

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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

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Ex parte BERND KLITSCH, STEFAN BREHM and MICHAEL MULLER

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Appeal No. 2005-1708  
Application No. 10/370,122

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ON BRIEF

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Before FRANKFORT, MCQUADE 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 1-8, which are all of the claims pending in this application.

**BACKGROUND**

The appellants' invention relates to a damping element between two masses, comprising a container tube 8, a piston 11 arranged in the container tube, a piston rod 12 connected to the piston and a fixing component 1 to connect the damping element to one of the two masses, the piston rod being connected to the other of the two masses.

The fixing component comprises a base 4 with a centering extension 5, a stem 3 and a fork 2 with fixing holes forged as one piece. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

### ***The Applied Prior Art***

The examiner relied upon the following prior art references of record as evidence of anticipation and obviousness in rejecting the appealed claims:

Finn et al. (Finn)	4,377,298	Mar. 22, 1983
Niaura et al. (Niaura)	6,318,521	Nov. 20, 2001

### ***The Rejections***

The following rejections are before us for review.

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Niaura.

Claims 6-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Niaura.

Claim 2 stands rejected under 35 U.S.C. § 103 as being unpatentable over Niaura in view of Finn.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed October 19, 2004) for the examiner's complete reasoning in support of the

rejections and to the brief (filed August 5, 2004) and reply brief (filed December 22, 2004) for the appellants' arguments thereagainst.

### OPINION

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

We turn first to the rejection of claims 1 and 3-5 as being anticipated by Niaura. Independent claim 1 expressly recites that the fixing component comprises a base, a stem, and a fork which are "made as a single piece." The examiner concedes on page 3 of the answer that Niaura's cylindrical portion 9 and U-shaped strap 10, the structure relied upon by the examiner as responding to the base, stem and fork of the fixing component in appellants' claim 1, are made of two pieces connected together (see column 4, lines 1-3). The examiner, however, takes the position that "[t]he mere fact that a given structure is a single piece does not preclude its consisting of two separate pieces [joined] together." For the reasons stated on pages 5 and 6 of the brief and page 2 of the reply brief, the examiner's position is not well taken. Two separate pieces joined together do not form a structure "made as a single piece." Accordingly, claim 1 is

not anticipated<sup>1</sup> by Niaura. The rejection of claim 1, as well as claims 3-5, which depend from claim 1, as being anticipated by Niaura is not sustained.

As explained above, Niaura lacks a fixing component comprising a base, stem and fork which are made as a single piece. We find no suggestion in Niaura, and the examiner has pointed to no such suggestion, to form the hollow cylindrical portion 9 and U-shaped strap 10 connected thereto as a single piece so as to arrive at the invention recited in independent claim 1. It thus follows that the rejection of claims 6-8, which depend from claim 1, cannot be sustained.

Finally, we turn our attention to the rejection of claim 2 as being unpatentable over Niaura in view of Finn.<sup>2</sup> Finn evidences that it was well known in the art at the time of appellants' invention to form a yoke-shaped element for connecting the sleeve 24 of a hydraulic damper in a vehicle suspension with one of the masses (the drive axle) of the vehicle as a single element by forging, the element comprising legs 28, 30 and an integral tubular portion accepting the sleeve 24. In light of the teachings of Finn, it would have been obvious to one of ordinary skill in the art to form the cylindrical portion

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<sup>1</sup> Anticipation is established only when a single prior art reference discloses, expressly or under the 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). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1896, 1010 (Fed. Cir. 1991).

<sup>2</sup> On page 6 of the answer, the examiner also referred to Breese (US Pat. No. 5,611,135, issued March 18, 1977), but this reference has been given no consideration since it was not positively included in the rejection. Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993). Where a reference is relied on to support a rejection, whether or not in a "minor capacity," there would appear to be no excuse for not positively including the reference in the statement of rejection. In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970).

9 and U-shaped strap 10 of Niaura's damper as a single piece by forging as an art-recognized alternative to the two-piece formation disclosed by Niaura.

The appellants argue that "[t]here is simply no way that the cylindrical section 9 and the fork 10 could be forged as one piece, because the cylindrical section 9 is a tubular section which receives the piston rod 19" (brief, page 7). Finn's disclosure of a forged yoke-shaped element comprising legs 28, 30 integral with a tubular portion clearly belies this argument. Appellants' argument on page 3 of the reply brief that Finn only discloses that a fork can be forged fails to appreciate Finn's teaching of forging the legs 28, 30 with a tubular portion accepting a separate sleeve 24 and is likewise not well taken. Appellants' arguments on pages 3-4 of the reply brief directed to the Breese patent have not been considered, as Breese was not relied on in the examiner's refection of claim 2, as noted above. Inasmuch as appellants' arguments fail to persuade us of any error on the part of the examiner in rejecting claim 2 as being unpatentable over Niaura in view of Finn, the rejection is sustained.

We note the that the examiner has not rejected claim 1, from which claim 2 depends, as being unpatentable over Niaura in view of Finn. Nevertheless, it logically follows from our decision herein sustaining the examiner's rejection of claim 2 as being unpatentable over Niaura in view of Finn that claim 1 is likewise unpatentable over Niaura in view of Finn. Thus, in the event of further prosecution in this application, the examiner should take appropriate action with respect to independent claim 1 in light of the affirmance of the rejection of dependent claim 2.

CONCLUSION

To summarize, the rejections of claims 1 and 3-5 as being anticipated by Niaura and claims 6-8 as being unpatentable over Niaura are reversed and the rejection of claim 2 as being unpatentable over Niaura in view of Finn is sustained. The examiner's decision is affirmed-in-part.

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

AFFIRMED-IN-PART

CHARLES E. FRANKFORT  
Administrative Patent Judge

JOHN P. MCQUADE  
Administrative Patent Judge

JENNIFER D. BAHR  
Administrative Patent Judge

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