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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte AMY B. HANGEN and MERRY S. RIEHM-CONSTANTINO

Appeal 2019-005078
Application 14/678,197
Technology Center 3700

Before JILL D. HILL, LEE L. STEPINA, and ARTHUR M. PESLAK,
Administrative Patent Judges.

HILL, *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 1–4, 6–9, 11–16, and 18–24. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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 Arthur Lansky Levine & Associates, Inc. d/b/a Lansky Sharpener. Br. 3.

BACKGROUND

Appellant's invention relates to an abrasive sharpener. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An abrasive sharpener comprising:
a housing comprising a slotted bottom surface;
an abrasive rod pivotally mounted within the slotted bottom surface for movement between a stored position and an extended position; and,
a first magnet positioned within the slotted bottom surface and arranged to directly attract and releasably secure the abrasive rod in the stored position.

REJECTION

Claims 1–4, 6–9, 11–16, and 18–24 stand rejected under 35 U.S.C. § 103 as unpatentable over Smith (US 8,221,199 B2, iss. July 17, 2012) and Carlson (2007/0193036 A1, pub. Aug. 23, 2007). Final Act. 2.

ANALYSIS

Appellant argues claims 1–4, 6–9, 11–16, and 18–24 as a group. Br. 23–30. We select claim 1 as representative. Claims 2–4, 6–9, 11–16, and 18–24 stand or fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner finds that Smith discloses all of the limitations of claim 1, including an abrasive rod secured in a stored position, except that Smith does not disclose a magnet in the bottom surface that directly attracts and releasably secures the abrasive rod in the stored position. Final Act. 3. The Examiner finds that Carlson discloses a magnet 60 that attracts and holds a tool in a stored position. *Id.* The Examiner concludes that it would have been obvious to replace each of Smith's rod holder 22a, 22b with a magnet

60 as taught by Carlson, “to secure the tool in a stored position . . . as an alternate tool storing means.” *Id.*

Independent claim 11 includes substantially similar limitations and the Examiner makes the same findings and uses the same reasoning in rejecting claim 11. *See* Final Act. 2–3.

Hindsight

Appellant argues that the Examiner’s conclusion of obviousness is based on impermissible hindsight, because the Examiner does not explain why a skilled artisan would make the combination absent Appellant’s disclosure. Br. 25.

Appellant’s contention that the Examiner relied on impermissible hindsight is not persuasive. Smith uses a pair of retention protrusions 22a, 22b that interact with projection 24b to secure its rod in a storage position. Smith, 3:10–18, Fig. 6; *see also* Final Act. 3–4. The Examiner finds that Carlson’s magnet 60, which “attract[s] and hold[s] a knife tool, 20, in a stored position,” would have been a suitable alternative to Smith’s protrusions “to secure the tool in a stored position.” Final Act. 3 (citing Carlson ¶ 28). Thus, the Examiner has articulated a reason why a skilled artisan would modify Smith based on Carlson, i.e., as a suitable known alternative for securing a tool in the stored position, which we find has a rational basis. Appellant does not contend Carlson’s magnet 60 is not a suitable alternative to each of Smith’s protrusions for securing a tool in a stored position, or that replacing each of Smith’s retention device 22a, 22b with a magnet 60 would achieve other than predictable results. “[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the

combination must do more than yield a predictable result. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007). Further, Appellant has not identified any portion of the Examiner's reasoning gleaned solely from Appellant's disclosure that was not otherwise within the level of ordinary skill at the time of the invention. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). We find no error in the Examiner's conclusion that such replacement/substitution would have been obvious.

Directly Attract

Claim 1 recites a first magnet positioned within a slotted bottom surface and arranged to directly attract and releasably secure an abrasive rod in a stored position. Independent claim 11 includes a substantially similar limitation. Claim 6, which depends from claim 1, and claim 18, which depends from claim 11, each recite a second magnet positioned within the slotted bottom surface and arranged to directly attract and releasably secure an abrasive rod in an extended position. Br. 32, 34 (Claims App.).

Appellant argues that Carlson's magnet 50 attracts a tang of its blade, which connects the blade to the handle, whereas the claimed magnet "directly attracts an abrasive rod." Br. 25–26.

The Examiner responds that replacing each of Smith's protrusions 22a and 22b with a magnet 60 of Carlson, and placing the magnet 60 in the same location as protrusions 22a, 22b, would cause Smith's rod to "directly contact the (first) magnet at 22a" in the closed position, and "directly contact the (second) magnet at 22b, when extended in the open position." Ans. 7–8.

Appellant's arguments that Carlson's magnets would not "directly attract and releasably secure an abrasive rod," are not persuasive. Smith discloses that "rod 24 includes circular pivot member 24a and integral

hollow plastic projection 24b.” Smith, 2:52–54. Smith also discloses that “protrusions 22a, 22b are spaced apart by a distance smaller than the diameter of projection 24b so that the projection snaps through the respective pair of protrusions 22a and 22b into the first storage position or the second sharpening position.” *Id.* at 3:11–15. We agree with the Examiner that by replacing protrusions 22a with a magnet, and placing the magnet in the same location as the protrusions 22a, rod 24 would remain in the stored position by magnetic attraction instead of relying on a snap-fit. Similarly, replacing protrusions 22b with a magnet, and placing the magnet in the same location as protrusion 22b, rod 24 would remain in the sharpening (extended) position by magnetic attraction instead of relying on a snap-fit. The Examiner does not propose a bodily incorporation of Carlson’s magnets and tang, but rather proposes employing only magnets as taught by Carlson in the place of Smith’s protrusions. “The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference Rather, “a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); *see also In re Sneed*, 710 F.2d 1544, 1550 (Fed. Cir. 1983) (“[I]t is not necessary that the inventions of the references be physically combinable to render obvious the invention under review.”); and *In re Nievelt*, 482 F.2d 965 (CCPA 1973) (“Combining the teachings of references does not involve an ability to combine their specific structures.”).

Contrary Teaching

Appellant argues that the Examiner’s proposed modification of Smith is contrary to the teachings of Smith, which require low friction plastic

projection 24b to retain the rod in an open or closed position. Br. 26. According to Appellant, plastic projection 24b is not an abrasive rod nor would low friction plastic projection 24b interact with a magnet because “magnets would not have any effect on a low friction plastic projection.” *Id.* Appellant contends that, even by replacing the low friction plastic projection with a ferromagnetic material, the magnets would not directly attract the abrasive rod but attract a projection attached to the abrasive rod.

We are not persuaded by Appellant’s arguments because they are not commensurate with the Examiner’s rejection. One of ordinary skill in the art would understand that projection 24b is only required to interact with projections 22a. Replacing projections 22a with a magnet, as the Examiner proposes, obviates the need for projection 24b. A skilled artisan would understand that projection 24b would not be needed or employed if magnets replaced projections 22a, 22b. Smith’s metal rod 24 (*see* Smith 2:56) made of a ferromagnetic material (*see* Final Act. 4), and without projection 24b, would then directly contact and be directly attracted to the magnet. *See* Final Act. 5.

Although Appellant presents arguments for claims 21–24 under separate heading (*see* Br. 27–29), these arguments essentially repeat Appellant’s arguments that Smith and Carlson do not teach an abrasive rod that directly contacts a magnet. Specifically, Appellant’s argument that Smith requires plastic projection 24b to interact with protrusions 22a and 22b (*see* Br. 28) is not persuasive for the reasons explained above. That claims 21–24 require contact between the abrasive coating and the magnet is not persuasive, because Smith discloses that “an abrasive grit, such as diamonds or other suitable abrasives, are provided on substantially all of the

surface 24 α on the cylindrical tapered external surface and in the slot of the tapered rod 24.” Smith 2:57–60; *see also* Final Act. 2.

We have considered each of Appellant’s arguments, but are not apprised of Examiner error. Accordingly, we sustain the Examiner's rejection of claims 1–4, 6–9, 11–16, and 18–24 under 35 U.S.C. § 103 as unpatentable over Smith and Carlson.

DECISION SUMMARY

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1–4, 6–9, 11–16, 18–24	103	Smith and Carlson	1–4, 6–9, 11–16, 18–24	
Overall Outcome:			1–4, 6–9, 11–16, 18–24	

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED