

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(2) is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte RONALD N. BRISSETTE, GARY J. KOSLOWSKI,  
and CRAIG HOLT

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Appeal No. 1999-1499  
Application No. 08/764,736

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ON BRIEF

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Before FRANKFORT, PATE and MCQUADE, Administrative Patent  
Judges. FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal  
to allow claims 1 and 3 through 18, which are all of the  
claims pending in this application. Claims 2, 19 and 20 have  
been canceled.

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We AFFIRM-IN-PART and denominate our affirmance as a new ground of rejection pursuant to 37 CFR § 1.196(b).

BACKGROUND

The appellants' invention relates to a universal joint assembly. An understanding of the invention can be derived from a reading of exemplary claims 1 and 11, 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:

Dutkiewicz et al. (Dutkiewicz)	5,000,609	Mar. 19, 1991
Borg-Warner Corporation (Borg-Warner) (British Patent Specification)	705,009	Mar. 3, 1954

Claims 1 and 3 through 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of

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Dutkiewicz.<sup>1</sup>

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 23, mailed December 7, 1998) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 22, filed September 2, 1998) and reply brief (Paper No. 24, filed February 12, 1999) for the appellants' arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

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<sup>1</sup> A review of the application file reveals that this rejection was first entered by the examiner in his answer (Paper No. 23, mailed December 7, 1998). While 37 CFR § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer, appellants have responded to this rejection in a Reply Brief (Paper No. 24, filed February 12, 1999), and have waived their right to allege that the examiner's answer contains an impermissible new ground of rejection, as they have not timely filed a petition under 37 CFR § 1.181(a). See Manual of Patent Examining Procedure § 1208.01.

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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.

As a preliminary matter, our review of the application file reveals numerous points of objection in the appealed claims. However, we have read and interpreted the claims in light of appellants' disclosure, and make the following observations about claims 1 and 3 through 18 on appeal:

In claim 1;

line 4 "having two opposed arms, each arm having two brackets" should be --having two opposed brackets, each bracket having two arms--,

line 5 "bore and" should be --bore; and--,

lines 11-12 "said bearing including a depression on an end face" should be deleted because "a depression" and "an outer face" are previously defined in line 7 of claim 1, and

line 13 "said yoke" should be --said second yoke--.

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In claim 11;

lines 6-7 "two opposing arms, each arm having two brackets extending from said arm" should be --two opposing brackets, each bracket having two arms extending from said bracket--,

line 20 "said yokes" should be --said second yoke--.

In claim 12;

lines 1 and 2 "said second yoke further includes a locator finger disposed between said arms" should be --said finger is disposed between said arms--, and

line 2 "bearings" should be --bearing--.<sup>2</sup>

We note that in their brief (Paper No. 22, page 4) appellants indicate that the appealed claims do not stand or fall together, and have separately argued the patentability of

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<sup>2</sup> While appellants' disclosure has provided us with the understanding to interpret appealed claims 1 and 3 through 18 as indicated, these issues should be addressed by the appellants and the examiner upon further prosecution of the application.

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the dependent claims with reasonable specificity. As a result, we will treat the claims as not standing or falling on the limitations of independent claims 1 and 11 on appeal.

Looking first at the examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz, we note that both the examiner and appellants appear to agree that Borg-Warner shows a universal joint which is basically the same as that set forth in claim 1 on appeal. In that regard, Borg-Warner shows a cross member C having a first and second pair of shafts 17, 18, a first yoke A connected to the first pair of shafts 17, a second yoke B having two opposed brackets 23, each bracket having two arms, with each arm including a bore 29, a locator finger 33 is disposed on each arm and is formed integrally therewith, two bearings D each including a hollow cup 27 and two opposed wings 28, each wing having a securement hole 30. Depression 34 is disposed on an outer face of each bearing D. The second pair of shafts 18 are each received in one of the cups 27, and the bearings D are connected to brackets 23 with securement members 31 passing through holes 30 and received in

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bores 29. Locator fingers 33 extend over the bearing D and are received in depression 34.

Borg-Warner thus discloses the subject matter of appellants' independent claim 1 except for an integrally formed locator finger which is disposed between the arms 26 of brackets 23, is received in a depression on an outer face of each bearing, and which transmits rotation from the second yoke B directly to the wings of each bearing. The examiner recognizes this, and turns to the Dutkiewicz patent for a teaching of a finger 20c which is disposed between, and is formed integrally with the arms 20a of universal joint yoke 20.

Based on the collective teachings of Borg-Warner and Dutkiewicz the examiner concluded (answer, page 4) that

[i]t would have been obvious to one of ordinary skill in the art to provide British '009 [Borg-Warner] with a second yoke having two opposed brackets and two arms defining a bore, and a locator finger, as taught by Dutkiewicz et al, for the purpose of securely fastening the wing bearings.

The examiner states (answer, page 7) that

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logic and common sense fairly suggests that the finger of Dutkiewicz et al transmits rotation as required by the claims.

In support thereof, the examiner refers to Dutkiewicz (column 5, lines 32-35) wherein it states:

An upstanding locating tang 20c is formed on each of the arm portions 20a **to assist in properly locating the bearing cups 13 and the cross 12 during assembly into the yoke 20** (emphasis ours).

We find the examiner's arguments to be unpersuasive. In that regard, while we fully appreciate the examiner's evaluation of the applied patents, and have ourselves considered such references with an eye towards the level of skill that is presumed on the part of those practicing in the art at issue, it is clear to us that finger 20c, by virtue of its reception into apertures 10e of Dutkiewicz's retainer 10 merely locates bearing cups 13 and cross 12 during assembly into yoke 20. Unlike the examiner, we are not of the view that the finger of Dutkiewicz transmits rotation from the yoke to the bearings. Furthermore, we see no teaching or motivation in the teachings of the applied prior art that

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would have suggested to one of ordinary skill in the art at the time the invention was made to modify the Borg-Warner reference by providing a centrally located finger to engage depression 34. Therefore, we must agree with appellants that in this particular instance the combination proposed by the examiner is based on what appellants teach and not on what the prior art references would have fairly taught or suggested to one of ordinary skill in the art at the time of appellants' invention.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none.

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Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decisionmaker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellants' own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain

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the examiner's rejection of independent claim 1 and claims 3 through 10 dependent thereon under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz.

We turn now to the examiner's rejection of independent claim 11 under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz. Independent claim 11 differs from claim 1 in that it defines a universal joint assembly comprising a first universal joint subassembly and a second universal joint subassembly. The details of the universal joint assembly are defined in the same manner as that set forth in claim 1. However, it is apparent that claim 11 is broader than claim 1, in that claim 11 does not limit the locator finger to be integral with and located between the bracket arms of the second yoke. Nor, does claim 11 require that the finger transmit rotation from the second yoke directly to the wings of the second bearings. In that regard, claim 11, lines 20 and 21 recite:

said wing bearing cups being closed at an outer surface, and a finger from said [second yoke] being received in a depression in said outer surface.

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While we cannot support the examiner's combination of Borg-Warner and Dutkiewicz, we nonetheless will sustain the examiner's rejection of claim 11 under 35 U.S.C. § 103(a). In reaching this conclusion we have carefully reviewed the complete disclosure of the Borg-Warner reference, and find that the subject matter set forth in claim 11 on appeal lacks novelty with regard to the universal joint assembly found therein. We refer specifically to flanges or fingers 33 on the outer extremity 26 of each arm of yoke B. Fingers 33 are received in depression 34 in the outer surface of bearing cups D. Given this teaching in Borg-Warner, we find the examiner's use of the Dutkiewicz patent to be mere surplusage. As noted above, Borg-Warner teaches all the limitations of claim 11. 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, we sustain the examiner's rejection of appealed claim 11 under 35

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U.S.C.

§ 103(a).

We next review the examiner's rejection of dependent claims 15, 16 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz. These claims recite, respectively, (1) that the arms extend from the second yoke bracket to at least partially surround the second pair of shafts, (2) that the ends of the arms are spaced by at least 90° measured from a central axis of the second pair of shafts, and (3) that the fully enclosed bores are circular. In looking at the Borg-Warner reference, we see that the arms of the brackets 23 partially surround shafts 18 and that the ends of the arms are spaced by at least 90° when measured from a central axis of shafts 18. Borg-Warner additionally shows (Fig. 3) fully enclosed circular bores 15 in the arms 14 of the yoke A. As we concluded in our analysis of independent claim 11, the Borg-Warner reference teaches each and every limitation of dependent claims 15, 16 and 18. Thus, Borg-Warner anticipates claims 15, 16 and 18, and because "anticipation is the epitome of obviousness" we will,

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therefore, sustain the examiner's rejection of claims 15, 16 and 18 under 35 U.S.C. § 103(a).

We now consider the examiner's rejection of dependent claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz. Claim 12 recites that the finger of appellants' invention is disposed between the arms of the second yoke, and that the finger extends into a depression on an outer face of the wing bearing. Thus, claim 12 recites essentially the same subject matter as that of independent claim 1. As we noted in our analysis of the rejection of independent claim 1, the examiner was aware of the fact that these features are lacking in the Borg-Warner reference and turned to the teaching of Dutkiewicz for a finger 20c located between arms 20a of yoke 20. The examiner then concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified Borg-Warner by providing a finger between the yoke arms, as taught by Dutkiewicz. Again, we do not agree. As we concluded above in our analysis of the examiner's rejection of claim 1 under

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35 U.S.C. § 103(a), we find no suggestion or incentive in the teachings of the combined prior art that would have led one of ordinary skill in this art at the time of appellants' invention, to modify the references in the manner urged by the examiner. In our view, the teachings of the prior art relied upon by the examiner as suggesting the subject matter of claim 12 are only sufficient when combined with impermissible hindsight.

Since all the limitations of dependent claim 12 are not taught or suggested by the applied prior art, the decision of the examiner to reject claim 12, and claims 13 and 14 dependent thereon, under 35 U.S.C. § 103(a) is reversed.

The last of the examiner's rejections for our review is that of dependent claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Borg-Warner in view of Dutkiewicz. We note that claim 17 recites that

**said second yoke includes a lip** which extends radially inwardly, and between said arms, overlying a top portion of said wing bearings (claim 17, our emphasis).

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A lip being absent from the teachings of Borg-Warner, the examiner again turned to the teachings of Dutkiewicz which shows retainer 10 which is inserted into yoke 20 between arms 20a. The retainer 10 has a "lip" 10c which, as part of retainer 10, functions to retain bearing cups 13 on cross 12 primarily during shipping. The examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Borg-Warner by providing a lip extending radially inwardly between the yoke arms, as taught by lip 10c extending between yoke arms 20a of Dutkiewicz. In support thereof, the examiner refers to Dutkiewicz at column 5, lines 6-8 which states:

If desired, however, the retainer 10 may be permanently secured to the bearing cups 13 before shipment.

In addition, the examiner makes note of column 5, lines 53-57 of Dutkiewicz which states:

If the retainer 10 is permanently secured to the bearing cups 13, then the retainer 10 additionally functions to limit the amount by which the bearing cups 13 may rotate relative to the yoke 20 following installation therein.

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The examiner argues (answer, page 8) that

Dutkiewicz et al clearly states that the retainer 10 can be permanently secured to the bearing cups and additionally functions to limit the amount by which the bearing cups may rotate relative to the yoke following installation therein. Therefore, if the retainer is a permanent part of the assembly, then the retainer, the bearing cups, and the yoke become an integral functioning member/assembly. Further noting that integral does not require the elements to be one homogenous piece, then element 10c meets the limitation of a lip extending outwardly of the mating surfaces, and between the arm[s] to overlay a top portion of the shoulder.

We do not share the examiner's view in this matter. In that regard, it is clear to us that the retainer 10 of Dutkiewicz may be a permanent part of cross 12 and bearing cups 13, and not of yoke 20 as the examiner would have us believe. While it is true that the assembly of cross 12, bearing cups 13 and retainer 10 with lip 10c is to be inserted between arms 20a of yoke 20, appellants' claim 17 expressly requires that "said **second yoke includes a lip** which extends radially inwardly" (emphasis ours). We must, therefore, agree with the appellants when they argue (reply brief, page 3) that the "retainer 10, and its portions 10[c], are not part of the yoke." We fail to perceive any teaching, suggestion or incentive in either Borg-Warner or Dutkiewicz which would have

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led one of ordinary skill in the art to have yoke B of Borg-Warner include a radially inwardly directed lip between the arms of the brackets 23 and overlying bearings D, absent the use of impermissible hindsight on the part of the examiner. However, 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, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Since all the limitations of claim 17 are not taught or suggested by the applied prior art, the decision of the examiner to reject claim 17 under 35 U.S.C. § 103(a) is reversed.

Since the examiner did belatedly make a new ground of rejection in his answer (Paper No. 23, mailed December 7, 1998), and since the thrust of our position for supporting that rejection of claims 11, 15, 16 and 18 differs significantly from that found in the examiner's answer, we hereby designate our affirmance of the rejection of claims 11,

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15, 16 and 18 as being a new ground of rejection pursuant to 37 CFR § 1.196(b).

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 3 through 10, 12 through 14 and 17 under 35 U.S.C. § 103(a) is reversed, however, the decision of the examiner to reject claims 11, 15, 16 and 18 is affirmed, the rejection being denominated a new ground of rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "[a] new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must

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exercise one of the following two options with respect to the  
new ground of rejection to avoid termination of proceedings

(37 CFR

§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the  
claims so rejected or a showing of facts relating to  
the claims so rejected, or both, and have the matter  
reconsidered by the examiner, in which event the  
application will be remanded to the examiner. . . .

(2) Request that the application be reheard  
under § 1.197(b) by the Board of Patent Appeals and  
Interferences upon the same record. . . .

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR

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§ 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
WILLIAM F. PATE, III	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JOHN P. MCQUADE	)	
Administrative Patent Judge	)	

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KEYBOARD ( )

FRANKFORT

APPEAL NO. 1999-1499 - JUDGE

APPLICATION NO. 08/764,736

APJ FRANKFORT

APJ McQUADE

APJ PATE

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR 1.196(b)**

Prepared By:

**DRAFT TYPED:** 04 Feb 02

**FINAL TYPED:**