

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DON H. SITTER and DALE P. GILSON

Appeal No. 1999-0346
Application No. 08/760,683¹

ON BRIEF

Before McCANDLISH, Senior Administrative Patent Judge, MEISTER
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 10 and 13, which are all of the claims pending in this application. On page 3 of the appellants' brief (Paper No. 11, filed July 6, 1998), the appellants state that they "do not appeal claim 13."

¹ Application for patent filed December 4, 1996.

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Accordingly, the appeal with respect to claim 13 is dismissed.

Claims 1 through 10 remain on appeal.

We AFFIRM-IN-PART.

BACKGROUND

The appellants' invention relates to a vibration damping pivot bushing. An understanding of the invention can be derived from a reading of exemplary claim 1, which appears in the appendix to the appellants' brief.

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

Ulderup et al. (Ulderup)	2,958,526	Nov.
1, 1960		
Damon	3,572,677	Mar. 30,
1971		

Claim 5 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 1 through 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ulderup in view of Damon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (Paper No. 9, mailed February 9, 1998) and the examiner's answer (Paper No. 12, mailed July 21, 1998) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief for the appellants' arguments thereagainst.

OPINION

The indefiniteness rejection

We sustain the rejection of claim 5 under 35 U.S.C. § 112, second paragraph.

In the final rejection (p. 2), the examiner rejected claim 5 as being indefinite for the following two reasons. One, it was not clear exactly which elastic member was being referenced on the last line of claim 5. Two, it was not clear exactly what is meant by "along the entire **length**."

The appellants have not specifically contested this rejection. Accordingly, we summarily sustain the rejection of claim 5 under 35 U.S.C. § 112, second paragraph.

The obviousness rejection

In reaching our decision in this appeal on this rejection, 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. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner² is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 10 under 35 U.S.C. § 103. Our reasoning for this determination follows.

² On page 6 of the answer, the examiner refers to a number of references of record that have not been applied in the rejection under appeal. These references will be given no consideration since they were not included in the statement of the rejection. See Ex parte Raske, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art 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) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue that the applied prior art does not suggest the claimed subject matter. Specifically, the appellants argue that (1) the combination of Ulderup and Damon is "simply untenable and is constructed solely from the hindsight provided by reading the patent specification," and (2) the limitation that the first and second elastomeric members are compressively preloaded to "fill" the annular space is not met due to Damon's teaching of gap 126. We agree.

Claims 1 through 8 recite a bushing which includes

a first and second elastomeric member, said elastomeric members shaped in a complementary manner and compressively preloaded to fill an annular space between the sleeve and the jacket so that the sleeve and the jacket are substantially coaxial when the bushing is in a substantially unloaded condition;

wherein the first and second elastomeric members each have a spring rate such that the bushing has a first spring rate when measured in a first radial direction and a second spring rate when measured in a second radial direction offset one hundred and eighty degrees from the first radial direction.

Claims 9 and 10 recite a suspension system having a bushing which includes

a first and second elastomeric member, the elastomeric members shaped in a complementary manner and compressively preloaded to fill an annular space between the sleeve and the jacket so that the sleeve and the jacket are substantially coaxial when the bushing is substantially unloaded;

said suspension system characterized by a first spring rate when measured in a first radial direction and a second spring rate when measured in a second radial direction offset one hundred and eighty degrees from the first radial direction.

However, these limitations of claims 1 through 10 are not suggested by the applied prior art. In that regard, while Damon does teach a suspension system which includes a bushing characterized by a first spring rate when measured in a first radial direction and a second spring rate when measured in a

second radial direction offset one hundred and eighty degrees from the first radial direction, Damon also teaches and suggests that the sleeve and the jacket are **not** substantially coaxial when the bushing is substantially unloaded

In our view, the only suggestion for modifying Ulderup in the manner proposed by the examiner to meet the above-noted limitations stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejections of claims 1 through 10.

CONCLUSION

To summarize, the appeal with respect to claim 13 is dismissed; the decision of the examiner to reject claim 5 under 35 U.S.C. § 112, second paragraph, is affirmed; and the decision of the examiner to reject claims 1 through 10 under 35 U.S.C.

§ 103 is reversed.

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

HARRISON E. McCANDLISH)	
Senior Administrative Patent Judge)	
))	
)	
)	
)	BOARD OF PATENT
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
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JEFFREY V. NASE)	
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APJ NASE

APJ MEISTER

SAPJ McCANDLISH

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 18 Jun 99

FINAL TYPED: