

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MICHAEL PATRICK McCARTHY

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Appeal No. 2004-1920  
Application No. 09/302,714

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ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to an impact tool in combination with a hollow pole. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the Brief.

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

Moeller	2,572,370	Oct. 23, 1951
Pesaturo	2,759,486	Aug. 21, 1956
De Rosa <u>et al.</u> (De Rosa)	4,836,232	Jun. 6, 1989
Reed <u>et al.</u> (Reed)	4,920,897	May 1, 1990

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

- (1) Claims 1, 6-13, 16, 17, 19 and 20 on the basis of Moeller in view of De Rosa and Pesaturo.
- (2) Claims 1-5, 13-15 and 18 on the basis of De Rosa in view of Pesaturo and Moeller.
- (3) Claim 18 on the basis of De Rosa in view of Pesaturo, Moeller and Reed.
- (4) Claims 1-17, 19 and 20 on the basis of Pesaturo in view of De Rosa and Moeller.
- (5) Claim 18 on the basis of Pesaturo in view of De Rosa, Moeller and Reed.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the Answer (Paper No. 24) for the examiner's reasoning in support of the rejections, and to the Brief (Paper No. 23) and Reply Brief (Paper No. 25) 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 prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention relates to a means for driving a hollow pole, such as those used to support beach umbrellas, into the ground, and removing it from the ground. Claim 1 is directed to the combination of an impact tool with a hollow pole. The claim recites a hollow pole and a ring member having top and bottom surfaces and an annular outer circumference mounted on the mid-section of the pole. It also recites an impact tool comprising a cylindrically shaped sleeve having open ends defining a center channel having an annular circumference greater than that of the annular ring, and first and second weight members mounted within the center channel on opposed sides of the annular ring member such that the first and second weight members can impact the top and bottom surfaces of the annular ring member when the sleeve is moved in downward strokes or upward strokes to cause the pole to be moved into or out of the ground.

(1)

The first of the examiner's rejections is that independent claims 1 and 13 and dependent claims 6-12, 16, 17, 19 and 20 are unpatentable over Moeller in view of De Rosa and Pesaturo.

The examiner finds all of the subject matter recited in claim 1 to be disclosed or taught by Moeller, except for using the impact tool to insert into or remove from the ground a closed, pointed, hollow pole such as those used on beach umbrellas. However, the examiner has taken the position that it would have been obvious to so utilize the Moeller impact device in view of the teachings of De Rosa and Pesaturo. 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). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

Applying this guidance to the situation at hand leads us to conclude that this rejection of claim 1 cannot be sustained. Our reasoning follows.

Moeller discloses a hammer 6 in combination with a stem 5. The objective of the invention is to provide “a tool for performing pulling, driving or rotating operations” on the stem (column 1, lines 1-4). An attachment screw 12 is provided at the end of the stem to allow the element which is to be pulled, driven or rotated to be attached to the stem, and a boss 9 is fixedly attached about the mid-portion of the stem. Boss 9 is not annular, but has a flat area 11 (Figure 3). Hammer 6 comprises a sleeve-like member having a hand-grasping cylindrical part 14 with an annular flange 16 at its upper end, a passage 18 through its center, and a lower end that includes an inward-facing shoulder 19. Passage 18 terminates at its upper end in internal threads 17 that receive the threads of a removable stop collar 7 which is provided with a bottom edge surface 26. Passage 18 is not annular, but has a flat side 20 that cooperates with flat area 11 of boss 9 to cause the hammer and the stem to be locked together when the hammer is rotated but slidable when the hammer is moved longitudinally. With collar 7 removed, hammer 6 is slipped over stem 8, whereafter the collar is screwed into place to anchor the hammer on the stem.

In operation, pushing force is applied to stem 8 by sliding hammer 6 downwardly until shoulder 26 of stop collar 7 impacts the upper face of flange 16, pulling force is applied by sliding hammer 6 upwardly until the upper surface of inward-facing shoulder

19 impacts the lower surface of flange 16, and rotating force is applied by twisting hammer 6, thus causing the stem to be rotated by the mated flats 11 and 20.

In the Moeller device, the boss attached to the stem is provided with a flat area, and thus it is not annular, as is required by claim 1. However, it is the examiner's view that it would have been obvious to one of ordinary skill in the art to modify Moeller by removing this flat area from the boss and presumably from the center passage of the hammer because the omission of an element and its function "involves only routine skill in the art" (Answer, page 5). In the present case, we cannot agree.

An object of the Moeller invention is "to provide a side percussion tool that is equally effective for driving operations, for pulling operations and for rotating operations" (column 1, lines 18 and 19; emphasis added). To modify the Moeller device in accordance with the examiner's instructions would eliminate a key feature of the invention, which in our view would operate as a disincentive for one of ordinary skill in the art to make the proposed modification. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). We fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to remove from the Moeller device the flats that enable rotating operation, other than the hindsight afforded one who first viewed the appellant's disclosure, which cannot form the basis for a rejection under

Section 103. In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). This problem is not alleviated by consideration of the teachings of De Rosa and Pesaturo.

The examiner also has taken the position that Moeller meets the requirements in claim 1 that the impact tool comprise a cylindrically shaped hammer sleeve having open ends within which first and second weight members are mounted. In order to arrive at this conclusion, the examiner has found that there is in Moeller a first weight member comprising the annular flange 16 that forms the upper portion of hammer 6 taken together with removable stop collar 7, a second weight member comprising the “cylindrical area [of hammer 6] below plane of surface [shoulder] 19,” and a cylindrically shaped sleeve that comprises passage 18 in hammer 6 plus an extension of passage 18 which passes through the portion of the weight that defines shoulder 19 (Answer, page 3). In other words, the examiner has divided hammer 6 into several pieces and has created from the disclosed one-piece hammer another separate element in order to define elements that will meet the limitations of claim 1. From our perspective, this contrived reading of the claim language on the Moeller device can be accomplished only by means of hindsight.

For the reasons expressed above, it is our conclusion that the teachings of Moeller taken in view of those of De Rosa and Pesaturo fail to establish a prima facie

case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain this rejection of independent claim 1 or of claims 6-12, which depend therefrom.

Since independent claim 13 contains the same limitations, we also will not sustain this rejection of claim 13 and dependent claims 16, 17, 19 and 20.

(2)

The examiner further has rejected independent claims 1 and 13, along with dependent claims 2-5, 14, 15 and 18, as being unpatentable over De Rosa in view of Pesaturo and Moeller. In this rejection the examiner finds all of the subject matter recited in claims 1 and 13 to be disclosed by De Rosa, except for the impact means, and takes the position that it would have been obvious to use an impact means to drive an umbrella pole in view of Pesaturo, and to utilize the impact means disclosed by Moeller to do so. While the order of the references in this rejection differs from that of the first rejection of claims 1 and 13, the individual references are relied upon for the same teachings. In particular, as was the case in the first rejection of claims 1 and 13, Moeller is deficient insofar as disclosing the impact means required by claim 1, and the present rejection cannot be sustained for the same reasons we advanced above against the first.

This rejection is not sustained.

(3)

Claim 18, which depends from claim 13, additionally has been rejected as being unpatentable over De Rosa in view of Pesaturo and Moeller as cited against claim 13, taken further in view of Reed, which is applied for teaching an umbrella having a table attached to the pole. Be that as it may, Reed fails to alleviate the deficiencies in Moeller with regard to the construction of the impact tool, and therefore this rejection cannot be sustained.

(4)

A third rejection of independent claims 1 and 13 is based upon Pesaturo in view of De Rosa and Moeller. Again, the references are applied for the same teachings as in the other two rejections of these claims, and Moeller suffers from the same problems. The rejection of claims 1-17, 19 and 20 on this basis is not sustained.

(5)

We reach the same conclusion, on the same basis, with regard to the rejection of claim 18 as being unpatentable over Pesaturo in view of De Rosa and Moeller, taken further in view of Reed.

CONCLUSION

None of the rejections is sustained.

The decision of the examiner is reversed.

IRWIN CHARLES COHEN  
Administrative Patent Judge

NEAL E. ABRAMS  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

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