

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES P. SHEAHAN

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Appeal No. 98-1199  
Application 08/380,112<sup>1</sup>

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ON BRIEF

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Before COHEN, ABRAMS, and McQUADE, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claim 29. Claims 7 through 13, 15, 16, 18, 19, 21, 26 and 28, the only other claims remaining in the application, stand withdrawn from further consideration by the examiner, as being drawn to

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<sup>1</sup> Application filed January 30, 1995. According to appellant, the application is a continuation of 08/027,382, filed March 8, 1993, now abandoned.

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a nonelected species, pursuant to 37 CFR 1.142(b).

Appellant's invention relates to a penetration device which is a mechanical fastener for piercing decks. A further understanding of the invention can be derived from a reading of claim 29, a copy of which appears in "APPENDIX A" of the substitute brief (Paper No. 16).

As evidence of anticipation, the examiner has applied the document specified below:

Lemke	4,834,600	May 30, 1989
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Claim 29 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Lemke.

The examiner's rejection of claim 29 and response to the argument presented by appellant can be found in the final rejection and answer (Paper Nos. 12 and 17), while the argument of appellant appears on pages 4 and 5 of the brief (Paper No. 16).

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OPINION

In reaching our conclusion on the anticipation issue before us, this panel of the board has carefully assessed appellant's specification and claim 29, the patent to Lemke, and the viewpoints of appellant and the examiner, respectively. As a consequence of our review, we make the determination which follows.

We reverse the rejection of claim 29.

As disclosed by appellant (specification, pages 5 and 6), the diameter of the cutting point for a self-tapping screw, the shank diameter, and the thread diameters can be adjusted to allow an opening between the hole in the deck and the shank of the screw to allow passage of limited amounts of water and air. Self-tapping screws are called piercing screws, owing to the fact that they do not usually require pre-drilled holes

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for use because they pierce the metal deck of the roof and make their own hole for entry. The self tapping characteristics of the screw mean they can be installed in one operation.

Claim 29 is drawn to a penetrating device which is a mechanical fastener for piercing decks comprising, inter alia, a screw having a driveable head, a piercing lower end, at least one opening extending from the piercing lower end to a point short of the driveable head, with the piercing lower end being a self tapping screw point having a cutting edge.

As perceived by the examiner (final rejection, page 2), Fig. 2 of the Lemke document shows a lower end being a screw point with a cutting edge. Further, the examiner explains that, as the edges of slot 28 are capable of cutting, each edge is qualified as a cutting edge (final rejection, page 2 and answer, page 4).

Appellant, on the other hand, argues that "[n]owhere in Lemke is it taught to have a self tapping screw point having a

cutting edge" (brief, pages 4 and 5).

We find that the Lemke patent teaches (column 3, line 46 to column 4, line 4) a hole 42 pre-drilled through membrane 18, insulation 16 and roof deck 20. Nut 12 is retained on tip portion 50 of bolt 14 so that the entire assembly 10 may be inserted through the pre-drilled hole 42. With the nut 12 in the hole in deck 20, a tool is utilized to rotate bolt 14 in a clockwise direction causing lower leg portions 41 to flare slightly and enhance the frictional fit between nut 12 and hole 42. The continued rotation of the bolt causes further outward flaring of lower legs 41 which prevents removal of nut 12 and provides the entire assembly 10 with superior holding power. As explained by the patentee (column 3, lines 1 through 3), the use of resilient material in the manufacture of nut 12 combined with slots 28 allows legs 26 to resiliently move outwardly on experiencing the necessary force.

Based upon our above findings relative to the overall teaching of the Lemke reference, it is quite apparent to us that one versed in the art would not have understood the

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structure of the fastener bolt of the Lemke reference as including a self tapping screw point having a cutting edge, as now claimed. This viewpoint is buttressed by Lemke's teaching, as set forth, supra, of a pre-drilled hole through which the fastener bolt is simply intended to pass. It follows, of course, that we are not in accord with the examiner's view that the slots 28 (between resilient legs 28) of Lemke present opposite cutting edges. Since the Lemke patent does not address every limitation of claim 29, the claim is not anticipated by this prior art reference. It is for this reason that the rejection under 35 U.S.C. § 102(b) must be reversed.

In summary, this panel of the board has reversed the examiner's rejection of claim 29.

REVERSED

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IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	BOARD OF PATENT
NEAL E. ABRAMS	)	
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