

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. BOLLINGER

Appeal No. 2004-0106
Application 09/907,974

ON BRIEF

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

DECISION ON APPEAL

Robert A. Bollinger originally took this appeal from the final rejection (Paper No. 12) of claims 24 through 27, 29 through 35 and 43 through 47, all of the claims pending in the application. As the appellant has chosen not to proceed with respect to claims 43 through 47 (see page 2 in the main brief, Paper No. 14), the appeal as to these claims is hereby dismissed, leaving for review the standing rejection of claims 24 through 27 and 29 through 35.

THE INVENTION

The invention relates to "an adapter having at least two sized cavities and/or extensions for mounting on a variety of different sized ratchets and other like tools" (specification, page 1). Representative claims 24 and 30 read as follows:

24. A socket comprising:

a body comprising a hexagonal receiving end cavity adapted to receive a workpiece and operate on said workpiece;

said body further comprising a drive tool end cavity comprising an interior shoulder that divides said tool end cavity into a first rectangular portion to receive a first sized polygonally shaped drive tool and a second rectangular portion to receive a second sized polygonally shaped drive tool, said first portion being positioned on an outer end of said body and being wider than said second portion;

wherein a first or second sized rectangular drive tool may be inserted into said drive tool end cavity and turn said body;

wherein the body is solid between an inner end of the second portion and the receiving end cavity.

30. A tool comprising:

a drive tool having a rectangular outwardly extending drive shaft;

an adapter comprising:

(i) a first receiving end having an outer and inner cavity each having a rectangular perimeter, said inner cavity having a smaller diameter than said outer cavity; and

(ii) a second end having a single cavity, wherein one of said inner and outer cavities being sized to receive said outwardly extending drive shaft;

wherein the body is solid between an inner end of the inner cavity and the single cavity.

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THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Rexford	5,148,724	Sep. 22, 1992
Hsiao	5,186,083	Feb. 16, 1993
Jarvis	5,943,924	Aug. 31, 1999

THE REJECTION

Claims 24 through 27 and 29 through 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jarvis in view of Rexford or Hsiao.

Attention is directed to the main and reply briefs (Paper Nos. 14 and 16) and to the answer (Paper No. 15) for the respective positions of the appellant and the examiner regarding the merits of this rejection.

DISCUSSION

Jarvis, the examiner's primary reference, discloses a socket wrench set which is summarized as follows:

a multifunctional, interchangeable socket wrench is provided having a drive handle and a plurality of interchangeable sockets. The drive handle has an integral ratcheting drive of a given dimension. An interchangeable multi-tiered drive is provided that is attachable to the integral drive. The multi-tiered drive provides a plurality of tiers of different dimensions thereby changing the dimension of the drive. Open ended sockets are provided. One end of the socket is configured to fit over the application object, such [as] a bolt head or nut, etc. The other end is

configured to [be] attached to the drive. The attachment end of the socket is configured to attach to any one of the plurality of the drive tiers, thereby allowing the user to change size of drives and/or size of the sockets on the same wrench [column 1, line 58, through column 2, line 5].

In applying Jarvis against the appellant's claims, the examiner focuses on the assembly shown in Figure 51. This assembly includes "a conventional socket wrench extension 500 and adapter 505" (column 8, lines 35 and 36). As depicted in Figure 51, the adapter 505 has a single cavity at one end for receiving an end of the socket wrench extension 500 and inner and outer cavities at the other end for receiving an end of a slidable drive adapter 187. It is not disputed that each of the cavities in the adapter 505 has a rectangular (square) cross-section.

According to the examiner (see pages 3 through 5 in the answer), Jarvis' adapter 505 constitutes a socket meeting all of the limitations in independent claim 24 except for the one requiring the receiving end cavity to be "hexagonal." The examiner considers the cavity in Jarvis' adapter 505 for receiving the extension 500 to be a receiving end cavity, but concedes that it is rectangular rather than hexagonal.

To overcome this deficiency in Jarvis, the examiner turns to either Rexford or Hsiao. Each discloses socket members (32 in Rexford and 40 in Hsiao) having hexagonal cavities at either end

for alternatively engaging hexagonal fasteners (e.g., nuts, bolts, etc.) of different size. In the examiner's view,

if one skilled in the art needed to engage a workpiece that is hexagonal in shape, the shape of that end of the socket must also be hexagonal. Thus the suggestion or motivation . . . is that one skilled in the art would clearly be lead [sic] to make the single cavity of Jarvis of a hexagonal shape if the workpiece were also similarly shaped. It would not be desirable or even feasible for a person using the Jarvis socket to engage anything but a rectangularly shaped workpiece, however with the suggestion provided by the Rexford and Hsiao patents, this person skilled in the art would be lead [sic] to make the proposed modification so that a hexagonally shaped workpiece can be operated upon [answer, page 5].

This proposed modification of Jarvis in view of either Rexford or Hsiao is unsound. As disclosed, the Jarvis adapter 505 is an intermediate drive element designed to be connected at either end to mating drive elements. Because the connections between such drive elements are conventionally rectangular as evidenced by Jarvis' disclosure, so too are the cavities in the ends of adapter 505. In contrast, the hexagonal cavities in the socket members disclosed by Rexford and Hsiao are configured to engage hexagonal fasteners rather than drive elements. They correspond to the open-ended sockets described by Jarvis for application to bolts and nuts. The only suggestion for modifying the rectangular drive cavity in Jarvis' adapter 505 in view of

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the hexagonal fastener cavities disclosed by either Rexford or Hsiao stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Thus, neither Rexford nor Hsiao cures the admitted shortcoming of Jarvis relative to the subject matter recited in independent claim 24. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 24, and dependent claims 25 through 27 and 29, as being unpatentable over Jarvis in view of Rexford or Hsiao.

We shall sustain, however, the standing 35 U.S.C. § 103(a) rejection of independent claim 30 as being unpatentable over Jarvis in view of Rexford or Hsiao.

The adapters 187 and 505 disclosed by Jarvis together embody a tool comprising a drive tool and an adapter, respectively, meeting all of the limitations in claim 30. Unlike claim 24, claim 30 does not require any of the cavities recited therein to be hexagonal and is broad enough in its other respects to be fully readable on these prior art components. Thus, the subject matter recited in claim 30 is anticipated by Jarvis.

Anticipation, of course, is the ultimate or epitome of obviousness. See In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982). Because Jarvis is anticipatory, the

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examiner's additional application of Rexford or Hsiao against claim 30 is superfluous.

We also shall sustain the standing 35 U.S.C. § 103(a) rejection of dependent claims 31 through 35 as being unpatentable over Jarvis in view of Rexford or Hsiao since the appellant has not challenged such with any reasonable specificity, thereby allowing these claims to stand or fall with parent claim 30 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).

Because our rationale for sustaining the rejections of claim 30, and claims 31 through 35 which stand or fall therewith, differs from that advanced by the examiner, we hereby designate our action in this regard as a new ground of rejection under 37 CFR § 1.196(b) in order to afford the appellant a fair opportunity to react thereto. See In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976).

SUMMARY

The decision of the examiner to reject 24 through 27 and 29 through 35 is affirmed with respect to claims 30 through 35 and reversed with respect to claims 24 through 27 and 29, with the affirmance designated as a new ground of rejection under 37 CFR § 1.196(b).

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This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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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; 37 CFR § 1.196(b).

JOHN P. MCQUADE)	
Administrative Patent Judge)	
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Administrative Patent Judge)	INTERFERENCES
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