

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL M. EGGERT et al.

Appeal No. 2000-2097
Application No. 08/852,681

HEARD: January 18, 2001

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 3, 5, 26, 28 and 29. Claims 8 to 10, 12 to 14 and 16 have been allowed. Claims 4, 6, 7, 11, 15, 17 to 25 and 27 have been canceled.

We REVERSE and enter new rejections pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to hand tools (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Epel et al. (Epel)	4,334,563	June 15, 1982
Cooper	4,986,147	Jan. 22, 1991
Zurbuchen et al. (Zurbuchen '300)	5,271,300	Dec. 21, 1993

References made of record by this panel of the Board are:

Demurger	5,062,328	Nov. 5, 1991
Zurbuchen et al. (Zurbuchen '251)	5,713,251	Feb. 3, 1998 ¹
Zurbuchen et al. (Zurbuchen '693)	5,875,693	Mar. 2, 1999 ²

¹ Effective filing date Nov. 15, 1995.

² Filing date August 9, 1996.

Claims 1, 2, 5, 26, 28 and 29 stand rejected under 35 U.S.C. § 103 as being unpatentable over Zurbuchen '300 in view of Cooper.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Zurbuchen '300 in view of Cooper as applied above, in further view of Epel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 21, mailed March 22, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 18, filed March 6, 2000) 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3, 5, 26, 28 and 29 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the

teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id.

Claim 1, the sole independent claim on appeal, reads as follows:

A wrench comprising:
a handle formed entirely of non-metallic material; and
a head at an end of the handle, said head including a non-metallic body, a metal workpiece-engaging member encompassed by said body so as to secure said member to said body, and a reinforcing structure embedded in said body and encompassing said workpiece-engaging member.

In this case, after reviewing the teachings of the applied prior art, we find ourselves in agreement with the appellants' position (brief, pp. 5-8) that there is nothing in either Zurbuchen '300 or Cooper which would have suggested either

(1) making the workpiece-engaging member of Zurbuchen '300 of metal, or (2) providing Zurbuchen '300 with a

workpiece-engaging member of metal. In fact, the advantages of utilizing a metal workpiece-engaging member are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching the obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id. Since the metal workpiece-engaging member limitation of claim 1 is not taught or suggested by the

applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 1, and of dependent claims 2, 3, 5, 26, 28 and 29.³

New grounds of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new grounds of rejection.⁴

Claims 28 and 29 are rejected under 35 U.S.C. § 112, first paragraph, as the specification, as originally filed, does not provide support for the invention as is now claimed.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the

³ We have also reviewed the reference to Epel additionally applied in the rejection of claim 3 but find nothing therein which makes up for the deficiencies of Zurbuchen '300 and Cooper discussed above.

⁴ In addition, we cite Zurbuchen '693 and the examiner should consider the teachings of Zurbuchen '693 as well as the other prior art of record in any future prosecution of this application.

artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

Claims 28 and 29 together with parent claim 1 recite that the "metal workpiece-engaging member" is "a ratchet gear." After reviewing the application as originally filed, we fail to find any support for the now claimed limitation that the ratchet gear (e.g., # 51 in Figures 1, 3, 4 and 10) is made of metal. While the appellants have written description support for the workpiece-engaging members shown in Figures 11-13 (i.e., inserts 95 and 105) being made of metal (specification, pp. 13-14), we have been unable to find any support that ratchet gear 51 is made of metal.

Claims 1, 2, 5, 26, 28 and 29 are rejected under 35 U.S.C.

§ 102(e) as being anticipated by Zurbuchen '251.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Zurbuchen '251 discloses a double-ended ratcheting box end wrench which includes a body formed entirely of glass-fiber-reinforced plastic material with box-type ratcheting inserts molded at opposite ends of the body. The body includes layers of random discontinuous glass-fiber-reinforced plastic material and a band of unidirectional continuous glass-fiber-reinforced plastic

material. The body is subjected to a compression molding process embedded within which are the ratcheting inserts to form a composite wrench structure. Each ratcheting insert includes a two-part housing in which are disposed a ratchet gear, a pawl and a bias spring. Zurbuchen '251 teaches (column 5, lines 55-62) that

Because the plastic materials used to make the body 11 include no metallic components, it is non-conductive. Thus, although the ratchet wrench 10 includes metallic ratcheting inserts 20, during operation, when the user's hand is on the handle portion 12, the user is effectively protected from shock hazard. Also, the plastic composition of the body 11 results in its being corrosion resistant, non-marring, non-sparking and lightweight.

Claim 1 reads on Zurbuchen '251 as follows:

A wrench (ratchet wrench 10) comprising: a handle (handle portion 12) formed entirely of non-metallic material; and a head (head portions 13a, 13b) at an end of the handle, said head including a non-metallic body (body 11 is non-metallic), a metal workpiece-engaging member (gear wheel 51 which is shown as being metal) encompassed by said body so as to secure said member to said body, and a reinforcing structure (housing portions 30, 40) embedded in said body and encompassing said

workpiece-engaging member. With regard to claims 2 and 5, we note that the housing portions 30, 40 of Zurbuchen '251 are shown as being formed of metal in the form of a plate.

Claims 1 to 3 and 5 are rejected under 35 U.S.C. § 102(b) as being anticipated by Demurger.

Demurger discloses a plastic wrench with a metal insert. As shown in Figures 1-4, the plastic wrench 1 includes a handle 2 and a gripping head 3, 4, having a polygonal opening 5, 6 in which there is embedded an open metal insert 10, 11, likewise polygonal. The walls 12, 13, 14, 15 of the insert 10, 11 forming the jaw are parallel and protrude slightly from the lateral faces 16-19 of the openings 5, 6 of each gripping head 3, 4. Demurger teaches (column 3, lines 54-61) that

In an advantageous embodiment, the main horizontal surfaces of the inserts (10,11) are sandblasted, grooved or the like, so as to facilitate adhesion to the plastic during injection. In a variant, in order to facilitate this adhesion, the inserts (10,11) have, in the vicinity of the base (21), through holes (22,23,24), for example of two to four millimeters in diameter, through which the plastic passes during injection.

Claim 1 reads on Demurger as follows:

A wrench (wrench 1) comprising: a handle (handle 2) formed entirely of non-metallic material; and a head (head 3, 4) at an end of the handle, said head including a non-metallic body (head 3, 4 is non-metallic), a metal workpiece-engaging member (the part of the metal insert 10, 11 by walls 12-15) encompassed by said body so as to secure said member to said body, and a reinforcing structure (the part of the metal insert 10, 11 remote from walls 12-15) embedded in said body and encompassing said workpiece-engaging member. With regard to claim 3, we note Demurger's through holes 22, 23, 24 through which the plastic passes during injection.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5, 26, 28 and 29 under 35 U.S.C. § 103 is reversed; and new rejections of claims 1 to 3, 5, 26, 28 and 29 have been added pursuant to provisions of 37 CFR § 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR § 1.196(b)

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 2000-2097
Application No. 08/852,681

Page 15

HAROLD V. STOTLAND
SEYFARTH, SHAW, FAIRWEATHER & GERALDSON
42ND FLOOR
55 EAST MONROE STREET
CHICAGO, IL 60603-5803

Appeal No. 2000-2097
Application No. 08/852,681

Page 16

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