

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN P. STREICH, DANIEL G. FINDLE,
PATRICK S. KEENAN and DAVID NAMEY JR.

Appeal No. 2003-0187
Application No. 09/134,109

HEARD: November 5, 2003

Before FRANKFORT, STAAB, and McQUADE, Administrative Patent Judges

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 4, 7 through 12, 14, 15, 20, 33, 35, 38, 39, 41, 44 through 61, 64 and 65. Claims 5, 62, 63 and 68 stand allowed. Claims 21 through 32, 34, 66 and 67, which are the only other claims remaining in the application, have been

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withdrawn from consideration by the examiner. Claims 2, 6, 13, 16 through 19, 36, 37, 40, 42 and 43 have been canceled.¹

Appellants' invention relates to a tool container and tool retaining insert for use within such a container, and to a method of making a tool container. Independent claims 1, 39, 49 and 55 are representative of the subject matter on appeal and a copy of those claims may be found in Exhibit E (Paper No. 25, filed July 23, 2001).

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

Hanson	2,844,244	Jul. 22, 1958
Gretz	4,048,051	Sep. 13, 1977
Kazen et al. (Kazen)	4,253,830	Mar. 03, 1981
Lay	4,778,047	Oct. 18, 1988
Kaszubinski	5,201,414	Apr. 13, 1993
Hurson	5,525,314	Jun. 11, 1996
Yeh	5,590,770	Jan. 07, 1997

¹ Claim 41 was amended subsequent to the final rejection in a paper filed October 20, 2000 (Paper No. 17). Claim 40 was canceled in that same amendment.

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Cheng et al. (Cheng)	5,676,254	Oct. 14, 1997
Vasudeva	5,803,254	Sep. 08, 1998
Gühring (German Auslegeschrift)	DE 1 085 810	Jul. 21, 1960

Claims 49, 52 through 56 and 58 through 61 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lay.

Claims 1, 3, 4, 7, 33 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson as applied above, and further in view of Hanson.

Claims 9 through 12 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson as applied to claim 1 above, and further in view of Gretz.

Claims 14, 15, 64 and 65 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen, Hurson and Gretz as applied to claim 9 above, and further in view of Official Notice.

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Claims 39, 41, 44, 45, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Hanson and Gühring or Vasudeva.

Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Hanson and Gühring or Vasudeva as applied to claim 45 above, and further in view of Kazen and Hurson.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson as applied to claim 1 above, and further in view of Gühring.

Claims 39, 41, 44, 47 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Gühring or Vasudeva.

Claims 50, 51 and 57 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of Yeh or Kaszubinski.²

² The rejection of claims 40 and 41 under 35 U.S.C. § 112, second paragraph, made in the final rejection (Paper No. 15, page 2), has now been withdrawn by the examiner in view of the amendment filed by appellants on October 20, 2000 (Paper No. 17), and thus is not before us on appeal.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answers (Paper Nos. 26 and 30) for the reasoning in support of the rejections and to appellants' briefs (Paper Nos. 23, 25, 27 and 31) for the arguments thereagainst.

OPINION

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

Looking first to the rejection of claims 49, 52 through 56 and 58 through 61 under 35 U.S.C. § 102(b) based on Lay, we note that according to the examiner (answer, Paper No. 26, pages 3-4), "Lay discloses a container with a plurality of inserts on first and second housing members 11, 12. The insert has recesses and a

tenon formed therein and the walls of the container has [sic] tenons formed therein." Appellants argue that while it is true that Lay speaks of the spring mechanisms (20) therein being "secured or fixed to a wall member" (col. 2, lines 1-6) of one of the container or shell members (11, 12), the wall member shown in Lay (Fig. 3) to which the spring mechanisms are fixed is the base of the shell member, not a wall extending from the base as required in the claims on appeal. In addition, appellants argue (brief, page 6) that Lay fails to teach a tool retaining insert wherein at least one securement member on the insert cooperates with the securement members on the housing wall to secure the insert with the housing member wall, as recited in claim 49. Appellants make a similar argument with respect to method claim 55, contending that Lay fails to disclose or suggest providing an insert and housing member with mating mechanisms which mate with one another when the insert is positioned within the cavity of the housing member (brief, page 7).

From our perspective, the examiner has correctly determined that Lay discloses a housing member (e.g., 12) defining a cavity, wherein the cavity is defined by a base and a wall extending from the base, and wherein the wall includes a plurality of securement

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members (20). We see nothing wrong in the examiner construing the upstanding portion of the housing member (12) carrying hinge latches (13), as seen in Figure 3 of Lay, as "a base" and the larger area portion of the housing member to which the springs (20) are fixedly attached as "a wall extending from said base." Where we disagree with the examiner is in finding that Lay has securement members (claim 49) or mating mechanisms (claim 55) on both the housing member wall and the insert, which securement members and mating mechanisms, respectively, cooperate or mate with one another to secure the insert to the housing member wall.

The only disclosure we find in the Lay patent regarding how the inserts (30) are secured relative to the housing wall of the container therein is found at column 2, lines 17-20, wherein it is noted that the disc envelopes (30) include "bottom surfaces which may be affixed to individual spring member appendages 22 through any well known technique." Thus, we find that it is unclear from the Lay patent as to exactly how the envelopes (30) are affixed to the individual spring member appendages (22). In light of this ambiguity, in our opinion, it is rank speculation on the examiner's part to conclude that Lay "clearly teaches tenons 22 on the container to engage the recesses on the insert

when the insert is positioned in the cavity" (answer, page 8). While there may be many possibilities as to how the envelopes (30) could be affixed to the individual spring member appendages (22) of the disc storage container in Lay, we do not see that Lay teaches any particular way to secure the envelopes (30) and spring appendages (22) together, and certainly does not teach cooperating securement members or mating mechanisms like those required in appellants' claims 49, 52 through 56 and 58 through 61 for securing an insert with the housing member wall.

In light of the foregoing, we will not sustain the examiner's rejection of claims 49, 52 through 56 and 58 through 61 under 35 U.S.C. § 102(b) based on Lay.³

As for the rejection of claims 50, 51 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of Yeh or Kaszubinski, the examiner has asserted that it would have been obvious in view of Yeh or Kaszubinski "to substitute the tenon and recess mechanism [of one of those secondary references] for

³ The issue of whether it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the envelopes (30) of Lay with securement members or mating mechanisms of the type broadly set forth in appellants' above-noted claims is not before us in this appeal.

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the mechanism of Lay since they are both equivalent in function" (answer, page 8). We find no basis whatsoever which would have led one of ordinary skill in the art to any such modification of the spring mechanisms of Lay, or to a conclusion that the spring mechanisms of Lay and the insert support mechanisms of Yeh and Kaszubinski are in any way "equivalent in function." Simply stated, if either of the examiner's proposed substitutions indicated above were to be made it would render Lay inoperable for its intended purpose as described in column 2, lines 37-42, thereof, wherein it is indicated that when the container is opened, the disc envelopes (30) are "rotated through the bias of spring member appendages 22 into individual differing angles." For that reason, we will not sustain the examiner's rejection of claims 50, 51 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Lay in view of Yeh or Kaszubinski.

With regard to the examiner's rejection of claims 1, 3, 4, 7, 33 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson, we are in complete agreement with appellants' arguments as presented in the brief (page 7-9) and in the two reply briefs. Any reading of the Cheng patent would have made it immediately apparent to one of ordinary skill

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in the art that an important object of the invention therein is to provide a tool box which "automatically turns the stored objects [elongated tool bits and tool accessories] from a horizontal position to a tilted position upon the opening of the tool box cover, so that the stored objects can be conveniently taken out of the tool box" (Cheng, col. 1, lines 26-30). The examiner's proposed substitution of the dovetail fitting tongues and grooves of Kazen or tenons and recesses of Hurson for the tool insert securing mechanism of Cheng would eliminate any such pivotal action of the tool insert upon opening of the container, and thus render Cheng inoperable for its intended purpose. For that reason, it is apparent to us that one of ordinary skill in the art would not have made the substitution proposed by the examiner. Since there is clearly no suggestion or motivation to combine the references in the manner urged by the examiner, it follows that we will not sustain the examiner's rejection of claims 1, 3, 4, 7, 33 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen and Hurson.

We have also reviewed the examiner's rejections of 1) claim 8 under 35 U.S.C. § 103(a) as being unpatentable Cheng in view of Kazen, Hurson and Hanson; 2) claims 9 through 12 and 20 under 35

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U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen, Hurson and Gretz; 3) claims 14, 15, 64 and 65 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen, Hurson and Gretz as applied to claim 9 above, and further in view of Official Notice; and 4) claim 35 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Kazen, Hurson and Gühring. However, we find nothing in the patents to Hanson, Gretz and Gühring, or the examiner's invoking of Official Notice, which changes our view expressed above with regard to the examiner's basic combination of Cheng in view of Kazen and Hurson. Accordingly, we will not sustain the examiner's above-noted rejections of claim 8; claims 9 through 12 and 20; claims 14, 15, 64 and 65; or claim 35 under 35 U.S.C. § 103(a).

Next for our review is the examiner's rejection of claims 39, 41, 44, 45, 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Cheng in view of Hanson and Gühring or Vasudeva. Appellants' claim 39 and the claims which depend therefrom are directed to a tool retaining insert *per se*, such an insert is best seen in Figures 16-20 of the present application. In rejecting the above-noted claims, the examiner observes that Cheng has neither a plurality of V-shaped tool receiving cradles

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nor a finger mechanism of the type defined in appellants' claims on appeal. However, the examiner points to the retaining fingers (40) of the molded plastic drill bit container of Hanson and the V-shaped recesses of Gühring and Vasudeva (Fig. 9), from which teachings it appears the examiner considers that it would have been obvious to modify a tool insert like that seen, for example, in Figure 5 of Cheng by providing "a variety of shapes and retaining fingers for the tool receiving member of Cheng et al to better secure tools with similar shapes and sizes" (answer, pages 5-6).

Like appellants (brief, pages 9-10), given the construction of the tool retaining inserts seen in Cheng (Figs. 4 and 5), we find that there would be no need, and thus no motivation except that derived from impermissible hindsight, for modifying the tool retaining inserts of Cheng in the manner proposed by the examiner. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), that it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered

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obvious. Moreover, and more to the point in the present appeal, we observe that the mere fact that some prior art reference may be modified in the manner suggested by the examiner does not make such a modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Here, the prior art relied upon by the examiner contains no such suggestion.

Since we have determined that the teachings and suggestions found in Cheng, Hanson and Gühring or Vasudeva would not have made the subject matter as a whole of claims 39, 41, 44, 45, 47 and 48 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a).

Regarding the examiner's rejection of dependent claim 46 under 35 U.S.C. § 103(a) based on the collective teachings of Cheng, Hanson, Gühring or Vasudeva, Kazen and Hurson, we remain of the view expressed above with regard to claims 39 and 45 that there would be no need, and thus no motivation except that derived from impermissible hindsight, for modifying the tool retaining inserts of Cheng in the manner proposed by the

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examiner. Moreover, with respect to the examiner's further modification of Cheng's tool retaining inserts to include "dovetail tenons and recesses" adapted to couple with a container as required in claim 46 on appeal, we remain of the view expressed supra in our treatment of claim 1 based on the examiner's proposed combination of Cheng, Kazen and Hurson, i.e., that any such modification of the tool retaining inserts of Cheng would render Cheng inoperable for its intended purpose. Thus, we will not sustain the examiner's rejection of claim 46 under 35 U.S.C. § 103(a).

The last of the examiner's rejections for our review is that of claims 39, 41, 44, 47 and 48 under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Gühring or Vasudeva. In this instance, the examiner begins with the molded plastic drill bit container of Hanson, urging that Hanson discloses "most of the elements of the claims, but lacks V-shaped cradle [sic]" (answer, page 7). To account for this difference, the examiner again looks to Gühring and Vasudeva (Fig. 9) for a tool retaining member with V-shaped cradles, and contends (based on those teachings) that it would have been obvious to substitute a V-shaped cradle for the

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circular cradles of the tool receiving member of Hanson "since both shapes would work equally well with the insert [sic, tool to be retained therein]."

Appellants contend (brief, page 7) that the examiner has again utilized impermissible hindsight to pick and choose elements from among the various references and combine them in a selective way to arrive at the claimed subject matter. We agree. There is simply no teaching, suggestion or motivation in the applied references which would have led one of ordinary skill in the art to a modification of the molded plastic drill bit container of Hanson so as to have both a plurality of V-shaped cradles and retaining finger mechanisms of the type required in claim 39 on appeal. While Gühring has V-shaped cradles for the miniature drill bits therein, it clearly teaches away from having any form of tool retaining finger mechanism of the type shown in Hanson and required in appellants' claim 39, because of the high probability of breakage of the miniature drill bits when such drill bits must be removed from the container.

As for Vasudeva (Fig. 9), we are at a loss as to exactly what structure the examiner considers to be "V-shaped tool

receiving cradles" therein. The only structure we see in Figure 9 that is broadly V-shaped and may serve as a cradle is that seen in the main box portion (1) of the tool case therein. However, it is apparent from a full consideration of the Vasudeva patent that this structure is merely the back side of the molded recess (15) in the face of main box portion (1), as can be best seen in Figures 3, 7 and 8 of the patent. Further, as is apparent from Figures 9-11 of Vasudeva, the back side of the molded recess (15) is intended to be covered by a tool receiving insert panel (10). There is simply no indication in Vasudeva that the V-shaped recesses seen in Figure 9 are intended to be "tool receiving cradles" like those set forth in appellants' claim 39, and certainly no reason or suggestion therein as to why one of ordinary skill in the art would consider using the V-shaped recesses seen in Figure 9 of Vasudeva in a molded plastic tool container like that of Hanson.

Thus, after considering the applied prior art references as a whole, we have concluded that the examiner's rejection of claim 39, and claims 41, 44, 47 and 48 which depend therefrom, under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view of Gühring or Vasudeva will not be sustained.

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To summarize, we have refused to sustain any of the examiner's rejections before us on appeal in this application. As a result, the decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
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Administrative Patent Judge)	

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