

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN L. MORRIS

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Appeal No. 2003-0458  
Application No. 09/894,738

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ON BRIEF

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Before KIMLIN, GARRIS, and DELMENDO, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 1, 3, 6, 8 and 9 as amended subsequent to the final rejection. These are all of the claims remaining in the application.

The subject matter on appeal relates to a device for driving eyebolts and hooks. With reference to the appellant's drawing,

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the device 10 includes a body 12 having an elongated driver head 14 with a longitudinal slot 22 centrally located therein for slidably receiving a nonthreaded portion of an eyebolt or hook, wherein the slot extends completely across the driver head so as to be open on opposite sides. This appealed subject matter is adequately represented by independent claim 1 which reads as follows:

1. A device for driving eyebolts and hooks comprising:

a body including an elongated driver head having opposite forward and rear ends and a central axis of rotation extending through the ends;

the body having a shank connected to the rear end of the driver head for detachably connecting the driver head to a source of rotary power;

the driver head having a centrally located longitudinal slot of a given width therein adapted to slidably receive a nonthreaded portion of an eyebolt or hook, the slot extending across the forward end and along the central axis of rotation toward the rear end to a given depth so as to terminate in a bottom wall and define a pair of opposing side walls, the slot extending completely across the driver head so as to be open on opposite sides;

the driver head having a threaded hole extending through one of the side walls and entering into the slot, the threaded hole having a centerline spaced forwardly a distance  $d_{ss}$  from the bottom wall;

a set screw of a given diameter for mating installation into the threaded hole so as to selectively protrude into the slot;  
and

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the distance  $d_{ss}$  and the diameter of the set screw being such that the set screw engages a rod of an eyebolt or hook placed in the slot with a positive, non-yielding clamping force.

The references set forth below are relied upon by the examiner as evidence of obviousness:

Onofrio	4,724,731	Feb. 16, 1988
Womack	5,058,465	Oct. 22, 1991
Grubbs	5,791,208	Aug. 11, 1998

Claims 1, 3, 6 and 8 are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Grubbs in view of Womack, and claim 9 is correspondingly rejected over these references and further in view of Onofrio.<sup>1</sup>

Rather than reiterate the respective positions advocated by the appellant and by the examiner concerning these rejections, we refer to the brief and to the answer for a complete exposition thereof.

#### OPINION

For the reasons which follow, we cannot sustain either of the rejections before us on this appeal.

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<sup>1</sup> On page 7 of the brief, the appellant states that "[c]laims 1, 3, 6, 8, and 9 are to be considered a single group of claims." Consistent with this statement, all of the arguments presented in the brief are directed to claim 1 only which is the sole independent claim on appeal. It follows that, in assessing the merits of the above noted rejections, we will focus on independent claim 1. See In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983); compare In re McDaniel, 293 F.3d 1379, 1382-85, 63 USPQ2d 1462, 1464-66 (Fed. Cir. 2002).

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As recognized by the examiner, appealed independent claim 1 distinguishes over Grubbs by virtue of, inter alia, the claim limitation "the slot extending completely across the driver head so as to be open on opposite sides." In patentee's screw eye driving and removing device, the slot is U-shaped as shown in Figure 6 and as disclosed in the paragraph bridging columns 3 and 4. Concerning this distinction, the examiner concludes that:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Grubbs by forming the slot completely through the driver head as taught by Womack in order to easily engage a workpiece and to readily accept a variety of different sized workpieces [answer, page 3].

We cannot agree with this conclusion.

Like the appellant, we consider the applied prior art to contain no teaching or suggestion for combining the Grubbs and Womack references in the above quoted manner proposed by the examiner. In the examiner's view, an artisan with ordinary skill would have been motivated to so combine these references "in order to easily engage a workpiece and to readily accept a variety of different sized workpieces" (Id.). However, Womack contains utterly no teaching of such desiderata as "to easily engage a workpiece" or "to readily accept a variety of different sized workpieces." Similarly, Grubbs contains no disclosure which would support a determination that his device possesses any

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problems relating to the easy engagement of a workpiece or to the ready acceptance of different sized workpieces.

With further regard to this issue, the examiner seems to believe (see the paragraph bridging pages 5 and 6 of the answer) that an artisan with ordinary skill would have associated the above discussed desiderata with an open slot of the type under consideration based upon the figures such as Figure 1 of Womack's drawing. The infirmity of this belief is that it is sheer speculation on the examiner's part with utterly no evidence to support it in the record of this appeal. We here remind the examiner that a section 103 rejection must rest on a factual basis without resort to speculation, assumption or hindsight reconstruction. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Under the circumstances recounted above, it is our determination that the Grubbs and Womack references are evidentially inadequate to establish a prima facie case of obviousness with respect to the modification proposed by the examiner and discussed above. We cannot sustain, therefore, the examiner's section 103 rejection of claims 1, 3, 6 and 8 as being unpatentable over Grubbs in view of Womack. Furthermore, because the deficiencies of these references are not supplied by Onofrio,

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we also cannot sustain the section 103 rejection of claim 9 as being unpatentable over Grubbs, Womack and Onofrio.

The decision of the examiner is reversed.

REVERSED

Edward C. Kimlin	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
Bradley R. Garris	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
Romulo H. Delmendo	)	
Administrative Patent Judge	)	

BRG:tdl

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