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Maginot, Moore & Beck LLP One Indiana Square, Suite 2200 Indianapolis, IN 46204			PETERSON, KENNETH E	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BRADLEY PADGET

Appeal 2019-004608
Application 14/982,319
Technology Center 3700

Before BIBHU R. MOHANTY, MICHAEL C. ASTORINO, and
PHILIP J. HOFFMANN, *Administrative Patent Judges*.

HOFFMANN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–8 and 10–13. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM IN PART.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Robert Bosch GmbH. Appeal Br. 2.

According to Appellant, “[t]he disclosure relates to hand-held power tools, and particularly to tools having an oscillating cutting blade.” Spec.

¶ 2. Below, we reproduce claim 1 as illustrative of the appealed claims:

1. A foot for supporting a hand-held power tool on a workpiece, the power tool having a blade operably driven at an output portion at a working end of the tool, the foot comprising:

a plate defining a recess configured to receive and support at least the working end of the power tool with the blade positioned to contact the workpiece;

a plurality of elements supported by the plate, each of the plurality of elements configured for rolling or sliding contact with the surface of the workpiece for movement of the foot along the surface of the workpiece,

wherein said recess is configured to retain at least the working end of the power tool within said recess when the foot is moved along the surface of the workpiece with the blade positioned in contact with the workpiece.

REJECTIONS AND PRIOR ART

The Examiner rejects the claims as follows:²

- I. Claims 7, 8, 12, and 13 under 35 U.S.C. § 112(a) as failing to comply with the written-description requirement;
- II. Claim 10 under 35 U.S.C. § 112(b) as indefinite;
- III. Claims 1 and 3–6 under 35 U.S.C. § 102(a)(1) as anticipated by Moreno (US 2013/0081841 A1, pub. Apr. 4, 2013);
- IV. Claim 11 under 35 U.S.C. § 103 as unpatentable over Moreno and Ende (US 7,958,641 B1, iss. June 14, 2011);

² In the Answer, the Examiner withdraws a number of rejections from the Final Office Action. *See, e.g.*, Answer 14.

- V. Claims 12 and 13 under 35 U.S.C. § 103 as unpatentable over Moreno and Heinlen et al. (US 2003/0183303 A1, pub. Oct. 2, 2003) (“Heinlen”);
- VI. Claims 1–4, 7, and 8 under 35 U.S.C. § 103 as unpatentable over Clowers (US 4,628,605, iss. Dec. 16, 1986) and Kalb (US 9,533,430 B1, iss. Jan. 3, 2017); and
- VII. Claims 1–6 under 35 U.S.C. § 103 as unpatentable over Moreno and Kalb.

ANALYSIS

Rejection I—Written-description rejection

For the reasons set forth below, we do not sustain the Examiner’s written-description rejection of claims 7, 8, 12, and 13.

The Examiner rejects claims 7 and 8 based on the following:

Claims 7 and 8 recite “a blade guide feature . . . arranged to support the planar surface of the blade,” and that said blade guide is adjustable. However, this . . . is not shown in the drawings. As seen in [F]igures 2 and 4, elements 27 and 28 do not appear to guide a planar surface of the blade. It is also not well described how it would be adjusted.

Answer 4. We agree with Appellant that at least paragraph 18 of the Specification, as originally filed, provides written-description support for the quoted claim recitation. Appeal Br. 6; *see* Spec. ¶ 18 (“Returning to F[igures] 2 and 4, . . . hub 27 that supports one of . . . rollers 30 may be modified to include . . . blade guide feature 28. In one embodiment, . . . feature 28 may be a roller or similar bearing surface that bears against the working end of . . . blade B to help prevent the blade [from] bending during a cut.”). We also agree with Appellant that neither claim recites that the

blade guide is adjustable. Appeal Br. 5. Thus, we do not sustain the Examiner's written-description rejection of claims 7 and 8.

The Examiner rejects claims 12 and 13 based on the following:

Claims 12 and 13 recite "a recess insert," or "a plurality of recess inserts." However, there is no description of how this insert is attached to the plate. How does it "insert," especially since the recess goes to the edge of the plate?

Answer 4. However, we agree with Appellant that at least paragraph 20 of the Specification, as originally filed, provides written description support for the claim recitations. Appeal Br. 9–10; *see* Spec. ¶ 20 ("The foot may be configured to accommodate a wide range of oscillating tools. In one aspect, . . . recess 24 may be in the form of . . . recess insert 24' that is calibrated to a particular tool. . . . [R]ecess insert 24' fits into a standard cut-out (not shown) in . . . plate 22, while the surface of the recess is shaped according to the tool being used. The foot may thus be provided with several recess inserts 24' for use with several different tools."). Thus, we do not sustain the Examiner's written-description rejection of claims 12 and 13.

Rejection II—Indefiniteness rejection

The Examiner rejects claim 10 as indefinite, because "[c]laim 10 depends from a cancelled claim." Answer 5. Appellant does not argue that the Examiner errs. *See generally* Appeal Br. Thus, we summarily sustain claim 10's indefiniteness rejection.

Rejection III—Anticipation rejection of claims 1 and 3–6, based on Moreno

For the reasons discussed below, the Examiner does not support adequately that Moreno discloses all of independent claim 1's recitations.

Thus, we do not sustain the Examiner's anticipation rejection of claim 1, or of claims 3–6 that depend from claim 1.

Claim 1 recites, in relevant part, “a plate defining a recess configured to receive and support at least the working end of the power tool with the blade positioned to contact the workpiece.” Appeal Br., Claims App. Consistent with Appellant's argument (Appeal Br. 12–19), the Examiner does not support adequately that Moreno's recess supports the tool's working end (Answer 17–19). We acknowledge the Examiner's citation to Moreno's Figure 3, which appears to show “Moreno's ‘working end’ . . . sitting in the recess.” Answer 18. However, we agree with Appellant that

there is not enough in the drawings of Moreno to establish unequivocally that the area around the pinion gear is supported by the unlabeled recess in the plate. For example, Fig[ure] 32 of Moreno clearly leaves open the possibility of a clearance in the area between the working end of the tool and the recess in . . . foot (456).

Reply Br. 7 (citation to Appeal Brief omitted); *see also* Appeal Br. 17 (“As can be seen in [Moreno's] Fig[ure] 32, even when the power tool is in its lowest position such that . . . clamping component (590) is at the bottommost point of . . . slot (498), the ‘recess’ does not appear to support any portion of . . . foot (456).”). Further, the Examiner does not rely on anything in Moreno describing that “the ‘recess’ supports, or even so much as contacts the bottom contour of . . . pinion gear (256).” Reply Br. 7. Thus, we determine that the Examiner relies on conjecture to determine that the recess supports the tool's working end, which is insufficient to support an anticipation rejection. Therefore, the Examiner fails to adequately support the finding that Moreno discloses all of independent claim 1's recitations. Consequently, we do not sustain this rejection of claims 1 and 3–6.

Rejections IV and V—Obviousness rejections of claims 11–13, based on Moreno and either Ende or Heinlen

Claims 11–13 depend from claim 1. The Examiner does not rely on Ende or Heinlen to disclose anything that would remedy the above-discussed deficiency in claim 1’s rejection as anticipated by Moreno. Accordingly, we do not sustain the Examiner’s obviousness rejections of claims 11–13.

Rejection VI—Obviousness rejection of claims 1–4, 7, and 8, based on Clowers and Kalb

For the reasons discussed below, the Examiner does not support adequately that Clowers discloses certain of independent claim 1’s recitation. Consequently, we do not sustain the Examiner’s obviousness rejection of claim 1, or of claims 2–4, 7, and 8 that depend from claim 1.

As set forth above, claim 1 recites, in relevant part, “a plate defining a recess configured to receive and support at least the working end of the power tool with the blade positioned to contact the workpiece.” Appeal Br., Claims App. According to the Examiner, everything below the raised edge of Clowers’s base 21 is the claimed recess defined in the plate. *See, e.g.*, Answer 25. According to Appellant, such an arrangement may not properly be interpreted as disclosing a recess defined in a plate. *See, e.g.*, Appeal Br. 44–47.

Thus, the question is whether the Examiner adequately supports that Clowers’s base 21 discloses the claimed plate with a recess. *See, e.g.*, Answer 25. We determine that the Examiner does not. The Examiner does not point to anything in the record supporting adequately that base 21 is recognized as a plate with a recess. Instead, inasmuch as almost all of Clowers’s base 21 is a flat plate that is below the raised edge, it appears to us

that base 21 is a plate with a raised edge rather than a plate that defines a recess. *See* Appeal Br. 44–47. Accordingly, we do not sustain this obviousness rejections of independent claim 1 and dependent claims 2–4, 7, and 8.

Rejection VII—Obviousness rejection of claims 1–6, based on Moreno and Kalb

In this rejection, the Examiner appears to rely on Moreno to disclose the claimed plate defining a recess configured to receive and support a power tool’s working end. *See, e.g.*, Answer 13. Thus, we do not sustain this obviousness rejection of claims 1–6 for substantially the same reasons that we do not sustain the anticipation rejection based on Moreno, discussed *supra*.

CONCLUSION

We REVERSE the Examiner’s written description, anticipation, and obviousness rejections of claims 1–8 and 11–13.

We AFFIRM the Examiner’s indefiniteness rejection of claim 10.

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
7, 8, 12, 13	112(a)	Written description		7, 8, 12, 13
10	112(b)	Indefiniteness	10	
1, 3–6	102(a)(1)	Moreno		1, 3–6
11	103	Moreno, Ende		11
12, 13	103	Moreno, Heinlen		12, 13
1–4, 7, 8,	103	Clowers, Kalb		1–4, 7, 8
1–6	103	Moreno, Kalb		1–6
Overall Outcome			10	1–8, 11–13

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED IN PART