

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS D. HAUKE

Appeal No. 96-3463
Application 08/514,835¹

ON BRIEF

Before MEISTER, FRANKFORT and CRAWFORD, **Administrative Patent Judges**.

MEISTER, **Administrative Patent Judge**.

DECISION ON APPEAL

Thomas D. Hauk (the appellant) appeals from the final rejection of claims 12, 14-18 and 20-25, the only claims remaining in the application.

We REVERSE.

¹ Application for patent filed August 14, 1995. According to appellant, this application is a continuation of Application 08/337,948, filed November 9, 1994, which is a division of Application 08/067,216, filed May 26, 1993, now U.S. Patent No. 5,386,746, issued February 7, 1995.

Appeal No. 96-3463
Application 08/514,835

The appellant's invention pertains a power jaw apparatus for applying high torques to sections of threadedly connected pipe. Of particular importance is the provision of a pair of cooperating toothed pipe-gripping dies wherein one die is mounted for rotation through a relatively large angle and the other die is either (1) fixed or (2) mounted for rotation through a relatively small angle. According to the appellant's specification, this arrangement (1) achieves the advantages of (a) providing "more stability" than the examiner's primary reference to Hauk and (b) maximizes the extension of the power cylinder (see the paragraph bridging pages 12 and 13). The appellant's specification further states that the required arrangement (2) provides the above-noted advantages (a) and (b) and, in addition, provides the advantage of (c) "spreading" the load over different teeth (see pages 13 and 14). Independent claims 12 and 15 are further illustrative of the appealed subject matter and copies thereof may be found in the appendix to the appellant's brief.

The references relied on by the examiner are:

Wheeler	2,959,996	Nov. 15, 1960
Inoue	4,706,528	Nov. 17, 1987
Schulze-Beckinghausen	5,044,232	Sep. 3, 1991
Hauk	5,060,542	Oct. 29, 1991

Appeal No. 96-3463
Application 08/514,835

Claims 12, 14, 16, 18, 20, 22, 23 and 25 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hauk in view of Schulze-Beckinghausen.

Claims 15, 17, 21 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hauk in view of Wheeler or Inoue.

The examiner's rejections are explained on pages 2 and 3 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-10 of the brief, pages 1-3 of the reply brief, pages 3-5 of the answer and page 2 of the supplemental answer.

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and reply brief and by the examiner in the answer and supplemental answer. This review leads us to conclude that the prior art relied on by the examiner fails to establish the obviousness of the appealed subject matter within the meaning of 35 U.S.C. § 103.

Appeal No. 96-3463
Application 08/514,835

Initially we note that in rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a **prima facie** case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. *Id.* If the examiner fails to establish a **prima facie** case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Turning specifically to the rejection of claims 12, 14, 16, 18, 20, 22, 23 and 25 under 35 U.S.C. § 103 as being unpatentable over Hauk in view of Schulze-Beckinghausen, the examiner considers that it would have been obvious

to modify Hauk by using two movable jaw dies, one movable to a greater degree than the other because Schulze-Beckinghausen suggests the use of two movable jaw dies, one movable to a greater degree than the other to allow for better gripping and ungripping.
[Answer, page 3.]

In support of this position the examiner urges that the active jaw 27 of Schulze-Beckinghausen is mounted for

pivotal movement about the pin 34 against the cam surfaces 32, 33. Thus there is a small degree of pivoting as compared to the passive jaw 26. This is the claimed improvement over appellant's prior patent. [Answer, page 4.]

We will not support the examiner's position. We observe that the manner and circumstances under which the passive jaw 26 and active jaw 27 (both of which carry gripping dies affixed thereto) of Schulze-Beckinghausen are moved, as well as for what purpose, are less than clear. With respect to the passive jaw 26, even though this jaw is illustrated in Figs. 1, 3 and 5 as being attached to the "third" piece 25 by an unnumbered bolt via an arcuate slot 127, the sole explanation given by Schulze-Beckinghausen with respect to this arrangement is that:

The third piece **25** carries a passive jaw **26** which is slidably mounted on the third piece **25** within the confines of a slot **127**. [Column 3, lines 51-53.]

It is unclear from this explanation, however, whether the passive jaw 26 is "slidably mounted" simply for adjustment purposes and then the bolt is tightened or whether the bolt and slot is a loose connection which allows the passive jaw 26 to move or self-align "slidably" during the pipe-gripping operation. It is also not altogether clear as to the exact nature of the movement of the active jaw 27 in the embodiment of Fig 1. of Schulze-Beckinghausen (upon which the examiner apparently relies)

Appeal No. 96-3463
Application 08/514,835

although, admittedly, the artisan might reasonably infer from the statements in column 4, lines 27-32, to the effect that an unillustrated peg can be inserted in either bore 37 or bore 38' to limit movement of the active jaw 27, that this jaw is in fact pivotally mounted about pin 37 as the examiner asserts.

In any event, even if we were to agree with the examiner's finding that in Schulze-Beckinghausen the jaw 26 is mounted for rotation through a relatively large angle and that the jaw 27 is mounted for rotation through a relatively small angle, the mere fact that this is the case does not serve as a proper motivation to combine the teachings of Hauk and Schulze-Beckinghausen in the manner proposed by the examiner. Instead, it is the teachings of the prior art which must suggest the desirability of the proposed modification. *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992) and *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, Hauk teaches that both gripping dies should be mounted for rotation through relatively large angles in order to achieve the advantage of high stress concentration and thus prevent slippage (see column 9). On the other hand, Schulze-Beckinghausen (even when construed in a light most favorable to the examiner's position) at the most teaches that one gripping die is mounted for rotation through a

Appeal No. 96-3463
Application 08/514,835

relatively large angle while the other gripping die is mounted for rotation through a relatively small angle, with no reason whatsoever being set forth as to what advantages such an arrangement might provide. Although the examiner opines that the incorporation of the arrangement of Schulze-Beckinghausen into the device of Hauk would "allow for better gripping and ungripping," there is nothing in Schulze-Beckinghausen which either teaches or suggests that this is the case.

In our view, the examiner has impermissibly relied upon the appellant's own teachings in arriving at a conclusion of obviousness. Accordingly, we will not sustain the rejection of claims 12, 14, 16, 18, 20, 22, 23 and 25 under 35 U.S.C. § 103 based on the combined teachings of Hauk and Schulze-Beckinghausen.

Turning to the rejection of claims 15, 17, 21 and 24 under 35 U.S.C. § 103 as being unpatentable over Hauk in view of Wheeler or Inoue, it is the examiner's position that:

It would therefore be [sic, have been] obvious to one skilled in the art at the time the invention was made to modify Hauk by using one movable jaw die and one fixed jaw die because either Wheeler or Inoue suggests the use of one movable jaw die and one fixed jaw die to allow for better gripping and ungripping. [Answer, page 3.]

Appeal No. 96-3463
Application 08/514,835

We will not support the examiner's position. As we have noted above in the rejection of claims 12, 14, 16, 18, 20, 22, 23 and 25 under § 103, it is the teachings of the prior art which must suggest the desirability of the proposed modification. It is true that, as a broad proposition, Wheeler and Inoue both employ one fixed jaw die and one movable jaw die; however, the movable jaws of both Wheeler and Inoue move **rectilinearly** along an angular path. Wheeler is directed to a pipe wrench wherein the movable jaw moves rectilinearly in order to accommodate "a different sized pipe or fitting" (column 1, lines 33 and 34). Inoue is directed to an adjustable wrench that can be used as both "a crescent and pipe wrench" and wherein the movable jaw moves rectilinearly for the purpose of gripping objects "irrespective of the geometric configuration of the object" (see column 1, lines 48-53). On the other hand, Hauk teaches that both gripping dies should be mounted for rotation through relatively large angles in order to achieve the advantage of high stress concentration and thus prevent slippage (see column 9). Absent the appellant's own teachings we are at a loss to understand why one of ordinary skill in this art would have been motivated to seek out the broad teaching of one movable gripping die (which moves along a rectilinear path) and one fixed gripping

Appeal No. 96-3463
Application 08/514,835

die from the disparate teachings of either Wheeler and Inoue and incorporate into the device of Hauk (who already teaches an arrangement to prevent slippage by allowing both gripping dies to move rotatably) in order to "allow for better gripping and ungripping" as the examiner proposes to do. This being the case, we will not sustain the rejection of claims 15, 17, 21 and 24 under 35 U.S.C. § 103 as being unpatentable over Hauk in view of Wheeler or Inoue.

The examiner's rejections of the appealed claims 35 U.S.C. § 103 are reversed.

REVERSED

JAMES M. MEISTER)	
Administrative Patent Judge)	
)	
)	
)	
CHARLES E. FRANKFORT)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 96-3463
Application 08/514,835

Richard J. Gausewitz
Poms, Smith, Lande & Rose
2029 Century Park East
38th Floor
Los Angeles, CA 90067-3024

JMM/cam

Appeal No. 96-3463
Application 08/514,835