

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0178
Application No. 09/877,188

HEARD: JANUARY 11, 2006

Before GARRIS, FRANKFORT, and NASE, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal which involves claims 1-32, 37-87, 92-95, 100-104, 109-118 and 122-130.

The subject matter on appeal relates to a snowmobile. With reference to Figure 2 of the appellants' drawing, the snowmobile comprises a frame (14), a seat having first and second seat positions (52, 54), a forward-most drive track axle (44), a steering device (32) having a steering position (34) and a steering shaft (36) operatively connecting two skis to the steering device for steering the snowmobile. The appellants' claimed snowmobile possesses certain features such as

the feature wherein the steering shaft is disposed over the snowmobile engine at an angle ϵ of less than 45° from vertical, the feature wherein the first seat position is disposed less than 590 mm behind the forward-most drive track axle, and the feature wherein the steering position is disposed forward of the forward-most drive track axle. This appealed subject matter is adequately represented by independent claims 1 and 118 which read as follows:

1. A snowmobile, comprising:

a frame;

a straddle-type seat disposed on the frame;

first and second seat positions defined by the seat;

an engine disposed on the frame in front of the seat;

a drive track disposed below the frame and connected operatively to the engine for propulsion of the snowmobile;

a forward-most drive track axle disposed on the frame;

two skis disposed on the frame;

a steering device having a steering position; and

a steering shaft operatively connecting the two skis to the steering device for steering the snowmobile, wherein the steering shaft is disposed over the engine at an angle ϵ of less than 45° from vertical, the first seat position is disposed less than 590 mm behind the forward-most drive track axle, the second seat position is disposed behind the first seat position by between 265 mm and 365 mm, and the steering position is disposed forward of the forward-most drive track axle.

118. A snowmobile, comprising:

a frame;

a straddle-type seat disposed on the frame;

an engine disposed on the frame in front of the seat;

a drive track disposed below the frame and connected operatively to the engine for propulsion of the snowmobile;

a forward-most drive track axle disposed on the frame;

two skis disposed on the frame;

a steering device having a steering position; and

a steering shaft operatively connecting the skis to the steering device for steering the snowmobile, wherein the steering position is disposed forward of the forward-most drive track axle.

The prior art set forth below is relied upon by the examiner as evidence of obviousness:

Christensen et al. (Christensen)	3,734,219	May 22, 1973
Atherley	5,944,380	Aug. 31, 1999

The admitted prior art as presented in Figures 1 and 8 of the appellants' drawing and as described on pages 1-2 of the appellants' specification.

Claims 1-21, 24, 26-32, 37-47, 50, 52-65, 67-75, 77-87, 92-95, 100-104, 109-118 and 122-130 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the appellants' admitted prior art in view of Christensen, and claims 22, 23, 25, 48, 49, 51, 66 and 76 are correspondingly rejected over the aforementioned prior art and further in view of Atherley.

Rather than reiterate the respective positions advocated by the appellants and by the examiner concerning these rejections, we refer to the brief and to the answer for a complete exposition thereof.

OPINION

For the reasons which follow, we cannot sustain either of the above-noted rejections.

The examiner acknowledges that the appellants' admitted prior art contains no teaching or suggestion of a snowmobile having the here claimed features wherein the steering shaft is

disposed over the engine at an angle ε of less than 45° from vertical and wherein the steering position is disposed forward of the forward-most drive track axle. However, the examiner finds that Christensen discloses a snowmobile having these features and concludes that it would have been obvious for an artisan to provide the admitted prior art snowmobile with these features in order to “help provide a stable steering system” (answer, page 6). Regarding certain other features claimed by the appellants (e.g., the previously mentioned claim feature wherein the first seat position is disposed less than 590 mm behind the forward-most drive track axle), the examiner’s obviousness conclusion appears to be based on the proposition that “discovering an optimum value of a result effective variable ... involves only routine skill in the art” (answer, page 6).

With respect to this last mentioned point, it is generally correct to conclude that it would have been obvious for an artisan to develop workable or even optimum values for art-recognized, result-effective parameters. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936-37 (Fed. Cir. 1990); In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980); In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Nevertheless, it is clear that this generality does not support the examiner’s obviousness conclusion regarding the here claimed feature wherein a first seat position is disposed less than 590 mm behind the forward-most drive track axle. This is because the corresponding disposition of the first seat position in the appellants’ admitted prior art snowmobile is 905 mm (i.e., A+D of the conventional snowmobile shown in Figure 8).¹ Manifestly, the appellants’ claimed dimension is far outside the

¹ It is appropriate to emphasize that the appellants’ claimed first seat position cannot be reasonably interpreted as being located at any point on the snowmobile seat. This is because the phrase “seat position” has been expressly disclosed by the appellants (e.g., see the first two paragraphs on specification page 8 as well as Figures 9 and 10 of

corresponding dimension of the admitted prior art. It is well settled that the discovery of optimum values, which are far outside the prior art values and not in anyway suggested by the prior art as here, likely would not have been obvious. In re Sebek, 465 F.2d 904, 907, 175 USPQ 93, 95 (CCPA 1972).

It follows that we can not agree with the examiner's obviousness conclusion concerning the above-discussed disposition of the first seat position as claimed by appellants.

We also can not agree with the examiner's above-noted finding that Christensen discloses the here-claimed feature wherein the steering shaft is disposed over the engine at an angle ϵ of less than 45° from vertical. In support of his finding, the examiner refers to patentee's teaching that "axes p are at an angle t which may be approximately 25° more or less" (column 2, lines 44-45). However, this angle relates to axes p of steering shafts 11,12 which are connected to skis 19, 20 and are disposed along the outer sides of the snowmobile rather than over the engine as claimed (see lines 30-49 in column 2 as well as Figures 2 and 3 of the drawing). While these steering shafts are ultimately connected to patentee's steering handle 10, the specifics of this connection are unknown since it is referred to by Christensen merely as "conventional linkage, not shown" (column 2, lines 31-32).

Apparently, the examiner believes that this conventional linkage includes a steering shaft disposed over the engine at an angle less than 45° as claimed by appellants. As reflected by our discussion above, there is no evidentiary basis for such a belief. We are constrained, therefore,

the drawing) as particular positions on a snowmobile that are adapted to function as the seat position for a standard rider having specific dimensions. See generally Phillips v. AWH Corp., 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005).

to regard this belief as nothing more than conjecture, speculation or assumption on the examiner's part. It has long been settled that a Section 103 rejection must rest on a factual basis rather than conjecture, speculation or assumption. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967); cert. denied, 389 U.S. 1057 (1968).

Under these circumstances, it is clear that the examiner's factual finding and consequent obviousness conclusion are improper with respect to the steering shaft disposition claimed by the appellants.

As for the here claimed feature wherein the steering position is forward of the forward-most drive track axle, we fully share the examiner's finding that Figure 3 of Christensen unquestionably shows this feature. The appellants' contrary view is vitiated by their own annotation of Figure 3 which appears on page 26 of their brief. Moreover, the definition of steering position at paragraph [0041] on specification page 8 militates for the examiner's finding, rather than against it as argued by appellants. That is, when Christensen's steering position is considered to be the center of the handlebar grips (i.e., when the skis are positioned straight-forward) in accordance with the specification definition, it is clear (particularly when viewing appellants' annotation of patentee's Figure 3) that the steering position of Christensen's steering handle 10 is disposed forward of the forward-most drive track axle.²

² This interpretation of the claim phrase "steering position" is perhaps the most narrow provided by the appellants' specification. Of course, during examination proceedings, claims are given their broadest reasonable interpretation consistent with the specification. In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). When so interpreted, the here claimed steering position would include the center stem portion of Christensen's handlebars since this stem is located at "the center of [i.e., the center between] the grips of the handlebars" (specification, page 8, paragraph [0041], last line). Under such an interpretation, the propriety of the examiner's finding cannot be gainsaid.

Although the examiner's finding is correct, his obviousness conclusion derived from this finding is erroneous. As previously indicated, the examiner concludes that it would have been obvious for an artisan to provide the admitted prior art snowmobile with a steering position forward of the forward-most drive track axle in accordance with Christensen in order to "help provide a stable steering system" (answer, page 6). While the objective of Christensen's invention is indeed to provide a stable steering system (e.g., see lines 37-39 in column 1), the reference contains no teaching or suggestion that the steering position and axle disposition shown in Figure 3 helps to achieve this stable steering objective. Instead, it is the particular steering system or suspension designed by patentee which provides the desired stability (e.g., see lines 39-60 in column 1 and lines 12-14 in column 2).

Thus, an artisan would not have been motivated to provide the admitted prior art with the steering position and axle disposition shown in Figure 3 of Christensen in order to "help provide a stable steering system" (answer, page 6) as urged by the examiner. Again, this is because the Christensen patent contains no teaching or suggestion that the disposition in question helps to achieve patentee's stable steering system objective. The examiner's obviousness conclusion still would be improper even if we were to assume that the disposition shown in Figure 3 helps to stabilize Christensen's steering system. This is because the steering system designs of Christensen and the admitted prior art are entirely different. Therefore, no reasonable expectation exists for believing that a feature helpful in stabilizing the Christensen steering system would be successful in stabilizing the admitted prior art steering system. See In re O'Farrell, 853 F.2d 894, 903-4, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (obviousness requires a reasonable expectation of success).

In light of the foregoing and because each of the independent claims on appeal is limited to at least one of the above-discussed features of the appellants' invention, we cannot sustain the examiner's Section 103 rejection based on the admitted prior art in view of Christensen.

Because the informalities of this rejection are not cured by Atherley, we also cannot sustain the examiner's Section 103 rejection based on the admitted prior art in view of Christensen and further in view of Atherley.

It follows that we hereby reverse each of the rejections advanced by the examiner on this appeal.

REMAND

As previously explained, the examiner has correctly found that the snowmobile of Christensen possesses the appellants' claimed feature wherein the steering position is disposed forward of the forward-most drive track axle. Nevertheless, we reversed the examiner's Section 103 rejection of claims reciting this feature because the examiner had inappropriately concluded that it would have been obvious to provide the admitted prior art snowmobile with this feature of Christensen. Notwithstanding this reversal, the record presents an issue as to whether certain of these claims are unpatentable over Christensen alone or in combination with other prior art.

In particular, independent claim 118 is directed to a snowmobile having the above-mentioned feature. Moreover, the only argument concerning claim 118 is restricted to this feature. With respect to Christensen specifically, the appellants argue that "Christensen ... can not anticipate or render obvious claim 118 as there is no disclosure or suggestion of a steering position disposed forward of the forward-most drive track axle" (Brief, page 74). This argument is not well taken for reasons set forth earlier.

Accordingly, we hereby remand this application to the examiner for the purpose of addressing and resolving on the written record whether claim 118 should be rejected under 35 U.S.C. § 102(b) as being anticipated by, or under 35 U.S.C. § 103(a) as being obvious over, Christensen taken alone (or in combination with other prior art under § 103).

Independent claim 104 is directed to a snowmobile having the above-discussed feature as well as the feature wherein the frame is between about 1493 mm and 1913 mm long. These two features are the only limitations of claim 104 which have been argued by the appellants in their brief. In this regard, the appellants contend that “Claim 104 is not anticipated or rendered obvious by Christensen ... as there is no disclosure or suggestion of a steering position disposed forward of the forward-most drive track axle, nor is there any disclosure or suggestion of a frame between 1493 and 1913 mm long” (Brief, page 69).

Again, there is no convincing merit in the appellants’ argument concerning the steering position feature. As for the claim length feature, it is true that the Christensen patent contains no teaching or suggestion of appellants’ claimed frame length. However, it is significant that patentee repeatedly describes his snowmobile as being conventional except for the steering system or suspension of his invention (e.g., see lines 37-39 in column 1 and lines 12-14 in column 2). This is significant because the conventional snowmobile disclosed in Figure 8 of the appellants’ drawing has a frame length which reasonably appears to be within the here claimed range of between about 1493 mm and 1913 mm. For example, in the conventional short frame snowmobile of Figure 8, the distances for reference characters B, D, F and N total 1575 mm. This fact reasonably supports the proposition that a conventional short frame snowmobile possesses a frame length within the appellants’ claimed range. Since the snowmobile of

Christensen is described as conventional except for the steering system or suspension, there appears to be a prima facie case for concluding that it would have been obvious to provide the conventional snowmobile of Christensen with a conventional short frame length of the type disclosed in Figure 8 of the admitted prior art.

For this reason, we also hereby remand this application to the examiner for the purpose of addressing and resolving on the written record whether independent claim 104 should be rejected under 35 U.S.C. § 103(a) as being obvious over Christensen in view of the admitted prior art disclosed in Figure 8 of the appellants' drawing.

Independent claim 52 is directed to a snowmobile having the above discussed steering position feature as well as the feature wherein a back end of the seat extends behind a rearward-most portion of the frame. These are the only features of claim 52 which have been argued by the appellants in their brief (see pages 58-59).

The appellants' argument that Christensen does not disclose the steering position feature is unpersuasive as stated earlier. While it is true that the Christensen patent does not show the feature wherein the seat back end extends behind the rearward-most portion of the frame, it is our view that this feature is shown in the admitted prior art snowmobile illustrated in Figure 1 of appellants' drawing.

Alternatively, the conventional short frame snowmobile disclosed in Figure 8 of appellants' drawing includes the same rearward disposition for the back of frame and the back of seat, that is, the distance between the back of frame and back of set is zero (see reference character M in Figure 8). Thus, for a conventional short frame snowmobile, the seat back end extends up to, though not behind as here claimed, a rearward-most portion of the frame.

Nevertheless, the fact that the seat back end of a conventional snowmobile may extend up to the rearward-most portion of the frame provides a reasonable expectation of success for a seat back end which extends, for example, 1 mm behind the rearward-most portion of the frame. The 1 mm difference between these two seat back end dispositions is so small that an artisan would have reasonably expected a disposition 1 mm behind the frame rear to possess the same acceptable properties (e.g., comfort) as the conventional disposition (i.e., wherein the seat back end extends up to, though not behind, the frame rear). See Titanium Metals Corp. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Thus, from our perspective, the appellants' admitted prior art appears to expressly show (see Figure 1), or at less would have suggested based on a reasonable expectation of success (see Figure 8), a conventional snowmobile wherein the back end of the seat extends behind a rearward-most portion of the frame as required by independent claim 52. For this reason and because Christensen describes his snowmobile as conventional except for the steering system or suspension, there appears to be a prima facie case for concluding that it would have been obvious for an artisan to provide Christensen's snowmobile with the seat back end feature under consideration in view of the admitted prior art disclosed in Figures 1 and 8 of appellants' drawing. This provision would have been motivated by the desire for a snowmobile which successfully and comfortably accommodates a rear-most rider (e.g., as shown in appellants' Figure 1) who is larger than average.

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