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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte HEIKO ROEHM

Appeal 2015-007231
Application 12/865,647¹
Technology Center 3700

Before PHILIP J. HOFFMANN, BRUCE T. WIEDER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the final rejection of claims 10–47. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

According to Appellant, the invention relates to a hand-held power tool. Spec. ¶ 2. Claims 10, 28, and 47 are the only independent claims on appeal. Appeal Br., Claims App. We reproduce claim 10, below, as illustrative of the appealed claims.

¹ According to Appellant, “[t]he real party in interest . . . is Robert Bosch GmbH.” Appeal Br. 2.

10. A power tool, comprising:
 - a housing;
 - an electric drive motor;
 - a user-actuatable motor switch element moveable in a first direction for activating said electric drive motor and in an opposite direction for deactivating said electric drive motor; and
 - a shift transmission that is driven by the drive motor and has a first gear and at least one second gear,wherein said motor switch element is mechanically coupled to said shift transmission in such a way that movement of said motor switch element in said first direction along a predefined distance activates said electric drive motor, and movement of said motor switch element along a further predefined distance in said first direction shifts said shift transmission from the second gear into the first gear or from the first gear into the second gear.

Id.

REJECTION AND PRIOR ART

The Examiner rejects claims 10–47 under 35 U.S.C. § 102(e) as anticipated by Ho (US 2008/0032848 A1, pub. Feb. 7, 2008).

ANALYSIS

Appellant argues that the Examiner’s anticipation rejection of claims 10–47 is erroneous because Ho does not teach the claimed motor switch element, as recited in independent claims 10, 28, and 47, from which each of the remaining claims depend. Appeal Br. 5–11. Based on our review of the record, we agree with Appellant, and, thus, we do not sustain the rejection.

With respect to independent claim 10, the claim recites, in relevant part,

a user-actuatable motor switch element moveable in a first direction for activating said electric drive motor and in an opposite direction for deactivating said electric drive motor;

. . .

wherein said motor switch element is mechanically coupled to said shift transmission in such a way that *movement of said motor switch element in said first direction along a predefined distance activates said electric drive motor, and movement of said motor switch element along a further predefined distance in said first direction shifts said shift transmission* from the second gear into the first gear or from the first gear into the second gear.

Appeal Br., Claims App. (emphases added). Restated, the claim recites that a motor switch element is moved in a first direction to activate a drive motor, and is further moved in the first direction to shift a transmission.

The Examiner finds that

Ho discloses . . . said motor switch element (18, 20) and is mechanically (para. 0031) coupled to said shift transmission (16) in such a way that movement of said motor switch element (18, 20) in said first direction along a predefined distance (para. 0055), activates said electric drive motor (10), and movement of said motor switch element (18, 20) along a further predefined distance in said first direction shifts said shift transmission (16, paras. 0057, 0061, 0062) from the second gear (high speed with low torque para. 0062) into the first gear (low speed with high torque para. 0068) or from the first gear into the second gear.

Answer 3; *see also* Final Action 2–3. Based on our review of the cited portions of Ho, we determine that none clearly describes that a motor switch element is moved in a first direction to activate a drive motor, and is further moved in the first direction to shift a transmission. Ho’s paragraph 31 states that “[t]he drive train 14 may include a variable speed transmission 16 to mechanically change the speed of the output 12. The power tool 2 may also

include a trigger switch **18** and a motor switch **20** for selectively activating the motor **10** to supply power to the drive train **14**,” but does not describe movement of a motor switch element, such as trigger switch 18 or other hardware, to shift transmission 16, for example. *See* Ho ¶ 31. Further, none of the other cited portions of Ho appears to describe movement of a motor switch element to shift a transmission. *See id.* ¶¶ 55, 57, 61, 62, 68.

Conversely, it appears that “the Ho transmission switches automatically in response to an increase in the amount of torque experienced during operation by the power tool—not in response to movement of the trigger switch along a further predefined distance in the same direction that it moved to actuate the motor.” Appeal Br. 6 (emphases omitted); *see also* Ho Abstract (“A variable speed transmission that changes the output speed of a power tool in response to an increase in torque.”).

In response to Appellant’s argument, the Examiner determines that “Ho stated in paragraph 0057 [*sic*—58], lines 43[–]47 that the trigger is continued to be actuated, suggesting the trigger is being move along a distance to start the motor and [to] shift [an] input pinion.” Answer 4. To the extent that the Examiner finds that Ho’s statement that “[a]s the trigger switch **18** continues to be actuated, the trigger switch **18** engages the trigger bar **184** and actuates the motor switch **20**” teaches that a further movement of a motor switch element occurs to shift a transmission, we disagree, and note, for example, that “continue[d] . . . actuat[ion]” may refer to continued holding of switch 18 in a certain position without further movement, while we also note that the cited portion does not discuss any shifting of a transmission.

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Thus, based on the foregoing, we do not sustain the rejection of independent claim 10 or its dependent claims 11–27. Inasmuch as independent claims 28 and 47 recite similar recitations, we also do not sustain the rejection of these independent claims or claim 28’s dependent claims 29–46.

DECISION

We REVERSE the Examiner’s anticipation rejection of claims 10–47.

REVERSED