

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TERENCE M. GATES, PHILIPPE GOUGEON,
LEONIDA S. VAITUS, and
WILLIAM ETHAN A. McCLURE

Appeal 2008-1892
Application 10/865,627
Technology Center 3600

Decided: August 12, 2008

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges.*

O'NEILL, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Terence M. Gates et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-16, 18-30, and 32-34. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

The claimed invention relates to an accessory component module for a vehicle lift gate. The module carries a plurality of components and is mountable on a vehicle lift gate exterior surface. (Spec. ¶¶ 0011-0012.)

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

1. A component module mountable on an exterior surface of a vehicle lift gate, the module comprising:
a plurality of individual components; and
a carrier carrying at least two components, the carrier mountable on a vehicle lift gate exterior surface.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Ponziani	US 6,174,016 B1	Jan. 16, 2001
Ogawa	US 2002/0127331 A1	Sep. 12, 2002
Mathias	US 2003/0002165 A1	Jan. 2, 2003
Galantucci	EP 0111457 A2	Jun. 20, 1984

THE REJECTIONS

The following rejections are before us for review:

¹ Our decision will make reference to Appellants' Appeal Brief ("Br.," filed Jan. 10, 2007) and the Examiner's Answer ("Ans.," mailed Apr. 30, 2007).

Claims 1, 2, 7-11, 13-15, 21, 22, and 24-29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ponziani.

Claims 3 and 6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani and Mathias.

Claims 4 and 5 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani, Mathias, and Ogawa.

Claims 12 and 23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani.

Claims 16, 18, 30, and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani and Galantucci.

Claims 19 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani and Galantucci and the Examiner taking Official Notice.

Claims 20 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponziani and Galantucci and the Examiner taking Official Notice.

ISSUES

The first issue is whether the Appellants have shown that the Examiner erred in rejecting claims 1, 2, 7-11, 13-15, 21, 22, and 24-29 as being anticipated by Ponziani. This issue turns on whether Ponziani's module: is mounted on an exterior surface of vehicle's lift gate, is covered, and has a lens directly mounted thereto.

The second issue is whether the Appellants have shown that the Examiner erred in rejecting claims 3 and 6 as being unpatentable over Ponziani and Mathias. This issue turns on whether the Appellants have rebutted the Examiner's prima facie case of obviousness with the application of the teachings of Mathias to the disclosure of Ponziani.

The third issue is whether the Appellants have shown that the Examiner erred in rejecting claims 4 and 5 as being unpatentable over Ponziani, Mathias, and Ogawa. This issue turns on whether the Appellants have rebutted the Examiner's prima facie case of obviousness with the application of Ogawa's teachings to the combination of Ponziani and Mathias.

The fourth issue is whether the Appellants have shown that the Examiner erred in rejecting claims 12 and 23 as being unpatentable over Ponziani.

The fifth issue is whether the Appellants have shown that the Examiner erred in rejecting claims 16, 18, 30, and 32 as being unpatentable over Ponziani and Galantucci.

The sixth issue is whether the Appellants have shown that the Examiner erred in rejecting claims 19 and 33 as being unpatentable over Ponziani, Galantucci, and the Examiner taking Official Notice.

The seventh issue is whether the Appellants have shown that the Examiner erred in rejecting claim 20 and 34 as being unpatentable over Ponziani, Galantucci, and the Examiner taking Official Notice.

The fourth, fifth, sixth, and seventh issues turn on whether the Appellants have shown that the Examiner erred in rejecting claim 1.

FINDINGS OF FACT

We find that the following enumerated findings of fact 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).

1. The Appellants' Specification discloses that components connected together are mounted together. (Spec. ¶ 0047, 0049-50, 0055-56, 0064, 0066, 0069-0074.)
2. From the Specification and Figures, it appears when the Appellants' Specification uses the verb "mounted" to express the mode of connection between two components this means: to connect the components in such a manner as to be elevated by or secured to a support. (See *Webster Third New International Dictionary* 1476 (1961)("mount" (verb) 4b: to become elevated by or secured to a support ... <the transmission *mounts* crosswise in the vehicle – *Principles of Automotive Vehicles*>.
3. The Appellants' Specification discloses that a lens cover is mounted by fasteners to the carrier. (Spec. ¶ 0056.)
4. Ponziani describes a module 12. The module 12 is mounted on the door 10. The module 12 contains various circuits. For example, module 12 contains a circuit board 18 with switch 20 and switch control logic 21 for actuating latches 14 and 16 on door 10. (Ponziani, col. 4, ll. 28-47.) Other components that are mounted on module 12 are wiper motor 50, center high mounted stop light area 68

- (CHMSL or chimsel), heater control circuit (not shown), and illumination system 60. (Ponziani, col. 5, ll. 47-50, col. 6, ll. 6-10 and ll. 53-56, col. 7, ll. 15-19.)
5. Ponziani describes once the module is mounted onto the door an aesthetically pleasing interior door cover (not shown) is mounted to hide module 12 and its components. (Ponziani, col. 7, ll. 38-42.)
 6. Module 12 is mounted on an exterior surface of the door 10 that faces the interior of the vehicle. (Ponziani, Figures 1 and 4.)
 7. A heater plug 80 and heater control circuit (not shown) coupled to a conventional heating grid 19 (*sic* 79, see Figure 1), used to defrost the window 82, connects window 82 to module 12. (Ponziani, col. 6, ll. 53-56 and Figure 1.)
 8. Mathias describes mounting a camera unit 18 in a “chimsel.” (Mathias, ¶ 0029.)
 9. Ogawa describes a transparent protective adsorbed monomolecule film 3 for a glass substrate 1. (Ogawa ¶ 0052-0056.) Ogawa describes that the film 3 can be used with motor vehicle and building window glasses, windshields, optical lenses, glass lenses, touch panels, photocopy machine face plates, fresnel plate, display glass, optical filters, lamps, glass or plastic lenses, microscope lens, telescope lens, binocular lens, magnifying glass lens, and other apparatus lenses. (Ogawa ¶ 0002 and 0049.)

PRINCIPLES OF LAW

Anticipation

Anticipation is a question of fact. *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). However, “[t]he law of anticipation does not require that the reference ‘teach’ what the subject patent teaches. Assuming that a reference is properly ‘prior art,’ it is only necessary that the claims under attack, as construed by the court, ‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or ‘fully met’ by it.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

Obviousness

In *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the Supreme Court particularly 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. Importantly, the Supreme Court 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.* The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* (1) “In *United States v. Adams*, 383 U.S. 39, 50-51 (1966), ... [t]he Court recognized that when a patent claims a structure already known in the prior art that is altered by the

mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” *Id.* at 1740.
(2) “In *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 60-62 (1969) ... [t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *Id.* (3) “[I]n *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976), the Court derived ... the conclusion that when a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* The principles underlying these cases are instructive when the question is whether a patent application claiming the combination of elements of prior art would have been obvious. Thus, when considering obviousness of a combination of known elements, the operative question, as stated by the Supreme Court, is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

ANALYSIS

For claim 1

The Appellants contend that claim 1 limits the module or carrier to be mounted on an exterior surface of a vehicle’s lift gate that is also an exterior surface of the vehicle. (Br. 4.) The Examiner determined that claim 1 does not require the exterior surface of the vehicle’s lift gate to form an exterior surface of the vehicle. (Ans. 7.) The Examiner is correct. As the Examiner has pointed out to the Appellants, a vehicle’s lift gate is a three-dimensional

object that has several exterior surfaces. (See Ans. 7.) Ponziani describes a carrier having a plurality of components thereon and attached to an exterior surface of a vehicle's lift gate that faces the interior of the vehicle. (Facts 4 and 6.) As such, the Appellants have failed to persuade us of error in the Examiner's rejection of claim 1 as anticipated by Ponziani.

The Appellants rely on their arguments raised against claim 1 for claims 2, 7-8, 10-11, 15, 21, 22, and 26-29. (Br. 5.) Given that we find those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion with regard to the arguments as they apply to the rejection of these claims; that is, we find them unpersuasive as to error in the rejection.

For claim 9

The Appellants contend Ponziani fails to describe the module having an exterior decorative body because it contains an aesthetically pleasing cover facing the interior of the vehicle to hide the module 12. (Br. 4.) The Examiner finds and responds with a portion of the tailgate forms the exterior decorative body. (Ans. 3 and 7.) While, the Examiner's reasoning in the Answer could have been more detailed, we understand what was intended. Ponziani is not lengthy and, as pointed out by the Appellants, its pertinence is readily apparent. (See Br. 4, ll. 6-8 and 24-25.) Moreover, the reference as a whole is relied on, not just the portions mentioned by the Examiner. Ponziani describes an aesthetically pleasing cover is mounted to the module 12 to cover the module. (Fact 5.) The module 12 is mounted onto an exterior surface of the vehicle's lift gate that faces the interior of the vehicle. (Fact 6.) The claims are not limited to the exterior surface of the vehicle's

lift gate being the exterior surface of the vehicle. As such, Ponziani's aesthetically pleasing cover mounted to module 12 is an exterior decorative body as claimed. Thus, the Appellants have failed to persuade us of error in the Examiner's rejection of claim 9 as anticipated by Ponziani.

For claim 13

The Appellants contend window 82 is not part of the carrier or module 12 nor is attached thereto. (Br. 5.) The Examiner finds the window 82, which the Examiner finds as meeting the lens cover structure of claim 13, is indirectly connected to the module. (Ans. 7.) We understand the Appellants' contention to mean that the claim should be interpreted as requiring the lens cover to be *directly* mounted, i.e. securely attached, affixed, or fastened, to the carrier. We agree with the Appellants this is the proper interpretation of the claim. The claim recites "at least one lens cover mounted on the carrier." The Specification discloses components connected together are mounted in such a manner as to be secured together. (Fact 1.) We find one of ordinary skill in the art would understand in the context of this art that to be "mounted on" would mean to be securely attached, affixed, or fastened to. (Fact 2.) The Specification discloses that the lens cover is mounted by fasteners to the carrier. (Fact 3.) We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims "their broadest reasonable interpretation consistent with the specification" and "in light of the specification as it would be interpreted by one of ordinary skill in the art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). In this case, the broadest reasonable interpretation is the lens cover is *directly* mounted on to the carrier, because one of ordinary skill in this art would understand the

Specification as disclosing components connected together are to be securely attached, affixed, or fastened to each other. (See Facts 1-3.) In addition, the evidence in record fails to show that one of ordinary skill in the art, in the context of the Specification, would understand “mounted-on” to mean more than components being securely attached, affixed, or fastened to (in other words “directly mounted to”). *See, e.g., Asyst Tech., Inc. v. Emtrak, Inc.*, 402 F.3d 1188, 1193-95 (Fed. Cir. 2005). The Examiner finds that although window 82 is not directly mounted to the carrier, its indirect mounting meets claim 13. (Ans. 3 and 7.) We do not read the claim so broadly. The Examiner should have properly read the claim as requiring the lens to be securely attached, affixed, or fastened to the carrier. The Appellants have persuaded us of an error in the Examiner’s rejection of claim 13, because the Examiner’s reading of this claim is too broad as compared to reading one of ordinary skill in the art would give the claim in light of the Specification, and Ponziani connects the window 82 to the module 12 through a series of electrical connections (see Fact 7), not a direct secured connection. As such, we do not sustain the rejection of claim 13. For the same reasons, we do not sustain the rejections of claims 14, 24, and 25.

For claims 3 and 6

The Appellants have argued claims 3 and 6 as a group and we select claim 3 to be representative of this group.

The Appellants contend that based on the teachings of Mathias and the intent of the present invention it would not have been obvious to add a camera to Ponziani. (Br. 5.) The Examiner finds Ponziani has a chimsel connected to the carrier or module 12 and Mathias describes mounting a

component, a camera, to a chimsel. (Ans. 4 and 8.) We agree with the Examiner findings. Mathias describes mounting a camera in the chimsel. (Fact 8.) Ponziani describes its carrier contains a chimsel. (Fact 4.) The Examiner has provided a rationale for applying the teachings of Mathias to Ponziani, which is to improve a driver’s vision of objects behind the vehicle. (Ans. 4.) We find the Examiner has articulated an apparent reason, with logical underpinning, for combining the disclosures of the Ponziani and Mathias in reaching the subject matter of claim 3. Absent unexpected results, when a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than one would expect from such an arrangement, the combination is obvious. *KSR* at 1740 (citing to *Sakraida* 425 U.S. at 282). The Appellants have not provided any evidence of unexpected results for the combination of components claimed. As such, we find, as the Examiner has found, the combination of components claimed is simply an arrangement of old elements with each component performing the same function as it had been known to perform. In addition, the intent of the present invention is not relevant to the determination of whether a claim is obvious because “what matters is the objective reach of the claim.” *Id.* at 1741-1742. In this case, the objective reach of the claim reaches into the combined descriptions of Ponziani and Mathias. Accordingly, we find that the Examiner has established a prima facie case of obviousness and the Appellants’ contention does not persuade us of error in the Examiner’s prima facie case.

For claims 4 and 5

The Appellants argue claims 4 and 5 as a group and we select claim 4 as representative of the group.

The Appellants contend the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 5 because Ogawa is only relevant for a disclosure of a hydrophobic and contamination free transparent substrate to a glass or plastic lens and does not cure the contended deficiencies of Ponziani and Mathias previously noted. (Br. 6.) We are not persuaded by the Appellants' contention that the Examiner has failed to establish a prima facie case of obviousness for claims 4 and 5. We find no deficiencies in Ponziani and Mathias in reaching the subject matter of claim 3, from which claim 4 depends. Ogawa describes a protective film for a variety of lens applications. (Fact 9.) The Examiner finds camera lenses are optical lenses. (Ans. 8.) The Examiner finds that it would have been obvious to apply the teachings of Ogawa to the combination of Ponziani and Mathias in order to reduce the contamination of the lens. (Ans. 5.) We find the Examiner has articulated an apparent reason, with logical underpinning, for combining the disclosures of Ponziani and Mathias with Ogawa in reaching the subject matter of claim 4. Accordingly, we find that the Examiner has established a prima facie case of obviousness and the Appellants' contention does not persuade us of error in the Examiner's prima facie case.

For claims 12, 16, 18-20, 23, 30, 32-34

The Appellants rely on the arguments raised against the rejection of claim 1. (Br. 6-7.) Given that we find those arguments unpersuasive as to error in the rejection of claim 1, we reach the same conclusion with regard to the arguments as they apply to the rejection of these claims; that is, we find them unpersuasive as to error in the rejection.

CONCLUSIONS OF LAW

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 1, 2, 7-11, 15, 21, 22, and 26-29 as being anticipated by Ponziani.

We conclude that the Appellants have not shown that the Examiner erred in rejecting claims 3-6, 12, 16, 18-20, 23, 30, and 32-34 as being unpatentable over Ponziani, taken alone or in combination with Mathias, Ogawa, and/or Galantucci.

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 13, 14, 24, and 25 as being anticipated by Ponziani.

DECISION

The Examiner's decision to reject claims 1-12, 15, 16, 18-23, 26-30, and 32-34 is affirmed.

The Examiner's decision to reject claims 13, 14, 24, and 25 as being unpatentable over Ponziani and Mathias is reversed.

AFFIRMED-IN-PART

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