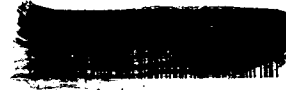


UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 76/641176

APPLICANT: Nakayama, Toshiro



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1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address..

Serial Number 76/641176

This letter responds to applicant's communication filed on April 16, 2007.

The trademark examining attorney has carefully reviewed the request for reconsideration and is not persuaded by applicant's arguments. No new issue has been raised and no new compelling evidence has been presented with regard to the points at issue in the final action. TMEP §715.03(a). Accordingly, applicant's request for reconsideration is *denied*, and the Section 2(e)(5) functional refusal and the Sections 1, 2, and 45 non-distinctive configuration refusal are *continued*. 37 C.F.R. §2.64(b); TMEP §715.04.

1. Refusal Under Section 2(e)(5) – Proposed Mark is Functional

The applicant has applied to register "the three-dimensional configuration of a blade for a hand-held saw." The goods are "MANUALLY OPERATED HAND-HELD SAWS FOR SAWING WOOD, PLASTIC PIPE, PLASTIC BOARD STOCK, ACRYLIC, DRYWALL, CEMENT WALLBOARD, PARTICLE BOARD, PLASTERBOARD, MELAMINE, FLAT FOAM SHEETS, WALLBOARD, ARTIFICIAL WOOD, AND COMPOSITE BOARD."

In its request for reconsideration, the applicant provided information relating to each of the four "Morton-Norwich factors":

(1) Patents

“Applicant states that the mark is not, and has not been the subject of a design or utility patent (either active or expired), or an application for a design or utility patent (either active or abandoned).” Applicant’s April 16, 2007 correspondence, p.2. “Although the existence of a utility patent could weigh against applicant in terms of showing that the configuration is de jure functional, the absence of such a patent simply has no weight in our analysis.” *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1950 n.3 (TTAB 2001).

(2) Applicant’s Advertising, Promotional and/or Explanatory Materials

The applicant “does tout the utilitarian advantages of its saw blades, for example, that they cut on the pull, which allows for a thin, lightweight, and flexible blade, that the teeth are precision ground (not stamped into) the highest quality carbon spring steel, and that the teeth are electrically impulse-hardened.” [emphasis in original]. Applicant’s April 16, 2007 correspondence, p.3. Where applicant’s own advertising materials extol the utilitarian aspects of its design, such materials are strong evidence that the matter sought to be registered is functional. See, e.g., *M-5 Steel Mfg., Inc. v. O’Hagin’s Inc.*, 61 USPQ2d 1086 (TTAB 2001); *In re Visual Communications Co., Inc.*, 51 USPQ2d 1141 (TTAB 1999); *In re Edward Ski Products, Inc.*, 49 USPQ2d 2001 (TTAB 1999); *In re Caterpillar Inc.*, 43 USPQ2d 1335 (TTAB 1997); *In re Bio-Medicus Inc.*, 31 USPQ2d 1254 (TTAB 1993); *In re Witco Corp.*, 14 USPQ2d 1557 (TTAB 1989).

The applicant submitted additional promotional materials for the goods. However, the promotional materials submitted with the request for reconsideration are highly similar to the promotional materials previously submitted by the applicant in that they tout the overall utilitarian features of the saw blades. For instance, from the brochure entitled “Power and Quality you can depend on”:

What Makes SharkSaw® Better?

- Blade are made of the finest Japanese high-carbon spring steel.
- SharkSaw teeth are diamond-ground on three cutting edges.
- Teeth are impulse-hardened; they stay sharp two to three times longer than those in ordinary hand saw blades.
- Teeth, blade, and handle angles are all integrated to maximize cutting performance.
- Because they cut “on the pull,” SharkSaw blades can be thinner, lighter, and flexible.
- Tough lacquer finish on blades fights rust and corrosion.
- Blade width is optimized to keep it steady during cutting.
- Ultra-thin kerf ensures straight, effortless cutting.
- Ergonomic design is like an extension of your arm. No need to cock your wrist when sawing.
- Comfortable, sure-grip handles are made of long-lasting steel with a soft grip.
- Handle features quick release twist design for easy blade replacement.

The applicant goes on to argue “that the overall combination of features, and the particular design used to provide this functionality functions [to] indicate Applicant as the source of the goods.” The proposed mark is “the three-dimensional configuration of a blade for a hand-held saw.” The saw blade in question is not just any saw blade for a hand-held saw, it is a saw blade for a Japanese-style hand saw. Unlike Western-style saws, Japanese-style saws cut on the pull stroke rather than on the push stroke. See the attached excerpt from <http://en.wikipedia.org/wiki/Ryoba>. Because of that fact, the configuration of the applicant’s saw blade must contain certain functional elements that allow it to cut on the pull-stroke.

The applicant argues that "while a saw blade is overall a useful article, the design of Applicant's saw blade, including the shape of the blade, the length of the blade, the number and positioning of the teeth, the manner in which the blade joins the handle, are not functional." The applicant's own advertising discusses the functionality of each of the foregoing features of the saw blade: "Blade width is optimized to keep it steady during cutting," "Handle features quick release twist design for easy blade replacement," "Teeth, blade, and handle angles are all integrated to maximize cutting performance," "Ultra-thin blade produces an accurate, clean, and controlled cut that is easy to start," "**3-Cutting Edges Per Tooth** perform easy rip and cross-cuts with special high-tech hardening," "This saw features the thinnest blade (kerf 0.017") of the entire SharkSaw® line. Its 19 tpi tooth set makes exceptionally smooth, fine cuts – as thin as 1/32" . . .," "The 15 tpi blade cuts smoothly through most hard and soft woods and plastic pipe. Teeth to the tip of the blade aid in tight flush and mid-panel cuts."

Even assuming arguendo that the applicant's saw blades contain non-functional features, where the evidence shows that the overall design is functional, the inclusion of a few arbitrary or otherwise nonfunctional features in the design will not change the result. See *Textron, Inc. v. U.S. International Trade Commission*, 753 F.2d 1019, 224 USPQ 625, 628-29 (Fed. Cir. 1985); *In re Vico Products Mfg. Co., Inc.*, 229 USPQ 364, 368 (TTAB 1985), *recon. denied*, 229 USPQ 716 (TTAB 1986).

(3) Alternative Designs

As for the availability of alternative saw blade designs, the only saw blades that matter in this analysis are saw blades for Japanese-style hand saws. Applicant's evidence concerning saw blades for Western-style saws or hack saws is not relevant in this case. The evidence attached to this Office action and the prior Office actions shows that the applicant's general configuration is one of a few designs available for Japanese-style pull saw blades.^[1] The overall shape of the applicant's blade is not unique to the applicant. See, in particular, the website excerpts from www.screwfix.com and www.tooled-up.com attached to the initial Office action, the website excerpts from www.japanwoodworker.com; www.traditionalwoodworker.com; www.hidatool.com; and www.fine-tools.com attached to the final Office action, and the three website excerpts attached to this Office action. As explained in the final Office action, the existence of viable alternative designs does not per se disprove functionality. The availability of alternatives does not detract from the functional character of a configuration that is the best or one of the few superior designs available. *In re Bose Corp.*, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985).

Moreover, "the question in each case is whether protection against imitation will hinder the competitor in competition." *In re Morton-Norwich, supra*, at 14, quoting *Truck Equipment Service Co. v. Fruehauf Corp.*, 536 F.2d 1210, 1218, 191 USPQ 79, 85 (8th Cir. 1976). The evidence of record shows that numerous Japanese-style saw blade manufacturers other than the applicant use the same *general* shape for their Japanese-style saw blades.

(4) Manufacturing Cost

The applicant writes that its "saw blades are generally more expensive to make than competitors' saw blades, though the expense of Applicant's saw blades is generally directed to their quality, rather than those factors that make up the mark covered by the instant application." Applicant's April 16, 2007 response, p. 5. An applicant's assertions that its design is more expensive or more difficult to make are insufficient to establish that the configuration is not functional. *In re Pingel Enterprise Inc.*, 46 USPQ2d 1811, 1821 (TTAB 1998) ("That applicant, despite the inherent advantages of a design which is simple and less expensive to manufacture than other petcocks, has, however, deliberately chosen a

more complex and expensive manner in which to manufacture its product does not mean that the configuration thereof is not de jure functional.”); *See In re Caterpillar Inc.*, 43 USPQ2d 1335, 1341 (TTAB 1997); *In re American National Can Co.*, 41 USPQ2d 1841, 1844-45 (TTAB 1997).

For the foregoing reasons, the Section 2(e)(5) functional refusal is **CONTINUED**.

2. Refusal Under Sections 1, 2, and 45 - Non-distinctive Configuration of the Goods; Evidence Insufficient to Establish Acquired Distinctiveness

The applicant submitted a supplemental declaration in support of its claim of acquired distinctiveness under Section 2(f). The additional evidence supplied by the applicant is insufficient to establish acquired distinctiveness.

In determining whether the proposed mark has acquired distinctiveness, the following are some of the factors that are considered: (1) length and exclusivity of use by applicant of the mark in the United States; (2) the type, expense and amount of advertising of the mark by applicant in the United States; and (3) applicant's efforts, such as unsolicited media coverage and consumer studies, in the United States to associate the mark with the source of the goods identified in the application. *In re Steelbuilding.com*, 415 F.3d 1293, 1300, 75 U.S.P.Q.2d 1420, 1424 (Fed. Cir. 2005). A showing of acquired distinctiveness need not consider each of these factors, and no single factor is determinative. *Id.*; see 37 C.F.R. §2.41; TMEP §1212.06 *et seq.* Further, the evidence must relate to the promotion and recognition of the specific configuration embodied in the proposed mark and not to the goods in general. *Wal-Mart*, 529 U.S. at 211, 54 USPQ2d at 1068; *See* TMEP §§1212.06 *et seq.* regarding evidence of acquired distinctiveness.

The applicant claims use of the mark for approximately nineteen years. As explained in the initial Office action, long use of the mark is one relevant factor to consider in determining whether a mark has acquired distinctiveness. *See In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986); *In re Packaging Specialists, Inc.*, 221 USPQ 917, 920 (TTAB 1984). TMEP 1212.06(a). However, when the evidence of acquired distinctiveness is considered *in toto*, nineteen years is insufficient to establish acquired distinctiveness.

The applicant also claims “Extensive sales of products sold in association with this design in the United States, in that the number of saws sold in association with the mark (sold both with the handles and separately) from 2001 through 2006 exceeded 47,000.” That is approximately 9,400 saw blades sold per year. On its face, the foregoing sales figure does not seem to be significant, and applicant has not provided any information to the contrary. *See In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001). At best, the sales figure demonstrates the apparent popularity or commercial success of the applicant's saws, but such evidence alone does not establish that the relevant purchasers recognize the shape of the entire saw as indicating source or origin. *In re Bongrain International (American) Corp.*, 894 F.2d 1316, 13 USPQ2d 1727 (Fed. Cir. 1990); *WLWC Centers, Inc. v. Winners Corporation*, 221 USPQ 701, 707 (M.D. Tenn. 1983); *In re Leatherman Tool Group Inc.*, 32 USPQ2d 1443, 1451 (TTAB 1994).

The applicant claims “Extensive advertising of products with which the design has been used in the United States, in that total approximate advertising expenditures for Applicant's products, including the saws sold in association with the design of the instant application for the years 1996-2006 exceeded \$800,000” and “Significant trade show attendance at which products with which the design has been used have been promoted, whose trade show expenditures alone, from 1996 – 2006, exceed \$1,100,000.” Large scale expenditures in promoting and advertising goods and services under a particular mark are significant to indicate the extent to which a mark has been used. However, proof of

an expensive and successful advertising campaign is not in itself enough to prove secondary meaning. *In re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars -- two million of which were spent on promotions and promotional items which included the phrase THE BEST BEER IN AMERICA -- found insufficient to establish distinctiveness, in view of the highly descriptive nature of the proposed mark); *Mattel, Inc. v. Azrak-Hamway International, Inc.*, 724 F.2d 357, 221 USPQ 302, 305 n. 2 (2d Cir. 1983). TMEP §1212.06 (b).

The ultimate test in determining whether a designation has acquired distinctiveness is applicant's success, rather than its efforts, in educating the public to associate the proposed mark with a single source. The examining attorney must examine the advertising material to determine how the term is being used, the commercial impression created by such use, and what the use would mean to purchasers. *In re Redken Laboratories, Inc.*, 170 USPQ 526, 529 (TTAB 1971) (evidence adduced by applicant pursuant to §2(f) held insufficient to establish acquired distinctiveness of THE SCIENTIFIC APPROACH, for lectures concerning hair and skin treatment, notwithstanding ten years of use, over \$500,000 in promotion and sponsorship expenses, and the staging of over 300 shows per year). *See also In re E.I. Kane, Inc.*, 221 USPQ 1203, 1206 (TTAB 1984) (refusal to register OFFICE MOVERS, INC., for moving services, affirmed notwithstanding §2(f) claim based on, *inter alia*, evidence of substantial advertising expenditures. "There is no evidence that any of the advertising activity was directed to creating secondary meaning in applicant's highly descriptive trade name."); *In re Kwik Lok Corp.*, 217 USPQ 1245 (TTAB 1983) (evidence held insufficient to establish acquired distinctiveness for configuration of bag closures made of plastic, notwithstanding applicant's statement that advertising of the closures involved several hundred thousands of dollars, where there was no evidence that the advertising had any impact on purchasers in perceiving the configuration as a mark). *Cf. In re Haggard Co.*, 217 USPQ 81, 84 (TTAB 1982) (background design of a black swatch held registrable pursuant to §2(f) for clothing where applicant had submitted, *inter alia*, evidence of "very substantial advertising and sales," the Board finding the design to be, "because of its serrated left edge, something more than a common geometric shape or design"). TMEP §1212.06(b).

The applicant did submit additional advertising materials with its request for reconsideration. However, all of the advertising materials thus far submitted by the applicant relate to the promotion and recognition of the goods in general and not to the specific configuration embodied in the proposed mark. See subsection 1(2) above for specific examples from the applicant's advertising materials. There is, however, the following paragraph which appears in the printout from the applicant's website at www.sharkcorp.com, which was submitted by the applicant with its July 20, 2006 response:

Our saw product designs are unique to SHARK CORPORATION

The unique saw design and saw blade design were originally created by SHARK Corporation and have been recognized by customers and users based on the unique designs that the saws and blades have been provided by the same source, according to SHARK Corporation's continuous sales efforts for more than ten years.

The foregoing statement is not persuasive on the issue of whether the saw configuration has acquired distinctiveness. It is awkwardly worded, and it is unclear what the statement actually means. Further, the statement is conclusory, and the applicant has provided no evidence of consumer perception of the proposed mark to support the statement.

The applicant also submitted copies of two unsolicited articles that feature the applicant's Japanese-style saws. The first article from *American How-To* is entitled "Pull Saws The fine points of working with

Japanese-style saws." The article excerpt submitted by the applicant does not mention the applicant's goods by name, but does feature photographs of its hand saws in use. The second article is from *JLC'S Tools of the Trade* and is entitled "Japanese-Style Saws." The article features both a photograph of one of the applicant's hand saws and a discussion of the applicant's "Takagi Pullsaw." However, neither of the article excerpts discusses the specific configuration embodied in the proposed mark. Both articles discuss the overall benefits of using Japanese-style pull saws.

Given the similarities of his Japanese-style saw blades to the Japanese-style saw blades manufactured by his competitors, the applicant's evidence *in toto* is insufficient to establish acquired distinctiveness.

For the foregoing reasons, the Sections 1, 2, and 45 non-distinctive configuration refusal is **CONTINUED.**

The application file will be returned to the Trademark Trial and Appeal Board for resumption of the appeal.

/Barbara A. Gaynor/
Barbara A. Gaynor
Trademark Examining Attorney
Law Office 115
571-272-9164

[1] Attached to this Office action are three website excerpts from the examining attorney's latest search of the internet using the Metacrawler search engine.



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Japanese saw

From Wikipedia, the free encyclopedia
(Redirected from Ryoba)

The **Japanese saw** or *nokoqiri* (鋸) used in woodworking and Japanese carpentry differs from its North American and European counterpart since it cuts on the pull stroke as opposed to the push stroke. This allows it to have thinner blades that cut more efficiently and leave a narrower kerf. Push-saws require a thick blade to remain rigid. Otherwise, the blade would flex wildly as the craftsman pushed on the handle, instead of cutting. A pull-saw, on the other hand, is under tension rather than compression during cutting. Therefore there is no stiffness requirement, and the blade can be much thinner.

Japanese style saws have also gained popularity outside Japan.

Contents (hide)

- 1 Types of Japanese hand saws
- 2 Other Japanese saws
- 3 See also
- 4 External links

Types of Japanese hand saws

[edit]

- *Dōzuki* (胴付鋸)

A type of backsaw. The Japanese means "attached trunk", thus a saw with a stiffening strip attached, i.e., a backsaw.

- *Ryōba* (両刃)

Multi-purpose carpentry saw with two cutting edges. The Japanese means "double blade". There is a cross-cutting (*yokobiki*) blade on one side and a ripping (*tatebiki*) blade on the other.

- *Azebiki* (あぜ引き)

A small *ryōba* saw used for cutting into the flat surface of a board rather than from the edge. The blade has a convex curve which can begin the cut anywhere on the surface.

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in other languages

- [Deutsch](#)

Two hand axes can be used for cutting into the flat surface of a board rather than from the edge. The blade has a convex curve which can begin the cutting, then on the convex

- *Mawashibiki* (回し引鋸)

A thin saw used for cutting curves, the Japanese version of a keyhole saw. The name means "turning cut".

- *Kaeba* (替え刃)

A saw with a disposable blade. The Japanese means "changing blade".

[edit]

Other Japanese saws

- *Oga*

A large two person saw used for ripping large boards in the days before power saws. One person stood on a raised platform, with the board below him, and the other person stood underneath him/her.

[edit]

See also

- [Japanese carpentry](#)

[edit]

External links

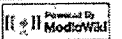
- [Nokogiri](#) ^{at JAANUS (Japanese Architecture and Art Net Users System)}
- [Japanese saw](#) ^{at the Takeraka carpentry tools museum}

Categories: [Saws](#) | [Woodworking hand tools](#) | [Japanese tools](#)



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Overview

The secret of finer Japanese woodwork

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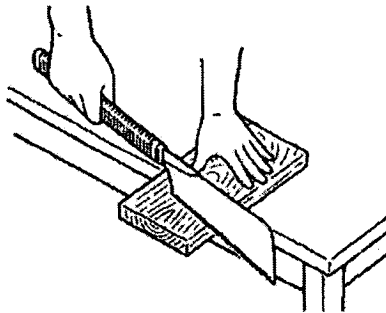
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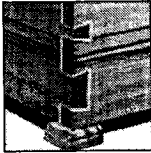
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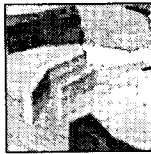


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SELECTING A SAW

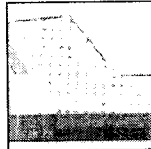
Basically any backless push or pull saw is suitable for use with the AngleMag. Even a wide Dovetail saw or a Tenon saw can be used. However, the total width of the saw measured from below the brass stiffener, would need to accommodate the height of the circular magnetic Saw Glide plus the depth of your intended cut. The height the Saw Glide from the top edge of the wood is $2\frac{5}{16}$ th of an inch or 58mm. Before using a Tenon saw with the AngleMag, check that the entire length of its teeth are in a straight line. Hold it up to the light and sight along the teeth. If the saw is warped, the result of your cuts will be questionable. Cutting the Tailboards for dovetailing would be fine. However, the Pinboard cuts would naturally not match, leaving gaps between the Tailboard and the Pinboard.



JAPANESE PULL SAWS AND SPLINES

These blades are disposable when blunt.

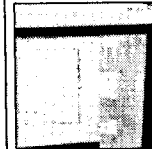
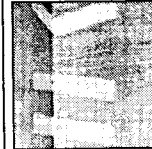
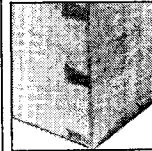
Since most joinery is on the end grain, select a Rip saw that would give you good crisp end grain cuts. There are double-edged Japanese Pull saws on the market. These are not suitable for the AngleMag, as they will damage the Saw Glide.



GYOKUCHO RAZORSAW 0.5mm 255



I have used several brands of Pull saws and find the following most suitable for use with the AngleMag. For general purpose cross cutting and rip cutting, the GYOKUCHO RAZORSAW 0.5mm 255 (length) is very good. This is a backless saw with a SHORT SPLINE.



(rough) is very good. This is a carbide saw with a SLOTTED BLADE.
SUPPLY: We supply the complete 0.5mm 255 saw.

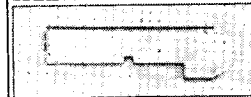
GYOKUCHO RAZORSAW No S-303 0.3mm 240



Since 85% of work with the AngleMag will require you to make RIP CUTS, the ideal saw is the GYOKUCHO RAZORSAW No S-303 0.3 - 240-saw blade. However, because this is a Superfine blade, it has a SPLINE fitted to the entire length of the blade. This is overcome by fitting the 0.3mm blade onto the 0.5's handle. These blades and handles are interchangeable. Naturally the magnetic Saw Guide replaces the need for the stiffener. This will give you the best cuts possible for hand cut joints with the AngleMag.

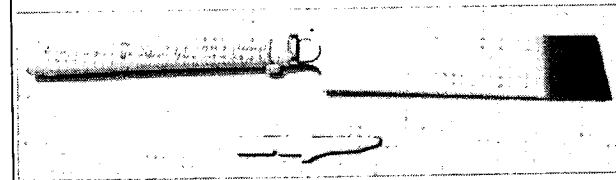
SUPPLY: We supply only the 0.3mm blade, not the entire saw

SPLINES



The standard Spline supplied with the RAZORSAW 0.5mm 255 is 70mm or 2⁷/₄' long. The longest pull stroke with this Spline will only permit the use of ¼ of the teeth available on the saw. In order to increase the use of the blade, I use and also, supply an optional VERY SHORT SPLINE. The VERY SHORT SPLINE will give you longer, smoother "pull" strokes; thereby using almost the whole length of saw and the blades last longer.

SUPPLY: We supply the VERY SHORT SPLINE.



DO NOT USE DOUBLE SIDED SAWS, AS THESE WILL DAMAGE THE SAW GLIDE.