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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ERICH HUNGER and SEBASTIAN HUNGER

Appeal 2019-003660
Application 13/642,562
Technology Center 2800

Before ROBERT E. NAPPI, THU A. DANG, and
JOHN P. PINKERTON, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's Final Rejection of claims 1–20 (Appeal Br. 1), which constitute all the claims pending in this application.[1] We have jurisdiction under 35 U.S.C. § 6(b). We held an Oral Hearing on June 17, 2020.

We REVERSE.

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[1] We use the word "Appellant" to refer to "applicant" as defined in 37 C.F.R. § 1.42. According to Appellant, the real party in interest is IML-Instrumenta Mechanik Labor GmbH. Appeal Br. 2.

A. INVENTION

According to Appellant, the claimed invention relates to "a method and an instrument for examining the condition of wood," and "other column-shaped or cylindrical sections of bodies." Spec. 1:3–5.

B. ILLUSTRATIVE CLAIM

Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A hand-held testing instrument for examining the condition of column-shaped or cylindrical sections of an object, comprising:

a drive device having a drill chuck, which holds a drill needle that is driven by the drive device,

a guiding device for centrally-axially guiding the drill needle into the object to be examined, wherein the guiding device comprises a telescopic tube,

wherein said telescopic tube comprises two tube sections including a shorter inner tube section and a longer outer tube section, wherein the shorter inner tube section is arranged in the longer outer tube section such that it is axially displaceable and has a longitudinally arranged measuring scale on an outer circumference of the inner tube section,

wherein said telescopic tube is mounted on the drive device via the inner tube section in non-rotating manner, wherein the drive device is a drilling machine,

wherein the drill needle extends in central-axial direction from the drill chuck through the inner tube section and through the outer tube section,

wherein the drill needle can be driven into the object to be examined in a manner guided by the guiding device while the inner tube section is being inserted into the outer tube section,

wherein the hand-held testing instrument comprises neither an electronic nor a mechanical recorder to measure how far the needle penetrated the object, wherein the longitudinally arranged measuring

scale on the outer circumference of the inner tube section provides a direct measure of how far the needle penetrated the object.

C. REJECTION

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Name	Reference	Date
Foley	US 2003/0131674	July 17, 2003
Kipp	DE 4004242	August 14, 1991
Rinn '494	DE 4122494	March 5, 1992
Rinn '395	DE 10031395	April 26, 2001

Claims 1–19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinn '395, Rinn '494, and Kipp.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rinn '395, Rinn '494, Kipp, and Foley.

II. ISSUES

The dispositive issues before us are whether the Examiner has erred in determining that the combination of Rinn '395, Rinn '494 and Kipp teaches or suggests "a telescopic tube" of "a guiding device" that comprises "a shorter inner tube section and a longer outer tube section," wherein "the shorter inner tube section is arranged in the longer out tuber section" such that it "has a longitudinally arranged measuring scale on an outer circumference of the inner tube section." Claim 1.

III. ANALYSIS

a. Claims 1–19

With respect to the Examiner's rejection of claims 1–19, Appellant contends that none of the cited references teach a longitudinally arranged measuring scale on an outer circumference of the inner tube section. Appeal Br. 5–7. According to Appellant, the Examiner relies on Kipp to teach this feature, "alleging that the measuring scale 8 is on an outer circumference of the inner tube section 27." *Id.* at 5. However, Appellant contends that, in Kipp, "it is clear from Fig. 3 that the measuring scale 8 is not on an outer circumference of the inner tube section." *Id*. at 6.

We have considered all of Appellant's arguments and evidence presented. We agree with Appellant that the preponderance of the evidence on this record does not support the Examiner'sconclusion that claim 1 and claims 2–19 depending therefrom would have been obvious over Kipp in combination with Rinn '395 and Rinn '494.

The claimed invention provides a "hand-held testing instrument" for "examination of a large number of trees and wood constructions as well as wooded poles for the presence of decay." Spec. 7:1–4. Figure 1 is reproduced below:

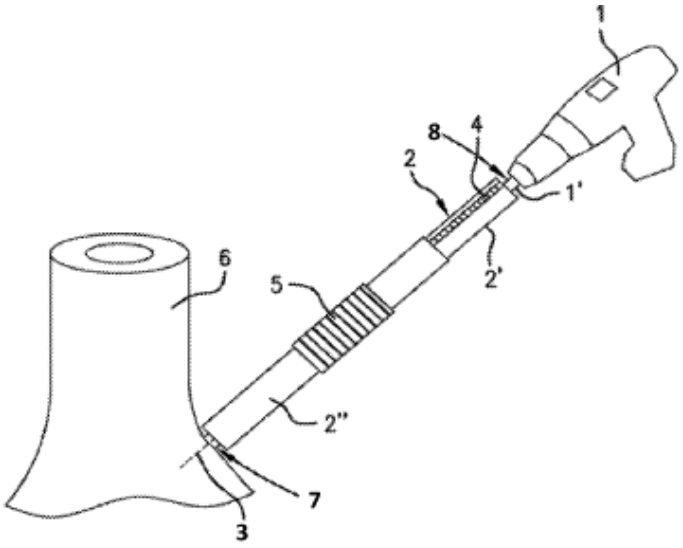

FIG. 1

Figure 1 of the claimed invention shows a hand-held testing device comprising drive means 1 having a drill chuck into which drill needle is inserted, a guidance for guided penetration of drill needle 3 into object 6 to be examined, and measuring scale 4 showing the depth at which the diseased wood is detected, wherein the guidance comprises telescopic tube 2 having inner tube section 2' that is shorter than outer tube section 2" surrounding it. Spec. 7:30–8:8. As shown in Figure 1, inner tube section 2' is arranged in out tube section 2" comprising measuring scale 4 thereon. *Id.* at 8:8–12.

On the record before us, we are persuaded that the Examiner erred in finding that Kipp teaches or suggests "the shorter inner tube section is arranged in the longer outer tube section" such that it "has a longitudinally arranged measuring scale on an outer circumference of the inner tube section," as recited in claim 1. We agree with Appellant that, in Kipp, "because there is an intermediary part between [measuring scale 8 and inner tube 27,] the scale is not on the circumference of the inner tube." Appeal Br. 6 (citing Kipp, Fig. 3).

Kipp discloses a testing device using a metal wire which is rotated and caused to penetrate the wood, with detection of the penetration depth. Kipp, Abstract. Figure 3 of Kipp is reproduced below:

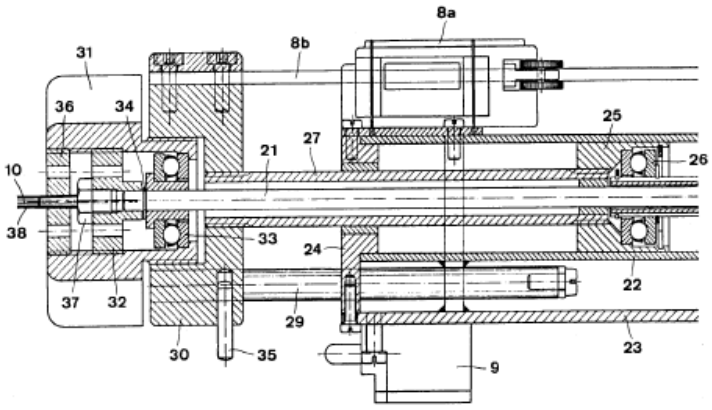

Fig.3

Figure 3 of Kipp shows telescope device 25, comprising inner tube 27 inside outer tube 22, and caliper 8 with digital display 8a.

We are unpersuaded by the Examiner's finding that claim 1's "longitudinally arranged measuring scale" encompasses Kipp's caliper 8. Final Act. 5–6. As Appellant points out, as shown in Kipp's Figure 3, caliper 8 "is significantly above the circumference of the inner tube 27 and even above the circumference of the outer tube 22." Appeal Br. 6. That is, although the Examiner relies on Kipp's caliper 8 as a "longitudinally arrange[d] measuring scale on the outer circumference of the inner tube section" (Final Act. 5–6), as shown in Figure 3, Kipp's caliper 8 is arranged above outer tube 22 and inner tube 27. *Compare* claim 1 *with* Kipp, Fig. 3.

In the Answer, the Examiner adds that the "broadest reasonable interpretation consistent with the specification" of the term "on" does not preclude having an intermediary between the two elements. Ans. 4. According to the Examiner, "Kipp teaches an inner tube section (27) and an outer tube section (22) (Figure 3)," and "a longitudinally arranged measuring

scale [8] which is attached to (30) which is supported by the outer circumference of the inner tube section (27) (Figure 3)." *Id.* 4–5.

However, the broadest reasonable interpretation of a claim term does not mean an interpretation so broad that it would encompass an unreasonable construction under claim construction principles. *See Microsoft Corp. v. Proxyconn, Inc*., 789 F.3d 1292, 1298 (Fed. Cir. 2015). As shown in Kipp's Figure 3, and as agreed by the Examiner, caliper 8 is attached to element 30 of the telescope device, which is attached to the inner tube section 27. Ans. 4–5. However, as shown in Figure 3 and given the broadest *reasonable* interpretation of "on," which would not encompass an unreasonable construction under claim construction principles, caliper is not "on" the outer circumference of section 27, but rather *above* the various sections of the telescope device, including the inner tube section 27. *Compare* claim 1 *with* Kipp, Fig. 3.

Further, the broadest reasonable interpretation of "on" does not allow for a legally incorrect interpretation that is divorced from the specification and record evidence. *See PPC Broadband, Inc. v. Corning Optical Commc'ns RF, LLC*, 815 F.3d 747, 751–53 (Fed. Cir. 2016). Interpretation of "a longitudinally arranged measuring scale on an outer circumference of the inner tube section" as encompassing Kipp's caliper 8 attached to element 30 of the telescope device, which is then attached to the inner tube section 27, is divorced from the specification and record evidence, wherein the specification's Figure 1, for example, clearly shows measuring scale 4 arranged "on" inner tube section 2'. *Compare* Kipp, Figure 3 (caliper 8) *with* Spec., Figure 1 (measuring scale 4).

Consequently, we are constrained by the record before us to find that the Examiner erred in concluding Appellant's claim 1 and claims 2–19 depending therefrom would have been obvious over Kipp in combination with Rinn '395 and Rinn '494.

b. Claim 20

Independent claim 20 similarly recites "a measuring scale on an outer circumference of the inner tube section." *See* claim 20. The Examiner does not suggest, and has not established on this record, that the additionally cited Foley reference overcomes the aforementioned deficiencies of Kipp. *See* Final Act. 8–11, Ans. 9–12. Consequently, we are constrained by the record before us to find that the Examiner also erred in concluding that the combination of Rinn '395, Rinn '494, Kipp, and Foley renders obvious Appellant's claim 20.

IV. CONCLUSION AND DECISION

The Examiner's rejections of claims 1–20 under 35 U.S.C. § 103(a) are reversed.

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–19	103(a)	Rinn '395, Rinn '494, Kipp		1–19
20	103(a)	Rinn '395, Rinn '494, Kipp, Foley		20

REVERSED