

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TIMOTHY S. LEATHERMAN, BENJAMIN C.
RIVERA and PHILLIP C. GIBSON

Appeal No. 97-4206
Application 08/662,263¹

ON BRIEF

Before COHEN, MEISTER and NASE, Administrative Patent Judges.
MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

Timothy S. Leatherman, Benjamin C. Rivera and Phillip C. Gibson (the appellants) appeal from the final rejection of claims 1-8 and 22. Claims 17-21 stand allowed. Claims 9-16 and 23-26, the only other claims present in the application,

¹ Application for patent filed June 7, 1996. According to appellants, the application is a continuation of Application 08/182,414, filed January 13, 1994.

stand withdrawn from further consideration by the examiner under the provisions of 37 CFR § 1.142(b) as being directed to a nonelected invention.

We AFFIRM-IN-PART.

The appellants' invention pertains to a blade locking mechanism for a tool of the type having a plurality of folding blades. Independent claims 1, 5 and 6 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the appellants' brief.

The prior art relied on by the examiner is;²

Rohrer (Rohrer '142) 1920	1,362,142	Dec. 14,
Rohrer (Rohrer '143) 1920	1,362,143	Dec. 14,
Smith 1971	3,568,315	Mar. 09,
Brooker 1987	4,703,560	Nov. 03,
Yamagishi 03, 1988	4,741,106	May
Favreau 1994	5,327,651	Jul. 12,
		(filed May 03, 1993)
Herder	159,369	Dec. 24,

² The examiner failed to include the references to Brooker and Favreau in the listing of prior art on page 3 of the answer. Additionally, the examiner improperly grouped the two references to Rohrer together as a single citation.

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1903
(Germany)³

The admitted prior art illustrated in Fig. 3 of the drawings and described on pages 7 and 8 of the specification. (the admitted prior art)

The claims on appeal stand rejected in the following manner:

(1) Claims 1, 2, 7, 8 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Brooker, Rohrer '143 or Favreau;

(2) Claims 1-4 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Smith or Rohrer '142;

(3) Claims 5, 7 and 8 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Yamagishi or Herder; and

(4) Claim 6 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Herder or Favreau.

³ Translation attached.

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The examiner's rejections are explained on pages 3-6 of the answer. The arguments of the appellants and examiner in support of their respective positions may be found on pages 5-14 of the brief and pages 6-8 of the answer.

OPINION

We have carefully reviewed the appellants' invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellants in the brief and by the examiner in the answer. As a consequence of this review, we make the following determinations.

Rejection (1)

Initially we note that, with respect to this rejection, the appellant on page 5 of the brief state that "all of claims 1, 2, 7, 8, and 22 stand or fall together." Accordingly, these claims will stand or fall with representative claim 1. 37 CFR § 1.192(c)(7).

Considering first of claims 1, 2, 7, 8 and 22 based on the combined teachings of the admitted prior art and Rohrer '143, the examiner is of the opinion that it would have been obvious to form the flange of the admitted prior art with "an inside corner of approximately 90E having effectively a zero radius of curvature," as set forth in representative claim 1, in view of the teachings of Rohrer '143.

The appellants do not dispute the examiner's finding that Rohrer '143 has a flange which has an inside corner that extends at an angle of "approximately 90E" and has "effectively a zero radius of curvature." Instead, the appellants note the deficiencies of the references individually and urge that there is no suggestion to combine their teachings in the manner proposed by the examiner. With respect to the relied on prior art the brief states that:

The prior art tool shown in FIG. 3 and associated description at page 10, lines 8-36, in the present application includes a catch 341 including a spring 316 of thin sheet metal, with an end of the spring bent to form a flange 318, but forming a curved inside corner 322, as well. Such a spring

and flange need to be wide enough to span the several blades or tool bits, and thin enough to be flexible without too much force, since the length of the spring is limited by its formation as a part of the back of the channel-shaped handle. Formation of such a spring too long would weaken the handle.

* * *

Rohrer '143 also discloses a single-bladed tool. There is no suggestion to use its construction, either, in a multi-bladed tool. While Rohrer '143 discloses a blade-locking member 13 carried on a spring, and a cam lever 14 useful for unlatching the single blade from its latched-open position, the spring is of a narrow, deep configuration. Rohrer does not suggest how such a blade locking member could be utilized for a multi-bladed tool of the type shown in FIG. 3 of the present application, where a spring and locking member such as shown by Rohrer, if made wide enough to engage several blades, would be too stiff for practicality. [Pages 6 and 7.]

Thereafter, the appellants conclude that the examiner has used a hindsight reconstruction of the references in arriving at a conclusion of obviousness.

We are unpersuaded by the appellant's arguments. While the obviousness of an invention cannot be established by combining the teachings of the prior art absent some teaching, suggestion or incentive supporting the combination (**see ACS Hospital Systems, Inc. v. Montefiore Hospital**, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)), this does not mean that the cited references or prior art must specifically suggest making the combination (**B.F. Goodrich Co. v. Aircraft Braking Systems Corp.**, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996) and **In re Nilssen**, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)). Rather, the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. **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). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom (**In re Preda**, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968)), and

all of the disclosures in a reference must be evaluated for what they fairly teach one having

ordinary skill in the art (*In re Boe*, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966)).

Here, as the appellants recognize, the admitted prior art and Rohrer '143 each utilize a spring arm having a generally perpendicularly-extending flange on the end thereof in order to engage a notch in the base of a pivotally-mounted blade, and thereby latch the blade in an extended position. Both references employ cams (347 in the case of the admitted prior art and 18 in the case of Rohrer '143) on the bases of adjacent tools that are pivotally mounted on the same axis as their respective blades for the purpose of engaging the end of the flange in such a manner so as to lift the flange from the notch, and thus unlatch the blade. The flange 318 of the admitted prior art, while extending from spring arm 316 at approximately a 90° angle, has a significant radius of curvature on the inside corner (see Fig. 3). The flange of Rohrer '143, however, extends from spring arm 13 at

approximately a 90E angle and has effectively a zero radius of curvature on the inside corner (see Figs. 1-3). Taken as a whole, the teachings of the admitted prior art and Rohrer '143 establish that the provision of generally perpendicularly-extending flanges on the ends of spring arms having (1) a radius of curvature on the inside corner and (2) effectively a zero radius of curvature on the inside corner, are art-recognized alternatives which are well known, and the respective advantages and disadvantages of each would have been apparent to one of ordinary skill in the art. **See, e.g., In re Heinrich**, 268 F.2d 753, 756, 122 USPQ 388, 390 (CCPA 1959). Applying the test for obviousness⁴ as set forth in **In re Keller**, 642 F.2d at 425, 208 USPQ at 881, we are convinced that one of ordinary skill in this art would have found it obvious to provide the flange 318 of the admitted prior art with an effectively zero radius of curvature on the inside corner in view of the teachings of Rohrer '143.

⁴ The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.

As to the appellants' contention that if the latching member of were made wide enough to engage several blades it would be "too stiff for practicality," we observe that all of the features of the secondary reference need not be bodily incorporated into the primary reference (see the above-noted test for obviousness) and the artisan is not compelled to blindly follow the teaching of one prior art reference over the other without the exercise of independent judgment (***Lear Siegler, Inc. v. Aeroquip Corp.***, 733 F.2d 881, 889, 221 USPQ 1025, 1032 (Fed. Cir. 1984)). Here, it is the admitted prior art which teaches that the spring arm should not be so stiff that it could not effectively engage several blades.

In view of the foregoing, we will sustain the rejection of claims 1, 2, 7, 8 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Rohrer '143.

Turning to the rejection of claims 1, 2, 7, 8 and 22 based on the combined teachings of the admitted prior art and either Brooker or Favreau, the examiner is of the opinion that it would have been obvious to form the flange of the admitted

prior art with "an inside corner of approximately 90° having effectively a zero radius of curvature," in view of the teachings of either Brooker or Favreau. We observe, however, that while Brooker and Favreau are both directed to latching devices for pivotally mounted blades which have generally perpendicularly extending flanges that can broadly be considered to have an inside corner with a zero radius of curvature, neither of the flanges are mounted on the end of a spring arm. Brooker's flange 24 is formed on the end of a rigid support unit 12 that is fixedly mounted on the handle in such a manner so as to cooperate with a notch 19 on the blade 11 via a rectilinearly movable lost motion connection 14,18. This lost motion connection includes a lock nut unit 14 which must be loosened and re-tightened when moving the blade from one position to another. Favreau's flange or engaging foot 20 is mounted one end of a rigid lever arm 18 that pivots about an axle 19 and the engaging foot cooperates with ratchet teeth 17 formed on the base of the blade to position the blade in a selected angular orientation. In order to secure the blade in the selected orientation, the engaging foot is positioned in a

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desired ratchet tooth and the rigid lever arm is fastened to the ratch mechanism by a threaded lock rod 26, which must be unfastened and refastened each time the blade is moved from one angular orientation to another. There is simply nothing in the disparate teachings of either Brooker or Favreau which would fairly suggest modifying the flange on the end of the spring arm of the admitted prior art in the manner proposed by the examiner. While the examiner opines that the proposed modification would "more securely lock" the blade of the admitted prior art, the mere fact that such a result would occur does not serve as a proper basis for concluding that such a modification would have been obvious. Instead, it is the prior art teachings which must be sufficient to suggest to one of ordinary skill in the art to make the modification needed to arrive at the claimed invention (*see, e.g., In re Lulu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984)). Here, there is no such suggestion. Accordingly, we will not sustain the rejection of claims 1, 2, 7, 8 and 22 under 35 U.S.C. § 103 as being unpatentable over the

admitted prior art in view of either Brooker or Favreau.

Rejections (2) and (3)

Each of these rejections is bottomed on the examiner's view that it would have been obvious to form the flange of the admitted prior art with "an inside corner of approximately 90° having effectively a zero radius of curvature," in view of the teachings of either Smith, Rohrer '142, Yamagishi or Herder; however, each of these secondary references suffer from generally the same deficiencies that we have noted above in Rejection (1) with respect to the teachings of Brooker and Favreau. That is, while each of the secondary references are directed to latching devices for pivotally mounted blades which have generally perpendicularly extending flanges that can broadly be considered to have an inside corner with a zero radius of curvature, none of the flanges are mounted on the end of a spring arm. Instead, all the flanges are mounted on the ends of rigid lever arms which pivot about a fixed axis. Thus, for generally the same reasons we have stated above in Rejection (1) with respect to the teachings of Brooker and Favreau, we find nothing in the combined teachings of the

admitted prior art and either Smith, Rohrer '142, Yamagishi or Herder which would fairly suggest the modification which the examiner has proposed. Accordingly, we will not sustain the rejections under 35 U.S.C. § 103 of claims 1-4 and 22 as being unpatentable over the admitted prior art in view of Smith or Rohrer '142 and claims 5, 7 and 8 as being unpatentable over the admitted prior art in view of Yamagishi or Herder.

Rejection (4)

The examiner has taken the position that it would have been obvious to provide the notch of the admitted prior art with a bottom which is wider than the opening at the top in view of the teachings of Herder or Favreau. We do not agree. With respect to Favreau, there is not even any clear teaching therein of a notch which is wider at the bottom, much less a suggestion to combine Favreau's disparate teachings with those of the admitted prior art. That is, the flange or engaging foot 20 of Favreau is clearly depicted as having an arcuate bottom "for reception between a plurality of said ratchet teeth" (column 4, lines 43 and 44). See also column 1, lines 40-45. Thus, in Favreau the ratchet teeth form the notches

and they are clearly narrower at the bottom than at the top.

As to Herder, while this reference does in fact teach a notch that is wider at the bottom than at the top, it is used to cooperate with a lever having a correspondingly shaped flange on the end thereof that pivots about a **vertical axis** so as to swing the flange **laterally** into and out of the notch, thereby forming a "swallow-tailed" (translation, page 2) or dovetail connection when the flange is engaged in the notch. There is absolutely nothing in the combined teachings of the admitted prior art and Herder which would suggest singling out the feature of the notch having a wider bottom than opening at the top (which was intended to cooperate with a correspondingly shaped flange) and incorporate it into the notch of the admitted prior art wherein the spring arm pivots about a generally **horizontal axis** so as to swing the flange **vertically** into and out of the notch. The examiner may not pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts

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necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. **See *Bausch & Lomb, Inc., v. Barnes-Hind/Hydrocurve Inc.***, 796 F.2d 443, 448, 230 USPQ 416, 419 (Fed. Cir. 1986) and ***In re Kamm***, 452 F.2d 1052, 1057, 172 USPQ 298, 301-02 (CCPA 1972).

In view of the above, we will not sustain the rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Herder or Favreau.

In summary:

The rejection of claims 1, 2, 7, 8 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Rohrer '143 is affirmed.

The rejection of claims 1, 2, 7, 8 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Brooker or Favreau is reversed.

The rejection of claims 1-4 and 22 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Smith or Rohrer '142 is reversed.

The rejection of claims 5, 7 and 8 under 35 U.S.C. § 103

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as being unpatentable over the admitted prior art in view of Yamagishi or Herder is reversed.

The rejection of claim 6 under 35 U.S.C. § 103 as being unpatentable over the admitted prior art in view of Herder or Favreau is reversed.

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

IRWIN CHARLES COHEN
Administrative Patent Judge

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