

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CHUAN-CHEN CHEN

Appeal No. 2005-1173
Application No. 10/134,793

ON BRIEF

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

DECISION ON APPEAL

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

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates to a wrench with a magnet (specification, p. 1).
A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Morrissey et al. (Morrissey)	4,823,652	April 25, 1989
White	5,307,713	May 3, 1994
Bogni et al. (Bogni)	5,924,343	July 20, 1999

Claims 1, 2, 4, 6, 7, 9, 10, 12 to 14 and 18 stand rejected under 35 U.S.C. § 103
as being unpatentable over Bogni in view of Morrissey.

Claims 8 and 15 to 17 stand rejected under 35 U.S.C. § 103 as being
unpatentable over Bogni in view of Morrissey and White.

Claims 1 to 5 and 11 to 20 stand rejected under 35 U.S.C. § 103 as being
unpatentable over Bogni in view of White.

Claims 6 to 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over
Bogni in view of White and Morrissey.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (mailed March 16, 2004) for the examiner's complete reasoning in support of the rejections, and to the brief (filed January 2, 2004) 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. Upon evaluation of the rejections before us, it is our conclusion that the rejections as set forth by the examiner are insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 20 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See

In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination

that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Claims 1, 3 and 11, the independent claims under appeal, read as follows:

1. A wrench comprising, in combination; a handle; a head formed at an end of the handle for engagement with a nut having a threadable axis, with the handle integrally formed as a single piece with the head and extending generally perpendicular to the threadable axis and for manual grasping in a handle of a user; and a magnet at least partially embedded in the head for keeping the nut in the head.

3. A wrench comprising, in combination: a handle; a head formed at an end of the handle for engagement with a nut; and a magnet at least partially embedded in the head, wherein the head includes an intermediate portion and two jaws extending from the intermediate portion, wherein the magnet is embedded in the intermediate portion.

11. A wrench comprising, in combination: a handle; a head formed at an end of the handle for engagement with a nut; and a magnet at least partially embedded in the head, wherein the head is a ring, wherein the magnet is embedded in the ring, wherein the magnet includes a first tip embedded in the ring and an exposed second tip for performing as a stop for the nut.

Bogni's invention relates to a box spanner with a device for retaining the object to be turned. Bogni teaches that box spanners, in particular for turning sparking plugs of engines for motor vehicles, which have means for gripping the object to be turned are known. The gripping means make it possible to avoid pushing the plug, or the fastening

component to be connected, onto the threaded seat, such as for example the threaded seat of the cylinder head of the engine, in advance, before using the box spanner for tightening, and make it possible to withdraw the component easily when unscrewing it, in particular in cases of difficult access or close to sources of heat, such as the cylinder head of an engine.

Bogni then teaches that one embodiment of the retaining device for a box spanner, which is known from the prior art, consists of a permanent magnet of hollow cylindrical shape fixed to the internal surface of the hollow space of the box spanner above the polygonal seat for turning the plug. The permanent magnet of cylindrical shape has a coaxial hole of a size which is necessarily smaller than the cavity of the box spanner but large enough for the passage of the ceramic extension of the plug. Retention of the plug is provided by the action of the permanent magnet on the metal part of the plug, which is located at the bottom of the ceramic extension. The disadvantage of this embodiment is that the cylinder of magnetic material forms a projection which partially obstructs the hollow space of the box spanner. Insertion of the plug in a manner which is not perfectly coaxial with the box spanner, which is highly likely if the spanner is being used in a situation with difficult direct access to the threaded member, brings about scraping of the very delicate surface of the ceramic

extension of the plug by the magnet. This scraping may lead to damage of the ceramic part which, even if only slight, causes the plug not to function.

The aim of the Bogni's invention was to overcome that disadvantages of the prior art, and to reduce the likelihood of the ceramic part of the plug scraping against the box spanner and therefore to reduce the likelihood of damage to the plug. This aim was achieved by means of a box spanner with a device for retaining the object to be turned with an end which can be connected to auxiliary turning tools and at the open end an internal polygonal seat which can mate with the polygonal body of the object to be turned, characterized in that the polygonal seat of given spanner opening is followed by a hollow space which is delimited by the body of the box and has a transverse width essentially comparable with the spanner opening of the polygonal seat, and in that, in the sides of the polygonal seat, the body of the box has housings which accommodate permanent magnets. Advantageously, the permanent magnets are located in the adjacent sides of the polygonal seat and extend around half the perimeter of the polygon.

Morrissey's invention relates to an open, box end, or combination wrench which incorporates the use of spring loaded plungers to retain a nut in the wrench. The design facilitates adjustable pressure by which the user can adjust the amount of spring tension

on the plunger which retains the nut. Figure 1 depicts the relative size and location of the plunger assemblies in a standard wrench. The protrusion of the plunger into the throat of either the open or box end need only be approximately 1/32 of an inch. The location of the assemblies can be on either side of the open or box end. Figure 2 shows a detail of the plunger assembly itself. It can easily be seen that the amount of pressure on the plunger can be adjusted by the amount that a setscrew is screwed into the drilled and threaded hole.

White's invention is directed to wrenches and more particularly to open-end and box end wrenches, adjustable and non-adjustable as well as ratchet type and spanner wrenches. A drawback to end wrenches, both open and closed end, is the tendency of the wrench to slip off of the head of the nut or bolt during adjustment. This tendency is especially critical when the wrench is in an odd position or the person using the wrench is positioned awkwardly and has difficulty in reaching the nut or bolt. The user of the wrench is often times given to fumbling with an index finger or use of the other hand to position the head of the wrench while turning the wrench and nut.

White discloses a self-positioning wrench, i.e., a wrench that will position itself on the head of the nut or bolt for tightening or loosening. His invention is directed to any type of end wrench or spanner wrench, but it works particularly well with open-end

wrenches, both adjustable and non-adjustable. The wrench includes one or two protrusions positioned on the face of the wrench substantially through the axis of a nut when the nut is positioned within the wrench in a manner for loosening or tightening. The protrusion or protrusions extend inwardly from the wrench head to within a distance "d" of the bolt. The distance "d" does not extend inwardly sufficiently to cause interference with the bolt, but extends sufficiently to rest upon the head of the nut to position it for tightening or loosening. The protrusion will, further, extend upwardly in some embodiments so that it will not interfere with the "self-locking" segment of that type nut. Further, the positioning of the projection or projections through an axis 90° to the wrench axis and the axis of the nut or bolt permits the wrench to be canted at an angle (especially in open-end wrenches) during use.

In the rejections under 35 U.S.C. § 103 before us in this appeal, the examiner determined that it would have been obvious to one having ordinary skill in the art to form the box spanner of Bogni in any of a variety of wrench forms as taught by either Morrissey or White. We do not agree.

In our view, there is no motivation, suggestion or teaching in the applied prior art for a person having ordinary skill in the art to have modified the box spanner of Bogni to be a wrench form (e.g., an open end box wrench, a closed end wrench, an adjustable

wrench, a ratchet wrench). The box spanner of Bogni is a tool specially designed for a specific purpose. As such, there is no reason for an artisan to have modified the box spanner of Bogni to become a tool incapable of being used for that specific purpose. In our view, the only suggestion for modifying Bogni's box spanner in the manner proposed by the examiner to arrive at the claimed subject matter stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

REMAND

We remand this application to the examiner to consider if any of claims 1 to 20 are unpatentable under 35 U.S.C. § 103 based on the teachings of either Morrissey or White taken in view of Bogni. That is, would it have been obvious at the time the invention was made to a person having ordinary skill in the art in view of the teachings

of Bogni to have modified either Morrissey's wrench or White's wrench to have utilized a magnet to hold a nut in place.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 20 under 35 U.S.C. § 103 is reversed.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED; REMANDED

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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NIKOLAI & MERSEREAU, P.A.
900 SECOND AVENUE SOUTH
SUITE 820
MINNEAPOLIS, MN 55402

JVN/jg