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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JEREMY R. EBNER

Appeal 2020-000550
Application 15/440,830
Technology Center 3700

Before JENNIFER D. BAHR, BRETT C. MARTIN, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant¹ seeks our review under 35 U.S.C. § 134(a) of the final rejection of claims 1–20. 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(a). Appellant identifies Milwaukee Electric Tool Corporation, as the Applicant and real party in interest. Appeal Br. 2.

THE INVENTION

Appellant's invention relates to chainsaws. Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A chainsaw comprising:

a housing including a handle housing portion, a motor housing portion, and a drive housing portion, the handle housing portion having a longitudinal axis that defines a first axis of the chainsaw;

a motor supported by the motor housing portion, the motor including an output shaft having a longitudinal axis that defines a second axis of the chainsaw;

a driven gear coupled to the output shaft such that the driven gear rotates in response to rotation of the output shaft;

a sprocket coupled to the driven gear such that rotation of the driven gear rotates the sprocket;

a guide bar extending from the drive housing portion and having a longitudinal axis that defines a third axis of the chainsaw; and

a chain supported on the guide bar and engaged with the sprocket such that rotation of the sprocket moves the chain along the guide bar,

wherein the first axis, the second axis, and the third axis are generally coplanar, and wherein the first axis and the second axis define a first included angle between about 75 degrees and about 95 degrees.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

NAME	REFERENCE	DATE
Hayashimoto	US 4,204,320	May 27, 1980
Newman	US 4,884,340	Dec. 5, 1989
Naughton	US 2010/0162579 A1	July 1, 2010

The following rejections are before us for review:

1. Claim 6 is rejected under 35 U.S.C. § 112(a) as failing to comply with the written description requirement.

2. Claims 1–10 and 13–20 are is rejected under 35 U.S.C. § 103 as being unpatentable over Hayashimoto and Naughton.

2. Claims 11 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over Hayashimoto, Naughton, and Newman.

OPINION

Written Description – Claim 6

The written description requirement of 35 U.S.C. § 112 provides, in pertinent part, that “[t]he specification shall contain a written description of the invention.” That requirement is satisfied only if the inventor “‘convey[s] with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention,’ and demonstrate[s] that by disclosure in the specification of the patent.” *Centocor Ortho Biotech, Inc. v. Abbott Labs.*, 636 F.3d 1341, 1348 (Fed. Cir. 2011) (quoting *Carnegie Mellon Univ. v. Hoffmann–La Roche Inc.*, 541 F.3d 1115, 1122 (Fed. Cir. 2008)). “The essence of the written description requirement is that a patent applicant, as part of the bargain with the public, must describe his or her invention so that the public will know what it is and that he or she has truly made the claimed invention.” *Nuvo Pharmaceuticals (Ireland) Designated Activity Company v. Dr Reddy’s Labs Inc.*, 923 F.3d 1368, 1377 (Fed. Cir. 2019).

It is the specification itself that must demonstrate possession. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). A written description that merely renders the invention obvious does

not satisfy the requirement. *Id.* Amended claims that introduce limitations not supported by the original disclosure violate the written description requirement. *In re Lukach*, 442 F.2d 967 (CCPA 1971).

The Examiner evaluates Appellant’s April 7, 2018, claim amendment and determines that the claim 6 limitation – “wherein the sprocket is provided *on the guide bar*” – constitutes impermissible new matter. Final Act. 3.

Appellant argues that it attempted to reduce the issues on appeal by filing a claim amendment that changed “on” the guide bar to “part of” the guide bar. Appeal Br. 7; April 11, 2019 Proposed Claim Amendment. Appellant acknowledges that the Examiner did not enter the proposed amendment. *Id.* Appellant argues that paragraph 16 of the Specification provides written description support for the current “*on the guide bar*” limitation at issue in this appeal. *Id.* at 8. Paragraph 16 recites that “sprocket 220 may be provided as part of the guide bar 95.” Spec. ¶ 16.

In response, the Examiner observes that sprocket 220 has to rotate during use to drive chain 100 that is wrapped around guide bar 95 during use. Ans. 13. The Examiner finds that the original specification does not reasonably convey to one skilled in the art how to make sprocket 220 part of guide bar 95 while keeping sprocket 220 rotatable with respect to guide bar 95, which is stationary during use. *Id.* According to the Examiner, rotatable sprocket 220 and stationary guide bar 95 have to be made into two separate pieces and somehow joined together to be considered as “part of” one another. The Examiner directs our attention to Appellant’s Figure 3 and notes that guide bar 95 and sprocket 220 are two separate and spaced apart pieces. *Id.* Thus, guide bar 95 and sprocket 220 may be usable together as

an assembly to drive chain 100 along guide bar 95. *Id.* However, the Examiner maintains that guide bar 95 does not “include” sprocket 220. *Id.*

In reply, Appellant argues that a person of ordinary skill in the art would understand that sprocket 220 can be part of an assembly with guide bar 95. Reply Br. 4.

Appellant’s argument about the Examiner’s decision not enter the proposed amendment is to no avail. The Examiner’s refusal to enter an amendment is reviewable by petition under 37 C.F.R. § 1.181 and, consequently, is not within the jurisdiction of the Board. *See Ex Parte Frye*, 94 USPQ2d 1072 (BPAI 2010). We carefully observe the line of demarcation between appealable matters for the Board and petitionable matters for the Director. MPEP § 1201. Ordinarily, we will not hear a question that should be decided by the Director on petition. *Id.*

Appellant’s position on the merits is unpersuasive. Although it may be true that a person of ordinary skill in the art would understand that sprocket 220 can be part of an assembly with guide bar 95, it does not necessarily follow that sprocket 220 is “on” guide bar 95. Appellant’s chain saw, taken as a whole, may be considered to be an “assembly.” So, in at least that sense, guide bar 95 and sprocket 220 are components in an assembly. Apart from guide bar 95 and sprocket 220 both being components of the saw that serve as a track for the saw chain, the Specification provides almost no teaching disclosure as to how guide bar 95 and sprocket 220 interact with each other mechanically. *See generally* Spec.

We agree with the Examiner that there is insufficient disclosure in the Specification to demonstrate possession of the “on the guide bar” limitation. We decline to opine on whether Appellant’s proposed, but as-yet-unentered

amendment, cures such deficiency. We sustain the Examiner's Section 112 written description rejection of claim 6.

*Unpatentability of Claims 1–10 and 13–20
over Hayashimoto and Naughton*

Claim 1

The Examiner finds that Hayashimoto discloses the invention substantially as claimed except for orientation of the various axes, for which the Examiner relies on Naughton. Final Act. 4–6. The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to rearrange Hayashimoto's axes. *Id.* at 6. According to the Examiner, a person of ordinary skill in the art would have done this to achieve a more compact design. *Id.*

Appellant argues that a person of ordinary skill in the art would not have combined the teachings of the prior art because, to do so, would entail a substantial reconstruction and redesign of Hayashimoto and would change the basic principle of operation of Hayashimoto's chainsaw. Appeal Br. 11. Appellant characterizes the "principle of operation" of Hayashimoto as "two-handed." *Id.*

In response, the Examiner acknowledges that Hayashimoto is a two-handed tool and that Naughton is a one-handed tool and appreciates that one-handed and two-handed operation are different, but nevertheless states that Appellant fails to satisfactorily explain how such difference would have dissuaded one of ordinary skill from making Hayashimoto's saw more compact, easier to use with only one hand, and having the advantage of use in a confined work area due to its compactness. Ans. 14.

In reply, Appellant reiterates that modifying Hayashimoto as proposed would require a substantial reconstruction and redesign. Reply Br. 4. Appellant argues that the Examiner's proposed modification – “would not only change the ergonomics of Hayashimoto's saw, but also change the placement of the power cord, trigger switch, and any other components contained within the handle housing portion P1.” *Id.*

Naughton's published application eventually issued as US 8,407,902 B2 (iss. Apr. 2, 2013). Naughton is assigned to Milwaukee Electric Tool Corporation. '902 Patent, p. 1. Milwaukee Electric Tool Corporation is also the Applicant, Appellant, and real-party-in-interest in the appeal before us. A comparison of Naughton Figure 7 and Appellant's Figure 3 reveals that the arrangement of components within the interior of the housing of Appellant's chain saw is virtually identical to the arrangement of components in Naughton's reciprocating saw. Fig. 3; Naughton, Fig. 7. In particular, each handle axis 400, motor axis 410, and cutting axis 420 is labeled the same and resides in the same location in the two saws. In each case, the axes are co-planar. In each case, the respective angles between the axes are the same and are assigned identical labels. *Id.* Essentially, what Appellant Milwaukee Electric Tool Corporation is doing in the instant application is applying the ergonomic principles from its compact reciprocal saw to its compact chain saw.

In the instant rejection on appeal, the Examiner merely relies on Hayashimoto as teaching the well-known features of a generic chain saw. We put no weight on the fact that the Examiner designates Hayashimoto as the primary reference and Naughton as the secondary reference. It is well settled that where a rejection is predicated on two references, it is of no

significance to term one reference primary and the other secondary. *In re Bush*, 296 F.2d 491, 496 (CCPA 1961).

Appellant's argument against the combination amounts to the classic, bodily incorporation argument. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981); *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012). The obviousness inquiry does not ask "whether the references could be physically combined but whether the claimed inventions are rendered obvious by the teachings of the prior art as a whole." *In re Etter*, 756 F.2d 852, 859 (Fed. Cir. 1985) (en banc).

Naughton and Appellant's inventions are substantially the same except for using different types of saw blade. Here, Appellant merely adapts the ergonomic principles from its reciprocating saw to its chain saw. It is well settled that if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007). Appellant presents neither evidence nor persuasive technical reasoning that adaptation of the ergonomic principles of Naughton's saw to Appellant's chain saw requires more than ordinary skill or produces unexpected results.

We sustain the Examiner's unpatentability rejection of claim 1.

Claims 2–5, 7, 8, and 10

Appellant does not argue for the separate patentability of these claims apart from arguments presented with respect to claim 1 which we have

previously considered. Accordingly, we sustain the Examiner's rejection of claims 2–5, 7, 8, and 10. *See* 37 C.F.R. § 41.37(c)(1)(iv) (failure to separately argue claims constitutes a waiver of arguments for separate patentability).

Claim 6

Claim 6 depends from claim 1 and adds the limitation, “wherein the driven gear is a bevel gear, and wherein sprocket is provided on the guide bar.” Claims App. Appellant argues that Hayashimoto's sprocket is “separate from” the guide bar and, therefore is not “provided on the guide bar” as required by the claim. Appeal Br. 13.

We previously determined that claim 6, in its present form, is unpatentable as lacking written description support. In view of the obvious confusion attendant on the meaning of “on the guide bar” versus being a “part of” the guide bar and in view of Appellant's previous arguments that claim 6 can be met as long as the guide bar and sprocket are components within an overall, undefined “assembly,” we elect not to reach the art rejection of claim 6. *See* 37 C.F.R. § 41.50(a)(1) (The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed); *Ex Parte Smith*, Case No. 2008-5902, 2008 WL 4998624 (BPAI Nov. 24, 2008).

Claim 9

Claim 9 depends from claim 1 and adds the limitation: “wherein the guide bar has an overall length between about 8 inches and about 14 inches, and wherein about half of the overall length of the guide bar is disposed within the drive housing portion.” Claims App. Appellant argues that the

prior art fails to disclose this limitation. Appeal Br. 14. In particular, Appellant denies that having any particular proportion of the guide bar disposed within the housing is recognized in the art as a result effective variable. *Id.*

In response, the Examiner states that because Naughton teaches the advantage of making a saw compact by reducing its size, it would have been obvious to one skilled in the art to modify Hayashimoto by selecting a desirable guide bar length and respective proportions of the length of the bar to be inside and outside of the housing. Ans. 15.

Appellant's Specification teaches the following concerning guide bar length.

[I]n some embodiments, the guide bar 95 defines an overall length between about 6 inches and about 16 inches. In other embodiments, the guide bar 95 defines an overall length between about 8 inches and about 14 inches. In the illustrated embodiment, the overall length of the bar 95 is about 11 inches. The guide bar 95 projects from the forward-most edge of the drive housing portion 55 by a distance D. In some embodiments, the distance D is between about 3 inches and about 12 inches. In other embodiments, the distance D is between about 4 inches and about 10 inches. In other embodiments, the distance D is between about 4 inches and about 8 inches. In the illustrated embodiment, the distance D is about 6 inches. Accordingly, in the illustrated embodiment, a ratio of the distance D to the overall length of the guide bar 95 is about 0.5.

Spec. ¶ 18. In evaluating the respective positions of Appellant and the Examiner, it is clear that we are not talking about a large chain saw. Appellant's saw is at the extreme small end of size and compactness for a chain saw. Persons with familiarity in the use of a chain saw would immediately recognize that an exposed bar length of only 4 inches, at best,

can be used to trim small tree branches or fell very small saplings.

Appellant's Specification teaches that the invention encompasses embodiments where distance "D" (the length of the guide bar that extends beyond the housing – *see* Fig. 3), is up to 12 inches in length. Spec. ¶ 18. The Specification further teaches that the overall length of the guide bar may be up to 16 inches in length. *Id.* Simple arithmetic reveals that a 16 inch guide bar that extends 12 inches beyond the housing would leave only about 4 inches of length inside of the housing. *Id.* This represents a ratio of 0.25 of the overall guide bar length. *Id.*

Appellant's Specification does not disclose that there is any particular advantage to using an 8 inch guide bar with 4 inches each respectively inside and outside of the housing. Appellant presents neither evidence nor persuasive technical reasoning as to why the claimed dimension is critical or produces unexpected results. *See generally* Appeal Br.; Reply Br. In particular, if an embodiment of Appellant's invention can use a 16 inch guide bar with 12 inches extending out of the housing and 4 inches remaining in the housing, Appellant fails to explain how shortening the extension of the bar outside of the housing from 12 inches to 4 inches results in a patentable invention.

Here, Appellant fails to explain why the claimed length and proportion is inventive. The main thrust of Appellant's argument appears to be that the "general conditions" of claim 9 are not disclosed in the art. Appeal Br. 14. This argument is not persuasive as chain saw operators recognize that the housing protects the interior components of the chain saw mechanism from dust, dirt, and debris. It is a given, therefore, that some length of the guide bar will invariably be enclosed in the housing. We are

not inclined to ascribe invention to a purely arbitrary relative dimension. *See Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1346 (Fed. Cir. 1984) (upholding a District Court finding that a claimed relative dimension amounted to mere “window dressing”). “[A] claim to a product does not become nonobvious simply because the patent specification provides a more comprehensive explication of the known relationships between the variables and the affected properties.” *In re Applied Materials, Inc.*, 692 F.3d 1289, 1297 (Fed. Cir. 2012).

We sustain the Examiner’s rejection of claim 9.

Claims 13–15

Appellant argues claims 13–15 as a group. Appeal Br. 14–15. We select independent claim 13 as representative and claims 14 and 15 will stand or fall therewith. *See* 37 C.F.R. § 41.37(c)(1)(iv). Claim 13 is substantially similar in scope to claim 1. Claims App.

In traversing the rejection, Appellant relies solely on arguments that we previously considered and found unpersuasive with respect to claim 1 and find equally unpersuasive here. Appeal Br. 14–15. We sustain the rejection of claims 13–15.

Claim 16

Claim 16 depends from claim 13 and adds the limitation:

[F]urther comprising a driven gear coupled to the output shaft such that the driven gear rotates in response to rotation of the output shaft, wherein the guide bar includes a sprocket coupled to the driven gear such that rotation of the driven gear rotates the sprocket, and wherein the motor is positioned above the guide bar.

Claims App. Appellant argues that Hayashimoto’s guide bar 11 is separate from sprocket 8. Appeal Br. 15–16.

In response, the Examiner maintains that Hayashimoto's guide bar 11 is no more or less separate from sprocket 8 than Appellant's guide bar 95 is separate from sprocket 220. Ans. 15–16.

In reply, Appellant argues that its Specification teaches two embodiments, one in which sprocket 220 is integrally formed with driven gear 215 and another in which sprocket 220 is part of guide bar 95. Reply Br. 6.

We have considered the competing positions of Appellant and the Examiner. Appellant's arguments are reminiscent of the positions taken with respect to the written description problems identified with respect to claim 6. Appellant's claim drafting and arguments generate confusion as to what it means for a sprocket to be "on," "part of," and "included" with respect to a guide bar and particularly where the sprocket is merely included, to some unspecified extent, in an assembly that interconnects a sprocket and guide bar. The Examiner notes, correctly, that Appellant's guide bar 95 and sprocket 220 are two separate and spaced apart pieces. *Id.* at 13. Thus, although guide bar 95 and sprocket 220 may be usable together as an assembly to drive chain 100 along guide bar 95, that does not mean that guide bar 95 "includes" sprocket 220. *Id.* The Examiner cogently points out the absence of any distinction between Hayashimoto and the claimed invention with respect to the claim limitation at issue. Ans. 15–16. Appellant has no effective rebuttal to the Examiner's position. We are not apprised of error.

We sustain the Examiner's rejection of claim 16.

Claims 17–20

Appellant argues claims 17–20 as a group. Appeal Br. 16–17. Independent claim 17 is representative. 37 C.F.R. § 41.37(c)(1)(iv). Appellant relies on arguments that we previously considered and found unpersuasive with respect to claims 1 and 13 and find equally unpersuasive here. Appeal Br. 16–17. We sustain the rejection of claims 17–20.

*Unpatentability of Claims 11 and 12
over Hayashimoto, Naughton, and Newman*

Claims 11 and 12 depend, directly or indirectly, from claim 1. Claims App. Appellant merely argues that Newman fails to cure the deficiencies of Hayashimoto and Naughton. However, having previously determined that the combination of Hayashimoto and Naughton is not deficient with respect to claim 1, we sustain the Examiner’s rejection of claims 11 and 12.

CONCLUSION

Claims Rejected	§	Reference(s)/Bases	Aff’d	Rev’d
6	112	Written Description	6	
1-5, 7-10 13-20	103	Hayashimoto, Naughton ²	1-5, 7-10, 13-20	
11, 12	103	Hayashimoto, Naughton, Newman	11, 12	
Overall Outcome			1-20	

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

AFFIRMED

² We do not reach the prior art rejection of claim 6. 37 C.F.R. § 41.50(a)(1).