

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DEREK K. GAUGER and JOSEPH J. GRAJEWSKI

Appeal No. 98-1455
Application No. 08/625,936¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 20, which are all of the claims pending in this application.²

¹ Application for patent filed April 1, 1996.

² Claims 10, 16, 17 and 20 were amended subsequent to the final rejection. It is apparent that the examiner has withdrawn the rejection of claims 10, 17 and 20 under 35 U.S.C. § 112, second paragraph, made in the final rejection since the answer does not set forth this rejection as a ground

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We AFFIRM-IN-PART.

of rejection under appeal.

BACKGROUND

The appellants' invention relates to a linkage assembly with extruded hole member. An understanding of the invention can be derived from a reading of exemplary claims 1 and 16, which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Williams 1958	2,865,428	Dec. 23,
De Rose 1959	2,892,483	June 30,
Chinomi 1996	5,501,422	Mar. 26,

Claim 16 stands rejected under 35 U.S.C. § 102(b) as being anticipated by De Rose.

Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over De Rose.

Claims 18 through 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over De Rose.

Claims 1 through 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Chinomi in view of De Rose and Williams.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 15, mailed November 17, 1997) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 14, filed October 17, 1997) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the

examiner. As a consequence of our review, we make the determinations which follow.

The anticipation issues

We sustain the rejection of claims 16 and 17 under 35 U.S.C. § 102(b) as being anticipated by De Rose.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but

only that the claims on appeal "read on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

Claims 16 is drawn to a linkage member, per se, for welded attachment to an elongate torsion member. The linkage member comprises, inter alia, a unitary body and a collar means. The collar means includes an integrally formed extruded flange extending outwardly from the body. Dependent claim 17 adds to parent claim 16 the limitation that the flange is "capable of having a wall thickness between about 50% and about 150% of a wall thickness of a torsion member."

From our perspective, claims 16 and 17 are anticipated by De Rose. De Rose (see Figures 13-17) clearly shows a member 101 (i.e., a linkage member) mounted on a shaft 96 (i.e., a torsion member). The member 101 comprises spaced side plates 102 (one of which can be considered to be a unitary body) connected at a common hub 103 (i.e., a collar means). As shown in Figure 17, the hub 103 has a flange extending to the

right of the right side plate 102. It is our opinion that the claimed "integrally formed extruded flange extending outwardly from the body" is readable on this flange of De Rose. As to claim 17, the thickness of this flange of De Rose is clearly **capable** of being between about 50% and about 150% of a wall thickness of a torsion member inserted into the hub 103.

The argument presented by the appellants (brief, pp. 7-11) with respect to claim 16 does not convince us that the subject matter of claim 16 is novel. In that regard, we must point out that the claimed subject matter is the linkage member per se, not the combination of the linkage member, torsion member and weld seam as set forth in claims 1 through 15. It is our determination that De Rose's hub 103 (i.e., the collar means) is inherently capable of equalizing mass of one of the side plates 102 (i.e., the body) with respect to a torsion member adjacent a weld site for attaching the side plate to the torsion member. The appellants argue that De Rose does not teach welding the hub 103, and more specifically the flange of the hub, to the torsion member to secure the side links 102 thereto. While this is true, we must point out

that such is not claimed. The appellants also argue that the claimed "integrally formed extruded flange extending outwardly from the body" is not taught by De Rose. As pointed above, it is our opinion that the claimed "integrally formed extruded flange extending outwardly from the body" is readable on the flange of De Rose. As shown by the hatching of Figure 17, the hub 103 is an integrally formed member having a flange extending outwardly from the rightmost side plate 102.

While De Rose does not specifically teach that the hub 103 is made by extrusion, the appellants have offered no evidence³ that (1) the term "extruded" as used in claim 16 is a structural limitation, and (2) that the hub 103 of De Rose could not be formed by extrusion (see page 8 of the brief). It is our determination that this method of making limitation does not affect the product itself (i.e., the claimed linkage member) and therefore cannot impart patentability to the product. See In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964,

³ Attorney's arguments in a brief cannot take the place of evidence. In re Pearson, 494 F.2d 1399, 1405, 181 USPQ 641, 646 (CCPA 1974).

966 (Fed. Cir. 1985) (Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.). Once the appellants have been provided with a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the appellants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. See In re Marosi, 710 F.2d 799, 803, 218 USPQ 289, 292-93 (Fed. Cir. 1983). The appellants have not come forward with any evidence to satisfy that burden. Compare In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977); In re Ludtke, 441 F.2d 660, 664, 169 USPQ 563, 566-67 (CCPA 1971).

The argument presented by the appellants (brief, pp. 9-11) with respect to claim 17 does not convince us that the subject matter of claim 17 is novel. Specifically, the appellants argue that De Rose does not teach any specific thickness of a flange relative to the thickness of a torsion member since there is no reason for varying the wall thickness. This argument is unpersuasive since it is not commensurate in scope with the claimed invention. Once again, as pointed out above, the claimed invention is the linkage member per se. The claimed recitation of claim 17 (i.e., the flange is "capable of having a wall thickness between about 50% and about 150% of a wall thickness of a torsion member") reads on the flanged end of Dr Rose's hub 103 since the flanged end has a predetermined thickness, which thickness is **capable** of being between about 50% and about 150% of a wall thickness of a torsion member placed through the opening in the hub 103.

For the reasons set forth above, the decision of the examiner to reject claims 16 and 17 under 35 U.S.C. § 102(b) is affirmed.

The obviousness issues

We sustain the rejection of claims 17 through 20 under 35 U.S.C. § 103, but not the rejection of claims 1 through 15.

Claim 17

As noted above, De Rose does teach all the limitations of claim 17. A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974). Thus, the decision of the examiner to reject claim 17 under 35 U.S.C. § 103 is affirmed.

Claims 18 through 20

Dependent claim 18 adds to parent claim 16 the limitation that the flange has "a wall thickness less than a thickness of the unitary body."

De Rose does not teach the relative thickness of his flange relative to the thickness of one of his side plates 102. However, the claimed unitary body reads on both side plates 102 and the connecting hub 103 therebetween (i.e., all

of connecting hub 103 except for the projecting flange as discussed above). When read in this manner, as shown in Figure 17, the wall thickness of the flange is shown to be less than the thickness of the unitary body. Thus, De Rose anticipates claim 18 and "anticipation is the epitome of obviousness." Furthermore, it is our determination that the relative thickness between De Rose's flange relative to the thickness of one of his side plates 102 would have been an obvious matter of engineering design as in In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975) ("Use of such means of electrical connection in lieu of those used in the references solves no stated problem and would be an obvious matter of design choice within the skill in the art." (citations omitted)).

Dependent claim 19 adds to parent claim 16 the limitation that the flange extends "outwardly from the unitary body by a dimension at least as great as a thickness of the unitary body."

De Rose does not specifically teach the distance his flange projects relative to the thickness of one of his side plates 102. However, as shown in Figure 17, the distance his flange projects is shown to be about equal to the thickness of one of his side plates 102. Thus, De Rose would appear to anticipate claim 19 and "anticipation is the epitome of obviousness." Furthermore, it is our determination that the relative projection distance of De Rose's flange relative to the thickness of one of his side plates 102 would have been an obvious matter of engineering design as in Kuhle.

Dependent claim 20 adds to parent claim 16 the limitation that the flange is "capable of receiving a weld seam formable at the weld site for integrally attaching the unitary body to a torsion member, the weld seam having a thickness essentially equal to a wall thickness of the flange."

De Rose's flange is clearly **capable** of receiving a weld seam formable at the weld site for integrally attaching the side plate 102 (i.e., unitary body) to a torsion member, the

weld seam having a thickness essentially equal to the wall thickness of the flange. Thus, De Rose anticipates claim 20 and "anticipation is the epitome of obviousness."

The argument presented by the appellants (brief, pp. 12-13) with respect to claims 18 through 20 is unpersuasive for the reasons set forth above. In addition, we observe that an artisan must be presumed to know something about the art apart from what the references disclose (see In re Jacoby, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962)) and the conclusion of obviousness may be made from "common knowledge and common sense" of the person of ordinary skill in the art (see In re Bozek, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969)). Moreover, skill is presumed on the part of those practicing in the art. See In re Sovish, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985).

Claims 1 through 15

Claims 1⁴ through 8 are drawn to a linkage assembly comprising, inter alia, at least one linkage member having a flat body region and a flange member, an elongated torsion member and a weld seam integrally attached to the flange member and the outer surface of the torsion member. Claims 9⁵ through 15 are drawn to a seat track mechanism comprising, inter alia, a linkage member having a flat body portion and a flange member, a torsion bar and a weld seam integrally attached to the terminal surface of the flange member and the outer surface of the torsion bar.

In applying the test for obviousness⁶, we reach the conclusion that the claimed subject matter would not have been suggested by the applied prior art. Specifically, we see no

⁴ In claim 1, line 18, the phrase "the flange" should be "the flange member" for proper antecedent basis.

⁵ In claim 9, line 39, the phrase "the flange" should be "the flange member" and in claim 9, lines 39 and 42, the term "rod" should be "bar" for proper antecedent basis.

⁶ The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

suggestion in the applied prior art of modifying Chinomi by the flange on De Rose's hub 103. Thus, we must conclude that the examiner used impermissible hindsight.⁷ In addition, we perceive no suggestion in Williams to provide the claimed weld seam (i.e., weld the flange member to the torsion member) absent the use of impermissible hindsight since Williams teaches welding the flat body portion/region and not a flange member of the arm 115 (i.e., the linkage member) to the torsion bar 114 as shown in Figure 4.

Since all the limitations of claims 1 through 15 are not suggested by the applied prior art for the reasons set forth

⁷ The conclusion that the claimed subject matter is obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

above, the decision of the examiner to reject claims 1 through 15 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 15 under 35 U.S.C. § 103 is reversed; the decision of the examiner to reject claims 16 and 17 under 35 U.S.C. § 102(b) is affirmed; and the decision of the examiner to reject claims 17 through 20 under 35 U.S.C. § 103 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-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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ANDREW R. BASILE
BASILE AND HANLON
SUITE 624
3001 WEST BIG BEAVER ROAD
TROY, MI 48084

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APJ NASE

APJ COHEN

APJ ABRAMS

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 11 Dec 98

FINAL TYPED: