

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. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte MARTIN K. BOULTON, LORENZO MATTABONI, MARK J. PIVAC, and  
MAXWELL A. WESTON

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Appeal No. 2004-0531  
Application No. 09/871,126

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ON BRIEF

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Before COHEN, STAAB, and NASE, Administrative Patent Judges.  
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 15. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to a work machine, and to a method of providing a self-lubricating suspension system for a

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work machine having a chassis and at least one ground engaging member. A basic understanding of the invention can be derived from a reading of exemplary claims 1, 10, and 14, respective copies of which appear in "APPENDIX A" of the brief (Paper No.9).

As evidence of obviousness, the examiner has applied the documents listed below:

Whiteley	1,743,645	Jan. 14, 1930
Adinoff	3,502,380	Mar. 24, 1970
Hart	4,090,723	May 23, 1978
Hickman et al (Hickman)	6,016,885	Jan. 25, 2000

The following rejections are before us for review.

Claims 1 through 7, 10, and 12 through 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickman in view of Hart and Adinoff.

Claims 8, 9, and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickman in view of Hart, Adinoff, and Whiteley.

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The full text of the examiner's rejections and response to the argument presented by appellants appears in the final rejection and the answer (Paper Nos. 7 and 10), while the complete statement of appellants' argument can be found in the brief (Paper No. 9).

In the brief (page 4), appellants state that claims 1 through 6, 8, 9, 10 through 12, 14, and 15 stand together, and that claims 7 and 13 stand separately. In light of the above and the argument presented, we select claims 1 and 7 for review, with the respective remaining claim(s) of each of the above groupings standing or falling therewith.

#### OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the applied teachings,<sup>1</sup> and

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<sup>1</sup> In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not  
(continued...)

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the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determinations which follow.

We sustain the obviousness rejection of claims 1 and 7. It follows that we also sustain the obviousness rejection of the respective remaining claim(s) in each of appellants' groupings, supra, since these claims stand or fall with claims 1 and 7 as indicated.

Claim 1 is drawn to a work machine, comprising, inter alia, at least one mounting member attached to the chassis of the work machine, at least one elongate member having a first end, said first end rotatably coupled to said mounting member, and a self-lubricating member situated between the first end and mounting member.

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<sup>1</sup>(...continued)  
only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

Claim 7 depends from claim 1 and recites the feature of the self-lubricating member having a thickness of up to 2mm.

In applying the test for obviousness,<sup>2</sup> we conclude that it would have been obvious to replace the known lubricated bearings in a work machine or construction vehicle (Hickman and Hart)<sup>3</sup> with known bearings that are self-lubricating (Adinoff).<sup>4</sup> As we see it, one having ordinary skill in the art would have been motivated to replace bearings of a work machine needing periodic lubrication maintenance with self-lubricating bearings, simply to gain the art recognized benefit of self-lubricating bearings, i.e., no periodic maintenance (lubrication) is needed. Adinoff

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<sup>2</sup> The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

<sup>3</sup> These patents are understood to represent and reflect what appellants have acknowledged as known work machines in the background section of the specification (page 1), which machines include typical bearings which require periodic maintenance (lubrication).

<sup>4</sup> The Adinoff reference is akin to appellants' acknowledgment (specification, page 5) of known "commercially available" self-lubricating bearings that are relatively thin, typically up to and including 2mm.

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expressly addresses the no maintenance advantage of dry bearings over bearings requiring periodic lubrication maintenance (column 1, lines 22 through 52). For these reasons, we sustain the obviousness rejection of claim 1. As indicated (footnote 4), the claimed feature of the self-lubricating member having a thickness of up to 2mm would have been suggested by the prior art. Thus, we also sustain the rejection of claim 7.

The argument of appellants fails to persuade this panel of the Board that the content of claims 1 and 7 is patentable under 35 U.S.C. § 103(a). Contrary to the point of view advocated by appellants (brief, pages 4 and 7), there is a basis or suggestion in the art for combining or modifying the references, as articulated above. Further, we explained above that appellants have acknowledged the problem in the art (specification, page 1) of pendulum armed machines (Hickman and Hart) at the time of the present invention. Thus, from our perspective, to one having ordinary skill in the art when appellants' invention was made, there was a suggestion in the art of the problem, contrary to appellants' point of view (brief, page 5). Clearly, the Adinoff reference is appropriate and analogous prior art since it is reasonably pertinent to the particular lubrication and bearing

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maintenance problems with which appellants were involved. We note that appellants recognize (brief, page 7) that Adinoff teaches "a thickness of 0.050 inches (approximately 1.27mm)", which thickness does fall within the range of a thickness of up to 2mm, as set forth in claim 7. To support the rejection of dependent claims, e.g., claims 2 through 6, 10, 12, and 15 and claims 8, 9, and 11, appellants rely upon the arguments above presented relative to claims 1 and 7, which arguments we concluded are not convincing (brief, page 6, 8 and 9).

In summary, this panel of the board has sustained the respective rejections of appellants' claims under 35 U.S.C. § 103(a).

The decision of the examiner is affirmed.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
LAWRENCE J. STAAB	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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