

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN DOUGHERTY

Appeal 2008-5021
Application 10/126,009
Technology Center 3700

Decided: November 24, 2008

Before JAMESON LEE, SALLY C. MEDLEY and JAMES T. MOORE,
Administrative Patent Judges.

MEDLEY, *Administrative Patent Judge.*

DECISION ON APPEAL

A. Statement of the Case

John Dougherty (“Dougherty”), the real party in interest, seeks review under 35 U.S.C. § 134(a) of a Final Rejection of claims 1-9, the only claims remaining in the application on appeal. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Dougherty’s invention is a ratchet extension. Referring to figure 1 below, [numbers from **figure 1** inserted] the ratchet extension [**10**] includes a telescopic elongated cylindrical extension member [**20**] fabricated from

chrome plated steel and a locking apparatus [40] including a locking tool.
(Spec. 6-9).

Dougherty's figure 1 is reproduced below.

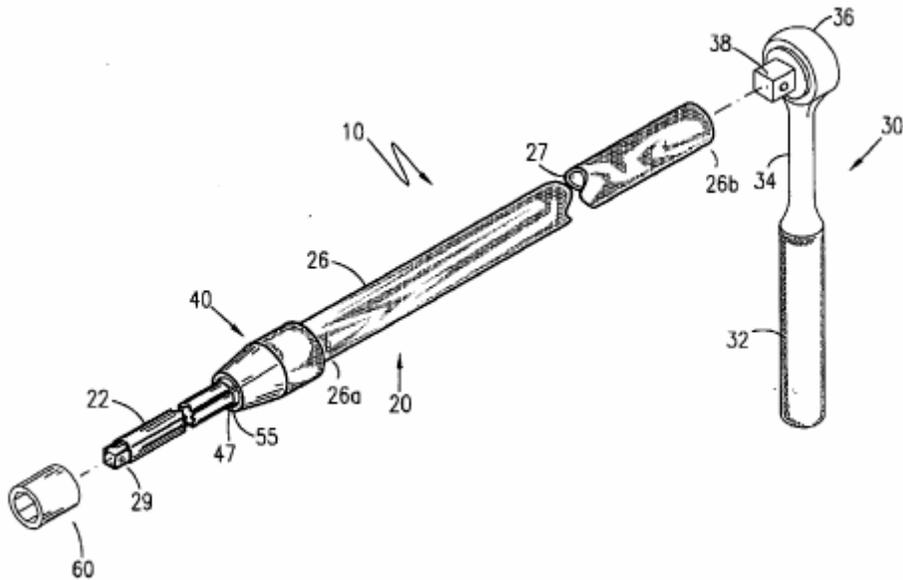


Figure 1 depicts a ratchet wrench with a telescopic extension member.

Representative claim 1, reproduced from the Claim Appendix of the Appeal Brief, reads as follows:

A ratchet extension comprising:
an elongated, cylindrical extension member, said elongated, cylindrical extension member is telescopic and fabricated of tool steel metal material being chrome plated so as to retard rust; and
a locking apparatus, said locking apparatus includes a locking tool.

The Examiner relies on the following prior art:

Long	1,932,113	Feb. 15, 1933
Lojczyc	2,814,226	Nov. 26, 1957
Tarquinio	2,842,020	Jul. 8, 1958
Schroeder	3,343,434	Sep. 26, 1967
Henrit	4,208,942	Jun. 24, 1980
Valadez	4,459,716	Jul. 17, 1984

The Examiner rejected claims 1-8 under 35 U.S.C. § 103(a) as follows:

1. Claims 1-6 as unpatentable over Schroeder and Henrit or Valadez;
2. Claims 7-8 as unpatentable over Schroeder, Henrit or Valadez, and Tarquinio;
3. Claim 9 as unpatentable over Schroeder, Henrit or Valadez, and Long or Lojczyc.

B. Issues

Has Dougherty shown that the Examiner erred in rejecting all of the claims as obvious because the references or combination of references do not teach or suggest every element of the claims and because the references are non-analogous art?

Has Dougherty shown that the Examiner erred in rejecting claims 1-6 as obvious because the prior art does not describe each and every limitation of the claims and because the Examiner does not provide a teaching or suggestion found in the prior art to modify or combine the references?

Has Dougherty shown that the Examiner erred in rejecting claims 7-8 as obvious because the prior art does not describe each and every limitation of the claims?

Has Dougherty shown that the Examiner erred in rejecting claim 9 as obvious because the Examiner does not provide a teaching or suggestion found in the prior art to modify or combine the references?

C. Findings of Fact (“FF”)

Schroeder

1. Referring to Figure 2 below [numbers from **figure 2** inserted], Schroeder describes a ratchet extension including a tubular extension element [**26**] and a locking apparatus comprising threads [**27**], [**36**], V-

shaped openings [28], chuck jaws [31], and chuck collar [35]; the locking apparatus including a locking tool comprising the chuck jaws [31] and chuck collar [35]. (Col. 2, l. 63-col. 3, l. 24).

2. The chuck collar [35] may be screwed onto threads [27], where the sloping surfaces [37] of the chuck collar [45] will engage the sloping surfaces [33] of chuck jaws [31] against the sides of shaft [29] to lock the shaft [29] in any selected extended or retracted position. (Col. 3, ll. 18-24).
3. The chuck collar [35] can be loosened by turning collar [35] on threads [27]. (Col. 3, ll. 34-38).

Figure 2, reproduced from Schroeder's figure 5, is below.

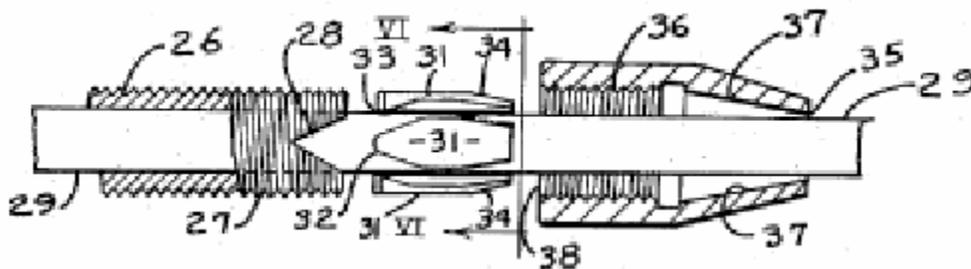


Figure 2 depicts an extension element for a ratchet wrench.

Official Notice

4. We take official notice that nearly all screw threads are right-handed screw threads such that a clockwise motion results in tightening of a bolt or nut on a screw and counter-clockwise motion results in loosening of a bolt or nut on a screw.

C. Principles of Law

“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a

combination of references.” *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

“Two separate tests define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and, (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

In *KSR*, the Supreme Court rejected the rigid application of the “teaching suggestion, or motivation” (TSM) test, instead favoring the “expansive and flexible approach” used by the Court. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1739 (2007).

“The question is . . . whether the combination was obvious to a person with ordinary skill in the art. Under the correct analysis, any need or problem known in the field of endeavor at the time of the invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *Id.* at 1742.

In an obviousness analysis, it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account. *Id.* at 1741.

“A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.* at 1742.

D. Analysis

Rejection of claims 1-9 over the prior art

Dougherty argues that the references or combination of references do not teach or suggest every element of the claims. (App. Br. 6). Dougherty submits that “applicant fails to see any similarity between Valadez and Henrit that would suggest that they could replace each other as enabling references for the present invention, neither is there any indication that they can be used in conjunction with the Schroeder device to make a telescopic ratchet extension.” (App. Br. 6, emphasis omitted). Dougherty also argues that (1) Tarquinio describes a holder for hexagonal type wrenches “the applicability of which is also not seen in conjunction with the present invention,” and (2) Long and Lojczyc describe pipe wrenches and adjustable wrenches. (App. Br. 6).

Dougherty’s arguments are unpersuasive because Dougherty does not explain which elements of the claims are not taught or suggested by the references. Dougherty’s arguments attack the references individually instead of addressing the teachings of the combined references. Attacking references individually where the rejection is based upon the teachings of a combination of references is insufficient to establish non-obviousness.

To the extent that Dougherty argues that the references are non-analogous art, the arguments are unpersuasive. Dougherty has not explained why the Schroeder, Valadez, Henrit, Tarquinio, Long and Lojczyc references are not from the same field of endeavor, or why the references are not reasonably pertinent to the particular problem

with which the inventor is involved. All of the references are directed to hand tools.

For all these reasons, Dougherty has not shown that the Examiner erred in determining that claims 1-9 are obvious over the applied prior art.

Rejection of claims 1-6 as obvious over Schroeder and Henrit or Schroeder and Valadez

Independent claim 1 is representative and recites “[a] ratchet extension comprising: an elongated, cylindrical extension member . . . is telescopic and fabricated of tool steel metal material being chrome plated . . . and a locking apparatus . . . includes a locking tool.” (App. Br. 9).

The Examiner finds that Schroeder meets the claim limitations with the exception of the extension member being chrome plated. (Final Rejection 2, Ans. 3). Schroeder describes a ratchet extension including an elongated cylindrical extension member [26] and a locking apparatus [27], [28], [31], [35] including a locking tool [35]. (FF 1). The Examiner finds that Henrit or Valadez suggest that a tool can have chrome plating for appearance and rust proofing. (Final Rejection 2, Ans. 3). The Examiner concluded that it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Schroeder to use chrome plating to form the tool body because either Henrit or Valadez suggests the use of chrome plating in tools. (Final Rejection 2, Ans. 3-4).

Dougherty argues that the Examiner uses hindsight reasoning and does not provide a teaching or suggestion found in the prior art to modify or combine the references. (App. Br. 7-8). The Supreme Court has rejected the rigid application of the teaching suggestion or motivation test. In an

obviousness analysis, it is not necessary to find precise teachings in the prior art directed to the specific subject matter claimed because inferences and creative steps that a person of ordinary skill in the art would employ can be taken into account.

In this case, Dougherty does not dispute the Examiner's finding that (1) chrome plating of hand tools is notoriously old and well known in the art; and (2) a tool can have chrome plating for the purpose of appearance and rust proofing. (Final Rejection 2, Ans. 3, 5). One with ordinary skill in the art at the time the invention was made would appreciate that providing an enhanced appearance and rust proofing would be beneficial and applicable to all hand tools. A person of ordinary skill is a person of ordinary creativity, not an automaton.

Dougherty also argues that the Examiner erred in determining that it is obvious to use chrome plating to form the tool body and by not addressing chrome plating of just the extension member of the ratchet extension. (Reply Br. 3). Dougherty's arguments are not commensurate in scope with the claim limitations. The claim language does not limit the chrome plating only to the extension member of the ratchet extension. As modified by the Examiner, Schroeder's entire tool, including the extension element [26], is chrome plated.

Dougherty further argues that Schroeder does not describe a locking apparatus with a locking tool that is separate from the extension member. (Reply Br. 3). Dougherty argues that Schroeder describes all the parts are integrally part of the extension element. (Reply Br. 3). Dougherty's arguments again are not commensurate in scope with the claim limitations.

The claim language does not require the locking apparatus with a locking tool to be separate from the extension member.

For all these reasons, Dougherty has not shown that the Examiner erred in determining that claims 1-6 are obvious over Schroeder and Henrit or Valadez.

Rejection of claims 7-8 as obvious over Schroeder, Henrit or Valadez, and Tarquinio

Claim 8 is representative and recites “whereby manual clockwise rotation of said locking tool actuates mechanical impingement . . . and whereupon manual counter-clockwise rotation of said locking tool facilitates removal of mechanical interference . . .”. (App. Br. 10-11, Reply Br. 3-4). Dougherty argues that none of the references describe the disputed limitations. (Reply Br. 4).

Dougherty’s arguments are unpersuasive because Schroeder describes the disputed limitations. Schroeder describes a chuck collar [35] (i.e., locking tool) which when screwed onto threads [27] locks the shaft [29] in position (i.e., mechanical impingement). (FF 2). The chuck collar [35] may be loosened by turning the collar on the threads [27]. (FF 3). Dougherty does not explicitly state that chuck collar [35] is screwed onto threads [27] with a clockwise motion and loosened by a counterclockwise motion. Nearly all screw threads are right-handed screw threads. (FF 4). It would have been obvious to one with ordinary skill that rotating Schroeder’s chuck collar [35] on threads [27] in a clockwise motion would result in locking shaft [29] in position (i.e., mechanical impingement) and rotating the chuck collar [35] on threads [27] in a counter-clockwise motion would

loosen the chuck collar [25] (i.e., facilitate removal of the mechanical interface).

For all these reasons, Dougherty has not shown that the Examiner erred in determining that claims 7-8 are obvious over Schroeder and Henrit or Valadez and Tarquinio.

Rejection of claim 9 as obvious over Schroeder, Henrit or Valadez, and Long or Lojczyc

Claim 9 recites “wherein said inner cylinder has measuring indicia engraved along an external circumferential surface of said inner cylinder in a sequentially progressive manner . . .”. (App. Br. 11). Dougherty argues that the Examiner uses hindsight reasoning, and there is no teaching, suggestion, or motivation to modify or combine the references. (Reply Br. 4-5).

Dougherty’s arguments are unpersuasive. As explained before, the Supreme Court has rejected the rigid application of the teaching, suggestion, or motivation test. Precise teachings in the prior art directed to the specific subject matter claimed are not necessary in an obviousness analysis.

In this case, the Examiner has identified that Long and Lojczyc describe tools and suggest providing indicia on the inner member to indicate distance. (Final Rejection 3, Ans. 4). One with ordinary skill in the art at the time the invention was made would appreciate that it would be beneficial to provide indicia on hand tools for the purpose of indicating distance.

For all these reasons, Dougherty has not shown that the Examiner erred in determining that claim 9 is obvious over Schroeder and Henrit or Valadez and Long or Lojczyc.

E. Conclusions of Law

Based on the Findings of Fact and the Analysis above, Dougherty has not shown that the Examiner erred in rejecting all of the claims as obvious on the basis that the references or combination of references do not teach or suggest every element of the claims or on the basis that the references are non-analogous art.

Further, Doherty has not shown that the Examiner erred in rejecting claims 1-6 as obvious on the basis that the prior art does not describe each and every limitation of the claims or on the basis that the Examiner does not provide a teaching or suggestion found in the prior art to modify or combine the references.

Still further, Doherty has not shown that the Examiner erred in rejecting claims 7-8 as obvious on the basis that the prior art does not describe each and every limitation of the claims.

Yet still further, Doherty has not shown that the Examiner erred in rejecting claim 9 as obvious on the basis that the Examiner does not provide a teaching or suggestion found in the prior art to modify or combine the references.

F. Decision

The decision of the Examiner rejecting claims 1-6 under 35 U.S.C. § 103(a) as unpatentable over Schroeder and Henrit or Valadez is affirmed.

The decision of the Examiner rejecting claims 7-8 under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Henrit or Valadez, and Tarquinio is affirmed.

The decision of the Examiner rejecting claim 9 under 35 U.S.C. § 103(a) as unpatentable over Schroeder, Henrit or Valadez, and Long or Lojczyc is

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affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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