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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROYDEN H. GIBSON, MARCUS E. NORDEN,
SAM D. HECTOR, JIM H. BENNETT, and CARL R. WALKER

Appeal 2015-001888[1]
Application 13/005,577[2]
Technology Center 3700

Before PHILIP J. HOFFMANN, JAMES A. WORTH, and
CYNTHIA L. MURPHY, *Administrative Patent Judges*.

WORTH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1–11. We have jurisdiction under 35 U.S.C. §§ 134 and 6(b).

We REVERSE.

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[1] Our decision refers to the Appellants' Appeal Brief ("Appeal Br.," filed July 1, 2014) and Reply Brief ("Reply Br.," filed Nov. 17, 2014), and the Examiner's Final Office Action ("Final Act.," mailed May 7, 2014) and Answer ("Ans.," mailed Oct. 23, 2014).

[2] According to Appellants, the real party in interest is The Ames Companies, Inc. (Appeal Br. 1).

Introduction

Appellants' disclosure "relates to a wood tool handle having an overmold and, more specifically, to a wood handle wherein substantially all of the handle surface is protected by the overmold." (Spec. 1, ll. 5–7).

Claim 1, reproduced below, is the sole independent claim on appeal and is representative of the subject matter on appeal:

> 1. A tool handle assembly comprising:
> an elongated wood member having a first end, a medial portion and a second end; and
> an overmold applied to substantially all of said medial portion and said second end.

(Appeal Br., Claims App.)

Rejections on Appeal

The Examiner maintains, and Appellants appeal, the following rejections:

I. Claims 1–4, 8, and 9 stand rejected under pre-AIA 35 U.S.C. § 102(b) as being unpatentable by Macioce (US 2003/0029278 A1, pub. Feb. 13, 2003).

II. Claims 5 and 10 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Macioce and Olroyd (US 8,506,532 B2, iss. Aug. 13, 2013).

III. Claims 6 and 11 stand rejected under pre-AIA 35 U.S.C. § 103(a) as being unpatentable over Macioce and Keathley (US 4,287,640, iss. Sept. 8, 1981).

ANALYSIS

Rejection I (Anticipation)

Independent claim 1 and dependent claims 2–4, 8, and 9

We are persuaded by Appellants' argument that Macioce fails to disclose "an overmold applied to substantially all of said medial portion and said second end," as recited by independent claim 1. The Examiner relies on grip cover 16 of Macioce, depicted below as annotated by the Examiner:

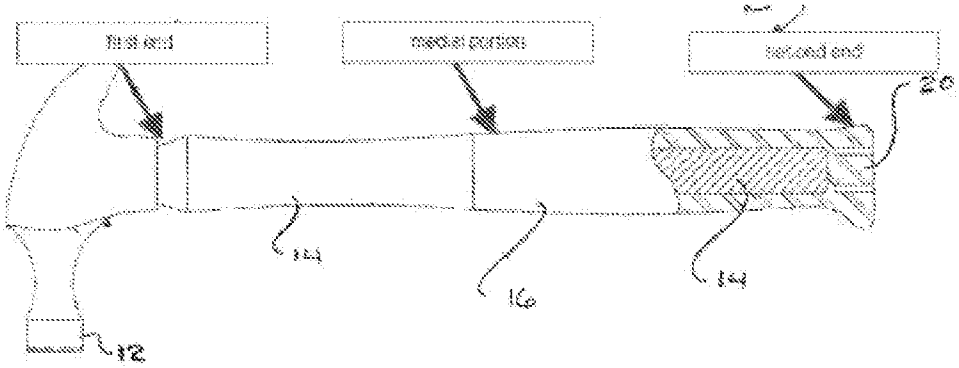

Figure 1 of Macioce as annotated by the Examiner

(Final Act. 2). In particular, Appellants argue that the Examiner's implicit construction of "medial portion" is inconsistent with the Specification (*see* Appeal Br. 9). Appellants point to a portion of the Specification, which states as follows:

> [t]he handle member first end 26 may have a cross-sectional area that is smaller than the handle member medial portion 28 immediately adjacent the handle member first end 26. Preferably, the transition between the handle member first end 26 and the handle member medial portion 28 is a flange 32 that extends generally perpendicular to the longitudinal axis of the wood 22.
>
> The handle member medial portion 28 includes the portion of the wood member 22 below ... the flange 32 to the handle member second end 30

(Spec. 4, ll. 6–9). Although the description following the word "preferably" represents a preferred embodiment, the portion of the disclosure preceding the word "preferably" is definitional, i.e., medial portion 28 is "immediately adjacent" first end 26. However, Macioce's overmold is not adjacent the first end.

The Examiner reasons that "regardless of definition," Macioce covers "substantially all" of the medial portion, as recited (Ans. 5). On the facts of this case, we find insufficient evidence that Macioce's overmold covers "substantially all" of the medial portion. First, one cannot rely on figures for mathematical values unless drawn to scale. *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000). Second, even looking at the proportions of the figures, we do not agree with the Examiner's findings. At most, Macioce's overmold covers half of the handle portion adjacent the handle's first end (i.e., half of the medial portion of the handle). Therefore, we do not sustain the Examiner's rejection under § 102 of independent claim 1, and of claims 2–4, 8, and 9, which depend therefrom.

<u>Rejections II and III (Obviousness)</u>

Claims 5–7, 10, and 11 depend from claim 1, and stand rejected under § 103 as obvious over Macioce and one of Olroyd and Keathley. Neither Olroyd nor Keathley remedies the deficiency in the Examiner's rejection under § 102 of independent claim 1. Nor does the Examiner supply reasoning as to why it would have been obvious to cover the entire medial portion of the handle. Accordingly, we do not sustain the Examiner's rejection under § 103 of claims 5–7, 10, and 11 over Macioce and one of Olroyd and Keathley.

DECISION

The Examiner's decision to reject claims 1–11 is reversed.

REVERSED