

1 The opinion in support of the decision being entered
2 today is *not* binding precedent of the Board.
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5 UNITED STATES PATENT AND TRADEMARK OFFICE
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7
8 BEFORE THE BOARD OF PATENT APPEALS
9 AND INTERFERENCES
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11
12 *Ex parte* MYRON J. MAURER, GAVIN D. VOGEL, EUGENIO TOCCALINO,
13 LAXMAN P. KATAKKAR, PRASHANT S. SHEMBEKAR,
14 and SRINIVASAN VELUSAMY
15

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17 Appeal No. 2007-0269
18 Application No. 10/799,095
19 Technology Center 3600
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22 Decided: September 27, 2007
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25 Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and DAVID B.
26 WALKER, *Administrative Patent Judges*.

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28 PATE, III, *Administrative Patent Judge*.
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31 DECISION ON APPEAL
32 STATEMENT OF THE CASE
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1 This is an appeal from the final rejection of claims 1, 3-5, 9, 17¹, 18, 24-29,
2 32 and 33 and the Examiner's refusal to allow claims 6-8, 10, 13-16 and 19-23 as
3 amended after final rejection. These are the only claims remaining in the
4 application. We have jurisdiction under 35 U.S.C. §§ 134 and 6.

5 The claimed invention is an impact absorbing structure comprising two or
6 more extruded plastic layers connected with a hinge and nested together. In some
7 independent claims, the layers have different properties with regard to structure or
8 composition, and the hinge feature is not claimed. A method of manufacture is
9 also claimed.

10 Claim 1, reproduced below, is further illustrative of the claimed subject
11 matter.

12 1. An article of manufacture, comprising:

13 An energy absorber comprising an extruded plastic first layer having a
14 first plurality of corrugations separated by a hinge from a second plurality of
15 corrugations, wherein the length of the corrugations are longer than their
16 widest cross-sectional width.
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18 The references of record relied upon by the Examiner as evidence of
19 obviousness are:

20 Brockenbrough	US 4,852,704	Aug. 1, 1989
21 Welygan	US 5,011,642	Apr. 30, 1991

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23 Claims 1, 3-10, 13-29, 32 and 33 stand rejected under 35 U.S.C. § 103 as
24 unpatentable over Brockenbrough in view of Welygan.
25

¹ Appellants at page 1 of the Brief acknowledge that claim 17 depends from canceled claim 12. Claim 17 should depend from independent claim 10.

1 attached to the rib or the base. (Welygan, col. 2, ll. 24-30). The embodiment of
2 Fig. 7, for instance, shows undulating ribs of a sinusoidal pattern where the ribs
3 undulate in phase with one another. The structure of Welygan is extruded, and the
4 structure can be made of many thermoplastics, rubbers, thermosetting plastic
5 materials, natural substances, or even foodstuffs. (Welygan, col. 3, ll. 15-50). The
6 structure of Welygan is suitable for use as packing or as an energy absorbing
7 material among other uses. (Welygan, col. 10, ll. 35-36).

8
9 PRINCIPLES OF LAW

10 “Section 103 forbids issuance of a patent when ‘the differences between the
11 subject matter sought to be patented and the prior art are such that the subject
12 matter as a whole would have been obvious at the time the invention was made to a
13 person having ordinary skill in the art to which said subject matter pertains.’” *KSR*
14 *Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007).

15 The question of obviousness is resolved on the basis of underlying factual
16 determinations including (1) the scope and content of the prior art, (2) any
17 differences between the claimed subject matter and the prior art, and (3) the level
18 of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459,
19 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the
20 sequence of these questions might be reordered in any particular case, the
21 [*Graham*] factors continue to define the inquiry that controls.”) The Court in
22 *Graham* further noted that evidence of secondary considerations “might be utilized
23 to give light to the circumstances surrounding the origin of the subject matter
24 sought to be patented.” 383 U.S. at 18, 148 USPQ at 467.

25 In *KSR*, the Supreme Court emphasized “the need for caution in granting a
26 patent based on the combination of elements found in the prior art,” *id.* at 1739,

1 82 USPQ2d at 1395, and discussed circumstances in which a patent might be
2 determined to be obvious.

3 In particular, the Supreme Court emphasized that “the principles laid down
4 in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*,
5 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham*, 383 U.S. at 12, 148 USPQ
6 at 464 (emphasis added)), and reaffirmed principles based on its precedent that
7 “[t]he combination of familiar elements according to known methods is likely to be
8 obvious when it does no more than yield predictable results.” *Id.* The Court
9 explained:

10 When a work is available in one field of endeavor, design
11 incentives and other market forces can prompt variations
12 of it, either in the same field or a different one. If a
13 person of ordinary skill can implement a predictable
14 variation, § 103 likely bars its patentability. For the same
15 reason, if a technique has been used to improve one
16 device, and a person of ordinary skill in the art would
17 recognize that it would improve similar devices in the
18 same way, using the technique is obvious unless its
19 actual application is beyond his or her skill.

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21 *Id.* at 1740, 82 USPQ2d at 1396. The operative question in this “functional
22 approach” is thus “whether the improvement is more than the predictable use of
23 prior art elements according to their established functions.”

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ANALYSIS

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28 Appellants argue that it would not have been obvious to fabricate the strips
29 of Brockenbrough of extruded plastic. Appellants make this point on page 8 of the

1 Reply Brief². We agree. In our view, it would not have been obvious to one of
2 ordinary skill to have used plastic in the invention of Brockenbrough. The
3 Examiner states as a possible motivation providing less expensive, lighter, and
4 easier to manufacture material for the energy absorber. However, Brockenbrough
5 is very specific about the requirement for a high strength steel with specific
6 minimum yield strength and minimum elongation (Brockenbrough, col. 3, ll. 26-
7 27). It is unclear from the Welygan patent whether plastic would be suitable in
8 providing the requisite yield strength and ductility necessary in the side guard
9 beam in a vehicle door. There is no reasonable expectation of success that any of
10 the plastic or extrudable materials disclosed in Welygan could perform the function
11 of a high strength steel beam in Brockenbrough. The results of substituting plastic
12 for the steel beams would not have been predictable, nor is this a matter of a simple
13 substitution of one known substance for another that yields predictable results.

14 Additionally, it appears that the sizes of the rib extrusions in Welygan,
15 which are listed as up to 26 mm, is another indication that the materials of
16 Welygan would not be suitable as a door guard beam. (Welygan col. 8, l. 5). A rib
17 extrusion that can only be made up to 26 mm is apparently too small. There is no
18 indication in Welygan that these ribs could be scaled-up or the extrusion process

² Appellants make this argument in a section of the Reply Brief entitled “Differing Compositions.” It is unclear whether this argument is meant to apply only to claims 9, 17, and 23, and the claims that depend therefrom, or to all claims on appeal. At some portions of page 8, Appellants appear to be applying this argument to all the appealed claims. In spite of this lack of clarity on the part of the Appellants, we will treat this argument as an argument respecting all the appealed claims.

1 would even work for larger ribs. The ribs of Brockenbrough are 3 inches wide.
2 (Brockenbrough, col. 3, l. 24).

3 Turning to the specific claims, we do not credit the Examiner's argument
4 that the end brackets 17, 18 can be regarded as a hinge (Answer 4-5), as called for
5 in claims 1, 28, and 29. It is clear that the structure is a clamp fixedly holding the
6 ends of the strips together.

7 With respect to argued claims 9, 17, and 23, which require layers of plastic
8 that differ in structure or composition, we credit the argument of the Appellant that
9 Welygan does not disclose multiple layers of extruded plastic. The Examiner
10 argues that the use of differing compositions is taught by Brockenbrough itself.
11 (Brockenbrough, col. 5, l. 49). While it may be true that Brockenbrough discloses
12 differing compositions, there is no indication that plastic is contemplated for any of
13 the strips of Brockenbrough, let alone layers of plastic differing in composition.
14 We do agree with the Examiner that Brockenbrough discloses layers of different
15 structure (Brockenbrough col. 3, ll. 28-31), but it would not have been obvious to
16 make these strips of differing structure of extruded plastic.

17 With respect to the argued claims 7, 15, and 21 directed to friction to
18 dissipate impact energy, we agree with Appellant that Brockenbrough is silent with
19 respect to frictional force as a means to dissipate impact energy. The Examiner's
20 reliance on frictional forces between the corrugations of Brockenbrough as the
21 beam collapses is apparently speculation.

CONCLUSION

The rejection of claims 1, 3-10, 13-29, 32 and 33 is reversed.

REVERSED

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