

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

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

Ex parte ILYA LISENKER
and
SAIMAN LUN

Appeal No. 2005-2108
Application No. 10/360,982

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 8 and 10 to 12. Claim 9, which is the only other claim pending in this application, has been objected to as depending from a non-allowed claim.

We REVERSE.

BACKGROUND

The appellants' invention relates to a suspension damper with rebound cut-off for use in a vehicle suspension system and, more particularly, to a suspension damper with a hydraulic rebound cut-off feature that provides a hydraulically cushioned stop at an end of rebound travel in the damper (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Curnutt	4,126,302	Nov. 21, 1978
Neff	4,828,237	May 9, 1989
Ivers et al. (Ivers)	6,158,470	Dec. 12, 2000

Claims 1, 2, 4 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Curnutt.

Claim 7 stands rejected under 35 U.S.C. § 103 as being unpatentable over Curnutt in view of Neff.

Claims 3, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Curnutt in view of Ivers.¹

Claims 10 to 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Curnutt in view of Ivers and Neff.²

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 February 23, 2005) for the examiner's complete reasoning in support of the rejections, and to the brief (filed December 20, 2004) and reply brief (filed April 18, 2005) 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. Upon evaluation of

¹The inclusion of claims 10 to 12 in this ground of rejection was inadvertent (see answer, p. 10).

²The omission of Neff in the statement of this rejection was inadvertent (see answer, p. 10).

all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 8 and 10 to 12 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the claims under appeal are drawn to a strut assembly having a suspension damper comprising, inter alia, (1) a substantially vertically-oriented tube having a top end and a bottom end; (2) a rod guide assembly closing the bottom end of the tube; (3) a damping piston assembly disposed within the tube and slidably mounted therein for reciprocal movement in the tube, wherein the tube is substantially filled with a liquid having a specific gravity that damps the reciprocating movement of the damping piston

assembly within the tube; (4) a piston rod connected to the damping piston assembly and extending through the tube and the rod guide assembly; (5) a rebound cut-off disk suspended in the tube between the rod guide assembly and the damping piston assembly and cooperating with the damping piston assembly to provide a rebound cut-off effect between the rebound cut-off disk and damping piston assembly; and (6) a spring disposed between the rebound cut-off disk and the rod guide assembly, wherein the disk has a specific gravity that is greater than the specific gravity of the liquid whereby the disk moves in the fluid toward the bottom end in response to its own weight.

Curnutt's invention relates to an inertia-responsive shock absorber arranged to be horizontally mounted for absorbing rear wheel shocks of a motorcycle. The shock absorber is designed to be horizontally mounted on a motorcycle and incorporates a weight responsive to acceleration and deceleration forces developed by the motorcycle itself. The arrangement is such that the weight will decrease the damping hydraulic fluid resistance under accelerating conditions and increase the hydraulic damping fluid resistance under decelerating conditions.

Curnutt does not disclose a strut assembly having a suspension damper having a substantially vertically-oriented tube as recited in the claims under appeal.³

With regard to this difference, the examiner determined (answer, p. 4) that:

It is inherent to orient the damper [of Curnutt] in a substantially vertical position whereby the disk and spring will move toward the bottom end in response to its own weight and is known in the art that damper can be used in various positions. It would have been obvious to one of ordinary skill in the art to have utilized the damper of Curnutt in substantially vertical positioning in order to vary the effective resistance to the fluid flow from one side of the piston to the other side so as to absorb shocks.

The appellants argue that it would not have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified Curnutt's shock absorber to be substantially vertically-oriented. We agree. Curnutt's shock absorber is horizontally-oriented in order to function as an inertia-responsive shock absorber for absorbing rear wheel shocks of a motorcycle. As such, there is no reason why a person having ordinary skill in the art would have rotated Curnutt's shock absorber to be vertically-oriented. The examiner's determination of obviousness has

³After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

not been supported by any evidence that would have led an artisan to have modified Curnutt so as to arrive at the claimed invention.

In our view, the only suggestion for modifying Curnutt in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 8 and 10 to 12 under 35 U.S.C. § 103 is reversed.⁴

⁴We have also reviewed the references to Neff and Ivers additionally applied in the rejection of claims 3, 5 to 7 and 10 to 12 but find nothing therein which makes up for the deficiencies of Curnutt discussed above.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 8 and 10 to 12 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT
Administrative Patent Judge

JOHN P. McQUADE
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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