

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 9

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Ex parte JOSEPH KARL BLAUSTEIN

Appeal No. 2002-0947
Application No. 09/518,835

ON BRIEF

Before COHEN, MCQUADE and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to wire-stripping tools and particularly to wire-stripping tools having jaws to strip two or more wires of identical size simultaneously

(specification, page 1). Further understanding of the invention may be obtained from a reading of representative claims 1, 13 and 15, which are reproduced in the appendix to appellant's brief.

The following rejection is before us for review.

Claims 1-15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yang¹.

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 and answer (Paper Nos. 5 and 8) for the examiner's complete reasoning in support of the rejection and to the brief (Paper No. 7) 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 Yang patent, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Each of appellant's independent claims 1, 13 and 15 is directed to a wire-stripping tool comprising a pair of cutting jaws and wire strippers for stripping a plurality of equally-sized wires (claims 13 and 15) or wires having a same gauge (claim 1). In accordance with appellant's disclosure, this is accomplished by providing a plurality of

¹ U.S. Patent No. 5,711,182, issued January 27, 1998.

adjacent stripping openings of equal size. As explained on page 5 of appellant's specification, a commonly used type of sheathed cable includes two insulated 12 gauge wires and a bare ground wire and an advantage of the provision of two adjacent stripping openings equally sized for stripping 12 gauge wires is that it allows a worker to strip both of the 12 gauge wires at one time.

Yang, the sole prior art reference relied upon by the examiner as evidence of obviousness, discloses a wire crimping and stripping tool comprising pivoted jaws and a wire stripping section 38 formed by a top face 381 of a first elongated member 31 provided with a wire stripping teathed edge and a downwardly inclined top face 382 of a second elongated member 32 also provided with a teathed edge. The relative sizes of the openings formed between the teeth of the faces 381, 382 of the wire stripping section 38 of Yang cannot be determined with any certainty from the inconsistent illustrations thereof in Figure 4, which appears to show a continuous graduation of openings from smallest to largest with increasing distance from the pivot, and Figure 5, which appears to show random size openings. The examiner's assertion on page 3 of the final rejection that "it appears that some of the holes in the wire-stripping [section] are equal in size" is based upon speculation.² As is evident from Yang's discussion of the background of the invention in column 1, lines 41-44, the recesses of the wire

² Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

stripping sections of the first and second elongated members are “of different dimensions for stripping the insulation layer of different sizes of electrical wires.” While an improvement of Yang’s invention is the provision of lobe members 39 for cooperatively preventing movement of the first and second elongated members away from each other when the first and second elongated members are operated such that the wire stripping members cooperatively strip an insulation layer of an electrical wire, Yang provides no teaching or suggestion to alter the relative sizes of the openings formed between the teeth of the stripping sections from that known in the prior art, that is, recesses of different dimensions for stripping the insulation layer of different sizes of electrical wires.

While the examiner may be correct that the holes in Yang’s wire stripping section “could be of equal size” (final rejection, page 3), this is insufficient to establish that it would have been obvious to so modify Yang’s wire-stripping section. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The examiner’s position that the provision of equally-sized stripping cutters would have been obvious to one of ordinary skill in the art at the time of the invention, “since it is within the general skill of a worker in the art to duplicate the essential working parts of a device on the basis of its suitability for the user’s preference as a matter of design

choice” (answer, page 3) is equally unsound, as the examiner has adduced no evidence showing that one of ordinary skill in the art would have considered the provision of equally-sized holes to be suitable or desirable in Yang’s wire-stripping section.³ On the contrary, in light of the teachings of Yang in the background of the invention, one of ordinary skill in the art would have been instructed by Yang to provide openings of different dimensions to permit stripping of wires of different sizes. From our perspective, the only suggestion for providing duplicate stripping openings of equal size in the wire-stripping section of Yang as proposed by the examiner is found in the luxury of hindsight accorded one who first viewed appellant’s disclosure, with its teaching of the desirability of simultaneously stripping the two 12 gauge wires of a sheathed cable, for example. This, of course, is not a proper basis for a rejection. See In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

For the foregoing reasons, we conclude that the evidence relied upon by the examiner is insufficient to establish that the differences between the subject matter of claims 1, 13 and 15 and Yang are such that the claimed subject matter would have been obvious within the meaning of 35 U.S.C. § 103. Accordingly, we shall not sustain the examiner’s rejection of these claims or, it follows, of dependent claims 2-12 and 14.

³ Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-15 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

JOHN P. MCQUADE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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