

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEF KOTSCHNER and RALPH PAUL KOTSCHNER

Appeal No. 2000-2087
Application No. 09/039,474

ON BRIEF

Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3 and 4, which are all of the claims pending in this application.

We REVERSE AND REMAND TO THE EXAMINER.

BACKGROUND

The appellants' invention relates to a hammer. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellant's Amended Brief (Paper No. 11).

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Newbrough	611,973	Oct. 4, 1898
Palomera	4,465,115	Aug. 14, 1984

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Palomera in view of Newbrough.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 12) and the final rejection (Paper No. 5) for the examiner's complete reasoning in support of the rejection, and to the Amended Brief (Paper No. 11) and Reply Brief (Paper No. 13) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The Examiner's Rejection

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

It is the examiner's view that all of the subject matter recited in claim 1 is disclosed by Palomera except for the asymmetric claws with a longer pointed claw and a shorter claw having a flat end. However, the examiner goes on to conclude that it would have been obvious to one of ordinary skill in the art to modify the Palomera hammer so that it incorporates this feature, in view of the teachings of Newbrough. In their Briefs, the appellants argue against this conclusion, and also point out that the references do not

disclose or teach a hammer shank having a square cross section and a scored face, a magnet that is a high energy product expressed as Mega Gauss Oersted's (MGOe), and a protection ring surrounding the head and the handle at the point of attachment.

We agree with the examiner that it would have been obvious to equip the Palomera hammer with the claimed asymmetric claws in view of the explicit advantages of such which are set forth in lines 23-30 of page 1 of Newbrough. However, we find ourselves in agreement with the appellants that the record does not support the conclusion that three of the four features mentioned above would have been obvious to one of ordinary skill in the art.

While the hammerhead disclosed by Palomera has a scored face, it is of circular shape rather than the square shape required by claim 1. Based on "his [own] skill in the art," and relying upon his "[own] experiences and skill in the art" (Answer, page 4), the examiner holds to his conclusion in the final rejection that making the face of the hammer in a square shape rather than a round one is merely a matter of design choice, notwithstanding the advantages of this shape put forward by the appellants and in the face of a request by the appellants that he provide evidence to support his position. The fact of the matter is that there is no credible evidence of record which supports the examiner's position, and therefore, from our perspective, the conclusion is inescapable that the square shape is not taught by the applied prior art.

We reach the same result with regard to the high energy magnet that is recited with specificity in claim 1 and is explained in detail and compared with “conventional” permanent magnets on page 3 of the appellants’ specification. With regard to this limitation, the examiner concluded in the final rejection that a “high energy” permanent magnet was disclosed by Palomera. However, he did not point out where this teaching appears in the reference, nor did he respond to the appellants’ argument that the Palomera magnet is precisely the type over which the claimed magnet is an improvement.¹

Finally, the claimed “protection ring” is not disclosed or taught in either of the applied references, notwithstanding the examiner’s indication in the final rejection that it is shown in Figure 2 of Palomera. The examiner has chosen not to respond to the arguments raised by the appellants on this issue in the Brief.

For the reasons set forth above, it is our conclusion that the combined teachings of Palomera and Newbrough fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain the standing rejection of claims 1, 3 and 4.

REMAND TO THE EXAMINER

This application is remanded to the examiner for action on the following matters:

¹Palomera states in lines 15-17 of column 3 that the magnet “comprises a natural magnet which is a configuration routinely marketed in hardware and home improvement centers.”

(1) Claim 1 includes the limitation that the shank portion of the hammer be “square shaped.” Without question, hammers are among the oldest tools used by man, and have been applied to accomplish a multitude of general and specialized tasks. It thus would seem quite probable that hammers having shanks of various configurations other than round, including square ones, are known in the prior art. However, as was pointed out above, there is no evidence of record regarding this claimed feature. The examiner should determine whether such evidence exists and, if so, revisit the matter of the obviousness of the square shaped hammer shank recited in claim 1.

(2) The appellants have admitted in their specification that the magnet specified in claim 1 is a known type. This being the case, the examiner should determine whether such a magnet has been utilized in the prior art in hammers or in situations which would suggest their use in hammers and, if so, revisit the matter of the obviousness of the use of the claimed magnet to hold nails in a notch in the head of a hammer.

(3) On page 3 of the appellants’ specification it is stated that

[a] handle 13, attached to the head, is enclosed in a protection ring 14 to provide a more secure connection between the head and the handle and to prevent damage to the head on impact (emphasis added).

However, the specification is devoid of details of the construction of the protection ring and the manner in which it is mounted to the handle and/or the head, as well as how it provides a more secure connection between the head and the handle and how it prevents damage

to the head. Nor is such apparent from the drawings. Thus, the issue arises as to whether the disclosure complies with 35 U.S.C. § 112, first paragraph. This situation is further clouded by the fact that claim 1 recites “a protection ring surrounding said handle and said head at the point of attachment” (emphasis added), which differs from the above-quoted recitation in the specification as well as the manner in which this limitation was expressed in claim 1 as originally filed (“said hammerhead being attached to a handle and a protection ring surrounding said handle at the point of attachment”). The examiner should make a determination with regard to the adequacy of the disclosure with respect to the protection ring.

SUMMARY

The rejection of claims 1, 3 and 4 as being unpatentable over Palomera in view of Newbrough is not sustained.

The decision of the examiner is reversed.

The application is remanded to the examiner for action in the three matters set forth above.

This application, by virtue of its "special" status, requires an immediate action, M.P.E.P § 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REVERSED AND REMANDED TO THE EXAMINER

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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JENNIFER D. BAHR)	
Administrative Patent Judge)	

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APJ COHEN

APJ BAHR

DECISION: **AFFIRM**

Prepared By:

DRAFT TYPED: 20 Mar 02

FINAL TYPED: