

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 EVERETT HALL

Appeal 2006-1143
Application 10/256,703

ON BRIEF

Before PATE, BAHR, and NAPPI, *Administrative Patent Judges*.

PATE, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 5-7 and 9. Claims 17-22 were previously allowed, and claims 10-13 and 15 were allowed in the examiner's answer. Claims 8 and 16 stand objected to as depending from a rejected independent claims. These are all the claims in the application.

The claimed invention is directed to a suspension system for an automobile that has front and rear hydraulic actuators. Claim 1, reproduced below, is further illustrative of the claimed subject matter.

1. A suspension system for a vehicle, comprising:
a vehicle frame having a front section and a rear section;

a first front hydraulic actuator and a second front hydraulic actuator in said front section;

a first rear hydraulic actuator and a second rear hydraulic actuator in said rear section;

a piston defining a first fluid chamber and a second fluid chamber within each of said first and second front hydraulic actuators and first and second rear hydraulic actuators;

a rod disposed in each of said second fluid chambers and operatively connected to said piston of each of said first and second front hydraulic actuators and first and second rear hydraulic actuators, wherein said first fluid chamber of said first front hydraulic actuator is in fluid communication with said second fluid chamber of said second front hydraulic actuator and wherein said first fluid chamber is said first rear hydraulic actuator is in fluid communication with said second fluid chamber of said second rear hydraulic actuator; and

a coupler that selectively fluidically couples and decouples at least one of said first and second front hydraulic actuators and at least one of said first and second rear hydraulic actuators.

The references of record relied upon by the examiner as evidence of obviousness are:

Tschanz 2,184,202 Dec. 19, 1939

Wilfert 3,881,736 May 6, 1975

The examiner has rejected claims 1, 2, 5-7 and 9 under 35 U.S.C. § 103 as unpatentable over Wilfert in view of Tschanz.

ISSUES

Appellant has two principal arguments with respect to the obviousness rejection. The first argument is that Tschanz does not show front and rear actuators that are selectively coupled. Appellant's second argument is that there is no teaching, suggestion, or motivation for combining the collective disclosures of Wilfert and Tschanz.

Accordingly, the sole issue on appeal is whether the examiner has by a preponderance of the evidence established a prima facie obviousness of claims 1, 2, 5-7 and 9.

FINDINGS OF FACT

Wilfert discloses a suspension system for a vehicle with a vehicle frame having front and rear sections. A first front and second front actuator are provided at 27 along with the two rear actuators 27. A piston divides each actuator chamber into two fluid chambers. Wilfert discloses that the first fluid chamber of the first front hydraulic actuator is in fluid communication with the second fluid chamber of the second front hydraulic actuator and vice versa. The same is true of Wilfert's rear actuators. We agree with the examiner that Wilfert does not show us a coupler for selectively fluidly coupling and decoupling at least one of the first and second front hydraulic actuators to said first or second rear hydraulic actuator.

Tschanz also discloses a hydraulic suspension system for a vehicle. The system includes two front hydraulic actuators, 1, 2, and two rear hydraulic actuators, 3, 4. Tschanz further discloses multiple ways for a coupling the front and rear hydraulic actuators. For example, it appears that hydraulic actuator 2 is always coupled to hydraulic actuator 3 via 8, 25 and 15. However, it is our finding and agreement with the examiner that large displacements of piston 5 in cylinder 24 for example, cause valve 10 to reciprocate to the left, open and bypass 12, and allowing communication via 24 and 15 with rear cylinder 4. Therefore, we are in agreement that Tschanz does allow for selective coupling of front and rear actuators.

PRINCIPALS OF LAW

Precedent requires that to find a combination obvious there must be some teaching, suggestion, or motivation in the prior art to select the teachings of separate references and combine them to produce the claimed combination. *In re Johnston*, 435 F.3d 1381, 1384, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (citing *Karsten Mfg. Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1385, 58 USPQ2d 1286, 1293 (Fed. Cir. 2001) ("In holding an invention obvious in view of a combination of references, there must be some suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to select the references and combine them in the way that would produce the claimed invention.")); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) ("When the references are in the same field as that of the applicant's invention, knowledge thereof is presumed. However, the test of whether it would have been obvious to select specific teachings and combine them as did the applicant must still be met by identification of some suggestion, teaching, or motivation in the prior art, arising from what the prior art would have taught a person of ordinary skill in the field of the invention."); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) (there must be "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

However, this is not to imply that the teaching suggestion or motivation must be found explicitly in the prior art, since “the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references....”

In re Kahn, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)(citing *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)).

When the examiner does not include a teaching, suggestion, or motivation in the examiner’s statement of the rejection, we infer that the examiner has used hindsight to conclude the invention was obvious. *See Kahn* at 986, 78 USPQ2d at 1335.

ANALYSIS

We are in agreement with the examiner that Tschanz discloses both continuous coupling of the front and rear actuators and selective coupling thereof. While appellant argues that claim 1 comprehends only selective coupling, the open ended comprising language thereof does not preclude reading on systems that permits both permanent coupling and selective coupling in the same system. Therefore, we do not credit appellant's argument that Tschanz does not have selective coupling.

On the other hand, it is our conclusion of law that there is no teaching, suggestion, or motivation for combining the subject matter of Tschanz and Wilfert. We agree with the appellant that incorporating the coupling mechanisms taught by Tschanz into the system of Wilfert would significantly change the Wilfert system and undermine its principle of operation. For example, Tschanz discloses direct connections between the similarly situated chambers in the front and rear actuators. Wilfert on the other hand, discloses a sort of cross over system where the A chambers are connected to the B chambers on the opposite side of the vehicle. In our view, one of ordinary skill would

not be motivated to use the coupling of Tschanz in the Wilfert device inasmuch as the front and rear actuators are connected in a contrary manner. Therefore, we can only conclude that the examiner's combination of references is based on an impermissible hindsight reconstruction of appellant's claimed subject matter.

CONCLUSION OF LAW

For the reasons given above, it is our conclusion of law that the examiner has not established, by a preponderance of the evidence, a prima facie case of obviousness with respect to the claims on appeal.

ORDER

The rejections of claims 1, 2, 5-7 and 9 are reversed.

REVERSED

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William F. Pate, III)
Administrative Patent Judge)
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) BOARD OF PATENT
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Administrative Patent Judge) APPEALS AND
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