

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS P. TREVORROW,
BEN D. YODER,
ALBERT E. ZUCCOLOTTO,
and THOMAS P. TREVORROW, JR.

Appeal No. 96-0563
Application 07/540,839¹

ON BRIEF

Before LYDDANE, MEISTER, and STAAB, Administrative Patent Judges.

LYDDANE, Administrative Patent Judge.

¹ Application for patent filed June 20, 1990.

DECISION ON APPEAL

This is a decision on an appeal from the final rejection of claims 30 through 33. Appellants have withdrawn the appeal of claim 33² (brief, page 1), and claims 1 through 29 and 34, the only other claims remaining in the application, stand withdrawn from further consideration by the examiner pursuant to 37 CFR § 1.196(b) as being drawn to a nonelected invention. Thus, claims 30 through 32 are the only claims before us for our consideration.

The subject matter on appeal is directed to a wrench. Claim 30 is exemplary of the invention and reads as follows:

30. A wrench assembly which comprises:

- a. an elongate handle;
- b. an open ended jaw formation located on one end of said handle for closely surrounding and engaging a majority of the perimeter of a splined cylindrical shaft;
- c. a spring loaded spline latch mechanism mounted on said handle and having a latch that, in a first position, protrudes into the jaw engagement area for engagement with a spline on said shaft and, in a second position is retracted

² This claim should be canceled from the application by direction of the examiner pursuant to the Manual of Patent Examining Procedure § 1215.03 (6th ed., no. 2, July 1996).

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from the jaw engagement area for disengagement with said spline on said shaft;

d. and means for moving said latch from one of said first position and said second position to the other of said first and second position.

The references of record relied upon by the examiner in rejections of the claims under 35 U.S.C. § 102(b) and under 35 U.S.C. § 103 are:

Myers	869,255	Oct. 29, 1907
Beran	1,006,348	Oct. 17, 1911
Bubb	1,287,211	Dec. 10, 1918
Plungis et al. (Plungis)	2,709,939	Jun. 7, 1955

Claim 30 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Beran.

Claims 30 and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over Plungis in view of Bubb.

Claims 30 and 32 stand rejected under 35 U.S.C. § 103 as being unpatentable over Plungis in view of Bubb and Myers.

Rather than reiterate the examiner's statement of the above rejections and the conflicting viewpoints advanced by

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the examiner and the appellants, we refer to pages 3 through 5 of the examiner's answer, to the supplemental answer, to pages 3 through 5 of the appellants' brief and to the reply brief for the full exposition thereof.

OPINION

Our evaluation of the patentability issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art, and the respective positions advanced by the appellants and the examiner. With respect to the applied references, we have considered all of the disclosure of each reference for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, we have taken into account not only the specific teachings of each reference, but also the inferences which one skilled in the art would have reasonably been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). On the basis of the knowledge and level of skill in the art at the

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time of appellants' invention, as reflected by the applied references, it is our conclusion that the examiner's rejection of claims 30 and 31 under 35 U.S.C. § 103 is well founded, but that the rejections of claim 30 under 35 U.S.C. § 102(b) and of claim 32 under 35 U.S.C. § 103 are not well founded. Our reasoning for this determination follows.

Considering first the rejection of claim 30 under § 102(b), we initially observe that an anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. See Constant v. Advanced Micro-Devices, Inc., 848 F.2d 1560, 1570, 7 USPQ2d 1057, 1064 (Fed. Cir.), cert. denied, 488 U.S. 892 (1988); RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.1984). Additionally, 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, i.e., all limitations of the claim are found in the reference. See Kalman v. Kimberly-

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Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984) (and overruled in part on another issue), SRI Int'l v. Matsushita Elec. Corp. Of Am., 775 F.2d 1107, 1118, 227 USPQ 577, 583 (Fed. Cir. 1985). Moreover, anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or recognition of properties that are inherently possessed by the reference. See Verdegaal Bros. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). Also, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. See In re Graves, 69 F.3d 1147, 1152, 36 USPQ2d 1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from In re LeGrice, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

With this as background, we turn to the disclosure of the patent to Beran. It is apparent that Beran (Figure 1) discloses a wrench assembly that includes an elongate handle

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(A), an open ended jaw formation (B,N), and a spring loaded spline latch mechanism (B,D,E,F) having a latch. However, the open ended jaw formation (B,N) of the wrench of Beran is not capable of "closely surrounding and engaging a majority of the perimeter of a splined cylindrical shaft," nor does the wrench of Beran include a "means for moving said latch," both required by appealed claim 30. The examiner considers the elements (C,D,E,F) to read on the claimed "means for moving said latch," but we disagree. It is clear from the disclosure of Beran that elements (D,E,F) provide the spring loading of the latch mechanism (B), and while they do provide a means for moving the latch mechanism, the "means for moving said latch" recited in paragraph d of claim 30 requires structure in addition to that defining the "spring loaded spline latch mechanism" of paragraph b. No such additional structure for moving the latch is present in the wrench of Beran. Therefore, the wrench of Beran does not include every element recited in appealed claim 30, and we cannot sustain the examiner's rejection thereof under 35 U.S.C. § 102(b).

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Considering next the rejection of appealed claims 30 and 31 under 35 U.S.C. § 103 as being unpatentable over Plungis in view of Bubb, we note that the examiner takes the position that Plungis discloses a wrench assembly having all the elements recited in appealed claims 30 and 31 except that the jaw assembly is not open ended, and this position is not disputed by appellants. The examiner has also taken the position that open ended wrenches are conventional, citing the patent to Bubb as evidence of this fact. Appellants again do not dispute this position, but in fact agree, as indicated on page 5 of the brief. Appellants do, however, dispute the conclusion of the examiner that one having ordinary skill in the art would have found it obvious to form the wrench of Plungis to be open ended in order to enable the wrench to laterally engage a workpiece having an axially inaccessible end. In this regard, appellants argue that such modification is "neither shown or suggested by the references" (brief, page 5).

In addressing appellant's argument that the prior art must contain something to suggest the desirability of the

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combination, we note that to justify combining reference teachings in support of a rejection under 35 U.S.C. § 103 it is not necessary that a device shown in one reference be capable of being physically inserted into the device shown in the other or that the prior art suggest expressly the changes or possible improvements the appellants have made. It is only necessary that knowledge clearly present in the prior art was applied. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981); In re Sernaker, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983). It is our opinion that the examiner has properly applied only knowledge which is clearly present in the prior art as evidenced by the patent to Bubb in the rejection of claims 30 and 31 under 35 U.S.C. § 103, and we shall thus sustain this rejection. Clearly, the motivation for making the modification of Plungis to have an open end would have been for the well known and self-evident purpose of permitting lateral access to a workpiece that is axially inaccessible, and the manner of making the wrench of Plungis to have an open end is also self-evident, as well as suggested by Bubb. We note that the law

presumes skill on the part of the artisan rather than the converse. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

We reach the opposite conclusion, however, with respect to the examiner's rejection of appealed claim 32³ under 35 U.S.C. § 103 based on the combined teachings of Plungis, Bubb and Myers. It is clear from reviewing the disclosure of the patent to Myers that the device disclosed therein is a ratchet wrench (Figures 1 through 3 and 5) having an axially movable dog 19 biased toward one position by spring 22 and movable to another position by stem 23 and head 24 by movement of the stem through slot 17, 18 in handle 8. However, like the appellants, we find no teaching or suggestion from the

³ It is our observation that the wrench including the cam structure recited in appealed claim 32 is purportedly depicted in Figure 5 of appellants' drawings. However, it is apparent that the cam surface 96 must engage pin member 98 on the opposite side from that shown in Figure 5 if rotation of the cam handle 94 is to retract the latch 76 from the engagement area 78 as described on pages 20 and 21 of appellants specification. It is our view that one having ordinary skill in this art would readily recognize this drawing error from the description in the specification and would know how to correct it. Accordingly, appellants should correct Figure 5 to comply with the description in the specification and with 37 CFR § 1.83(a).

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applied references or from knowledge clearly present in the prior art to substitute the axially movable dog of the ratchet wrench taught by Myers for plunger pin of spanner wrench of Plungis. As stated in W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984),

[t]o 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.

It is our conclusion that the only reason to combine the teachings of the applied references in the manner proposed by the examiner results from a review of appellants' disclosure and the application of impermissible hindsight. Thus, we cannot sustain the examiner's rejection of appealed claim 32 under 35 U.S.C. § 103.

Accordingly, the decision of the examiner rejecting claims 30 and 31 under 35 U.S.C. § 103 affirmed, but the decision rejecting claim 30 under 35 U.S.C. § 102(b) and rejecting claim 32 under 35 U.S.C. § 103 is reversed.

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

AFFIRMED-IN-PART

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Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
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