

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

Appeal No. 2006-0600  
Application No. 10/163,249

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 6, 7, 9, 12 through 15, 17, 18, 20 and 25 through 30, all the claims remaining in the application. Claims 5, 8, 10, 11, 16, 19 and 21 through 24 have been cancelled.

Appellant's invention relates to a leaf spring assembly (Fig. 1) and a pivot bushing used therein that has an anti-walkout feature to stop the tendency of the eye of the leaf spring to walk

out of, or off of, the bushing. Independent claims 1, 12, 25 and 28 are representative of the subject matter on appeal and a copy of those claims can be found in Appendix A of appellant's brief.

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

Dawda et al. (Dawda)	5,941,511	Aug. 24, 1999
Overby	6,015,158	Jan. 18, 2000
Cummings et al. (Cummings)	6,364,296	Apr. 2, 2002
McLaughlin et al. (McLaughlin)	6,430,774	Aug. 13, 2002

Claims 1 through 4, 6, 7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Overby in view of Dawda and Cummings.

Claims 12 through 15, 17, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dawda in view of Cummings.

Claims 25 through 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McLaughlin in view of Dawda and Cummings.

Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the appellant and examiner regarding those rejections, we make reference to the examiner's answer (mailed August 31, 2005) for the reasoning in support of the rejections, and to appellant's brief (filed July 6, 2005) and reply brief (filed October 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 references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determinations which follow.

In making the rejection of claims 1 through 4, 6, 7 and 9 based on the combined teachings of Overby, Dawda and Cummings

(answer, pages 3-4), the examiner is of the view that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide the elastomeric bushing (18) of Overby with a retaining ring located adjacent a first radially extending longitudinal end portion (following the teachings of Dawda) and to ensure that the entire outer surface of the retaining ring is encompassed by and in contact with the elastomeric bushing, as evidenced by Cummings. From the examiner's perspective, the artisan would have been led to make such a modification in the bushing of Overby in order to improve the axial load capability of the bushing, i.e., "in order to be able to sustain many cycles of considerable axial load without deteriorating the primary isolation function" (answer, page 4).

While we have fully considered the arguments advanced by appellant in the brief and reply brief, we are not convinced thereby that the examiner's conclusion of obviousness as regards independent claim 1 is in error. Although appellant points to alleged distinctions between the applied prior art and the invention of claim 1 based upon the particular problem which the invention was intended to solve, appellant has not specifically

addressed the examiner's stated position and reasons for the proposed combination of Overby, Dawda and Cummings.

Dawda expressly indicates that the bushing therein "improves the axial load capability of attachments of suspension members to structural members of a motor vehicle" (abstract, lines 1-3), and points out that the bushing apparatus "is useful for providing a resilient, pivotal suspension attachment capable of sustaining many cycles of considerable axial load without deteriorating the primary isolation function of the bushing device" (col. 1, lines 7-11).

Overby involves the very type of suspension attachments that Dawda indicates can be improved by using the bushing assembly described therein. Cummings involves a form of vehicle shear mount used to dampen vertical vibrations transmitted from the vehicle frame to the body and which also provides good lateral shake control. As can be seen in Figure 4, the bushing member (100) of Cummings includes an insert member (30) entirely encompassed by the elastomeric material of the bushing. The insert member (30), like that at (60) of Dawda, is used to provide an increased degree of lateral stiffness to the elastomeric bushing (note, col. 6, lines 1-6).

With an eye toward improving the axial load capability of the suspension mount of Overby, we are of the opinion that it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to provide the suspension mount of Overby with an improved bushing apparatus like that of Dawda, in place of the bushing (18), and wherein the insert member of such bushing apparatus is fully encompassed by the material of the elastomeric bushing, as in Cummings, for the self-evident purpose of protecting the metal insert member from exposure to the harsh environment, e.g., road chemicals used for snow and ice removal, etc., that can be present under a motor vehicle.

As for appellant's argument that the examiner's combination of the applied prior art does not address the same problem confronted by appellant, i.e., elimination of bushing walkout, we note that the purpose proposed as the reason why an artisan would have found the claimed subject matter to have been obvious based on the teachings of the prior art need not be identical to the purpose or problem which appellant indicates to be the basis for having made the invention in order to establish a prima facie case of obviousness. As long as some reasonable motivation or suggestion to combine the references is provided by the applied prior art

taken as a whole, as we believe there is in this case, the law does not require that the references be combined for the particular reasons contemplated by appellant. See In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); In re Dillion, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) and In re Kronig, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976). Thus, appellant's arguments in the brief and reply brief that the applied references to Overby, Dawda and Cummings do not address appellant's problem and would not have been combined so as to solve appellant's problem, are not persuasive.

The examiner's rationale of improved axial load capability for the bushing of Overby, i.e., in order to be able to sustain many cycles of considerable axial load without deteriorating the primary isolation function, as the stated basis for the combination of the applied references remains essentially unrebutted by appellant. Appellant's mere statement in the reply brief that "[t]here is nothing in Overby or Dawda, et al. which supports the examiner's position" or the examiner's reasoning for combining the references, without an explanation of why, is wholly inadequate to address this rejection.

For the above reasons, we will sustain the examiner's rejection of claim 1 under 35 U.S.C. § 103. Since no separate argument has been made by appellant regarding claims 2, 3, 4, 6, 7 and 9, we consider that those claims will fall with claim 1, from which they depend. Accordingly, the examiner's rejection of claims 2 through 4, 6, 7 and 9 under 35 U.S.C. § 103 is likewise sustained.

Appellant's arguments in the brief and reply brief concerning the examiner's rejection of claims 12 through 15, 17, 18 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Dawda in view of Cummings, and the rejection of claims 25 through 30 under 35 U.S.C. § 103(a) as being unpatentable over McLaughlin in view of Dawda and Cummings are essentially the same as those already addressed above concerning claim 1. In each instance appellant urges that "the above discussion regarding the... [applied references] and the impermissibility of combining these references applies here also" (brief, pages 16-17). For the reasons already set forth in our discussion of claim 1, we again find those arguments to be unpersuasive. Accordingly, the examiner's rejection of claims 12 through 15, 17, 18 and 20 under 35 U.S.C.

§ 103(a) as being unpatentable over Dawda in view of Cummings, and of claims 25 through 30 under 35 U.S.C. § 103(a) as being unpatentable over McLaughlin in view of Dawda and Cummings are sustained.

To summarize, since each of the rejections before us on appeal has been sustained, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

CHARLES E. FRANKFORT )  
Administrative Patent Judge )  
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 ) BOARD OF PATENT  
MURRIEL E. CRAWFORD ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
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**Comment [jvn1]:** Type or Paste Address

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