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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHN MCGARRY, PAMELA JO NAEVE, and
MICHAEL GRINNALL

Appeal 2017-000852
Application 14/038,023
Technology Center 3700

Before STEFAN STAICOVICI, EDWARD A. BROWN, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

John McGarry et al. (“Appellants”)¹ appeal under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–3, 5–7, 19, and 20.² An oral hearing, pursuant to 37 C.F.R. § 41.47, was held on October 31, 2018. We have jurisdiction under 35 U.S.C. § 6(b).

¹ Custom-Pak, Inc. is identified as the real party in interest. Br. 2.

² Claims 4, 8, 9, 21, and 22 are indicated to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Final Act. 8. The Final Action does not include a rejection of any of these claims.

We REVERSE.

THE CLAIMED SUBJECT MATTER

Appellants' invention is directed to "a blow molded chain saw case." Spec. ¶ 1. Claim 1, reproduced below, is illustrative of the claimed subject matter.

1. A hybrid double and single wall case for a chainsaw having a bar, said case comprising:

a first body section and a second body section, each having a base wall and a peripheral side wall, said peripheral side walls each defining an edge wherein said first body section is a single molded piece;

said first and second body sections pivotally connected with respect to each other and adapted to pivot between an open position and a closed position, the open position to allow the chainsaw to be positioned in the case, the closed position to contain at least a majority of the chainsaw within the case;

said peripheral side wall of said first body section having an opening with two side sections, the opening extending from said edge and towards said base wall;

a scabbard having an end portion with two side sections, said side sections of said end portion adapted to mate with said side sections of said opening, said scabbard adapted to be applied to the bar of the chain saw, said end portion adapted to be received within the opening;

a portion of the first body section being configured as a double wall structure; and

a portion of the first body section being configured as a single wall structure.

REJECTION

Claims 1–3, 5–7, 19, and 20 are rejected under 35 U.S.C. § 103 as unpatentable over Anderson (US 2003/0075467 A1, published Apr. 24, 2003) and Dembicks (US 4,371,079, issued Feb. 1, 1983).³

DISCUSSION

The Examiner finds that Dembicks discloses most of the limitations of claim 1 “except for a portion of the first body section being configured as a double wall structure; and a portion of the first body section being configured as a single wall structure.” Final Act. 3–4. The Examiner finds that Anderson discloses “a single wall or double wall construction could be used to construct panels and portions of walls of the container.” *Id.* at 4 (citing Anderson, ¶ 31). The Examiner concludes that it would have been obvious to one of ordinary skill in the art “to modify Dembicks such that a hybrid construction of single and double walls were provided for in order to save material, provide less waste and to use other forming techniques in producing the case.” *Id.*

Appellants’ first contention is that “[a]lthough one piece in Anderson may be single wall and others may be double wall [0031], none of the pieces include both single and double wall structures within a single molded piece.” Br. 6–7. Appellants’ second contention is that the Examiner’s reason for combining the teachings of Dembicks and Anderson, to save material, is not disclosed in the prior art but is based on Appellants’ disclosure. Br. 9–10

³ The rejection of claims 1–9 under 35 U.S.C. 112, second paragraph, as being indefinite has been withdrawn by the Examiner. *See* Advisory Action (dated Feb. 5, 2016); Final Act. 2–3.

(citing Spec. ¶ 8, 39). The Examiner responds that Anderson discloses “both a single wall construction and a double wall construction” of the panels, and, “Anderson as a whole teaches that the case in Figure 4 teach that these panels could be hinged ... [and] considered one piece.” Ans. 4. For the following reasons, we do not sustain the rejection of claim 1.

Anderson discloses a chain saw case 10C comprising a number of discreet flat panels that interconnect to form an enclosure for a chain saw. *See* Anderson, Figs. 3–4. Anderson further discloses that the flat panels are each blow molded and of double wall construction. *Id.* ¶ 28. Anderson also discloses that “one or more of the doors or panels of the case body may be of single wall construction.” *Id.* ¶ 31. The Examiner does not, however, direct us to any disclosure in Anderson of a single molded piece of Anderson’s chain saw case 10C that is configured with a single wall structure *and* a double wall structure as required in claim 1. Even accepting the Examiner’s position that Anderson’s individual panels connected together by hinges to form an enclosure may be considered “one piece,” that is not sufficient to satisfy the claim limitation of a first body section that is a single molded piece with a portion configured as a single wall structure and a portion configured as a double wall structure. To the extent that the Examiner asserts that this claim limitation is satisfied by the combined teachings of Dembicks and Anderson, the reason for the combination stated by the Examiner lacks a rational underpinning because, as Appellants correctly point out, the Examiner does not support the reasoning with specific findings supported by the prior art. As the rejection is based on an erroneous factual finding, the conclusion of obviousness cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (holding that “[t]he legal

conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.”). We, thus do not sustain the rejection of claim 1 and claims 2, 3, and 5–7 which depend directly or indirectly from claim 1.

Independent claim 19 requires that “a portion of the first body section being configured as a double wall structure; wherein at least a majority, based on surface area, of the *base wall* of the first body section being configured as a single wall structure.” Br. 23 (Claims App.) (emphasis added). The Examiner finds that Anderson discloses a hybrid construction where “the majority of the *side wall* panels are made from a single wall structure.” Final Act. 7 (emphasis added). We, thus, do not sustain the rejection of claim 19 because the rejection does not address the actual claim limitation that the majority based on surface area of the base wall is configured as a single wall structure. We also do not sustain the rejection of claim 20 which depends from claim 19 for the same reason.

DECISION

The Examiner’s decision rejecting claims 1–3, 5–7, 19, and 20 is reversed.

REVERSED