

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACK D. JARVIS

Appeal No. 1999-2439
Application No. 08/731,857¹

ON BRIEF

Before McQUADE, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4, 5 and 14 to 20, which are all of the claims pending in this application.

We REVERSE.

¹ Application for patent filed October 21, 1996.

BACKGROUND

The appellant's invention relates generally to hand tools and more specifically to an articulating multi-sized adapter (specification, p. 2). An understanding of the invention can be derived from a reading of the independent claims on appeal (i.e., claims 14, 16 and 19), copies of which are reproduced in the appendix to the appellant's brief.

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

Van Hoose	4,114,401	Sep.
19, 1978		
Cromwell	5,168,782	Dec. 8,
1992		

Claims 4, 5 and 14 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Van Hoose in view of Cromwell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No.

4, mailed September 18, 1998) and the answer (Paper No. 8, mailed April 13, 1999) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 6, filed March 22, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant 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 4, 5 and 14 to 20 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 prima facie case of

obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie 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).

In the rejection before us in this appeal, the examiner determined (final rejection, p. 2) that it would have been obvious in view of the teachings of Cromwell to have replaced Van Hoose's female member 94 with a male square drive member, thus the modified Van Hoose's adapter 10 would have a square drive at each end thereof. We do not agree.

In our view, the only suggestion for modifying Van Hoose in the manner proposed by the examiner stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible.

See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In that regard, it is our view that the combined teachings² of the applied prior art would have made it obvious at the time the invention was made to a person having ordinary skill in the art to have modified Van Hoose's male member (i.e., rectangular shank 16) to accept the extension bar 12 of Cromwell's tool extension adapter 10.

Moreover, we agree with the appellant's argument (brief, p. 10) that the applied prior art does not teach or suggest either (1) a socket having different sized openings at each end thereof as recited in claim 14, or (2) a straight adapter having different sized openings at each end thereof as recited in claim 14. Likewise, the applied prior art does not teach

² The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

or suggest a female drive member as recited in either claim 16 or claim 19.

For the reasons set forth above, we cannot sustain the examiner's rejections of claims 4, 5 and 14 to 20.

CONCLUSION

To summarize, the decision of the examiner to reject claims 4, 5 and 14 to 20 under 35 U.S.C. § 103 is reversed.

REVERSED

JOHN P. McQUADE)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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)	
JENNIFER D. BAHR)	
Administrative Patent Judge)	

Appeal No. 1999-2439
Application No. 08/731,857

Page 8

PAUL M. DENK
763 SOUTH NEW BALLAS ROAD
ST LOUIS, MO 63141

APPEAL NO. 1999-2439 - JUDGE NASE
APPLICATION NO. 08/731,857

APJ NASE

APJ McQUADE

APJ BAHR

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 03 Jan 00

FINAL TYPED: