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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/944,422	11/18/2015	Felix SORKIN	GTI.010002	9677
100183	7590	11/27/2019	EXAMINER	
Adolph Locklar Michael Locklar 4615 S.W. Freeway Suite 630 Houston, TX 77027			HOLLY, LEE A	
			ART UNIT	PAPER NUMBER
			3726	
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2019	ELECTRONIC

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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* FELIX SORKIN

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Appeal 2019-002180  
Application 14/944,422  
Technology Center 3700

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Before CHARLES N. GREENHUT, MICHAEL L. HOELTER, and  
JILL D. HILL, *Administrative Patent Judges*.

GREENHUT, *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 11–21. *See* Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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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 the real party in interest as Felix Sorkin. Appeal Br. 4.

CLAIMED SUBJECT MATTER

The claims are directed to a pocket former removal method and tool. Claims 11 and 21, reproduced below, are illustrative of the claimed subject matter:

11. A method for removing a pocket former from a concrete member, the concrete member having a surface, the pocket former having a pocket former extension, the concrete member and the pocket former having a connection, the method comprising:

a) supplying a pocket former removal tool, the pocket former removal tool comprising:

a tool body, the tool body having a fulcrum, a first end and a second end;

tines attached to the second end of the tool body; and

a handle, the handle attached to the first end of the tool body;

b) positioning the pocket former removal tool such that the fulcrum is in contact with the concrete member and the tines are engaged with the pocket former extension; and

c) applying, while the tines are engaged with the pocket former extension, a downward force to the handle to create an upward force on the pocket former;

wherein the tool body is configured such that the fulcrum engages the concrete surface and not the pocket former during steps b) and c) and wherein the pocket former engages the tool body at a point between the fulcrum and the tines at a time during step c) when the pocket former is partially removed from the concrete member.

21. A pocket former removal tool for removing a pocket former from a concrete member, the concrete member having a surface, the pocket former having a pocket former extension, the concrete member and the pocket former having a connection, the pocket former removal tool comprising:

a tool body, the tool body having a fulcrum, a first end and a second end; and

tines attached to the second end of the tool body;

wherein the tool body is configured such that the fulcrum does not engage the pocket former when the pocket former removal tool is positioned such that the fulcrum engages the concrete surface and the tines are engaged with the pocket former extension; and

wherein the tool body is configured such that when the pocket former is partially removed from the concrete member and the tines are still engaged with the pocket former extension, the pocket former will engage the tool body at a point between the fulcrum and the tines.

### REFERENCES

The prior art relied upon by the Examiner is:

Name	Reference	Date
Sorkin	US 5,897,102	Apr. 27, 1999
Witter	US 6,505,817 B1	Jan. 14, 2003
Williams	US 7,040,602 B1	May 09, 2006
Sindt	US 2013/0263382 A1	Oct. 10, 2013
Liou	US 2015/0014612 A1	Jan. 15, 2015

### REJECTIONS

Claim 21 is rejected under 35 U.S.C. § 102(a)(1) as being anticipated by any one of Sindt, Liou, Witter. Final Act. 2, 4, 5.

Claims 11–20 are rejected under 35 U.S.C. § 103 as being unpatentable over Sorkin and Williams. Final Act. 7.

### OPINION

#### *Anticipation*

As Appellant acknowledges by arguing the anticipation rejections together, the issues pertaining to the anticipation rejections of claim 21 are substantially the same for each of the applied references. App. Br. 8–9. Appellant takes issue with the Examiner’s comment that the prior-art tools are “fully capable of being configured to” perform the functions recited in

the wherein clauses of claim 21. App. Br. 8–9; Final Act. 3, 5, 7; Reply. Br 8–9. Although the Examiner’s exact wording in this regard is not consistent with the standards associated with anticipation, reading the rejection as a whole, particularly in view of the Examiner’s clarification in the Answer, it is clear that the Examiner did not intend to reject claim 21 based on making any structural changes or reconfigurations to the structures disclosed in the applied references. Ans. 10–11 (“ . . . No such reconfiguring or modifying of the structural limitation has been proposed.”). Rather, the Examiner determined that, although the prior-art devices were depicted removing nails or stakes, those prior-art devices were, without modification, reasonably regarded as being configured to perform the recited functions associated with a pocket former.

When a claim recites “configured to” language followed by a description of use, function or operation, it generally implies the element modified by that language possesses at least some structure such that it can reasonably be regarded as made, designed, or adapted to perform that function. *In re Giannelli*, 739 F.3d 1375, 1379–80 (Fed. Cir. 2014). Here, the function involves, when the tools’ tines are engaged with the pocket former extension, the tool’s fulcrum engaging the concrete, as opposed to the pocket former, at some time, and the tool’s body engaging the pocket former at some time during removal. *See* Figs. 3A–B. This interaction is evident from the process depicted in Appellant’s Figures 3A–B. However, claim 21 is not directed to the combination of a pocket former removal tool and a pocket former, only a pocket former removal tool itself. That pocket former removal tool of claim 21 is defined in terms of its cooperation with a pocket former of some undefined size and shape, which may or may not resemble that depicted in Appellant’s Figures.

To illustrate with a hypothetical, if a prior-art reference depicts a nail-removal tool being used to remove a framing nail, it does not necessarily define around that prior-art subject matter to claim a nail-removal tool “configured to” remove a roofing or some other type of nail unless the “configured to” language and the language that follows requires or implies a structural difference in the claimed nail-removal tool itself. The question is what the prior-art removal tool can reasonably be considered as “configured to” remove regardless of the particular type of nail it is expressly depicted as operating upon in the prior-art reference. To prevent issuing a claim directed to an old device predicated on a new use (MPEP § 2112(I)), the focus must remain on the structures of the prior-art and claimed devices as opposed to their illustrated or recited uses, respectively.

Here, as the Examiner points out, the pocket former removal tool of claim 21 is defined largely in terms of the unclaimed, undefined pocket former with which the removal tool is intended to cooperate or work upon. Ans. 6, 9, 12. There is nothing wrong, per se, with this form of claiming, but the question that must be posed is: what do these recitations related to the function that the removal tool is configured to perform, or the device the tool is intended to work upon, or cooperate with, tell us about the actual structural configuration of the removal tool itself? *See* Ans. 6, 9, 11 (citing MPEP §§ 2114, 2115). Appellant appears to agree with this formulation of the issue (Reply. Br. 7 (“The present tool has a certain shape, or structure, that is dictated by the structure of the device on which it is used”)), but fails to apprise us as to what particular structure of the removal tool itself is defined by the features of the unclaimed pocket former—the only subject matter absent from the cited prior art. Reciting unclaimed subject matter with which the claimed subject matter is intended to cooperate can, in

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appropriate circumstances, certainly influence the scope of the subject matter claimed. *See, e.g., In re Man Machine Interface Technologies LLC*, 822 F.3d 1282 (Fed. Cir. 2016) (defining a switch by the human thumb used for activating it). However, in this case, because there is very little recited related to the particulars of the pocket former, and on the record before us, pocket formers represent a virtually unbounded class of subject matter, the recitations here that are related to the pocket former provide very little information about the structure of the claimed *removal tool* itself.

Our reviewing court has considered the situation where a broad class of unclaimed subject matter is used to define the subject matter claimed in *Geneva Pharmaceuticals v. GlaxoSmithKline*, 349 F.3d 1373 (Fed. Cir. 2003). The court suggested indefiniteness issues might arise in such situations because the potential infringer is unduly burdened with having to consider a vast and open-ended category of unclaimed subject matter in order to determine the possibility of infringement. Ultimately, the court adopted a broad construction, wherein the claim is satisfied so long as there can be presumed to be *any* instance of that unclaimed subject matter in existence that satisfies the claim language.

Here, the Examiner provides uncontroverted evidence that a pocket former may have a form substantially similar to that of a conventional nail or stake, like those removed by the applied prior-art references, and may thus be pried by tools intended to cooperate with nails or stakes. Ans. 7–8 (reproducing a portion of the Polylok catalog). We have no reason to believe, and indeed Appellant does not appear to contest, that given the wide variety of pocket formers available, as illustrated in the Polylok catalog, there is not one of them in existence that would, when removed by the cited prior-art removal tools, result in the functional language of claim 21 being

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satisfied. Appellant does not provide sufficient arguments or evidence to explain or demonstrate the technical reasons why the cited prior-art tools could not function to remove, by virtue of the same leverage used for removing nails, a pocket-former.

Appellant contends, “pocket formers include a relatively large frustoconical cup, which forms the desired ‘pocket’ in a molded concrete form.” Reply. Br. 6. First, Appellant does not provide any evidence to support the assertion that a relatively large frustoconical cup is an inherent feature of pocket formers. Certainly *something* capable of forming a pocket must be present for something to reasonably be considered a “pocket former.” However, we see no reason why the cylindrical portion or head of a nail-like or stake-like structure would not also form a pocket in concrete. Appellant’s position that a relatively large frustoconical cup is inherently required of all pocket formers directly conflicts with the only evidence on the subject we have before us, which is the Polylok catalog provided by the Examiner. Second, and in any case, this argument is not on point because it, at most, only illustrates a distinction between unclaimed subject matter and the prior art as opposed to the subject matter actually claimed and the prior art.

For the foregoing reasons, we sustain the Examiner’s anticipation rejections.

### *Obviousness*

Regarding the obviousness rejection of representative method claim 11 (*see* 37 C.F.R. § 41.37(c)(1)(iv)), the Examiner relies on Sorkin as disclosing a pocket former and method for its removal, albeit without a removal tool. Final Act. 8–9. Appellant does not raise any issues concerning

the Examiner’s analysis of Sorkin. The Examiner relies on Williams as disclosing a stake removal tool in the concrete arts and concludes that, as the gripping end of Sorkin’s pocket former resembles the gripping end of a stake, it would have been obvious to use Williams’s tool to remove Sorkin’s pocket former to improve leverage. Final Act. 8–9.

Appellant contends that “if the Williams device were used in an attempt to remove a pocket former, the [fulcrum of the] Williams device would engage the pocket former [during steps b and c].”<sup>2</sup> App. Br. 9. This argument, like that rejected above, is premised on the pocket former having some inherent size or shape, none of which is recited in claim 11. Although “there is no teaching or suggestion in Williams regarding the space between the engagement point of the fulcrum and the stake,” the Examiner has made of record, via the Polylok catalog, that pocket formers come in various sizes and shapes. If the Williams removal tool were applied to a pocket former, even if the pocket former were of the particular construction described in Sorkin,<sup>3</sup> we see no reason why this limitation relating to a gap between the pocket former and fulcrum would not incidentally be satisfied when the removal tool and pocket former are sized suitably for doing so. Of course, the fulcrum would have no removal effect, or would just work to pry the

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<sup>2</sup> We have added language to Appellant’s argument to reflect that of the claim limitation believed to be argued. We also will interpret the preclusion from contact with the pocket former as not precluding contact with the pocket former extension which seemingly contradictorily appears to be recited as a part of the pocket former in claim 11 (“the pocket former having a pocket former extension”).

<sup>3</sup> As the Examiner points out, “[i]t is well-established that a determination of obviousness based on teachings from multiple references does not require an actual, physical substitution of elements.” *In re Mouttet*, 686 F.3d 1322, 1332 (Fed. Cir. 2012); Ans. 12–13.

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pocket former itself apart, if the fulcrum were placed on a radially extending part of the pocket former being removed. One skilled in the art would have the mechanical skill to understand that changes to dimensions could be made to arrive at a working device. *Powers-Kennedy Co. v. Concrete Co.*, 282 US 175, 185 (1930); *accord In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1382 (Fed. Cir. 2007) (“One skilled in the art would size the components [] appropriately for [the] application.”).

Regarding engagement between the pocket former and tool body, in the final wherein clause of claim 11, Appellant contends that it was unreasonable for the Examiner to regard bight 54 (shown engaging the stake during removal in Williams Fig. 10) as part of the tool body because it is part of the tines. App. Br. 10–11; Reply. Br 10. However, Appellant does not direct our attention to any specific language in claim 11 that precludes such an interpretation. Williams itself refers to teeth 50, 52 which are reasonably regarded as “tines,” and never described as *including* bight 54. Appellant does not apprise us of any specific reason this bight “would never engage a pocket former in the claimed manner.” App. Br. 10.

The Examiner additionally characterizes the requirements of this final wherein clause as “optional.” Ans. 18 (citing MPEP § 2111.04(I). It is perhaps more appropriately characterized as conditional or contingent in that it “only needs to occur if a condition precedent is met.” *See* MPEP § 2111.04(II) (*discussing Ex parte Schulhauser*, Appeal 2013-007847 (PTAB April 28, 2016) (precedential)). Nevertheless, we also agree with the Examiner’s alternative analysis of this limitation in that, under the broadest reasonable interpretation, method claim 11 is met by carrying out the affirmative manipulative steps, with a tool body configured as recited, without regard to what happens if the pocket former is partially removed—

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something not necessarily required by the recited manipulative steps. Ans. 18–19; MPEP § 2111.04(II).

For the foregoing reasons we sustain the Examiner’s obviousness rejection of claims 11–20.

### CONCLUSION

The Examiner’s rejections are affirmed.

### DECISION SUMMARY

<b>Claims Rejected</b>	<b>35 U.S.C. §</b>	<b>Reference(s)/Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
21	102(a)(1)	Sindt	21	
21	102(a)(2)	Liou	21	
21	102(a)(1)	Witter	21	
11–20	103	Sorkin, Williams	11–21	
<b>Overall Outcome</b>			11–21	

### TIME PERIOD FOR RESPONSE

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**