

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY A. WASEK, SEAN A. BANNON,
TRAVIS D. BECHTEL, and RICHARD J. BRETTFELD

Appeal 2008-0613
Application 11/022,433
Technology Center 3600

Decided: May 16, 2008

Before WILLIAM F. PATE, III, HUBERT C. LORIN, and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gregory A. Wasek et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1, 5-10, and 21-27. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.

THE INVENTION

Appellants' invention is a steering assembly which includes a steering column having a shaft, and a steering component operably attached to the shaft. The steering assembly further includes a telescoping subassembly and a tilting subassembly, with the tilting subassembly being fixedly attached at a first end to the steering component and pivotally attached at a second end to the telescoping subassembly. The tilting subassembly also includes a tilting gas spring pivotally attached to the tilting subassembly and to the telescoping subassembly.

Claim 1, reproduced below, is representative of the subject matter on appeal:

1. A steering assembly comprising:
 - a steering column having a shaft;
 - a steering component operably attached to the shaft;
 - a telescoping subassembly attached to the steering column to allow the steering column to have a telescopic range of motion; and
 - a tilting subassembly fixedly attached at a first end to the steering component, and pivotally attached at a second end to the telescoping subassembly, the

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tilting subassembly including a tilting gas spring pivotally attached at a first end to the tilting subassembly, and at a second end to the telescoping subassembly, the tilting gas spring mediating the tilting range of motion.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Heinrichs US 5,449,199 Sep. 12, 1995

The following rejections are before us for review:

1. Claims 1, 5, 7-10, and 22-27 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Heinrichs.
2. Claims 6 and 21 stand rejected under 35 U.S.C. § 103(a) as being obvious over Heinrichs.

ISSUES

A first issue before us is whether Appellants have shown that the Examiner erred in finding that the Heinrichs patent anticipates the subject matter of claims 1, 5, 7-10, and 22-27. A second issue before us is whether Appellants have shown that the Examiner erred in concluding that the Heinrichs patent renders obvious the subject matter of claims 6 and 21.

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF1. The term, *fixedly attached*, does not appear in the Specification as initially filed.

FF2. The Heinrichs patent discloses a steering assembly in which a tilting subassembly is connected or attached to an outer surface of a tubular column housing 14 at connection point 102a. (Heinrichs, Fig. 1; Col. 8, ll. 44-46).

FF3. The connection of tilting assembly at connection point 102a in Heinrichs is not a direct connection to steering wheel 12, nor does the connection restrict a telescoping movement of steering wheel 12 relative to the tilting subassembly. (Heinrichs, Fig. 1; Col 7, ll. 10-29).

PRINCIPLES OF LAW

Anticipation of a claim exists when each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987); *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). Once a prima facie case of

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anticipation has been established, the burden shifts to the Appellants to prove that the prior art product does not necessarily or inherently possess the characteristics of the claimed product. *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708-09 (Fed. Cir. 1990).

Claims on appeal are not to be confined to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (*en banc*). During *ex parte* prosecution, claims must be interpreted as broadly as their terms reasonably allow, since Applicants have the power during the administrative process to amend the claims to avoid the prior art. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). The broadest reasonable meaning of claim terms will be in accord with their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997).

Section 103 precludes issuance of a patent when, “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3)

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the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S.Ct. at 1734 (*Graham* factors continue to define the inquiry that controls).

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 127 S.Ct. at 1739 (*citing Graham*, 383 U.S. at 12), and reaffirmed principles based on its precedent that, “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.*

ANALYSIS

Anticipation rejection of claims 1, 5, 7-10, and 22-27

Appellants argue claims 1, 5, 7-10, and 22-27 as a single group. We will address herein claim 1, as it is the only independent claim in that group.

The Examiner rejects claim 1 under 35 U.S.C. § 102(b), asserting that the Heinrichs patent discloses each and every element of that claim. Appellants counter that Heinrichs does not disclose a tilting subassembly that is fixedly attached at a first end to a claimed steering component. (Appeal Br. 6-7; Reply Br. 3-5).

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Insofar as these claim elements are concerned, it is the Examiner's position that Heinrichs discloses a steering component in the form of a steering wheel 12, which is operably attached to a shaft (32 or 38). (Answer 3, 5-6). The Examiner contends that the tilting subassembly in Heinrichs includes gas spring 46a, tilting axis connection 20, and connections 100a and 102a; and that a first end of this subassembly is fixedly attached to the steering component at connection 102a. (Answer 6, 7).

Appellants specifically urge that the tilting subassembly in Heinrichs is not *fixedly attached* to the steering component. The term, *fixedly attached*, does not appear in the Specification as initially filed. (FF1). Appellants cite to dictionary definitions of "fixed" and "attached", in support of an assertion that persons of ordinary skill in the art would understand the term "fixedly attached" to mean, "a connection in which the components are not readily movable." (Reply Br. 3).

In Appellants' depicted preferred embodiment, this would require that steering wheel 30 be connected to the end of tilting subassembly 32 such that those components will not readily move relative to one another. In the Heinrichs steering assembly, the tilting subassembly is connected or attached at connection point 102a to an outer surface of a tubular column housing. (FF2). This connection is not a direct connection to the Heinrichs steering wheel, nor does the connection impede telescoping movement of the steering wheel relative to the tilting subassembly. (FF3).

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We therefore agree with Appellants that the connection of the tilting subassembly in Heinrichs to the outer surface of tubular column housing 14 at connection point 102a can not reasonably be construed as a construction in which a tilting subassembly is “fixedly attached” to what the Examiner has identified as the element in Heinrichs (steering wheel 12) corresponding to the claimed “steering component”. The Heinrichs patent thus falls short of disclosing each and every element set forth in Claim 1.

The Examiner has failed to establish a *prima facie* case of anticipation with respect to claim 1. The rejection of claims 1, 5, 7-10, and 22-27 under 35 U.S.C. § 102(b) will, accordingly, be reversed.

Obviousness rejection of Claims 6 and 21

Claims 6 and 21 are rejected under 35 U.S.C. § 103(a) in view of the Heinrichs patent. Both claims depend, either directly or indirectly, from claim 1. The Examiner contends that the elements found in those claims would have been obvious variants or modifications of the steering assembly disclosed in Heinrichs.

We found above, with respect to claim 1, that the Heinrichs patent failed to identically disclose a tilting subassembly that is fixedly attached at a first end to the claimed steering component. We see no evidence or logical reasoning presented in this rejection under 35 U.S.C. § 103(a), that tends to show that it would have been obvious to modify the Heinrichs device such that it would include this claimed feature.

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The rejection of Claims 6 and 21 under 35 U.S.C. § 103(a) will be reversed.

CONCLUSION OF LAW

We conclude that reversible error exists in the rejection of claims 1, 5, 7-10, and 22-27 under 35 U.S.C. § 102(b), and that reversible error exists in the rejection of claims 6 and 21 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 1, 5-10, and 21-27 is reversed.

REVERSED

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