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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte STEVE R. WENTE and DANIEL M. EGGERT

Appeal 2010-010919
Application 11/650,403
Technology Center 3700

Before CHARLES N. GREENHUT, MICHAEL C. ASTORINO, and
MICHAEL L. HOELTER, *Administrative Patent Judges*.

ASTORINO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision finally rejecting claims 1-10, 13, 15, 16, 18, and 22. Claims 11, 12, 14, 17, 19, 20, and 21 are cancelled. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

Claimed Subject Matter

Claims 1, 13, and 22 are the independent claims on appeal. Claim 13, reproduced below, is illustrative of the subject matter on appeal.

13. An adjustable tool extender comprising:

a wrenching device;

a sleeve defining a receptacle having an interior surface, the sleeve having an attachment end for cooperation with the wrenching device;

an extension member having a first end integral with a second end, the extension member being a single substantially solid component, said second end being slidable within said receptacle of said sleeve, said extension member having an intermediate portion between said first and second ends and having a cross-sectional area substantially less than that of either of said first and second ends; and

a bias member disposed between said sleeve and said extension member and biasing said extension member to the fully extended position, wherein said sleeve has a crimped end to capture said second end of said extension member in said receptacle and prevent said first end from entering the receptacle, and wherein said bias member selectively expands and contracts responsive to a compressive force applied by a user from the wrenching device to the attachment end.

Rejections

Claims 1-10, 13, 15, 16, 18, and 22 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claims 13, 15, 16, and 18 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ybarra (US 6,971,290 B1, iss. Dec, 6, 2005), Lin (US 6,155,144, iss. Dec, 5, 2000), and Brown (US 2,733,885, iss. Feb. 7, 1956).

Claim 22 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Lin, Brown, and Varnell (US 3,987,807, iss. Oct. 26, 1976).

Claims 1-3, 5-7, 9, and 10 are rejected under 35 U.S.C. § 103(a) as unpatentable over Ybarra and Middleton (US 4,470,527, iss. Sept. 11, 1984).

Claim 4 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Middleton, and Varnell.

Claim 8 is rejected under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Middleton, and Brown.

OPINION

Rejection of claims 1-10, 13, 15, 16, 18, and 22 as failing to comply with the written description requirement

The Examiner finds that “the extension member being a single substantially solid component” as recited in claims 1, 13, and 22 was not reasonably conveyed to one of ordinary skill in the art, at the time the invention was filed, because “the extension member is not a ‘single’ component” as it includes a detent ball 111 and a spring 113. Ans. 3-4; Spec. 8, para. [0041]. The Examiner supports his finding by pointing to Figures 4 and 5, which according to the Examiner depicts the detent ball 111 and the spring 113 as part of the extension member. Ans. 7.

The Appellants contend that “the extension member 102 is a single solid part and that the detent ball 111 and spring 113 are separate parts.” Reply Br. 4. *See* App. Br. 8. The Appellants correctly point out that the Specification does not describe that the extension member 102 and the detent ball 111 and spring 113 as a single component. *See* Reply Br. 4. Additionally, the Appellants correctly point out that the cross-sectional view of the extension member in Figures 4 and 5 depict the extension member

102 as a single substantially solid component. *See Id.* Notably, in Figures 4 and 5 the extension member 102, the detent ball 111, and the spring 113 are identifiable by different fill patterns. More specifically, the extension member 102 is filled in with a first type of cross-hatching line pattern, the detent ball 111 is filled in with a second type of cross-hatching line pattern, and the spring 113 is not filled in by any type of pattern, i.e., it is blank. As such, the originally filed written description conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, that the Appellants were in possession of “the extension member being a single substantially solid component” since the claimed “extension member” is not understood to include the detent ball 111 and/or the spring 113. *See also Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991).

Thus, the rejection of claims 1, 13, and 22 as failing to comply with the written description requirement is not sustained. Similarly, the rejection of claims 2-10, which depend either directly or indirectly from claim 1, and claims 15, 16, and 18, which depend either directly or indirectly from claim 13, are likewise not sustained.

*Rejection of claims 13, 15, 16, and 18 as unpatentable over
Ybarra, Lin, and Brown*

The Examiner finds that “Ybarra discloses all of the claimed subject matter except for having a spring in a cavity and a crimped end.” Ans. 4. To remedy the former deficiency of Ybarra the Examiner turns to Lin’s disclosure of a spring 34 in a cavity. Ans. 4. The Examiner concludes that “[i]t would have been obvious to one having ordinary skill in the art to form the device of Ybarra with a spring to allow for the automatic extension of the extension member as taught by Lin.” *Id.*

The Appellants contend that neither Ybarra nor Lin disclose a “bias member selectively expands and contracts responsive to a compressive force applied by a user from the wrenching device to the attachment end” as recited in independent claim 13. *See* App. Br. 9. The Appellants contend that the extension members of both Ybarra and Lin are not free floating because they include latchable extension members. *See* App. Br. 10-11. The Appellants’ characterization of Ybarra’s and Lin’s extension members as latchable is correct because Ybarra discloses a pawl 58 which is biased to engage with the teeth 56 of the rack 31 and Lin discloses a pawl 32 which is biased to engage with the teeth 42 of the driving stem 41. Ybarra, col. 4, ll. 29, 30; Lin, col. 2, ll. 52-55, 59-65. However, the Appellants contentions are not persuasive.

The inclusion of a pawl as part of an extension member does not exclude the functionality of a biasing member to selectively expand and contract responsive to a compressive force applied by a user. As articulated by the Examiner “[t]he bias member of Lin expands and retracts in response to a compressive force applied by a user *upon release of the latch.*” Ans. 7 (emphasis added). More specifically, Lin’s spring 34 biases the driving stem 41 forward and outward of handle 31 when panel 62 is not engaged with the teeth 42 of driving stem 41. Lin, col. 3, ll. 18-28. Accordingly, when Lin’s panel 62 is not engaged with the teeth 42 of the driving stem 41, Lin’s spring 34 acts as a biasing member to selectively expand and contract responsive to a compressive force applied by a user. Although the Appellants contend that “the Examiner erroneously maintains that bias member of Lin . . . expands and retracts in response to a compressive force applied by a user upon

release of the latch” (Reply Br. 5), the Appellants do not express a cogent reason supporting this contention.

The Appellants contend that the Examiner’s rejection is based on impermissible hindsight because “[p]ersons having ordinary skill in the art would recognize that movement of the inner connector 16 of Ybarra by displacing the pawl 58 is an adjustment step that is not practical to perform during use of the wrenching device to turn a fastener.” App. Br. 10-11. However, claim 13 does not require that a fastener is capable of being turned while Ybarra’s pawl 58 is displaced. Furthermore, the Appellants’ contention that there is no motivation to remove the latching mechanisms of either Ybarra or Lin is unpersuasive (*id.*) because the claims do not require the latching mechanisms to be removed. Additionally, the Examiner’s conclusion that “[i]t would have been obvious to one having ordinary skill in the art to form the device of Ybarra with a spring to allow for the automatic extension of the extension member as taught by Lin” is supported with rational underpinning. Ans. 4. *See In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds [require] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”) (*cited with approval in KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418 (2007)).

The Appellants also contend that Lin teaches away from combinations with Brown, Varnell, and Middleton. App. Br. 12. At the outset, we note that the Examiner does reject any claim with both Lin and Middleton in the same ground of rejection; and, Lin and Varnell are only included as prior art for the rejection of claim 22, discussed *infra*. As for the Examiner’s rejection of claim 13 as unpatentable over Ybarra, Lin, and Brown, the

Appellants contend “Lin explicitly teaches away from using telescoping tubular members such as those of Brown . . . because ‘the driving strengths of the tubular members of smaller size may be greatly decreased such that the driving tool may not be used to forceful drive the fasteners or the like.’” App. Br. 12 (citing Lin, col. 1, ll. 9-16). However, the Examiner correctly responds that the Appellants’ support for this contention is not directed to Lin’s retractable tool, rather the citation to Lin is a description of the prior art at the time Lin’s patent application was filed, i.e., the disclosure of a separate patent to Liu. *See* Ans. 10. As such, this contention is also unpersuasive.

Thus, the rejection of claim 13 as unpatentable over Ybarra, Lin, and Brown is sustained. Additionally, as the Appellants have not addressed the rejections of dependent claims 15, 16, and 18 separately, these claims are likewise sustained.

*Rejection of claim 22 as unpatentable over
Ybarra, Lin, Brown, and Varnell*

The Examiner’s rejection of claim 22 is similar to the rejection of claim 13 discussed above, except for the further modification of Ybarra with Varnell’s disclosure. The Examiner finds that “Varnell discloses a tapered coil spring disposed between the sleeve and the extension member and extending in a sleeve receptacle and a tapered extension cavity” and concludes that “[i]t would have been obvious to one having ordinary skill in the art to form the device of Ybarra as modified by Lin with a tapered cavity for receiving a tapered spring to provide a more compact device as taught by Varnell.” Ans. 5.

The Appellants assert that “Varnell discloses a tapered spring in a walking cane which is far afield from the present invention.” App. Br. 12. To the extent that this assertion argues that Varnell is not analogous art, we agree with the Examiner that “Varnell is reasonably pertinent to the particular problem with which the applicant was concerned, e.g., forming a collapsible telescoping shaft.” Ans. 10. *See In re Kahn*, 441 F.3d 977, 986-87 (Fed. Cir. 2006) (“The analogous-art test requires that the Board show that a reference is either in the field of the applicant’s endeavor *or* is *reasonably pertinent* to the problem with which the inventor was concerned in order to rely on that reference as a basis for rejection” (emphasis added)) (citing *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992)).

The Appellants also contend that Varnell does not remedy the deficiency discussed *supra* with regard to the combined teachings of Ybarra, Lin, and Brown. App. Br. 12. However, as discussed *supra*, the Examiner’s rejection includes no such deficiency and as such, the Appellants’ contention is unpersuasive. Additionally, as discussed *supra*, the Appellants’ contention that Lin teaches away from Brown and Varnell is unpersuasive because the Appellants’ support for this contention is directed not Lin’s retractable tool. Thus, the rejection of claim 22 as unpatentable over Ybarra, Lin, Brown, and Varnell is sustained.

*Rejection of claims 1-3, 5-7, 9 and 10 as unpatentable over
Ybarra and Middleton*

The Examiner finds “Ybarra discloses all of the claimed subject matter except for having a coil spring in a cavity of an extension member.” Ans. 6. The Examiner attempts to remedy this deficiency with regard to claim 1 by turning to Middleton, which the Examiner finds discloses

extension members 21 and 19, cavities 48 and 49, respectively, and a spring 22. *Id.* The Examiner concludes “[i]t would have been obvious to one having ordinary skill in the art to form the telescoping member of Ybarra with a cavity in the extension member and a substantial portion of a coil spring disposed in the cavity to urge the extension member into an expanded state as taught by Middleton.” Ans. 6.

However, the Examiner’s proposed modification of Ybarra’s extension member (rack 31) with Middleton’s extension members (either of bottom element 19 or intermediate element 21) would not result in a substantially *solid* “extension member” as called for in claim 1. *See App. Br. 13.* Although Ybarra’s rack 31 is solid, Middleton’s elements 19, 21 are not solid, and are entirely hollow. *See Ybarra, fig. 2; Middleton, fig. 3.* By modifying Ybarra’s rack 31 to include the cavity of Middleton, the Examiner must necessarily include Middleton’s teaching of hollow elements 19 or 21. Consequently, the Examiner’s proposed modification of Ybarra’s rack 31 in view of Middleton’s hollow elements 21 would not result in an “extension member being a single substantially solid component” as recited in claim 1.

Thus, the rejection of claim 1, and claims 2, 3, 5-7, 9 and 10, which depend either directly or indirectly therefrom, as unpatentable over Ybarra and Middleton is not sustained.

Rejection of claim 4 as unpatentable over Ybarra, Middleton, and Varnell and rejection of claim 8 as unpatentable over Ybarra, Middleton, and Brown

The remaining rejections based on Ybarra and Middleton in combination with Varnell or Brown rely on the same erroneous determination as discussed above with regard to claim 1 as unpatentable

over Ybarra and Middleton. As such, we cannot sustain the rejections under 35 U.S.C. § 103(a) of claim 4 as unpatentable over Ybarra, Middleton, and Varnell, and claim 8 as unpatentable over Ybarra, Middleton, and Brown.

DECISION

We REVERSE the rejections of: claims 1-10, 13, 15, 16, 18, and 22 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1-3, 5-7, 9, and 10 under 35 U.S.C. § 103(a) as unpatentable over Ybarra and Middleton; claim 4 under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Middleton, and Varnell; and, claim 8 under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Middleton, and Brown.

We AFFIRM the rejections of: claims 13, 15, 16, and 18 under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Lin, and Brown; and claim 22 under 35 U.S.C. § 103(a) as unpatentable over Ybarra, Lin, Brown, and Varnell.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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