

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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DENNIS M. FUTO AND JEFFREY S. PLANTZ

Appeal No. 1999-1165
Application No. 08/753,174

ON BRIEF

Before ABRAMS, STAAB, and CRAWFORD, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3-5, 7-11, 15-18, 20 and 21, which are all of the claims pending in this application.¹

We REVERSE.

¹Claim 20 was amended after the final rejection, which overcame a rejection under 35 U.S.C. § 112, first paragraph (see Papers No. 7 and 8).

BACKGROUND

The appellants' invention relates to a wrench for rotating a plastic slip nut in a plumbing drain system. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' Brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Vlasak <u>et al.</u> (Vlasak)	2,607,248	Aug. 19, 1952
Kolacinski	2,990,213	Jun. 27, 1961
Pennington	4,504,087	Mar. 12, 1985
Vollers	4,509,784	Apr. 9, 1985
Moulin	4,749,251	Jun. 7, 1988
Goss	5,279,190	Jan. 18, 1994
Gilbert, Jr. (Gilbert)	5,531,141	Jul. 2, 1996

The following rejections stand under 35 U.S.C. § 103:

- (1) Claims 1, 3-5, 8-11, 15, 17, 20 and 21 on the basis of Vollers in view of any of Moulin, Goss or Gilbert.
- (2) Claim 7 on the basis of the references applied against claim 1 et al. taken further in view of Kolacinski.
- (3) Claim 16 on the basis of the references applied against claim 1 et al. taken further in view of Vlasak.
- (4) Claim 18 on the basis of the references applied against claim 1 et al. taken further in view of Gilbert.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the Answer (Paper

No. 12) for the examiner's complete reasoning in support of the rejections, and to the Brief (Paper No. 10) and Reply Brief (Paper No. 13) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, the applied prior art references, the respective positions articulated by the appellants and the examiner, and the guidance provided by our reviewing court. As a consequence of our review, we make the determinations which follow.

According to the appellants, it has been difficult with the prior art devices to achieve proper sealing interengagement between the plastic pipes, sealing rings and slip nuts now commonly used in plumbing drain installations, especially when it is necessary to work in confined spaces. The appellants' wrench includes as its objectives enabling rotation of a plastic slip nut to achieve assembly or disassembly of a sealed joint in a drain line in such a manner as to promote a good seal without distorting the circular contour of the nut or otherwise damaging it, even when working under conditions of limited space, and optimizing the degree of rotation which can be imparted to the slip nut without having to reposition the wrench. See specification, pages 1-4).

As manifested in independent claim 1, the appellants' invention comprises a wrench having a C-shaped body portion of resilient polymeric material, spaced apart first

and second ends, and an inner circumferential surface between the ends upon which slip nut engaging means are affixed. First and second handles extend from the first and second ends for rotating the body portion, with the handles having inner surfaces that are spaced apart when the wrench is in a neutral condition. It is the examiner's view that all of the subject matter recited in claim 1 is disclosed by Vollers, except for the particular means for grasping the nut, which the examiner finds in any of Moulin, Goss or Gilbert.

The arguments set out by the appellants in response to the examiner's position focus on the preamble and the last seven lines of claim 1, which the appellants believe establish that there is a patentable distinction over the applied prior art. These passages read as follows:

A wrench for rotating a plastic slip nut relative to axially opposed tubular drain components having a diameter greater than one inch and coupled by said slip nut to provide a joint therebetween.

[H]andles having opposed spaced apart inner surfaces, said body portion having a neutral condition in which said ends of said body portion and said inner surfaces of said handles are spaced apart a given distance, the resiliency of said polymeric material biasing said body portion to said neutral condition, said given distance and the resiliency of said polymeric material providing for said handles to receive one of said drain line components therebetween and for said handles and body portion to be moved laterally onto said one drain component for aligning said wrench axis with said nut axis.

It is the appellants' position that the language of the preamble cannot be dismissed as merely setting forth a different use for the wrench disclosed by Vollers, as explicitly is

stated on page 6 of the Answer, or that the Vollers wrench is capable of operating in the manner required in the closing lines of claim 1, which is implicit in the examiner's rationale.

As we stated above, the objective of the appellants' invention is to solve problems which exist in the field of plumbing drain line connections. From our perspective, the preamble of claim 1 establishes this environment as a part of the claim, that is, that the wrench is for rotating a plastic slip nut relative to drain line components that are axially opposed, are tubular, and have a diameter of greater than one inch. We share the appellants' opinion that without consideration of the words in the preamble, the relationship between the various elements of the invention that is set forth in the last seven lines of the claim, requiring that there be a "neutral condition" in which ends of the body portion and that the inner surfaces of the handles are spaced apart "a given distance" which, along with the resiliency of the polymeric material, allow the handles and the body portion to be "moved laterally onto said one drain line component," would be meaningless.

Vollers discloses a wrench for removing the top from a soda bottle or the like. Its general shape has some commonality with the shape of the claimed wrench, in that it comprises a C-shaped resilient body portion that terminates in first and second spaced apart end portions, from which extend first and second legs, and the inner surface of the body portion is provided with surfaces for engaging the cap of the bottle. However, there

is no teaching in Vollers of installing the wrench upon the cap by moving it laterally so that the cap first passes between the legs, and we can perceive no reason why this would be necessary or desirable. It appears clear to us that one of ordinary skill in the art would have recognized that the body of the wrench is intended to be slipped over the cap in an axial direction. Moreover, the drawings suggest that the wrench is not capable of being opened to the extent that would be necessary to install it laterally, considering the significant difference between the width of the opening at cusps 20 and the diameter of the bottle cap. Further in this regard, since the legs of the wrench must be rigid enough to allow the bottle cap to be clamped within the body portion, in the absence of evidence to the contrary, it would seem to be unlikely that the body would be of such a resiliency at its apex to allow it to open a distance sufficient to allow the cap to pass between the cusps.

For the reasons set forth above, we do not agree with the examiner that Vollers discloses all of the subject matter recited in claim 1 except for the engaging surfaces in the wrench body, in that it does not disclose or teach the construction required by the final seven lines of the claim. This deficiency is not cured by further considering Moulin, Goss or Gilbert.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). A prima facie case of obviousness is

established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993). For the reasons expressed above, it is our view that the applied references do not establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we therefore will not sustain the rejection of claim 1 or, it follows, of claims 3-5 and 8-11, which depend therefrom.

The addition of Kolacinski, which was applied against dependent claim 7, does not cure the defect in Vollers. The rejection of claim 7 is not sustained.

We also will not sustain the rejection of independent claim 15, which recites the invention in somewhat different terms than claim 1, but includes the limitations found in the passages quoted above. Likewise, the rejection of dependent claims 17, 20 and 21 is not sustained.

Nor will sustain the rejection of dependent claims 16 and 18, for the teachings of Vlasak and Pennington, additionally applied, respectively, to these two claims, also fail to overcome the problems with the primary reference.

CONCLUSION

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

MURRIEL E. CRAWFORD
Administrative Patent Judge

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Appeal No. 1999-1165
Application No. 08/753,174

Page 9

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APPEAL NO. 1999-1165 - JUDGE ABRAMS
APPLICATION NO. 08/753,174

APJ ABRAMS

APJ STAAB

APJ CRAWFORD

DECISION: **REVERSED**

Prepared By:

DRAFT TYPED: 30 Mar 01

FINAL TYPED: