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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* MARKUS HOLUBARSCH and STEFAN SCHMID

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Appeal 2018-003382  
Application 14/270,908  
Technology Center 3700

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Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and  
SEAN P. O'HANLON, *Administrative Patent Judges*.

O'HANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision to reject claims 1–14. We have jurisdiction under 35 U.S.C. § 6(b). We REVERSE.

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<sup>1</sup> We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies Hilti Aktiengesellschaft as the real party-in-interest. Appeal Br. 2.

In explaining our Decision, we refer to the Specification filed May 6, 2014 (“Spec.”), the Final Office Action mailed February 21, 2017 (“Final Act.”), the Appeal Brief filed November 13, 2017 (“Appeal Br.”), the Examiner’s Answer mailed December 28, 2017 (“Ans.”), and the Reply Brief filed February 12, 2018 (“Reply Br.”).

### SUMMARY OF THE INVENTION

Appellant’s invention is directed to a power tool. Spec. ¶ 2. Claims 1 and 8 are independent. Claim 1, reproduced below from page 8 (Claims Appendix) of the Appeal Brief, is illustrative of the claimed subject matter:

1. A hand-held power tool comprising:
  - a tool socket;
  - a drive for driving the tool socket and having a first stationary part connected to or supporting a movable part of the drive;
  - a housing, the drive being arranged in the housing, the first stationary part being stationary with respect to the housing; and
  - at least one detachable clamped connection connecting the first stationary part to at least one element, the at least one element including at least one of the housing and another stationary part stationary with respect to the housing, the clamped connection having a cylindrical pocket in the first stationary part, a bushing made of plastic and inserted into the cylindrical pocket, and a screw screwed into the bushing.

### REFERENCES

The Examiner relies on the following prior art references in rejecting the claims on appeal:

Szczukowski	US 2011/0286813 A1	Nov. 24, 2011
Henriksson	WO 96/15881	May 30, 1996

## REJECTION

Claims 1–14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Henriksson and Szczukowski.

## ANALYSIS

### *Claims 1–7*

The Examiner finds that Henriksson discloses a hand-held power tool substantially as recited in independent claim 1, including a tool socket (tool part 16),<sup>2</sup> a drive having a first stationary part (head 17) and a movable part (impact piston 15), a housing (housing 11), and a clamped connection (retainers 26, 27) having a pocket (bores 20) and a bushing (sleeve 29). Final Act. 2–3. The Examiner finds that Henriksson does not disclose a screw screwed into the bushing, but finds that Szczukowski teaches a clamped connection having a screw (bolt 36) screwed into a bushing (sleeve 10). *Id.* at 3. The Examiner reasons that it would have been obvious to a person having ordinary skill in the art to substitute Szczukowski’s screw in place of Henriksson’s grooved retainer (retainer 27) because “[t]he substitution would have resulted in the predictable result of locking at least two materials together using a plastic insert and screw which is incorporated into the insert to provide the necessary expanding force.” *Id.* at 3–4.

Appellant challenges the Examiner’s rejection by arguing, *inter alia*, that “[Henriksson] clearly and specifically teaches one of ordinary skill in the art that ‘any other vibration-sensitive screw-threaded devices’ should not be used” and “[t]here is no factual basis for the Examiner’s assertion that the

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<sup>2</sup> Parentheticals refer to the terminology of the cited references.

screw and sleeve of [Szcukowski] is the ‘functional equivalent’ of the [Henriksson] device.” Appeal Br. 5; *see also* Reply Br. 2–3.

A reference teaches away from a claimed invention or a proposed modification if “a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant.” *In re Kubin*, 561 F.3d 1351, 1357 (Fed. Cir. 2009) (citing *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994)). Prior art does not teach away from claimed subject matter merely by disclosing a different solution to a similar problem unless the prior art also criticizes, discredits, or otherwise discourages the solution claimed. *See In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).

Henriksson identifies the use of threaded fasteners to connect housing components of breaking hammers as a problem to be avoided because “screw threads are shaken loose” and “[s]ide bolts can . . . fracture.” Henriksson 1:26–2:9. Accordingly, Henriksson explains that an object of its invention is to connect the tool part to the housing in a way that “eliminates the need for side bolts.” *Id.* at 2:29–35. Henriksson explicitly discloses that “the tool part 16 is carried by the machine housing 11 *without the aid of side bolts or any other vibration-sensitive screw-threaded devices.*” *Id.* at 4:18–20 (emphasis added). Henriksson’s housing and tool part include cooperating bores 19, 20 that align when the tool part is positioned within the housing. *Id.* at 4:29–33. Retainers 26, 27 are inserted through these bores to create “a robust attachment of the tool part 16 to the machine housing 11.” *Id.* at 4:34–37. Henriksson discloses that the retainers can be in the form of a slit cylinder or a grooved cylinder. *Id.* at 5:24–6:3.

Thus, rather than merely described the use of threaded fasteners as a “non-preferred embodiment” as suggested by the Examiner (*see* Ans. 3), Henriksson consistently criticizes and discourages the use of threaded fasteners in its breaking hammer. Furthermore, the Examiner does not identify, nor does our review reveal, any suggestion in Szczukowski that its fastening means helps to alleviate the detrimental effects of vibration in power tools such that a person having ordinary skill would view it as being a suitable replacement for Henriksson’s fasteners. Rather, the Examiner’s rationale for modifying the Henriksson device appears to be based on improper hindsight reasoning. *See* Appeal Br. 5. The Examiner has failed to articulate reasoning with rational underpinnings supporting the proffered modification to use a threaded fastener in Henriksson’s breaking hammer.

Additionally, we agree with Appellant that “the asserted tool socket, tool part 16, is not driven, and thus [Henriksson] does not show or teach ‘a drive for driving a tool socket’ as claimed.” Appeal Br. 4. The Examiner relies on Henriksson’s tool part 16 to correspond to the recited tool socket and piston 15 and head 17 to correspond to the recited “drive for driving the tool socket.” Final Act. 2. However, as explained above, Henriksson’s tool part 16, including its head portion 17, is affixed to housing 11 via retainers 26, 27 positioned within bores 19, 20. Henriksson 4:34–37. The piston reciprocates within housing bore 12 and tool part bore 21. *Id.* at 3:37–4:4, 6:5–10. Thus, Henriksson’s tool part 16 is stationary and is not driven. Nor do we agree with the Examiner’s finding that Henriksson’s breaking tool 18 corresponds to the recited tool socket (*see* Ans. 3), as the breaking tool is a tool, not a tool socket.

Accordingly, for the foregoing reasons, we do not sustain the Examiner's rejection of independent claim 1 or its dependent claims 2–7 as being unpatentable over Henriksson and Szczukowski.

*Claims 8–14*

Independent claim 8 contains recitations that are substantially the same as those of claim 1, but requires a drive having an exciter and a guide tube rather than a first stationary part and a movable part. *See* Appeal Br. 9 (Claims App.). The Examiner rejects claim 8 in substantially the same manner as claim 1. Final Act. 7–8.

For the same reasons set forth above with respect to claim 1, we do not sustain the Examiner's rejection of independent claim 8 or its dependent claims 9–14 as being unpatentable over Henriksson and Szczukowski.

CONCLUSION

In summary,

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>References</b>	<b>Affirmed</b>	<b>Reversed</b>
1–14	103	Henriksson, Szczukowski		1–14

REVERSED