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Maginot, Moore & Beck LLP One Indiana Square, Suite 2200 Indianapolis, IN 46204			HALL JR, TYRONE VINCENT	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MICHAEL WHITE, ROBERT J. KOCHIE, and
ROBERT A. JENSEN

Appeal 2019-002559
Application 14/930,983
Technology Center 3700

Before JENNIFER BAHR, KEVIN TURNER, and BRETT C. MARTIN,
Administrative Patent Judges.

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant,¹ Bosch Automotive Service Solutions Inc., appeals from the Examiner's decision to reject claims 1–20. Final Act. 1. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

The claims are directed “to automotive tools, and, more particularly, to tools used to separate a tire from a rim and/or to flip a tire.” Spec. ¶ 2. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. A tool for manipulating and changing a tire, the tire having a bead and a rim, the tool comprising:
 - a hollow shaft having a first end and a second end;
 - a weight slidably received within the shaft and configured to slide through the first end of the shaft along a longitudinal direction, the weight including a first end, which is always disposed outside of the shaft, and a second end, which is always disposed inside the shaft; and
 - an impact head fixedly attached directly to the second end of the shaft, the impact head including:
 - a first portion configured to engage with the bead of the tire; and
 - a second portion configured to engage with the rim of the tire.

REFERENCES

The prior art relied upon by the Examiner is:

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37 C.F.R. § 1.42(a). Appellant identifies the real party in interest as Bosch Automotive Service Solutions Inc. and Robert Bosch GmbH. Appeal Br. 2.

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Taylor	US 2,311,789	Feb. 23, 1943
Gutierrez	US 5,461,900	Oct. 31, 1995
Gallo	US 6,308,934 B1	Oct. 30, 2001
Al-Taweel	US 9,402,337 B2	Aug. 02, 2016

REJECTIONS

Claims 1, 2, 4, 5, 11–14, and 17–20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallo and Gutierrez. Ans. 3.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallo, Gutierrez, and Taylor. Ans. 9.

Claims 6–10, 15, and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Gallo, Gutierrez, and Al-Taweel. Ans. 10.

OPINION

We address Appellant’s arguments on the bases of the prior art references cited in the rejections listed above and Appellant’s arguments regarding those prior art references. *See* App. Br. 4–21; Reply Br. 2–6.

Gallo and Gutierrez

Appellant first argues that the Examiner’s rejection is not clear “exactly what modification and/or substitution would have been obvious to one of ordinary skill in the art.” Reply Br. 2. Appellant’s own argument, however, makes clear what the Examiner’s bases are for the rejection. The Examiner essentially makes two potential, alternative modifications of Gallo in view of Gutierrez. First, the Examiner states that it “is not necessary to use the second prying section.” Final Act. 11. Under this modification, the entire slide mechanism of Gutierrez could be incorporated into Gallo, including the handle at the end. Alternatively, the Examiner simply uses the slide aspects of Gutierrez without otherwise modifying Gallo such that “the

pry section (20) disclosed by Gallo is capable of being grasped by a user's hand." *Id.* The Examiner makes clear that either alternative would have been acceptable. We see no ambiguity in the Examiner's rejection merely because two potential modifications are stated in the alternative. Although the Examiner sets forth two alternatives, we focus primarily on the second alternative in the analysis that follows.

Appellant next argues that the Examiner failed to provide a reasonable basis with rational underpinnings for making the proposed modification, stating "the Examiner's sole reason for modifying Gallo with the sliding tube and shaft arrangement of Gutierrez is because they are alleged alternatives." Reply Br. 4. We find this to be a sufficient basis upon which to make the modification. The Examiner merely points out that the slide configurations in Gallo and Gutierrez are known alternatives and that one of skill in the art could have easily substituted one for the other. Ans. 14. Further, the fact that this modification results in "at least one shortcoming as compared to the unmodified Gallo pry bar" (*see* Reply Br. 4) is unpersuasive. There are often trade-offs in any combination. Here, the absence of a handle provides for a tool that can be used with a slide hammer on either end. We further note that, in operation, even in an unmodified state, a user would have to grasp tool end 24 when using the slide impact at tool end 20 or vice versa. The Examiner's combination does not radically change the manner in which Gallo would be used; it merely changes the configuration of the slide hammer. *See* Final Act. 3. As such we sustain the rejection of claim 1 and its dependent claims.

Specifically regarding claim 5, Appellant argues that the Examiner failed to provide a clear articulation of the reasons for obviousness as well as stating that the reasoning lacks rational underpinning. App. Br. 9. As

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Appellant points out, however, the Examiner laid out at least five reasons as to why the addition of a second slot would have been obvious. *See* Ans. 3, App. Br. 9–10. As to the third basis, in which the Examiner finds that duplicating the slot on both sides rather than on just one side would provide equal leverage for left- and right-handed users, Appellant merely argues that “prying a nail is typically not something performed with a single hand.” App. Br. 10. Appellant offers no evidence in support of this argument and again, equivocates on the statement against the Examiner’s combination. Even if it is not typically done, the Examiner has stated a reasonable basis with rational underpinnings as to why one of skill in the art might have added a second slot, per claim 5. We are not persuaded of error in the rejection of claim 5.

As to claims 12–14, Appellant asserts that the Examiner has misinterpreted the term “approximately.” Reply Br. 4. Appellant asserts that the Examiner failed to “analyze why one of ordinary skill in the art would have considered 5.33 to be approximately 7. *Id.* We disagree. The Examiner has made a reasonable finding that the two ratios are approximate and they are not so far apart for the finding to be invalid on its face. It is then incumbent on Appellant to explain why the two are not close enough to be approximately the same. The only argument Appellant makes is 5.33 is nearly twenty-five percent less than 7 without providing any basis as to why, in this particular application, the two are too far apart to be considered approximate. Simply stating, as Appellant does, that “[o]ne of ordinary skill in the art would not reasonably have considered a value that is 25% less than the reference value to be approximately, almost, or roughly exactly the reference value,” is insufficient to overcome the Examiner’s finding without

more explanation as to why this difference is too great. Reply Br. 5.
Accordingly, we are not persuaded of error.

Appellant also argues that the Examiner's alternative finding, that the claimed ratio is nothing more than routine optimization, is improper because the Examiner did not "provide any variable that modifying the ratio of wedge width to notch width, wedge width to slot width, or slot width to slot length would effect a desired result on." Reply Br. 4 (citing MPEP § 2144(II)). This section of the MPEP merely states that the "strongest rationale" is one where "some advantage or expected beneficial result would have been produced by their combination." MPEP § 2144(II). According to the Examiner's proposed optimization, one of skill in the art would understand that, given Gallo's acknowledgement that the claimed ratio has an effect on performance, such optimization could be tailored to the specific task at hand such that an increase from 5.33 to 7 would be within the skill in this art. Appellant provides no evidence in the form of prior art or declaration that the Examiner's proposed optimization is in error. Accordingly, we sustain the Examiner's rejection of claims 12–14.

Taylor

As to claim 3, Appellant argues that the Examiner's combination is in error because it allegedly "would no longer be suitable for" its intended purpose. Reply Br. 6. Appellant misses the point of the Examiner's combination. The Examiner points out that nothing in Gallo specifies where "the flatness [of Gallo's pry bar] is due to the roof engagement as Appellant claims." Ans. 17. The Examiner goes on to explain that both Gallo and Taylor are used to provide leverage for removing an object and that Taylor's concave taper "allows for enhanced engagement with an object to be acted on while providing additional leverage for removing an object." *Id.* We

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note that, again, Appellant provides no evidence supporting the argument that Taylor would no longer be suitable and even equivocates as to this fact by stating that Gallo's "flat surfaces *presumably* facilitate the first prying section (18) being wedged between a flat roof and the flashing" and that modifying "Gallo with the concave shape of the Taylor tool would *appear* to make it more difficult to wedge the Gallo prying section under the roof flashing." App. Br. 16 (emphasis added). Not only is this unsupported by evidence, but Appellant cannot even argue with certainty that such a result would actually occur. Accordingly, we do not find this argument persuasive.

Al-Taweel

Regarding claim 6 and the claims dependent therefrom, Appellant argues that the Examiner's addition of Al-Taweel's footrest "would be superfluous, since the horizontal use of the pry bar renders it impossible to position a users' foot to apply force at the first pry section." App. Br. 19. Even if the footrest would be superfluous in the horizontal direction, flashing is also installed vertically as well as at other angles besides horizontal, as noted by the Examiner. Ans. 18. Appellant does not argue that the footrest would interfere with the operation in the horizontal position, merely that it would make operation more difficult and it would be unnecessary because it could not be used to pry horizontal flashing. Any combination is often a trade off in costs and benefits and we agree with the Examiner that the inclusion of a footrest could be beneficial, at least when prying non-horizontal flashing.

Appellant further argues that Al-Taweel is non-analogous art because it "is clearly not in the field of automotive tools." App. Br. 20. First, Appellant defines the related art too narrowly. We note that Appellant does

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not argue that Gallo is non-analogous art even though it is also not an automotive tool, but is used to pry flashing. Gallo is appropriately used because it functions to pry in a similar manner to Appellant's claimed device. Similarly, Al-Taweel adds foot loops to provide additional impact. Ans. 11. This additional impact is the same purpose for which Appellant adds foot loops to its tool. As such, Al-Taweel, although for a different application, solves the same problem as Appellant and does so with the same feature, namely foot loops. Accordingly, we are not persuaded of error in the Examiner's combination.

DECISION

For the reasons stated above, all of the Examiner's rejections are Affirmed.

DECISION SUMMARY

Claims Rejected	Basis	Affirmed	Reversed
1, 2, 4, 5, 11–14, and 17–20	§ 103 over Gallo and Gutierrez	All	None
3	§ 103 over Gallo, Gutierrez, and Taylor	3	None
6–10, 15, and 16	§ 103 over Gallo, Gutierrez, and Al-Taweel	All	None

FINALITY AND 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).

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AFFIRMED