

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICK DULIN

Appeal No. 2002-2272
Application 09/375,712

HEARD: March 11, 2003

Before ABRAMS, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Rick Dulin appeals the examiner's decision (Paper No. 5) to reject claims 1 through 16, all of the claims pending in the application.

THE INVENTION

The invention relates to "a method [claim 16] and apparatus [claims 1 through 15] for the compacting of a road shoulder" (specification, page 1). A copy of claims 1 through 16 appears in an appendix to the appellant's main brief (Paper No. 7).

Appeal No. 2002-2272
Application 09/375,712

THE PRIOR ART

The references relied on by the examiner to support the
appealed rejections are:

Cronin	3,072,025	Jan. 8, 1963
Rogers et al. (Rogers)	3,554,291	Jan. 12, 1971
Foertsch	4,900,185	Feb. 13, 1990
Rossburger	5,395,182	Mar. 7, 1995
Hollon et al. (Hollon)	5,507,593	Apr. 16, 1996
Bergman	6,089,785	Jul. 18, 2000

THE REJECTIONS

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(b)
as being anticipated by Rossburger.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being
obvious over Rossburger.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being
obvious over Rossburger in view of Cronin.

Claim 6 stands rejected under 35 U.S.C. § 103(a) as being
obvious over Rossburger in view of Foertsch.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as
being obvious over Rossburger in view of Rogers.

Claims 9 through 12 stand rejected under 35 U.S.C. § 103(a)
as being obvious over Bergman in view of Hollon.

Claim 13 stands rejected under 35 U.S.C. § 103(a) as being
obvious over Bergman in view of Hollon and Cronin.

Appeal No. 2002-2272
Application 09/375,712

Claims 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Bergman in view of Hollon and Rogers.

Claim 16 stands rejected under 35 U.S.C. § 103(a) as being obvious over Cronin.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 7 and 12) and to the examiner's answer (Paper No. 10) for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 102(b) rejection of claims 1 through 3

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something disclosed in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. Kalman v. Kimberly Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Appeal No. 2002-2272
Application 09/375,712

Independent claim 1 recites a shoulder compacting apparatus comprising, inter alia, a ram capable of substantially horizontal linear movement, at least one arm supported for movement relative to the ram, a roller rotatably supported by the at least one arm and a second linear actuator "operably connecting said ram and said at least one arm" whereby the roller is actuated by the linear actuator in substantially vertical movement.

Rossburger discloses a shoulder compacting apparatus towed by a grader. The apparatus includes a pivotable frame 1 on the rear end of the grader, hydraulic cylinders 18 for pivotally raising and lowering the frame relative to the grader, a carriage 22 having tubes 23 and 24 slidable on the frame, a hydraulic cylinder 32 for moving the carriage laterally on the frame, a pivot arm beam 40 on the carriage, and a plurality of compacting wheels 75 depending from the pivot arm beam.

In rejecting claim 1 as being anticipated by Rossburger (see pages 4 and 5 in the answer), the examiner reads the limitations in the claim pertaining to the ram, the arm, the roller and the second linear actuator on Rossburger's carriage tubes 23, 24, pivot arm beam 40, wheels 75 and hydraulic cylinders 18, respectively. Even if the tubes 23, 24, pivot arm beam 40 and wheels 75 respectively embody a ram, arm and roller as recited in

Appeal No. 2002-2272
Application 09/375,712

the claim, neither of the hydraulic cylinders 18 is "operably connecting" the ram (tubes 23, 24) to the arm (pivot arm beam 40) under any reasonable interpretation of this term. As the Rossburger reference does not disclose any other structure meeting this limitation, it is not anticipatory with respect to the subject matter recited in the claim.

Accordingly, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of claim 1, and dependent claims 2 and 3, as being anticipated by Rossburger.

II. The 35 U.S.C. § 103(a) rejections of claims 4 through 8

Since Rossburger, considered alone or in combination with Cronin, Foertsch or Rogers, would not have rendered obvious a shoulder compacting apparatus responding to the second linear actuator limitation in parent claim 1, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 4 as being obvious over Rossburger, the standing 35 U.S.C. § 103(a) rejection of dependent claim 5 as being obvious over Rossburger in view of Cronin, the standing 35 U.S.C. § 103(a) rejection of dependent claim 6 as being obvious over Rossburger in view of Foertsch or the standing 35 U.S.C. § 103(a) rejection of dependent claims 7 and 8 as being obvious over Rossburger in view of Rogers.

III. The 35 U.S.C. § 103(a) rejection of claims 9 through 12

Independent claim 9 recites a shoulder preparing apparatus comprising, *inter alia*, a vehicle, a material applicator supported adjacent the rear end of the vehicle and a compacting apparatus supported adjacent the front end of the vehicle. The claim further defines the compacting apparatus as including a guide member, a ram engaging the guide member, a ram linear actuator supported by the guide member and operably connected to the ram, a pair of laterally spaced arms supported for movement relative to the ram, a roller rotatably supported intermediate the pair of arms, and at least one arm linear actuator operably connecting the ram and at least one of the pair of arms.

Bergman, the primary reference in the rejection of claim 9, discloses a road repair arrangement comprising a dump-truck 20, a material applicator 25 on the truck about midway along its length, and a compacting apparatus in the form of one of the truck's rear wheels 34. The examiner (see pages 8 through 10 in the answer) finds that the material applicator 25 is supported adjacent the rear end of the vehicle as required by claim 9, but concedes that the rear compacting wheel 34 lacks response to the compacting apparatus limitations in the claim. To overcome this admitted deficiency, the examiner turns to Hollon.

Hollon discloses a compacting device (see Figures 11 through 14) comprising a pivotable frame 140 on the front end of a vehicle, a carriage 132 movable along horizontal rails 142 on the frame, a roller 130 on the carriage 132, a hydraulic cylinder 134 between the frame and the carriage for laterally moving the carriage on the rails 142, and a hydraulic cylinder 138 between the frame 140 and the vehicle for applying pressure on the roller 130.

In rejecting claim 9, the examiner concludes that it would have been obvious to provide the Bergman arrangement with Hollin's compacting device "in order to expand the paving tasks of the compacting device to include shoulders and embankments" (answer, page 10). From the examiner's perspective, Hollon's horizontal rails 142, carriage 132, roller 130, and hydraulic cylinder 138 respectively constitute a ram, a pair of laterally spaced arms, a roller, and a linear actuator operably connecting the ram and at least one of the pair of arms as recited in claim 9.

This proposed reference combination is flawed for at least two reasons. First, there is nothing in the combined teachings of Bergman and Hollon which would have motivated the artisan to expand the paving capability of the Bergman arrangement by adding

Appeal No. 2002-2272
Application 09/375,712

a compacting device of the sort disclosed by Hollon. This rationale advanced by the examiner for combining the references stems from hindsight knowledge impermissibly derived from the appellant's disclosure. Second, even if the combination were effected, the result would not meet the compacting apparatus limitations in claim 9 under any reasonable interpretation of these limitations or of Hollon's disclosure of the compacting apparatus.

Additionally, and in the same vein, the examiner's finding that Bergman's material applicator 25, which is midway along the length of truck 20, is supported adjacent the rear end of the vehicle as required by claim 9 rests on an unreasonable interpretation of both the claim and the Bergman disclosure.

Thus, the combined teachings of Bergman and Hollon do not justify the examiner's conclusion that the differences between the subject matter recited in independent claim 9 and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 9, and dependent claims 10 through 12, as being unpatentable over Bergman in view of Hollon.

IV. The 35 U.S.C. § 103(a) rejections of claims 13 through 15

Because neither Cronin nor Rogers cures the shortcomings of the Bergman-Hollon combination relative to the subject matter recited in parent claim 9, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of dependent claim 13 as being obvious over Bergman in view of Hollon and Cronin, or the standing 35 U.S.C. § 103(a) rejection of dependent claims 14 and 15 as being obvious over Bergman in view of Hollon and Rogers.

V. The 35 U.S.C. § 103(a) rejection of claim 16

Independent claim 16 recites a method of preparing road shoulders comprising, inter alia, the steps of providing a roller, providing at least one pivotally mounted arm rotatably supporting the roller, providing an arm linear actuator "operably connected" to the at least one arm, and actuating the arm linear actuator for pivotally moving the arm and thereby vertically moving the roller.

Cronin discloses a pavement roller attachment on the rear end of a grading vehicle. The attachment comprises a telescopic boom 12 mounted for movement about a vertical axis, a horizontal axis and its own longitudinal axis, a vertically oriented piston-cylinder unit shown in Figure 2 (but not described by Cronin) ostensibly for moving the boom about the horizontal axis, a

roller yoke 52 rotatably mounted at the distal end of the boom, adjustable means 32, 36, 40' for fixing the rotational plane of the roller yoke relative to the boom, a cylinder-piston unit 14 for rotating the roller yoke in this plane, and a pavement roller 58 on the roller yoke.

In rejecting claim 16 as being obvious over Cronin (see pages 12 through 14 in the answer), the examiner finds that Cronin's steps of providing roller 58, providing roller yoke 52, providing the vertically oriented piston-cylinder unit shown in Figure 2, and actuating this piston-cylinder unit respectively meet the foregoing method steps in the claim. While the actuation of the vertically oriented piston-cylinder unit seemingly would vertically move the roller 58, there is nothing in Cronin to support the examiner's determination that such actuation would also pivotally move the arm or roller yoke 52 as required by claim 16.

Thus, the examiner's conclusion of obviousness relative to the subject matter recited in claim 16, based as it is on a faulty factual finding as to Cronin's disclosure, is unsound. Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 16 as being obvious over Cronin.

Appeal No. 2002-2272
Application 09/375,712

SUMMARY

The decision of the examiner to reject claims 1 through 16
is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
)	
)	APPEALS AND
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	INTERFERENCES
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JOHN P. MCQUADE)	
Administrative Patent Judge)	

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Appeal No. 2002-2272
Application 09/375,712

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