

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT L. CADDEN

Appeal No. 2000-0209
Application No. 08/693,985

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 to 5, 8 to 10 and 12. Claims 6 and 7 have been objected to as depending from a non-allowed claim. Claim 11 has been canceled.

We AFFIRM-IN-PART.

BACKGROUND

The appellant's invention relates to a suspension system. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

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

Hayes 1951	2,576,935	Dec. 4,
Masser 1968	3,406,983	Oct. 22,
Raidel 1978	4,114,923	Sep. 19,
Snyder 1994	5,346,247	Sep. 13,
Brandt 1995	5,458,359	Oct. 17,
Baxter 1995	5,470,096	Nov. 28,

Claims 2, 3/2, 4, 5 and 10 stand 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 appellant regards as the invention.

Claims 1 and 3/1 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snyder in view of Hayes.

Claims 2, 3/2, 5 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snyder in view of Hayes and Masser.

Claims 2 and 4 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snyder in view of Brandt.

Claims 8 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Snyder in view of Hayes and Baxter.

Claim 9 stands rejected under 35 U.S.C. § 103 as being unpatentable over Snyder in view of Hayes and Raidel.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the final rejection (Paper No. 10, mailed November 3, 1998) and the answer (Paper No. 14, mailed June 2, 1999) for the examiner's complete reasoning in

support of the rejections, and to the brief (Paper No. 13, filed March 31, 1999) and reply brief (Paper No. 15, filed July 19, 1999) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The obviousness rejections

We will not sustain the rejection of claims 1 to 5, 8 to 10 and 12 under 35 U.S.C. § 103.

Claim 1, the sole independent claim on appeal, reads as follows:

A suspension system installed between a chassis having side rail members and cross frame members and an axle of a vehicle, said suspension system including a step spring having a forward generally horizontal section having a leading end, a rearward generally horizontal

section having a trailing end, a generally vertical section between and contiguous with the forward and rearward sections and displacing the rearward section below the forward section, said leading end of said step spring being pivotally attached to said chassis, spring means extending between said chassis and said trailing end of said step spring and said axle being pivotally secured by pivot means to a mounting means on said forward generally horizontal section, said pivot means being above said axle.

Snyder's invention is directed to an "air ride" suspension for a truck, a tractor, or a trailer, which suspension reduces the tare weight of the vehicle so that a greater payload can be carried by the vehicle under existing highway weight restrictions. As shown in Figure 1, the "air ride" suspension 19 is interposed between a frame 11 of the vehicle and an axle 15. The suspension 19 includes a gooseneck spring 21, an air bag spring 43, a shock absorber 67 and a rigid torque arm 75. The gooseneck spring has a center section 23 clamped to the axle 15, an upwardly inclined front portion 25, a lower rear portion 27 and a vertical portion 29 that is inwardly twisted as shown most clearly in Figures 4 and 5. The upwardly inclined front portion 25 of the

gooseneck spring 21 bears against a plastic pad 35 attached to the upper end of a spring hanger 37 which is mounted on beam 13 of the frame 11. Snyder's air bag spring 43 is supported on and bolted to the lower rear portion 27 of the goose-neck spring 21. The top of the air bag spring 43 is mounted on the outer surface of the side beam 13. The shock absorber 67 extends between the beam 13 and the axle 15 inclined both transversely and longitudinally relative to the vehicle.

As shown in Figures 1-3 of Snyder, a top plate 51 rests on and engages the top surface of the center section 23 of the gooseneck spring 21. The lower surface of the center section of the spring engages an axle seat 53 which in turn rests on the top of the axle 15 which is tilted slightly rearwardly of the vertical. A cylindrical stud 31 depending from the spring 21 seats in a socket (not shown) in the top surface of the axle seat 53. A forwardly extending yoke arm 55 is formed integrally with the axle seat 53. A bottom plate 57 engages the lower portion of the axle 15 with the top plate, bottom plate, and axle seat clamped to the center section of the

spring 23 by U-bolts 59. The U-bolts are tightened by self-locking nuts 61 which engage the threaded lower ends of the U-bolts. The rigid torque arm 75 connects between the yoke arm 55 of the axle seat 53 and the front spring hanger 37.

Hayes' invention relates to spring suspensions for motor vehicles and more particularly to an overload spring rockably mounted on the vehicle axis. Hayes teaches (column 1, lines 5-12) that

[a]n important object of the invention is to provide a rigid arm rockably mounted at a point intermediate its ends on the axle of the vehicle to function as a lever and with spring means connecting one end of the arm to the vehicle frame and with shock absorbing means connecting the other end of the arm to the frame of the vehicle.

As shown in Figure 1 of Hayes, the number 5 designates a rigid spring suspension arm formed with an apertured lug 6 on its upper side. A lower saddle plate 8 is provided with a pair of spaced apart apertured lugs 7 so that lugs 6 and 7 can be pivoted together by a bolt or pin 9 for rockably connecting the arm 5 to the lower saddle plate 8. The lower saddle plate

8 is secured to the underside of vehicle axle 10 by U-bolts 11 which also secure an upper saddle plate 12 in position on the axle 10. A cup-shaped socket 13 formed on the upper saddle plate 12 receives the lower end of a coil spring 14. The upper end of the coil spring 14 is received in a socket 15 secured to the vehicle frame 16. A shock absorber 17 is mounted between the vehicle frame 16 and the front end of arm 5. A leaf spring 18 connects the rear end of arm 5 to the vehicle frame 16.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Snyder and claim 1, it is our opinion that the only difference is the limitation that the axle is pivotally secured by pivot means to a mounting means on the forward generally horizontal section of the step spring wherein the pivot means is above the axle.

With regard to this difference, the examiner determined (final rejection, p. 4) that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Snyder to "include an axle pivotally secured to a mounting means on the forward portion of spring 21 in view of Hayes's pivotal connection 9 between an axle and spring in order to mount the spring rockably on the vehicle axle for absorbing overload."

The appellant argues (brief, pp. 7-12; reply brief, pp. 3-5) that the applied prior art does not suggest the claimed subject matter. We agree.

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, it is our determination that the prior art contains none. In that regard, we see no teaching, suggestion, or motivation in the applied prior art for modifying Snyder to provide a pivot means above his axle. At best, the teachings of Hayes are suggestive of providing an overload spring pivotally connected below Snyder's axle.

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 . . . 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 the claimed subject matter as a whole is not taught or suggested by the applied prior art, we will not sustain the 35 U.S.C. § 103 rejection of independent claim 1, and of dependent claims 2 to 5, 8 to 10 and 12.¹

The indefiniteness rejection

We sustain the rejection of claims 2, 3/2, 4 and 5 under 35 U.S.C. § 112, second paragraph but not the rejection of claim 10.

The second paragraph of 35 U.S.C. § 112 requires claims to set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re

¹ We have also reviewed the references additionally applied in the rejection of claims 2, 3/2, 4, 5, 8 to 10 and 12 (i.e., Masser, Brandt, Baxter and Raidel) but find nothing therein which makes up for the deficiencies of Snyder and Hayes discussed above.

Johnson, 558 F.2d 1008, 1015, 194 USPQ 187, 193 (CCPA 1977).

In making this determination, the definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. § 112, second paragraph, is whether the claims meet the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. Some latitude in the manner of expression and the aptness of terms is permitted even though the claim language is not as precise as the examiner might desire. If the scope of the invention sought to be patented cannot be determined from the language of the claims with a reasonable degree of certainty, a rejection of the claims under 35 U.S.C. § 112, second paragraph, is appropriate.

Thus, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. As stated above, if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. See Ex parte Porter, 25 USPQ2d 1144, 1146 (Bd. Pat. App. & Int. 1992).

With this as background, we analyze the specific rejections under 35 U.S.C. § 112, second paragraph, made by the examiner of the claims on appeal.

The examiner (final rejection, p. 3) found claim 10 to be indefinite since there "is no antecedent basis for the 'distal ends.'" The appellant argues (brief, p. 7) that claim 10 is not indefinite. The appellant points out that claim 10 recites that the pair of divergent arms are joined at an apex and the distal ends of the divergent arms are pivotally coupled to one of the cross frame members. The appellant submits that if a pair of divergent arms are joined at an apex the ends of the divergent arms opposite to the apex are by definition distal ends. We agree with the appellant that the

rejection of claim 10 as being indefinite is improper since it is our view that the metes and bounds of claim 10 have been set forth with a reasonable degree of precision and particularity. Accordingly, the decision of the examiner to reject claim 10 under 35 U.S.C. § 112, second paragraph, is reversed.

The examiner (final rejection, p. 3) found claim 5 to be indefinite since claim 5 recites a second torque rod, but there is no clear antecedent basis for a first torque rod since parent claim 2 recites "a torque rod or other member." We agree with the appellant's argument (brief, p. 7; reply brief, p. 2) that the recitation of "a second torque rod" in claim 5 is not indefinite.

We agree with the examiner (final rejection, p. 3) that claim 2 is indefinite since the recitation in claim 2 that the leading end of the step spring is "pivotally attached to a hanger bracket rigidly mounted on said chassis" disagrees with the recitation in claim 1 that the leading end of the step spring is "pivotally attached to said chassis." The appellant

argues (brief, pp. 6-7; reply brief, p. 1) that claim 2 is definite since it is commonly understood that the hanger bracket is part of the chassis. We find this argument unpersuasive since claim 2 makes clear that the claimed hanger bracket is not part of the claimed chassis since claim 2 recites that the hanger bracket is "rigidly mounted on said chassis." Accordingly, we sustain the 35 U.S.C. § 112, second paragraph, rejection of claim 2, and of claims 3/2, 4 and 5 dependent on claim 2.

CONCLUSION

To summarize, the decision of the examiner to reject claims 2, 3/2, 4 and 5 under 35 U.S.C. § 112, second paragraph, is affirmed; the decision of the examiner to reject claim 10 under 35 U.S.C. § 112, second paragraph, is reversed; and the decision of the examiner to reject claims 1 to 5, 8 to 10 and 12 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

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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LOCKWOOD ALEX FITZGIBBON AND CUMMINGS
THREE FIRST NATIONAL PLAZA
SUITE 1700
CHICAGO, IL 60602

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