

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte KIRK R. ALLEN

Appeal No. 2004-1844
Application No. 09/522,023

ON BRIEF

Before COHEN, ABRAMS and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-19 and 21-26. Claim 20, the only other claim pending in this application, stands objected to as depending from a rejected claim but is otherwise indicated as containing allowable subject matter.

We REVERSE.

BACKGROUND

The appellant's invention relates to a bolt-on wheel cover that is integrally retained to, but thermally isolated from, lug nuts of a vehicle wheel (specification, page 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The examiner relied upon the following prior art references in rejecting the appealed claims:

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|-------------------------------------|-------------|----------------------------|
| Toth | 5,520,445 | May 28, 1996 |
| Inaba (Japanese patent document) | JP 63-87301 | Apr. 18, 1988 ¹ |

The following rejections are before us for review.

Claims 24-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Inaba.

Claims 13-19 and 21-26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Toth.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection and answer (Paper Nos. 18 and 23) for the examiner's complete reasoning in

¹ We derive our understanding of this application from the English language translation provided by appellant with Paper No. 11.

support of the rejections and to the brief and reply brief (Paper Nos. 22 and 24) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We turn our attention first to the rejection of claims 24-26 as being anticipated by Inaba. Each of these claims recites, inter alia, means for establishing a predetermined preload between the wheel cover and the wheel, the predetermined preload being applied proximate a radially outer portion of the wheel cover and the wheel (claims 14 and 26) or means for establishing a preload on a radially outer portion of the plastic wheel cover (claim 25) and at least one thermal isolator integrally mounted to an elongated tubular extension of the wheel cover. Appellant argues that neither of these features is disclosed by Inaba.

We share the examiner's view that Inaba's bushing 41 thermally isolates the wheel cover from the wheel nut and from the wheel (see page 3 of the translation) and thus responds structurally to the thermal isolator recited in appellant's claims 24-26. Appellant's argument on page 10 of the brief attempting to differentiate between thermal isolation and thermal delay is unconvincing. The "heat insulating effect"

(translation, page 3) of Inaba's bushing 41, while, as in all real-world applications, not a complete block to the transmission of heat, would be considered to be a thermal isolator by those skilled in the art.

It is puzzling to us that, notwithstanding that the means for establishing a predetermined preload is one of the features in dispute in this appeal, neither appellant nor the examiner has specifically identified the structure in appellant's underlying disclosure which corresponds to the means recitation so as to determine whether Inaba discloses that structure or an equivalent thereof in accordance with 35 U.S.C. § 112, sixth paragraph. We understand the corresponding structure in appellant's underlying disclosure to be the contour of the wheel cover 60 relative to the contour of the wheel 20 and lug nuts 40, wherein the bottom or apical portion of the lug tower 66 of the cover 60 when placed against the wheel 20 prior to tightening the lug nuts is spaced from its position after tightening so as to create a drawdown, as indicated by arrow A in Figure 1. In other words, the wheel cover is shaped so that it will be deformed inwardly when tightened against the wheel by the lug nuts.

While the examiner is correct that Inaba discloses that such a pre-load arrangement was known in the prior art (Figure 1(C) and translation, page 2), Inaba also teaches that such an arrangement is problematic, in that, as a result of creep in the plastic material, the force pulling to the right in Figure 1(C) gradually diminishes and ceases to be effective, causing "squeal/squeak/hum" if a gap C forms, and pre-load

stress and vibration/shock stress concentrations are created in the region of the bottom 11 of the cover. Thus, instead of the pre-load arrangement known in the prior art, Inaba discloses provision of a bushing 41 which both slows the transmission of heat from braking to the cover and provides elasticity to the wheel cover taper hole to allow for expansion and contraction and absorb vibrations. The examiner's determination that "[t]he cover is of the same construction as that shown in figures 1A-D" (final rejection, page 2) and that "[t]he difference between the prior art wheel cover and the inventive wheel cover of Inaba is the heat-resistant bushing" (answer, page 4) is speculative at best, as Inaba never states that the "pre-expanded" cover of prior art Figure 1(C) is used in the inventive wheel assembly. It is well established that an anticipation rejection cannot be predicated on an ambiguous reference. Rather, disclosures in a reference relied on to prove anticipation must be so clear and explicit that those skilled in the art will have no difficulty in ascertaining their meaning. In re Turley, 304 F.2d 893, 899, 134 USPQ 355, 360 (CCPA 1962). In fact, Inaba's teaching that the pre-loaded cover arrangement is problematic because of the resulting stress concentrations appears to us to teach against using such an arrangement.

For the foregoing reasons, we cannot sustain the examiner's rejection of claims 24-26 as being anticipated by Inaba.

We turn next to the rejection of claims 13-19 and 21-26 as being unpatentable over Toth.² The very same features mentioned above, the means for establishing a preload and the thermal isolator, are in dispute with regard to this rejection. While the disclosure in column 3, line 67, to column 4, line 9, of Toth appears to be directed to a preload arrangement of the type disclosed by appellant, the examiner's position that the skirt 63, illustrated in Figure 5, is a thermal isolator is unsound. The skirt 63 overlies the nut body flange 64 and extends through the aperture 28 in the wheel cover 12 and comprises a substantially U-shaped axially extending channel 60 with an outwardly turned edge 62 to prevent withdrawal of the lug nut from the wheel cover. While it does, by engaging the periphery of the aperture 28 of the wheel cover, space the wheel cover from the wheel, we find no teaching or suggestion in Toth that the skirt 63 provides any thermal isolation function. It follows that we cannot sustain the examiner's rejection of claims 13-19 and 21-26 as being unpatentable over Toth.

² We note, at the outset, that the examiner has not followed the procedure outlined in Section 706.02(j) of the Manual of Patent Examining Procedure (MPEP) for setting forth an obviousness rejection under 35 U.S.C. § 103 by expressly identifying a difference between the claimed subject matter and the disclosure of Toth or proposing a modification of Toth to arrive at the claimed invention. The examiner's statement on page 3 of the final rejection that "it is obvious that thermal isolation of the cover from the wheel would be achieved ..." more closely resembles a statement of inherency than a proposed modification of the reference.

CONCLUSION

To summarize, the decision of the examiner to reject claims 24-26 under 35 U.S.C. § 102 and claims 13-19 and 21-26 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2004-1844
Application No. 09/522,023

Page 8

VANOPHEM & VANOPHEM, PC
REMY J VANOPHEM, PC
51543 VAN DYKE
HELBY TOWNSHIP, MI 48316-4447