with two complimentary longitudinal members, each member comprising a handle portion, a shank portion, and a blade portion, said two complimentary longitudinal members secured at a pivot point, an illumination means secured to one of the shank portions proximate to said pivot point, said illumination means for illuminating the nostrils of the nose, and the nose hair therein, said illumination means comprising a housing member, said housing member containing a battery compartment, a switch means, and a light emitting diode, said light emitting diode positioned in said housing member, and facing said blade portion of said complimentary longitudinal members.

## REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Karram	US 6,428,180 B1	Aug. 6, 2002
Dallas	US 2005/0105286 A1	May 19, 2005

## THE REJECTIONS ON APPEAL

The Examiner made the following rejections:

Claims 1 and 5 stand rejected under 35 U.S.C §102(b) as being anticipated by Karram. Ans. 3.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Karram and Dallas. Ans. 3.

## ANALYSIS

### *Anticipation by Karram*

As stated by the Examiner, Karram teaches every structural limitation contained in both of claims 1 and 5. *See* Ans. 3-4. As the Examiner further states, and we agree, “[A]ppellant’s only argument is that the Karram scissors do not specifically state that they are capable of cutting nose hairs.” Ans. 5. Appellant solely emphasizes the specific surgical uses disclosed by Karram, which admittedly are different from the claimed use as a nose hair trimmer, but such argument is unpersuasive. *See* App. Br. 9-12. In response, the Examiner correctly points out “that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art” and that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.” Ans. 5-6.

*See also In re Schreiber*, 128 F.3d 1473, 1477-78 (Fed. Cir. 1997) (finding that the absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of a claimed apparatus because the limitations at issue were found to be inherent in the prior art reference). Further, "apparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Appellant has not pointed to any such structural difference in the claims that would differentiate the invention from Karram, nor does (or could) Appellant state that Karram's scissors are incapable of trimming nose hairs as asserted by the Examiner. As such, we sustain the rejection of claims 1 and 5 as anticipated by Karram.

*Obviousness over Karram and Dallas*

The Examiner rejects claim 4, which requires that "the battery source comprises lithium batteries," over the combination of Karram and Dallas. *See* Ans. 4-5. As the Examiner correctly states, "Appellant has not supplied any arguments to refute the obviousness rejection of claim 4, as being unpatentable over Karram in view of Dallas." Ans. 7. Appellant merely recasts the argument with respect to intended use, which we have already rejected, and applies it against the obviousness rejection. *See* App. Br. 16-17. Nowhere does Appellant even mention the aspect in claim 4 relating to battery type, which is the basis for the Examiner's combination of Dallas with Karram. Accordingly, we sustain the rejection of claim 4 as obvious over Karram and Dallas.

Appeal 2010-011128  
Application 11/899,944

**DECISION**

For the above reasons, we **AFFIRM** the Examiner's decision to reject claims 1, 4, and 5.

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**

Klh