

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOSEF THEURER and FRIEDRICH PEITL

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Appeal No. 96-2142  
Application 08/284,388<sup>1</sup>

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ON BRIEF

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Before CALVERT, COHEN and ABRAMS, Administrative Patent Judges.  
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 7 to 9 and 11. The other claims remaining in the application, claims 3 to 6 and 12, have been allowed.

The subject matter in issue concerns a machine for lining a track. The appealed claims are set forth in the appendix to appellants' brief.

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<sup>1</sup>Application for patent filed August 2, 1994.

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The references applied in the final rejection are:

Theurer et al.	(Theurer '753)	4,399,753	Aug. 23, 1983
Theurer	(Theurer '767)	5,113,767	May 19, 1992

Claims 1, 7 to 9 and 11 stand finally rejected under 35 USC § 103 as unpatentable over Theurer '767 in view of Theurer '753.

The basis of the rejection is stated on page 3 of the examiner's answer, and need not be repeated here.

Appellants do not contend that the combination of Theurer '767 and '753, as postulated by the examiner, would not meet all the limitations of claim 1. However, they argue that Theurer '753 is nonanalogous art, and therefore not properly combinable as a secondary reference, because it is not pertinent to the problem with which appellants were involved, viz., "the problem of preventing vibration to be [sic: being] transmitted from a track stabilization assembly to a lining drive" (brief, page 6). In support of this argument, they cite Oscar Mayer Foods Corp. v. ConAgra Inc., 35 USPQ2d 1278, 1281 (Fed. Cir. 1994), but the citation of this decision is considered improper since, as noted at page 1278 of the USPQ report, the Court indicated that the Oscar Mayer decision was not citable as precedent. See Shaked v. Taniguchi, 21 USPQ2d 1291, 1292 (1991) wherein the Commissioner stated (original emphasis:)

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Unpublished (or non-precedential) opinions of the Federal Circuit are not precedent in the Federal Circuit and will not be cited, considered, or regarded as precedent by the EIC, the Board, or any other tribunal within the Patent and Trademark Office.

In any event, we do not consider appellants' argument concerning nonanalogous art to be well taken. The test for determining whether prior art is analogous is well established; as set forth in In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992) (referred to in Oscar Mayer):

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

In the present case, Theurer '753 meets the first of these criteria since, being directed to a mobile track correction machine, it is clearly from the same field of endeavor as appellants' invention. The argument in the reply brief that appellants' "field of endeavor" is the same as the particular

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problem with which they were involved (i.e., preventing the transmission of vibration to the lining drive means) places far too restrictive an interpretation on the term "field of endeavor", and is not sustainable in view of the statement in In re Clay, supra, that the "field of endeavor" criterion is applicable "regardless of the problem addressed." If appellants' interpretation were adopted, there would be no difference between the two criteria set forth in In re Clay.

Appellants further argue that, while Theurer '753 discloses several benefits of the lining means (with an interposed lever) disclosed therein, it would not have been obvious to utilize the Theurer '753 lining means as the lining means in the Theurer '767 apparatus because one of ordinary skill would not have done so in order to solve the vibration transmission problem faced by appellants.

We do not agree. "As long as some motivation or suggestion is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor." In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). See also In re

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Kemps, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1311 (Fed. Cir. 1996), and In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990). Here, the numerous benefits disclosed by Theurer '753 (e.g., at col. 2, lines 35 to 56) would have provided ample motivation for one of ordinary skill in the art to combine the references as proposed by the examiner, notwithstanding that the combination would be for a different purpose than appellants'.

As the examiner correctly states at page 4 of the answer:

the fact that Applicant [sic] uses the spacing member means in the form of a force-transmitting lever for a different purpose [than Theurer '753] does not alter the conclusion that its use in a prior art device would be [sic: have been] prima facie obvious from the purpose disclosed in the reference.

Accordingly, we conclude that claim 1 is unpatentable under 35 USC § 103. On page 3 of the brief, appellants group claims 9 and 11 with claim 1. They also state that "they will argue that claims 7 and 8 are allowable on their own merits", but no explanation is presented as to why these claims are believed to be separately patentable. Claims 7 to 9 and 11 therefore fall with claim 1. 37 CFR § 1.192(c)(7).

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Conclusion

The examiner's decision to reject claims 1, 7 to 9 and 11 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
IRWIN CHARLES COHEN	)	BOARD OF PATENT
Administrative Patent Judge	)	APPEALS AND
	)	INTERFERENCES
	)	
	)	
NEAL E. ABRAMS	)	
Administrative Patent Judge	)	

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