

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board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

23

UNITED STATES PATENT AND TRADEMARK OFFICE

-----  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
-----

Ex parte CHRISTOPHER D. THOMPSON  
And JOSEPH R. HOEPFL  
-----

Appeal No. 1998-3353  
Application 08/692,711  
-----

ON BRIEF  
-----

Before McCandlish, Senior Administrative Patent Judge,  
and Pate and Nase, Administrative Patent Judges.

McCandlish, Senior Administrative Patent Judge.

DECISION ON APPEAL  
AND  
REMAND TO EXAMINER

This is a decision on an appeal from the examiner's final rejection of claims 21 through 25 and 28 through 33. No other claims are pending in the application.

We reverse the examiner's decision rejecting the appealed claims and remand this application to the

Appeal No. 1998-3353  
Application 08/692,711

examiner for consideration of new grounds of rejection discussed infra.

Appellants' invention relates to a ratcheting driver handle for a driver such as a screwdriver bit (70). The driver handle mainly comprises a grippable body (11) and a ratchet mechanism (40) conditioned by a selector member (60) in such a manner that rotation of the body in a given direction will either cause rotation of the driver or will allow the body to ratchet with respect to the driver. The ratchet mechanism comprises (a) a ratchet gear (41) having a bore for receiving the shank of the driver and (b) at least one spring biased pawl (50) which is engageable with the ratchet gear.

According to the independent claim 21, an actuator projection structure (65) on the selector member is positioned and dimensioned for direct engagement with the pawl to disengage the pawl from the ratchet gear upon moving the selector member to a certain position. Claim 33, the only other independent claim on appeal, contains a similar limitation, but is more limited than claim 21 in that it calls for first and second pawls and recites that the actuator projection structure on the selector

Appeal No. 1998-3353  
Application 08/692,711

member is "positioned and dimensioned for direct engagement with said pawls . . . in response to movement of said selector member between its first and second positions."

A copy of the appealed claims is appended to appellants' brief.

The following references are relied upon by the examiner as evidence of obviousness in support of her rejections under 35 U.S.C. § 103:

Froeschl et al. (Froeschl)	2,201,827	May 21, 1940
Gantz	2,627,330	Feb. 3, 1953
Herman et al. (Herman)	4,777,852	Oct.18, 1988

Claims 21 through 25 and 28 through 33 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herman in view of Froeschl, and claims 21, 23, 24 and 28 stand rejected under 35 U.S.C. § 103 as being unpatentable over Herman in view of Gantz. In both of these rejections, the examiner concedes that the Herman patent lacks a disclosure of a pawl-engaging actuator projection structure (which is referred to on pages 3 and 4 of the answer in a more limited sense as a "pin") on Herman's selector member 90.

Appeal No. 1998-3353  
Application 08/692,711

Instead, as noted in the examiner's analysis of the Herman patent (see, for example, page 3 of the answer), Herman discloses a two-part motion-transmitting assembly for transmitting the rotation of the selector member 90 to a selected pawl in the ratchet mechanism. Herman's two-part

assembly comprises what is described in Herman's specification as a "pin" 95 and an L-shaped lever 80. Herman's pin 95 is mounted on the rotatable selector member 90 for engaging the L-shaped lever 80 which is positioned between the pawls to contact a selected pawl and thereby disengage the selected pawl from the ratchet gear in the ratchet mechanism. The examiner nevertheless concludes, that each of the applied secondary references (namely Froeschl and Gantz) would have made it obvious to "form the actuator pin [95] and lever [80] of Herman et al as a pin in direct engagement with the pawls . . ." (answer, page 3). We cannot agree.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima

Appeal No. 1998-3353  
Application 08/692,711

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 in a manner 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 applying the teachings of the applied references in each of the standing rejections, the examiner has apparently lost sight of the fact that the selector and ratchet mechanism disclosed in each of the applied secondary references is distinctly different from the selector and ratchet mechanism disclosed in the Herman patent. As a consequence, a substantially complete reconstruction of Herman's mechanism would be required to incorporate the particular teachings of each secondary reference into Herman's structure. Such a requirement cannot be glossed over by generalizing the teachings of each secondary reference and applying those teachings with the hindsight benefit of appellants' disclosure as

Appeal No. 1998-3353  
Application 08/692,711

the examiner has done here to arrive at appellants' claimed invention. Hindsight analysis is clearly improper. In re Deminski, 796 F.2d 436, 443, 230 USPQ 313, 316 (Fed. Cir. 1986).

Accordingly, we cannot agree that the examiner has made out a prima facie case of obviousness based on Herman in view of Froeschl, and we also cannot agree that the examiner has made out a prima facie case of obviousness based on Herman in view of Gantz. Therefore, the examiner's decision

to reject claims 21 through 25 and 28 through 33 under 35 U.S.C. § 103 as being unpatentable over Herman in view of Froeschl is reversed, and the examiner's decision to reject claims 21, 23, 24 and 28 under 35 U.S.C. § 103 as being unpatentable over Herman in view of Gantz is also reversed.

This application is remanded to the examiner to consider the prospect of making the following rejections:

1. A double patenting rejection of one or more of the appealed claims based on any claim in appellants' U. S. Patent No. 5,570,616 (copy attached) as amended in the

Appeal No. 1998-3353  
Application 08/692,711

Reexamination Certificate B1 5,570,616 issued on August 25, 1998 (copy attached).

2. A § 103 rejection of one or more of the appealed claims utilizing the Gantz patent as the primary reference.

3. A § 103 rejection of one or more of the appealed claims utilizing the Froeschl patent as the primary reference.

As one example of a possible double patenting rejection, it appears that claim 21 in the instant application differs from claim 1 in Patent No. 5,570,616 in that it more broadly recites that the pawl-engaging element is an "actuator projection structure" whereas claim 1 of Patent No. 5,570,616 recites that the pawl-engaging element is an "actuator pin." Froeschl, however, teaches the use of a pin as the structure that is mounted on the selector member for directly engaging a selected pawl in a selector and ratchet mechanism.

With regard to a possible § 103 rejection utilizing Gantz as the primary reference and a possible § 103 rejection utilizing Froeschl as the primary reference, the examiner should analyze Gantz and Froeschl to determine the differences between each of these

Appeal No. 1998-3353  
Application 08/692,711

references and each of the appealed claims in the instant application. Considering appealed claim 21 as an example, the recitation of an "actuator projection structure . . . extending parallel to said axis" appears to be broad enough to read on the pawl-engaging pin 18 in Froeschl's mechanism and at least one of the pawl-engaging lugs 41 in Gantz's mechanism. It therefore

appears that at least claim 21 in the instant application differs from each of the Gantz and Froeschl references merely by reciting that ratchet mechanism has a bore for receiving the shank of the driver. Herman appears to contain a teaching of this feature.

Appeal No. 1998-3353  
Application 08/692,711

REVERSED/REMANDED

Harrison E. McCandlish, Senior )  
Administrative Patent Judge )  
)  
)  
) BOARD OF  
PATENT )  
William F. Pate, III )  
Administrative Patent Judge ) APPEALS  
AND )  
)  
)  
INTERFERENCES )  
)  
Jeffrey V. Nase )  
Administrative Patent Judge )

HMcC/cam

Harold V. Stotland  
Seyfarth & Shaw  
42<sup>nd</sup> Floor  
55 East Monroe Street  
Chicago, IL 60603-5803