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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ILYA SHOR

Appeal 2010-012495
Application 11/923,023
Technology Center 3700

Before JENNIFER D. BAHR, NEIL T. POWELL, and
BART A. GERSTENBLITH, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision rejecting claims 1 and 3-21. We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

THE CLAIMED SUBJECT MATTER

Independent claim 1, reproduced below, is illustrative of the appealed subject matter:

1. A hammer tacker, comprising:
a contact face for contacting a material;
a firing mechanism adjacent said contact face, said firing mechanism for driving a formed staple into the material when said contact face is brought into contact with the material;
a handle extending from said contact face; and
a curved staple guide for guiding a flexible pack of formed staples toward said contact face.

THE REJECTIONS

The Examiner's rejections of the claims to be reviewed on appeal include:

1. Claims 1 and 3-17 stand rejected under 35 U.S.C. § 102(b) as anticipated by Beckman (US 2,653,316; iss. Sept. 29, 1953).
2. Claims 1, 3-7, 9-15, and 17-21 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Fealey (US 6,012,623, iss. Jan. 11, 2000) and Wandel (US 2,946,059, iss. Jul. 26, 1960).

ANALYSIS

Rejection of Claim 1 Based on Beckman

The Examiner and Appellant dispute whether Beckman meets the limitation in claim 1 of “a curved staple guide for guiding a flexible pack of formed staples toward said contact face.” *See* App. Br. 3-5; Ans. 4 and 6-7; Reply Br. 1-2. The Examiner finds that Beckman discloses a curved staple guide that guides a flexible pack of formed staples, citing Figure 9 of Beckman as showing the flexible pack of formed staples. Ans. 4. The Examiner notes that “claims are given their broadest reasonable interpretation consistent with the specification” (Ans. 6), and that “the claims do not restrict or require the staples to be of a specific shape or form, just merely that they are ‘formed’” (*Id.* at 7). Given this, the Examiner finds that the roll shown in Figure 9 of Beckman includes “formed staples” because “the roll shown in the figure has been ‘formed’ into the shapes for staples,” noting that “each staple is distinct in that it has two legs.” *Id.* at 7.

Appellant counters that the Examiner has not properly interpreted the claim language consistent with the Specification. Reply Br. 1. In support of this position, Appellant argues that:

Paragraph 16 of the Detailed Description describes the formed staples within the flexible staple pack 30. The staples are described as “U-shaped staples” and that the staples have “pronged arms extending to a point.” A person having skill in the art of staples and the benefit of this disclosure would not interpret the claimed “formed staples” as applying to flat staple blanks.

Id. Appellant concludes that “[s]taples . . . have a U-shape.” *Id.* at 2.

In concert with the argument that the proper interpretation of the claim language “formed staples” requires a U-shape, Appellant argues that

Beckman discloses “flat staple blanks” that “are clearly not formed staples.” App. Br. 4. Without pointing to any other specific structural characteristics, Appellant further argues that “Beckman’s staple blanks should not be interpreted as teaching formed staples” because “Beckman teaches that formed staples set into machines limit the capacity for carrying staples” and “[f]or this reason Beckman incorporates the staple forming station and guides staple blanks, rather than formed staples.” *Id.* at 4-5. Appellant similarly asserts that “Beckman would not require a staple forming station if the staple blanks 20 were formed staples.” *Id.* at 4.

In arguing that the claim language “formed staples” is properly interpreted as requiring a U-shape based on the Specification and drawings, Appellant overlooks countervailing aspects of the Specification and the claims. For example, the portion of the Specification to which Appellant points discloses that “staples 34 are *typically* U-shaped,” indicating that they are not limited to a U-shape and may have other shapes. Spec. para. [0016] (emphasis added). And the Specification does not discuss “formed” staples or suggest that they must have a U-shape. In fact, the written description portion of the Specification does not include or describe the phrase “formed staples.” Nor does the Specification disclaim any shape of staples. Furthermore, claim 18, which depends from independent claim 1, adds only one limitation to claim 1—“wherein the formed staple is a U-shaped staple.” App. Br. 13. Under the doctrine of claim differentiation, this suggests that the language “formed staples” in claim 1 does not require a U-shape. *See, e.g., Curtiss-Wright Flow Control Corp. v. Velan, Inc.*, 438 F.3d 1374, 1380 (Fed. Cir. 2006) (“In the most specific sense, ‘claim differentiation’ refers to the presumption that an independent claim should not be construed as

requiring a limitation added by a dependent claim.”). In view of this evidence, we conclude that the claim language “formed staples” does not require a U-shape.

Appellant’s argument that Beckman does not meet the claim language falls with Appellant’s claim-construction argument, as Appellant does not clearly identify any characteristic other than the lack of a U-shape that would potentially distinguish Beckman’s roll from the “flexible pack of formed staples” recited in claim 1. Thus, Appellant has not apprised us of error in the Examiner’s rejection of claim 1 as anticipated by Beckman. Accordingly, we affirm the rejection.

Aside from this holding, we deem it worth noting that establishing anticipation of claim 1 would not have required the Examiner to establish that Beckman actually discloses guiding “a flexible pack of formed staples toward said contact face.” The language “for guiding a flexible pack of formed staples toward said contact face” in claim 1 is directed to the function or intended use of the curved staple guide. It is well settled that the recitation of an 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). In order to satisfy the functional limitations in an apparatus claim, the prior art apparatus must be capable of performing the claimed function. *Id.* at 1478. On the record presently before us, we do not discern any reason that Beckman’s guide surface would not be capable of “guiding a flexible pack of formed staples toward said contact face.” Appellant generally asserts that the functional language “implicates structure to the claimed curved staple guide . . . [that] is not shown in Beckman” (App. Br. 4), but Appellant does not identify any specific structure that Beckman’s curved

guide needs to perform the recited function but lacks. Accordingly, absent further evidence or explanation, it appears that Beckman would meet the disputed claim language regardless of whether it actually discloses guiding a flexible pack of formed staples.

Rejection of Claim 10 Based on Beckman

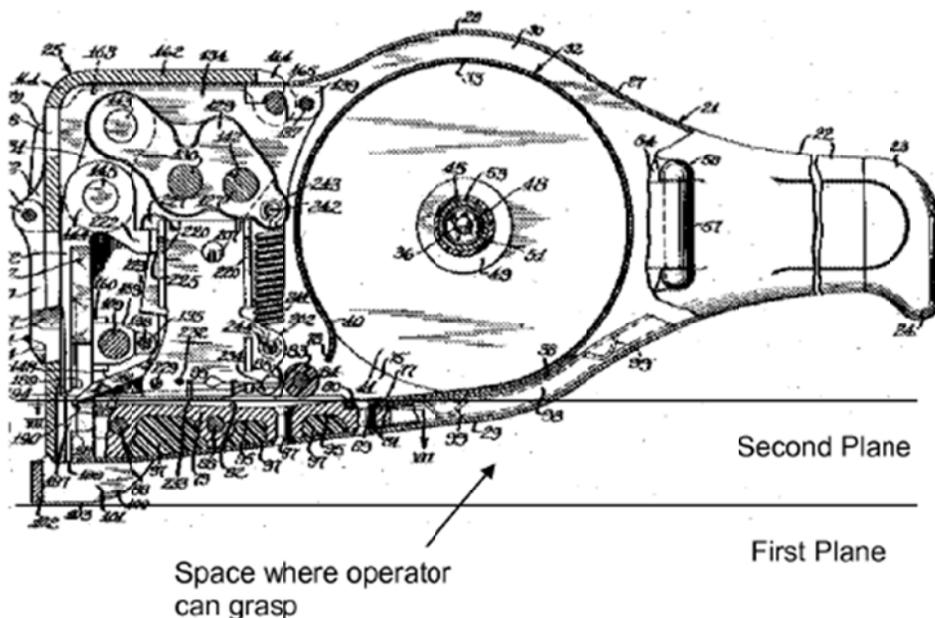
The Examiner and Appellant dispute whether Beckman meets the language in claim 10 of “a curved fastener guide extending from adjacent said contact face, said curved fastener guide for guiding a flexible fastener pack having a multiple of distinct fasteners adhesively secured relative to each other within the flexible fastener pack.” *See* App. Br. 5-6; Ans. 4 and 7; Reply Br. 2. The Examiner finds, *inter alia*, that Beckman discloses a curved guide “capable of guiding a pack of distinct fasteners that are adhesively secured relative to each other.” Ans. 4. Appellant argues that Beckman does not disclose guiding a flexible fastener pack having a multiple of distinct fasteners, but Appellant does not address the Examiner’s finding that Beckman’s curved guide is capable of doing so. *See* App. Br. 5-6; Reply Br. 2.

The language “for guiding a flexible fastener pack having a multiple of distinct fasteners adhesively secured relative to each other within the flexible fastener pack” in claim 10 is directed to the function or intended use of the curved fastener guide. In order to satisfy the functional limitations in an apparatus claim, the prior art apparatus must be capable of performing the claimed function. *Schreiber*, 128 F.3d at 1478. Accordingly, because Appellant does not dispute the Examiner’s finding that Beckman’s curved guide is capable of performing the function recited in claim 10, Appellant

does not establish error in the Examiner's rejection of claim 10 as anticipated by Beckman. Accordingly, we affirm the rejection.

Rejection of Claims 7 and 15 Based on Beckman

The Examiner and Appellant dispute whether Beckman meets the limitation in claims 7 and 15 that "a space between said first plane and said second plane provides clearance for an operator grasping said handle when said contact face contacts said material." See App. Br. 6; Ans. 4 and 7-8; Reply Br. 2. On page 5 of the Answer, the Examiner reproduces Figure 3 of Beckman with annotations showing where the Examiner finds Beckman discloses space between a first plane and a second plane to provide clearance for an operator; this annotated version of Beckman's Figure 3 is reproduced below.



The annotated version of Beckman's Figure 3 from page 5 of the Answer shows a cross-section of Beckman's stapler with annotations indicating

where the Examiner finds Beckman to disclose space between first and second planes where an operator can grasp the stapler.

The Examiner finds that “[a]n operator is capable of grasping the handle in the space between the two planes.” Ans. 4. Appellant argues that “the space between the planes does not provide clearance for an operat[or] to grasp a handle, the handle is not even located in the space between the planes.” App. Br. 6. In response, the Examiner concedes that handle portion 22 of Beckman’s stapler is not between the planes, but states that “[h]andle portion 21 (in the vicinity shown above) is capable of being grasped by a user, which is clearly between the two designated planes.” Ans. 8.

Consistent with Appellant’s argument, we note that the language of claims 7 and 15 requires that the space between the claimed planes provides clearance for an operator when the operator is “grasping said handle,” not that the space between the claimed planes provides clearance when the operator is grasping some other portion of the stapler. In conflict with the Examiner’s reference to “handle portion 21,” Beckman uses reference number 21 to identify “a body” of the stapler generally. Beckman, col. 3, ll. 21-22. And the Examiner cites no evidence that the portion of Beckman’s stapler at reference number 21 constitutes a handle. *See* Ans. 8. Furthermore, even if the Examiner established that the portion of Beckman’s stapler at reference number 21 did constitute a handle, the Examiner’s annotated drawing does not support the finding that reference number 21 “is clearly between the two designated planes.” *See id.* For these reasons, the Examiner has not clearly supported the finding that Beckman’s stapler meets the limitation that “a space between said first plane and said second plane

provides clearance for an operator grasping said handle when said contact face contacts said material.” Accordingly, we cannot sustain the rejection of claims 7 and 15 as anticipated by Beckman.

Rejection of Claims 3-6, 8, 9, 11-14, 16, and 17 Based on Beckman

Regarding the rejection of claims 3-6, 8, 9, 11-14, 16, and 17 based on Beckman, Appellant states only that “[t]hese claims depend from claim 1 or claim 10 and are patentable for at least this reason.” App. Br. 7.

Accordingly, for the above-discussed reasons that Appellant has not apprised us of error in the Examiner’s rejection of claims 1 and 10 based on Beckman, Appellant has not apprised us of error in the Examiner’s rejection of claims 3-6, 8, 9, 11-14, 16, and 17 as anticipated by Beckman.

Accordingly, we affirm the rejection.

Rejection of Claims 1, 3-5, 9-13, and 17-21 Based on Fealey and Wandel

With respect to the Examiner’s obviousness rejection, Appellant argues claims 1, 3-5, 9-13, and 17-21 as a group.¹ App. Br. 7-9. We select claim 1 as representative, and we treat claims 3-5, 9-13, and 17-21 as standing or falling with representative claim 1. *See* 37 C.F.R.

§ 41.37(c)(1)(vii) .

The Examiner finds that Fealey discloses a stapler that meets the limitations of claim 1 except that it lacks a curved staple guide. Ans. 5. The Examiner also finds that Wandel discloses “attaching a curved staple guide onto the end of a stapler for the purpose of increasing the magazine capacity

¹ Appellant presents a separate argument for claims 6 and 14. Accordingly, we address claims 6 and 14, and claims 7 and 15 depending therefrom, *infra*.

without substantially increasing the size of the tool.” *Id.* (citing Wandel, col. 1, ll. 37-40). The Examiner concludes that it would have been obvious “to attach a curved staple guide onto the end of Fealey’s stapler for the purpose of increasing the magazine capacity without substantially increasing the size of the tool.” *Id.*

Appellant advances various arguments disputing the Examiner’s rationale for combining Fealey and Wandel. First, Appellant argues that Fealey teaches away from the Examiner’s proposed modification. In support of this position, Appellant points to column 1, lines 53-57, of Fealey and argues that “Fealey states that ‘increasing the distance the staple must be moved in order to be driven increases the likelihood of jams’” and “[t]he proposed modification to Fealey adds a large bulky stapler magazine 34 and increases the distance the staple must be moved.” App. Br. 7-8. Apparently based on these assertions, Appellant also argues that the Examiner’s proposed modification renders Fealey “unsatisfactory for its intended purpose[] of not increasing the distance the staple must be moved.” *Id.* at 8.

The Examiner counters that “Fealey states in col. 1 lines 51-57 that increasing the distance the staples move during a *drive stroke* increases the likelihood of jams” and that “Fealey does not discuss the distance the staple moves within the magazine.” Ans. 8. Appellant responds that staple movement during the drive stroke and within the magazine “are intimately related” because “[a]s a staple to be driven moves, so too do the associated staples within the magazine.” Reply Br. 2. In combination with this, Appellant argues that “[i]nterpreting Fealey’s disclosure of the disadvantages of moving staples large distances in order to be driven as only

applying to some staples, and not all the staples within the magazine, is a clear mischaracterization of Fealey's disclosure." *Id.* at 2-3.

Contrary to Appellant's argument, the Examiner reads Fealey correctly as conveying concerns about increasing the distance each staple travels only during the drive stroke, not during movement of the staple within the magazine prior to the drive stroke. Fealey's comment regarding the likelihood of jams appears within an explanation of disadvantages associated with lengthening the drive track and the drive stroke. Fealey, col. 1, ll. 48-57. No part of this explanation supports Appellant's suggestion that Fealey discourages a longer staple magazine because movement during the drive stroke and movement within the magazine "are intimately related." And Appellant does not cite any other portion of Fealey or any other evidence that does support this suggestion. Furthermore, we do not agree with Appellant's suggestion that the Examiner characterizes Fealey as disclosing concerns about movement of only a subset of the staples. The Examiner's findings appear to read Fealey's statements about staple movement and jamming as applying to every staple but only during the period when the staple goes through the drive stroke. We agree with this reading of Fealey. Accordingly, Appellant has not established that Fealey teaches away from the proposed modification or that Fealey has a general purpose of not increasing the distance the staple moves.

Appellant also argues that the Examiner's proposed modification renders "Fealey unsatisfactory for its intended purpose[] of . . . alleviating hand clearance problems." App. Br. 8. The Examiner responds that "Wandel states in col. 3 lines 19-33 that providing the detachable magazine to a stapling device would increase the staple capacity while maintaining the

physical size of the device, thus permitting convenient manipulation of the device.” Ans. 8. Appellant offers no substantive explanation or evidence to counter this. Accordingly, Appellant has not established that the proposed modification would render Fealey unsatisfactory for its intended purpose.

Appellant also argues that the proposed modification would change the principle of operation of Fealey because it would require using flexible staple packs instead of staple sticks, and because it would require “substantial reconstruction and redesign of the elements shown in Fealey” “in order to accept . . . Wandel’s magazine . . . of edgewise oriented staples.” App. Br. 8-9. These arguments appear to rest on an erroneously narrow understanding of Fealey’s principle of operation.

Fealey focuses on the problem that many stapler configurations provide little clearance for accommodating a user’s hand between the stapler handle and a large planar work surface, which can make it difficult to drive a staple perpendicularly into the work surface. Fealey, col. 1, l. 41-col. 2, l. 12; Abstract. To address this problem, Fealey orients the staple feed track that extends through the stapler handle at an angle greater than 90° relative to the drive stroke of the stapler drive mechanism, and implements provisions for aligning the leading staple with the drive track during the drive stroke. *Id.* at Abstract; col. 2, ll. 39-50; col. 4, ll. 8-17. The angle at which the feed track extends through the handle allows configuring the handle to provide clearance for the operator’s hand between the handle and the working surface, while the provisions for aligning the staple with the drive track allows driving each staple generally perpendicularly into the working surface. *Id.* at Abstract; col. 2, ll. 41-54; col. 4, ll. 8-22. Thus, the basic principle of operation of Fealey is feeding staples through the handle

of the stapler at an angle of greater than 90° relative to the drive stroke and aligning the leading staple with the drive track for driving generally perpendicularly into the work surface. Accordingly, contrary to Appellant's arguments, modifying Fealey to use flexible staple packs oriented edgewise in Wandel's magazine would not change Fealey's basic principle of operation.

Appellant further argues that adding Wandel's magazine to Fealey would "severely inhibit the ability of the operator to swing the hammer stapler." App. Br. 9. Based on this argument, Appellant further asserts that the Examiner's proposed modification of Fealey would change Fealey's principle of operation because it would require substantial reconstruction and redesign to provide a different drive system. *Id.* These arguments do not apprise us of error in the rejection for at least two reasons. First, the arguments rest wholly on attorney argument, unsupported by evidence that the Examiner's proposed modification would significantly inhibit swinging Fealey's stapler and would require a different drive system. An attorney's arguments in a brief cannot take the place of evidence. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974). Second, the arguments do not establish that changing Fealey's drive system would necessarily involve changing Fealey's basic operating principle of feeding staples through the handle of the stapler at an angle of greater than 90° relative to the drive stroke and aligning the leading staple with the drive track for driving generally perpendicularly into the work surface.

Appellant also argues that the Examiner's determination that it would have been obvious to modify Fealey to include Wandel's magazine to increase staple capacity "is a conclusion or result of the modification, not a

reasoning with a rational underpinning for the modification.” App. Br. 9. This argument fails to recognize that the Examiner’s reasoning for combining the references rests on a correct finding that Wandel discloses the possibility of achieving the beneficial “result of the modification,” knowledge of which would have given a person of ordinary skill in the art a rational reason for making the modification. *See* Ans. 5. Thus, contrary to Appellant’s argument, the Examiner provides reasoning with rational underpinning for the conclusion of obviousness.

For the foregoing reasons, Appellant has not apprised us of error in the Examiner’s rejection of claim 1 as obvious over Fealey and Wandel. Accordingly, we affirm the obviousness rejection of claims 1, 3-5, 9-13, and 17-21.

Rejection of Claims 6, 7, 14, and 15 based on Fealey and Wandel

With respect to the Examiner’s obviousness rejection of claims 6 and 14, the Examiner and Appellant dispute whether the cited references suggest the limitations in claims 6 and 14 that “said contact face defines a first plane for contacting the material, and a surface of said curved staple guide on a contact face side of said curved staple guide defines a second plane generally aligned with said first plane, said second plane spaced from said first plane.” *See* App. Br. 10; Ans. 6. The Examiner finds that “Fealey’s contact face defines a first plane and a surface of the curved staple guide defines a second plane generally aligned with the first plane and spaced from it.” Ans. 6. This finding that Fealey meets the claim limitations conflicts with the Examiner’s finding that Fealey “fails to disclose a curved staple guide.” Ans. 5. Additionally, the Examiner does not clearly respond to the

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substance of Appellant's arguments that the cited references fail to meet the claim limitations. *See* App. Br. 10; Ans. 6. Accordingly, we cannot sustain the rejection of claims 6 and 14 as obvious over Fealey and Wandel. For the same reasons, we cannot sustain the rejection of claims 7 and 15, which depend from claims 6 and 14, as obvious over Fealey and Wandel.

DECISION

The Examiner's decision rejecting claims 1 and 3-21 is affirmed as to claims 1, 3-6, 8-14, and 16-21, and reversed as to claims 7 and 15.

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-IN-PART

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