

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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*Ex parte* HEINRICH LANG and ALBRECHT POPP

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Appeal 2007-3951  
Application 10/229,343  
Technology Center 2800

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Decided: March 27, 2008

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Before DONALD E. ADAMS, RICHARD M. LEOVITZ, and  
FRANCISCO C. PRATS, *Administrative Patent Judges*.

PRATS, *Administrative Patent Judge*.

**DECISION ON APPEAL**

This is an appeal under 35 U.S.C. § 134 involving claims to a bearing apparatus for pivoting a vehicle's outside mirrors. The Examiner has rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

## STATEMENT OF THE CASE

The Specification discloses “a pivotal bearing for a carrying arm for an outside mirror on a motor vehicle, relative to an anchorage affixed to a vehicle body” (Spec. 2). By coupling an auxiliary drive system, such as an electric motor, to the pivot bearing, “the driver of the motor vehicle, by the activation of the auxiliary drive possibly by touching a button, can pivot the carrying arm in reference to the anchorage” (*id.*).

Thus, the auxiliary drive system allows a driver to “accomplish a pivoting motion of the outside mirror on the passenger side, [without having to] . . . make an extra dismounting from the vehicle. Also, by means of the object of the present invention, difficultly accessible outside mirrors can be easily pivoted” (*id.*).

Claims 21-71 are pending (*see* Br. 3).<sup>1</sup> Claims 21-50, 52-64, and 66-71 have been withdrawn from consideration by the Examiner (*id.*). Claims 51 and 65 are on appeal (*id.*) and read as follows:

Claim 51: A bearing apparatus for pivoting a carrying arm, the bearing apparatus comprising:  
an anchorage having a proximal end and a distal end, the proximal end attached to a vehicle;  
a bushing depending from the distal end, the carrying arm attached to the bushing; and  
a pivot bearing assembly movably disposed in the bushing and configured to pivotably drive the carrying arm.

Claim 65: The bearing apparatus as in Claim 51, wherein the motion of the bearing assembly pivoting the carrying arm is selectively reversible.

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<sup>1</sup> Appeal Brief filed August 10, 2006.

The Examiner applies the following documents in rejecting the claims:

|          |              |              |
|----------|--------------|--------------|
| Brudy    | US 4,186,905 | Feb. 5, 1980 |
| Ravanini | US 5,844,733 | Dec. 1, 1998 |

The following rejections are before us for review:

Claims 51 and 65 stand rejected under 35 U.S.C. § 102(b) as anticipated by Brudy (Ans. 3).

Claims 51 and 65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ravanini (Ans. 3-4).

#### ANTICIPATION -- BRUDY

##### *ISSUE*

The Examiner cites Brudy as disclosing “a bearing apparatus for pivoting a carrying arm(13), including an anchorage(17) with proximal and distal ends, a bushing(22) depending from the distal end, the carrying arm(13) attached to the bushing, and a pivot bearing assembly (figs. 3 and 4) movably disposed in the bushing and configured to pivotably drive the carrying arm” (Ans. 3).

Appellants contend that Brudy does not meet the limitation in claim 51 requiring the pivot bearing assembly to be “configured to pivotably drive the carrying arm” (Br. 7). Rather, Appellants urge, Brudy discloses that “manual movement of support 12, i.e. arm 13 causes the pivot member 21 to move with respect to member 22, causing grooves 27 to engage with projections 27 maintaining the mirror in the desired adjusted position” (*id.*).

The issue with respect to this rejection, therefore, is whether the Examiner erred in finding that Brudy’s bearing apparatus has a pivot bearing assembly “configured to pivotably drive the carrying arm.”

*FINDINGS OF FACT*

1. Claim 51 recites a bearing apparatus for pivoting a carrying arm. The bearing apparatus has an anchorage with proximal and distal ends, the proximal end being attached to a vehicle. The bearing apparatus also has a bushing depending from the distal end, with the carrying arm being attached to the bushing. The bearing apparatus must have “a pivot bearing assembly movably disposed in the bushing and configured to pivotably drive the carrying arm.”

2. The Specification does not define the term “pivotably drive.”

However, the Specification states:

[A] pivoting motion of the carrying arm in relation to the . . . body affixed anchorage, about the rotation axis of the pivot bearing[,] is effected by an auxiliary drive which engages the pivot bearing.

Because of the auxiliary drive, acting at the pivot bearing, the necessity is eliminated to manually pivot the carrying arm in relation to the body-affixed anchorage. . . .

The auxiliary drive, for example, activates an externally applied torque, which is converted in a transmission mechanism within the pivot bearing into a pivoting motion.

(Spec. 2.)

3. Brudy discloses a pivotable truck mirror in which “the pivot means comprises two members of low friction material fixed to the arms. The pivot members define a chamber in which an axially movable member is positioned. One of the pivot members has axially extending circumferentially spaced grooves therein and [the] movable member has complementary projections” (Brudy, col. 1, ll. 49-55). Brudy discloses that combining the low friction material with the complementary grooves and projections allows “the mirror [to be] held in angularly adjusted position but

[it also] may be readily moved to a new angular position by manual manipulation” (*id.* at col. 1, ll. 57-59).

4. Figure 2 of Brudy is a detailed view of the pivot means, showing complementary grooves 34 and projections 33, as well as spring 45 which urges movable member 23 toward pivot member 21.

5. Figure 1 of Brudy shows the mirror mounted to a truck, with bracket arms 17 anchored to the truck, and pivot means 20 connecting the mirror’s support arm 13 to the anchoring bracket arms 17. Brudy’s only disclosed method of pivotably moving the mirror is by “manual manipulation” of the mirror itself (*see* Brudy, col. 2, ll. 60-68). Brudy does not disclose using the pivot means to drive the pivotal motion of the mirror.

#### *PRINCIPLES OF LAW*

It is well settled that “[t]o anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.” *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). It is also well settled that, “in proceedings before the PTO, claims in an application are to be given their broadest reasonable interpretation consistent with the specification and that claim language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983) (citation omitted).

Thus, “[c]laims are not to be read in a vacuum[;] while it is true they are to be given the broadest reasonable interpretation during prosecution, their terms still have to be given the meaning called for by the specification of which they form a part.” *In re Royka*, 490 F.2d 981, 984 (CCPA 1974).

*ANALYSIS*

We agree with Appellants that the Examiner erred in finding that Brudy's bearing apparatus has a pivot bearing assembly "configured to pivotably drive the carrying arm." In our view, the Examiner has interpreted that limitation too broadly.

Specifically, in concluding that Brudy anticipates claim 51, the Examiner states that the limitation "'configured to pivotably drive the carrying arm' has been construed as enabling pivotable driving of the carrying arm. Brudy clearly shows such structure in figs. 3 and 4 as set forth in the rejection" (Ans. 5).

We do not agree that it is reasonable to interpret claim 51 as merely "enabling" pivotable driving of the carrying arm. Claim 51 states that the bearing apparatus must have "a pivot bearing assembly . . . configured to pivotably *drive* the carrying arm" (emphasis added). Thus, claim 51 requires the pivot bearing's configuration to do more than merely allow the carrying arm to be moved in a pivoting fashion. Rather, the pivot bearing assembly itself must be configured to "drive the carrying arm."

As the Examiner points out (Ans. 5), *Merriam Webster's Deluxe Dictionary* 556 (10th Collegiate Ed. 1998) has a number of definitions for the word "drive," including "to set or keep in motion or operation (*drive* machinery by electricity)." Thus, because it requires the pivot bearing assembly to "drive the carrying arm," claim 51 requires the pivot bearing assembly to be capable of initiating or maintaining the carrying arm's pivoting motion.

We do not agree with the Examiner that Brudy's bearing assembly is disclosed as being capable of initiating or maintaining the carrying arm's

motion. The only disclosed source of motion for Brudy's carrying arm is manual manipulation of the carrying arm, i.e., grasping the mirror and physically moving it (*see* Finding of Fact ("FF") 5, above). When the mirror is being moved by hand, its motion is not initiated or maintained by the bearing assembly, as required by claim 51, because the mirror will cease to move once the person ceases to act on it. Therefore, in our view, Brudy does not meet the limitation requiring the claimed bearing apparatus to have a pivot bearing assembly "configured to pivotably drive the carrying arm."

The Examiner argues that Brudy's pivot bearing assembly meets the requirements of claim 51 because, "[c]learly, Brudy's bearing directs the motion and/or course of the carrying arm, thus satisfying the definition of 'drive' as in the claim" (Ans. 5).

We are not persuaded by this argument. We note that *Merriam Webster's Deluxe Dictionary* 556 (10th Collegiate Ed. 1998) includes "to direct the motions and course of (a draft animal)" and "to operate the mechanism and controls and direct the course of (as a vehicle)," as definitions for "drive."

However, as discussed above, claim terms must be interpreted as they would be by a person of ordinary skill in the art. *In re Sneed*, 710 F.2d 1544, 1548 (Fed. Cir. 1983). Moreover, that interpretation must be "consistent with the specification." *See In re American Academy Of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

The Specification does not relate to methods of directing the courses or directions of draft animals or operating vehicles. Rather, the Specification discloses techniques of moving a vehicle's exterior mirror by configuring a bearing apparatus such that the bearing itself can cause the

mirror to move when an auxiliary *drive* is applied to the bearing (*see* FF 2). Therefore, given the Specification's disclosure, we do not agree with the Examiner that a person of ordinary skill in this art interpreting claim 51 would consider it reasonable to apply definitions relating to guiding a draft animal or operating a vehicle, particularly when a definition much more consistent with the Specification exists (*see Merriam Webster's Deluxe Dictionary* 556 (10th Collegiate Ed. 1998), defining "drive" as "to set or keep in motion or operation (*drive* machinery by electricity)."

The Examiner argues that "no motor or actuator is present in the claim which would enable driving of the carrying arm" despite the Specification's disclosure that "an auxiliary drive (e.g. a motor) acts on the claimed bearing to pivot the bearing (and thus the carrying arm)" (Ans. 4-5 (citing Spec. 2, final paragraph)).

We are not persuaded by this argument. We note that it is improper to import limitations or embodiments from the Specification into the claims. *See In re Trans Texas Holdings Corp.*, 498 F.3d 1290, 1299 (Fed. Cir. 2007) ("[W]hile 'the specification [should be used] to interpret the meaning of a claim,' courts must not 'import[ ] limitations from the specification into the claim.' . . . [I]t is improper to 'confine the claims to th[e] embodiments' found in the specification . . . ." (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed.Cir.2005), citations omitted, bracketed text in internal quotes in original)).

In the instant case, however, we only refer to the Specification to determine which of the possible meanings of the term "drive" would be adopted by a person of ordinary skill in this art, and which of the possible meanings would be most consistent with the Specification. Moreover,

because the claim states that the pivot bearing assembly must be “configured to pivotably *drive* the carrying arm” (emphasis added), the claim itself, without reference to the Specification, requires the bearing assembly to include elements capable of initiating or maintaining the carrying arm’s pivoting motion.

The Examiner argues that “since Brudy's bearing is spring biased, there is a point during the rotation of the bearing at which spring(45) will serve to force or drive the assembly into a detent position via the interaction between elements 21 and 23 (note the movement arrows in figs. 3 and 4)” (Ans. 5). Therefore, the Examiner concludes, “even if additional weight were given to the term ‘drive’ as found in the claim, Brudy is seen to meet this limitation since his bearing and detent mechanism drive the carrying arm(13) into a detent position” (*id.*).

We are not persuaded by this argument. We note that Brudy’s bearing apparatus has a spring 45 that forces movable member 23 and its projections 32 and 33 to engage the complementary grooves in the other members to allow the mirror to maintain one of a plurality of pre-set positions (*see* FF 3 and 4). However, because the spring-biased movable portion 23 acts to ensure engagement of the complementary projections and grooves to stabilize the mirror’s position, it would appear that the spring of Brudy’s bearing impairs the mirror’s pivotal motion, as opposed to driving it.

Moreover, we do not see, and the Examiner does not point to, any explicit disclosure suggesting that Brudy’s spring 45 is necessarily strong enough to actually drive the mirror’s motion, particularly given the configuration of elements in Brudy’s bearing. The possibility that the spring in Brudy’s bearing apparatus might inherently be strong enough to force

pivotal motion of the mirror does not amount to anticipation. *See In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981) (“Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient.” (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)) (emphasis in original)).

Because the Examiner has not explained, nor do we see, that Brudy’s pivot bearing assembly has a configuration of elements that would allow the bearing assembly to initiate or maintain the carrying arm’s pivoting motion, we do not agree with the Examiner that Brudy’s bearing apparatus is configured to drive the carrying arm. Therefore, because Brudy does not meet all the limitations in claim 51, we reverse the Examiner’s anticipation rejection of claim 51 and its dependent claim 65 over Brudy.

#### ANTICIPATION -- RAVANINI

##### *ISSUE*

Claims 51 and 65 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ravanini (Ans. 3-4). The Examiner cites Ravanini as disclosing a bearing apparatus for pivoting a carrying arm, with “pivot bearing assembly (30, 40, 50) movably disposed in the bushing and configured to pivotably drive the carrying arm” (Ans. 4).

Appellants argue that claim 51 “calls for the bearing assembly to pivota[b]ly drive the carrying arm. The reference fails to teach this disclosure” (Br. 8).

The issue with respect to this rejection, then, is whether the Examiner erred in finding that Ravanini’s bearing apparatus has a pivot bearing assembly “configured to pivotably drive the carrying arm.”

*FINDINGS OF FACT*

6. Ravanini discloses a “reversible external sideview mirror [which] has a mirror element and a left/right reversing mechanism for alternately mounting the mirror on a left side and on a right side of the vehicle” (Ravanini, abstract). Figure 4 of Ravanini “is a view schematically showing left and right positions of the inventive mirror” (Ravanini, col. 2, ll. 37-38). Figure 4 shows anchorage 20 with its proximal end attached to vehicle 60 and distal end attached to a pivot bearing apparatus 10·40·30·50, with mirror 6 attached to the carrying arm.
7. Ravanini discloses that the bearing apparatus contains a bearing assembly comprised of stepped swivel pin 40 which is press fit against spring 30 (*see, e.g.* Ravanini, Fig. 1). An elastic pin 50 is fit into the lower end of swivel pin 40, and the action of spring 30 maintains the bearing assembly within the anchor arm 20 and carrying arm 10 (*id.* at col. 3, ll. 37-49; *see also* Fig. 3). The mirror’s alternative right/left mounting positions are accomplished by mounting the elastic pin in either groove 28 or groove 29 (*id.* at col. 3, ll. 50-65; *see also* Fig. 2).
8. Ravanini does not disclose using the pivot bearing assembly to initiate or maintain the mirror’s pivoting motion.

*ANALYSIS*

We agree with Appellants that the Examiner erred in finding that Ravanini’s bearing apparatus has a pivot bearing assembly “configured to pivotably drive the carrying arm.” While Ravanini’s spring-fit pivot bearing assembly allows the mirror-carrying apparatus to be mounted on either side of a vehicle by changing the orientation of the elastic pin 50 (*see* FF 7), the Examiner does not explain, and we do not see, how the elements constituting

the pivot bearing are configured in a manner that would initiate or maintain the mirror's pivoting motion.

Rather, the Examiner argues that "like Brudy, Ravanini includes a bearing assembly (30, 40, 50) which enables pivotable driving of the carrying arm. Further, Ravanini's bearing at least 'directs the motion and course of' the carrying arm, satisfying the definition of the term in question" (Ans. 6).

We are not persuaded by these arguments. As discussed above, because claim 51 states that the pivot bearing assembly must be configured to "drive the carrying arm," the claim requires the bearing assembly to include elements capable of initiating or maintaining the carrying arm's pivoting motion. Thus, we do not agree with the Examiner that it is reasonable to interpret claim 51 as encompassing pivot bearings, like Ravanini's, which merely "enable" pivotal motion of the carrying arm.

Moreover, as also discussed above, we do not agree with the Examiner that a person of ordinary skill in this art interpreting claim 51 in light of the Specification would have considered it reasonable to interpret the term "drive" as merely requiring the bearing apparatus to direct the course and motion of the carrying arm. We therefore do not agree with the Examiner that Ravanini meets the limitation in claim 51 requiring the pivot bearing assembly to be "configured to pivotably drive the carrying arm."

In sum, because Ravanini does not meet all the limitations in claim 51, we reverse the Examiner's anticipation rejection of claim 51 and its dependent claim 65 over Ravanini.

Appeal 2007-3951  
Application 10/229,343

SUMMARY

We reverse the Examiner's rejection of claims 51 and 65 under 35 U.S.C. § 102(b) as anticipated by Brudy.

We also reverse the Examiner's rejection of claims 51 and 65 under 35 U.S.C. § 102(b) as anticipated by Ravanini.

REVERSED

Ssc:

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