

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0320
Application No. 10/293,833

ON BRIEF

Before FRANKFORT, BAHR, and LEVY, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 27, all of the claims remaining in the application. Claims 1 through 9 have been canceled.¹

Appellant's invention relates to a non-metallic gas valve assembly for a shock absorber and to a shock absorber assembly including such a non-metallic valve assembly. Independent claims

¹ Claims 10, 14, 20, 23 and 26 were amended subsequent to the final rejection in a paper filed concurrently with the brief on March 2, 2005.

10, 23 and 26, each of which are directed to a shock absorber assembly, are representative of the subject matter on appeal and a copy of those claims can be found in the amendment filed March 2, 2005.

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

Gibson, Jr. (Gibson)	3,100,498	Aug. 13, 1963
Martin	4,568,081	Feb. 4, 1986

In addition to the foregoing prior art patents, the examiner has also relied upon appellant's admitted prior art (AAPA) found in paragraph 3 on page 1 of the specification.

Claims 10 through 27 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Martin and Gibson.²

² As indicated on page 10 of the answer, the examiner has determined that the amendment filed March 2, 2005 has overcome the rejection of claims 10 through 27 under 35 U.S.C. § 112, second paragraph, set forth on pages 3-4 of the final

Rather than reiterate the examiner's specific comments regarding the above-noted obviousness rejection and the conflicting viewpoints advanced by the examiner and appellant regarding that rejection, we make reference to the examiner's answer (mailed June 6, 2005) for the reasoning in support of the rejection, and to appellant's brief (filed March 2, 2005) and reply brief (filed June 27, 2005) for the arguments thereagainst.

OPINION

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

rejection. Thus, that rejection is no longer before us on appeal.

above-noted rejection under 35 U.S.C. § 103(a) will not be sustained. Our reasons follow.

The examiner's basic position concerning the rejection of claims 10 through 27 is set forth on pages 4-10 of the answer.³ For argument sake, in considering the examiner's obviousness rejection of the appealed claims, we have made the assumption that the examiner has correctly determined that Martin and Gibson are analogous prior art. However, after a consideration of the collective teachings of the applied patents and the AAPA, we must agree with appellant that there is no reasonable teaching, suggestion or motivation in the AAPA or either of Martin and Gibson, considered individually or collectively, for making the particular combination asserted by the examiner. In the final

³ Although the examiner has determined that the AAPA "lacks a valve as claimed" (answer, page 4), we note that the claims on appeal do not actually recite a gas valve or gas valve assembly associated with or forming a part of the shock absorber assembly defined therein. The claims on appeal merely recite some structure having a first portion mounted within a threaded opening of the shock absorber body and being formed of a first non-metallic material, and a second portion formed of a second non-metallic material less rigid than the first material and comprising a plug and a seal interconnected by a connecting member.

analysis, it is our view that the examiner is using the hindsight benefit of appellant's own disclosure to combine the non-metallic needle valve assemblies shown and described in Martin and Gibson, where they are used for inflating footballs, basketballs and soccer balls having an operating pressure in the range of about 3 psi, with the clearly distinct field of vehicle shock absorbers of the type described in the AAPA, where significantly higher pressures would be involved.

From our perspective, the examiner has merely used appellant's claimed invention as an instruction manual or "template" in an attempt to piece together disparate teachings of the prior art so that the claimed invention is rendered obvious. This approach to a determination of obviousness is improper and cannot be sanctioned by this Board. See In re Gorman, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed Cir. 1991) and Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

In formulating the rejection on appeal, the examiner appears to have lost sight of the fact that when determining

the patentability of a claimed invention which relies on the combination of two known elements, the question to be answered is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. In this case, we find that there is simply nothing in the disparate teachings of the applied prior art patents and the AAPA which would have indicated a desirability for their combination and thus have led one of ordinary skill in the art at the time of appellant's invention to such a combination.

Since we have determined that the teachings and suggestions found in the AAPA, Martin and Gibson would not have made the subject matter as a whole of independent claims 10, 23 or 26 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 11 through 22, 24, 25 and 27 under 35 U.S.C. § 103(a) based on the AAPA, Martin and Gibson also will not be sustained.

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In light of the foregoing, the decision of the examiner is reversed.

Appeal No. 2006-0320
Application No. 10/293,833

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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JENNIFER D. BAHR) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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STUART S. LEVY)
Administrative Patent Judge)

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