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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
12/002,247	12/14/2007	Eric Mascall	209,292	6050
38137	7590	02/01/2013	EXAMINER	
ABELMAN, FRAYNE & SCHWAB 666 THIRD AVENUE, 10TH FLOOR NEW YORK, NY 10017			CHUKWURAH, NATHANIEL C	
			ART UNIT	PAPER NUMBER
			3721	
			MAIL DATE	DELIVERY MODE
			02/01/2013	PAPER

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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* ERIC MASCALL

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Appeal 2010-011339  
Application 12/002,247  
Technology Center 3700

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Before BRETT C. MARTIN, LYNNE H. BROWNE and  
ANNETTE R. REIMERS, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

Eric Mascall (Appellant) appeals under 35 U.S.C. § 134 from the Examiner's decision to reject under 35 U.S.C. § 103(a): (1) claims 1-6 as unpatentable over Hetcher (US 7,032,683 B2, issued Apr. 25, 2006) and Mosher (US 1,898,639, issued Feb. 21, 1933); and (2) claims 1-6 as unpatentable over Hetcher and Tornqvist (US 4,592,431, issued Jun. 3, 1986). We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM.

## THE INVENTION

Appellant's invention relates to a hand-held power tool 1 including a guide tube 6, at least one anvil 8, a percussion mechanism 2 and an impact sleeve 10. Spec. 4, ll. 5-14 and fig. 2.

Claim 1, the sole independent claim, is illustrative of the claimed invention and reads as follows:

1. A hand-held power tool, comprising:
  - a guide tube (6) having two, spaced from each other, axial stops (7a, 7b);
    - at least one anvil (8, 8'a, 8'b) axially displaceable within limits between the two axial stops (7a, 7b) and having two, axially spaced from each other, outer radial bands (9a, 9b, 9');
    - a percussion mechanism (2) including a percussion piston (5) for impacting the at least one anvil (8, 8'a, 8'b) and an air spring (3) for driving the percussion piston; and
    - an impact sleeve (10, 10') arranged coaxially with the at least one anvil (8, 8'a, 8'b), axially displaceable within limits between the two outer radial bands (9a, 9b, 9') of the at least one anvil (8, 8'a, 8'b) for damping idle blows of the percussion mechanism by absorbing a portion of the motion energy of the at least one anvil, and having an

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outer diameter (A) smaller than an inner diameter (I) of the guide tube (6).

## ANALYSIS

*The obviousness rejection over Hetcher and Mosher*

*Claims 1-6*

Appellant does not present additional arguments regarding the patentability of dependent claims 2-6 separate from those directed against the rejection of independent claim 1. *See* App. Br. 11. Therefore, Appellant has argued claims 1-6 as a group for purposes of the rejection of those claims under § 103(a). Claim 1 is representative of the group. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2011).

The Examiner found that Hetcher discloses the limitations of independent claim 1, except “an impact sleeve arranged coaxially with the at least one anvil between the two outer radial bands.” Ans. 3-4. The Examiner further found that Mosher discloses an impact sleeve *F* arranged coaxially with the at least one anvil *w* axially displaceable within limits between the two outer radial bands (stopper) of the at least one anvil *w*. Ans. 4; Mosher, fig. 2. The Examiner concluded that it would have been obvious to one skilled in the art at the time of the invention to modify Hetcher in view of Mosher “in order to provide [a] plurality of pistons reciprocating independent of each other working to actuate the working implement with more impact force.” *Id.*

Appellant argues, “Hetcher and Mosher operate very differently and if Hetcher was modified in the manner suggested by the Examiner, it would change the principle of operation of Hetcher and would include an unnecessary duplication of parts.” App. Br. 9; Reply Br. 3. According to Appellant, (1) “[t]he principle of operation of Hetcher is a closed pneumatic

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chamber between a hammer piston and a motor driven excitation piston;” and (2) “Mosher teaches a percussion mechanism driven by an external compressor which provides a constant flow of pressurized air.” App. Br. 8-9; Reply Br. 2-3.

We are not persuaded by Appellant’s arguments because nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Further, obviousness does not require that all of the features of the secondary reference be bodily incorporated into the primary reference. *In re Keller*, 642 F.2d 413, 425 (CCPA 1981). Appellant provides merely conclusory statements without identifying why the Examiner’s proposed modification of Hetcher in view of Mosher would change the principle of operation of Hetcher. For these reasons, we are not apprised of Examiner error.

Appellant further argues that “there is no motivation to modify Hetcher to include the hammer piston F of Mosher because it has a different function.” App. Br. 10; Reply Br. 4. According to Appellant, “[u]nlike the hammer piston F of Mosher, the impact sleeve of claim 1 is not actively driven and, therefore, does not hit on the anvil in alternation to the hammer piston.” *Id.*

We are not persuaded by Appellant’s arguments because Appellant appears to be attempting to bodily incorporate features of Mosher into Hetcher. Further, Appellant’s argument that the hammer piston *F* of Mosher has a different function is not persuasive in itself because “[i]t is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable.” *In re Schreiber*, 128 F.3d 1473, 1477

(Fed. Cir. 1997). Appellant's conclusory statements do not apprise us of error in the Examiner's stated findings and conclusions of obviousness.

Appellant argues that the combination of Hetcher and Mosher fails to disclose (1) "an impact sleeve (10, 10') ... having an outer diameter (A) smaller than an inner diameter (I) of the guide tube (6);" and (2) "an impact sleeve (10, 10') . . . axially displaceable within limits between the two outer radial bands," as required by claim 1. App. Br. 10-11; Reply Br. 4-6; App. Br., Claims Appendix.

Regarding the first limitation, Appellant argues, "[t]he piston F of Mosher has an outer diameter that is equal to the inner diameter of chamber D." App. Br. 10; Reply Br. 5. The Examiner considered cylinder *B* of Mosher, not chamber *D* of Mosher, to be the guide tube. Ans. 4. As such, the Examiner correctly found that impact sleeve *F* of Mosher has "[an] outer diameter smaller than an inner diameter of the guide tube (B)." *Id.*; Mosher, fig. 1-2.

Regarding the second limitation, Appellant argues that (1) "[t]he impact sleeve recited by claim 1 is arranged between the two outer radial bands. By way of comparison, Mosher arranges the hammer piston F such that it hits on the anvil in a forward direction;" (2) the Examiner takes the position that impact sleeve F of Mosher "be arranged between the bands of the anvil 106 of Hetcher;" and (3) one skilled in the art "would arrange the hammer piston F of Mosher in the space between the piston 82 and the anvil 106 of Hetcher. This is because with this arrangement the hammer piston F of Mosher could still act in the forward direction and be simply integrated." App. Br. 11; Reply Br. 5-6.

We are not persuaded by Appellant's arguments for the following reasons. First, Appellant appears to be attempting to bodily incorporate

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features of Mosher into Hetcher. Second, the Examiner finds that Hetcher discloses “axially spaced from each other, outer radial bands (see outer bands of ram [anvil] 78 and striker [anvil 106]).” Ans. 3, 6. As such, it appears from the Examiner’s findings that the Examiner is proposing to modify Hetcher by arranging the impact sleeve *F* of Mosher between the outer radial bands of ram (anvil) 78 and striker (anvil) 106, not between the outer radial bands of anvil 106, as Appellant contends. Moreover, Appellant’s proposed arrangement of the impact sleeve *F* of Mosher in the device of Hetcher (i.e., in the space between the piston 82 and the anvil 106 of Hetcher) appears to concur with the Examiner’s proposed arrangement of the impact sleeve *F* of Mosher in the device of Hetcher (i.e., in the space between the ram (anvil) 78 and the striker (anvil) 106 of Hetcher). Consequently, Appellant has failed to provide any persuasive arguments as to why the Examiner’s proposed modification of Hetcher in view of Mosher is erroneous.

Accordingly, for the foregoing reasons, we sustain the rejection of independent claim 1 and of claims 2-6, which fall with claim 1, as unpatentable over Hetcher and Mosher.

Because our affirmance of the first ground of rejection is dispositive as to each claim on appeal, we do not reach the Examiner’s cumulative rejection of claims 1-6 based on unpatentability over Hetcher and Tornqvist under 35 U.S.C. § 103(a). *See* 37 C.F.R. § 41.50(a)(1) (2012) (“The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed”).

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DECISION

We AFFIRM the Examiner's decision to reject claims 1-6 under 35 U.S.C. § 103(a) based on Hetcher and Mosher. We do not reach the additional issues raised by Appellant regarding the cumulative rejection of claims 1-6 under 35 U.S.C. § 103(a) based on Hetcher and Tornqvist.

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

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