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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SIMON GARRY MOORE

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Appeal 2018-004825  
Application 12/863,182  
Technology Center 3600

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Before STEFAN STAICOVICI, LEE L. STEPINA, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Simon Garry Moore (“Appellant”) appeals under 35 U.S.C. § 134(a) from the Examiner’s decision rejecting claims 1–3, 8, 9, 12–17, 34–41, 43, and 44.<sup>1</sup> We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> DMOTM Limited is identified as the real party in interest. Appeal Br. 1.

### THE CLAIMED SUBJECT MATTER

The claims are directed to an adjustable connection mechanism for connecting two or more shafts. Spec. 1:5. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A mechanism for connection of two or more shafts in an adjustable position relative to one another, comprising  
at least a first shaft having at least a portion which is a rigid tube having an external surface with an outer diameter,  
and  
a second shaft having at least a portion which is a rigid tube and which is hollow at least in a portion at a first end,  
wherein a spring is anchored to the first end of the second shaft,  
the spring having an inner diameter of similar dimensions to the outer diameter of the first shaft,  
the spring configured such that when a force is applied to the spring its inner diameter is greater than the outer diameter of the first shaft enabling the second shaft to be moved over the first shaft to a desired position relative to the first shaft, said hollow portion of the second shaft receiving at least a portion of said first shaft, and  
when the force is no longer applied to the spring it is biased to return to its original inner diameter to bear against the external surface of the first shaft,  
and wherein the mechanism includes  
a second spring anchored to an end of the first shaft, the second spring having an outer diameter of similar dimensions to the hollow portion of the second shaft  
to inhibit rotation of the shafts relative to one another when in the desired position.

### REJECTIONS

1. Claim 43 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

2. Claim 43 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

3. Claims 1–3, 8, 9, 12–17, 34, 35, 39–41, 43, and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooldridge (US 809,880, issued Jan. 9, 1906) and Safarevich (US 6,293,594 B1, issued Sept. 25, 2001).

4. Claims 36–38 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooldridge, Safarevich, and Moore (WO 2007/086757 A1), published Aug. 2, 2007.

## DISCUSSION

### *Rejection 1*

The Examiner finds that the limitation “the ‘second spring is received within the rigid tube portion of the second shaft[,]’” as recited in claim 43 is not represented by the elected species of Figures 5a–6c. Final Act. 4. According to the Examiner, for the elected species, “the second spring is element 38 and the second shaft is element 36, thus, [the] second spring is not received within the rigid tube portion of the second shaft, and therefore, the issue of new matter appears to have been raised.” *Id.*

Appellant argues that the limitation in question “is fully illustrated in Figures 6(a)–6(c) ... a spring 37 associated with the first shaft is received within a hollow rigid tube portion of the second shaft 36.” Appeal Br. 6 (citing Spec. ¶ 190).<sup>2</sup>

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<sup>2</sup> Appellant refers to paragraph numbers of the U.S. Publication of the present application (US 2011/0306438 A1, published Dec. 15, 2011).

The Examiner responds that because the Specification denotes element 38 as “the second spring” and because spring 38 is shown in Figure 5(b) on second shaft 36, the second spring is not within the second shaft.

Ans. 6.

Although we appreciate the Examiner’s position that the Specification refers to spring 38 as “the second spring 38” (Spec. 38:18)<sup>3</sup>, we understand this one instance to be an inadvertent typographical error in that other instances of “spring 38” require “the first shaft 35 to be inserted into the interior of the spring 38 and second shaft 36” (Spec. 39:7–8) and “spring 38, following its natural bias to return to its original diameter, forms a friction fit against the external surface of the first shaft 35” (Spec. 39:16–17). Based on what is depicted in Figures 5(a)–6(c), particularly Figure 6(b), it is apparent that shaft 35 is the first shaft having second spring 37 and that shaft 36 is the second shaft having first spring 38. Thus, we agree with Appellant that the Drawings, as filed, illustrate a second spring received within the rigid tube portion of the second shaft, as required by claim 43.

For these reasons, we do not sustain the Examiner’s rejection under 35 U.S.C. § 112, first paragraph of claim 43 as failing to comply with the written description requirement.

### *Rejection 2*

The Examiner’s basis for the rejection of claim 43 as indefinite is based on the same findings noted above for Rejection 1. Final Act. 4–5. For the same reasons stated above for Rejection 1, we also do not sustain the Examiner’s indefiniteness rejection of claim 43.

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<sup>3</sup> We refer to the Specification as filed July 15, 2010.

The Examiner also objected to the drawings with respect to the subject matter of claim 43 under 37 C.F.R. § 1.83(a). Final Act. 2. In particular, the Examiner objected to the drawings because “for the elected species the second spring is element 38 and the second shaft is element 36, there is no illustration which shows what is claimed.” *Id.* Normally, an objection is not an appealable matter. *See In re Mindick*, 371 F.2d 892, 894 (CCPA 1967). However, if our disposition of a rejection also disposes of an issue in an objection, we may address the objection. *See* MPEP §1201. In this case, we are reversing the Examiner’s rejections under 35 U.S.C. § 112, first and second paragraphs for failure to comply with the written description requirement and for indefiniteness based on our finding that Appellant’s drawings show a second spring received within the rigid tube portion of the second shaft, as required by claim 43. The Examiner’s objection with respect to the limitations of claim 43 is, thus, moot.<sup>4</sup>

### *Rejection 3*

The Examiner finds that Wooldridge discloses many of the features of claim 1 including first and second shafts each having a spring anchored to the shaft, but that neither of the shafts of Wooldridge includes a rigid portion. Final Act. 6–7. The Examiner finds that Safarevich discloses a spring anchored to a rigid tube, and considers that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the shafts of Wooldridge to each have a portion which is a

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<sup>4</sup> The Examiner also objected to the drawings for failing to show the limitations of claim 44. Final Act. 2. We do not reach this part of the Examiner’s objection to the drawings because our decision regarding the Examiner’s rejections does not address it, and, therefore, it is a petitionable matter, not an appealable matter. *In re Mindick*, 371 F.2d at 894.

rigid tube with a spring anchored at an end thereof. *Id.* at 7. The Examiner concludes that the modification would be

for the purpose of providing a means to form a handle to better grip the device, or to aid in the prevention of getting ones hand pinched in the coils during use of the device, or for providing a device that increases the ability to apply force to the structure without the force applying portion flexing under load.

*Id.* at 8.

Appellant argues, *inter alia*, that Safarevich is non-analogous art because it is in a different field of endeavor and is not reasonably pertinent to the particular problem with which the inventor is involved. Appeal Br. 8. As to the field of endeavor, Appellant asserts that “the present invention is directed to a mechanism for adjustedly connecting two shafts (such as golf club shafts) while Safarevich is directed to pacemaker leads.” *Id.* As to the pertinence of Safarevich to the inventor’s problem, Appellant submits that although Safarevich has a shaft connected to a coiled member, “it is use of a coiled member to connect two shafts that is the focus of the present invention.” *Id.* Appellant argues that the problem to be solved by the claimed invention is to adjustably mate two shafts, whereas Safarevich “is directed to pacemaker leads” and “[w]elding a coil to a shaft in a manner that provides no adjustability . . . is not Appellant’s field of endeavor.” *Id.* According to Appellant, “Safarevich has nothing to do with adjustable mating and it can provide no teaching relevant to Appellant’s problem.” *Id.*

The Examiner responds that “Safarevich is in the same field because Safarevich is related to a shaft being connected to a coiled metal member, **similar to that of this instant application**, emphasis added.” Ans. 10. According to the Examiner, Safarevich is “pertinent or addressing the same issues/problem because such is related to a shaft member being connected to

a coiled member (spring member) where the shaft is connecting to another structure via a spring joint connection, **similar to that of this instant application**, emphasis added.” *Id.*

The analogous art test requires that a reference either be in the field of the applicant’s endeavor or reasonably pertinent to the problem with which the inventor was concerned in order to rely on that reference as a basis for the rejection. *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art. *Id.* (“[I]t is necessary to consider ‘the reality of the circumstances,’ --in other words, common sense--in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.” (quoting *In re Wood*, 599 F.2d 1032, 1036 (CCPA1979))).

Furthermore, the scope of analogous art is to be construed broadly. *Wyers v. Master Lock Co.*, 616 F.3d 1231, 1238 (Fed. Cir. 2010) (“The Supreme Court’s decision in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007), directs us to construe the scope of analogous art broadly, stating that ‘familiar items may have obvious uses beyond their primary purposes, and a person of ordinary skill often will be able to fit the teachings of multiple patents together like pieces of a puzzle.’ *Id.* at 402 (emphasis added).”).

We do not agree with the Examiner that Safarevich is in Appellant’s field of endeavor or that it is reasonably pertinent to the problem solved by the claimed invention. As Appellant correctly notes, Safarevich’s “invention relates generally to lead assemblies for connecting implantable medical devices ... namely, cardiac pacemakers.” Safarevich 1:5–21. Although we appreciate that Safarevich connects wound member 36 to shaft 37 (*see*

Safarevich 7:8–9; Fig. 4), even if one of ordinary skill in the art were to equate a coiled wire strand (Safarevich 7:11–12) that electrically connects a pacemaker to heart tissue (Safarevich 1:25–41) with a spring, Appellant adjustably connects two shafts to each other, each having a spring. *See* Spec. Figs. 5(a)–6(c). We agree with Appellant that Safarevich’s depiction of one shaft connected to a coiled wire in Figure 4 is insufficient to support a conclusion that Safarevich is in Appellant’s field of endeavor of connectors that connect two shafts to each other.

As to whether Safarevich is reasonably pertinent to the problem with which Appellant was concerned, the claimed invention seeks to “improve the reliability of connection devices,” because prior art devices are subject to failure by prematurely separating when subject to vibration. Spec. 1:12–18. To address this problem, Appellant invented a mechanism that resists separation forces acting on the two shafts, but the two shafts are still able to be separated so that the mechanism is an adjustable connection mechanism. *See* Spec. Figs. 5(a)–5(c) (disengaged) and Figs. 6(a)–6(c) (engaged). As discussed above, Safarevich is not directed to connecting two shafts. Nor is Safarevich intended to be separable, or adjustable. Rather, Safarevich provides a permanent connection between coiled wire 36 and shaft 37 by welding. *See* Appeal Br. 9. Specifically, Safarevich uses a thermal fusing process to form “weld joint 64 between wound element 36 and the transition component 50” and to form spot welds 66 at “the joint between the transition component and the mating connector 37.” Safarevich 7:25–53. Given that Safarevich does not connect two shafts and does not have an adjustable connection, we agree with Appellant that Safarevich is not reasonably pertinent to improving an adjustable connection between two shafts. We,

thus, do not sustain the Examiner's rejection of claims 1–3, 8, 9, 12–17, 34, 35, 39–41, 43, and 44 as unpatentable over Wooldridge and Safarevich because we do not agree with the Examiner that Safarevich is analogous art to the claimed invention.

*Rejection 4*

Claims 36, 37, and 38 depend from claims 1, 8, and 13, respectively. Appeal Br. 20 (Claims App.). The Examiner does not rely on the disclosure of Moore in any manner that would remedy the deficiencies in the rejection of claims 1, 8, and 13 discussed above based on Wooldridge and Safarevich. For the same reasons, we do not sustain the rejection of claims 36–38 as unpatentable over Wooldridge, Safarevich, and Moore.

DECISION

The Examiner's decision to reject claim 43 as failing to comply with the written description requirement, and as being indefinite, is reversed.

The Examiner's decision to reject claims 1–3, 8, 9, 12–17, 34–41, 43, and 44 as unpatentable is reversed.

REVERSED