

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

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Ex parte KAZUHIKO HAYASHI,

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Appeal No. 2001-2327  
Application No. 08/835,460

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ON BRIEF

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Before COHEN, STAAB, 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 7 to 10. Claim 12 has been allowed. Claim 11 has been objected to as depending from a non-allowed claim. Claims 1 to 6 have been canceled.

We REVERSE.

### BACKGROUND

The appellant's invention relates to a strut mount in a vehicular suspension system which receives a load from a shock absorber having a piston rod. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 7 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over the admitted prior art shown in Figure 1 of this application (the admitted prior art) in view of U.S. Patent No. 5,743,509<sup>1</sup> to Kanda et al. (Kanda).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 18, mailed January 22, 2001) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 17, filed January 2, 2001) and reply brief (Paper No. 19, filed March 26, 2001) 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

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<sup>1</sup> Issued April 28, 1998.

respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal.<sup>2</sup> Accordingly, we will not sustain the examiner's rejection of claims 7 to 10 under 35 U.S.C. § 103. Our reasoning for this determination follows.

Claim 7, the only independent claim on appeal, reads as follows:

A strut mount in a vehicular suspension system which receives a load from a shock absorber having a piston rod, the strut mount comprising:  
a washer fixable to a top end of the piston rod;  
an upper sheet fixable to the piston rod at a predetermined distance from the washer;  
an upper rubber ring portion and a lower rubber ring portion disposed between said washer and said upper sheet;  
a plate disposed between said upper rubber ring portion and said lower rubber ring portion and extending outwardly in the radial direction; and  
a coil spring receiving rubber ring portion provided on a lower side of said plate for receiving a coil spring disposed about the shock absorber, said lower rubber ring and said coil spring receiving rubber ring portion each serving as impact absorbing bodies, at least said lower rubber ring portion and said coil spring receiving rubber ring portion being formed as an integral structure molded to said plate by vulcanization molding thereby defining a joining portion interconnecting said lower rubber ring portion and said coil spring receiving rubber ring portion, said joining portion overlying at least an area portion of said lower side of said plate.

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<sup>2</sup> 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).

The admitted prior art is described on pages 1-2 of this application which we hereby incorporate. In brief, the admitted prior art shown in Figure 1 discloses a strut mount in a vehicular suspension system which receives a load from a shock absorber. The strut mount including a washer 2 fixable to a top end of a piston rod 1 of the shock absorber; an upper sheet 4 fixable to the piston rod at a predetermined distance from the washer; an upper rubber ring 100 and a separate lower rubber ring 101 disposed between the washer and the upper sheet; a plate 5 disposed between the upper rubber ring 100 and the lower rubber ring 101 and extending outwardly in the radial direction; and a separate coil spring receiving rubber ring 102 provided on a lower side of the plate for receiving a coil spring 6 disposed about the shock absorber.

Kanda's invention relates in general to a generally cylindrical elastic mount interposed between two structures for elastically connecting these two structures, and more particularly to such elastic mount which exhibits sufficiently high degrees of spring stiffness in both axial and radial directions thereof and which can be suitably used as body mounts, cab mounts and sub-frame mounts for a motor vehicle, for example. Figures 1-3 of Kanda show a cylindrical elastic mount in the form of a body mount 30 for a motor vehicle. The body mount 30 has a first support member 34 to be attached to a frame 32, a second support member 38 to be attached to a body 36 of the vehicle, and four generally

cylindrical elastic bodies 40, 42, 44, 46. The body mount 30 is interposed between the frame 32 and the body 36, for elastically securing the frame 32 to the vehicle body 36. The first support member 34 includes an axial portion in the form of a sleeve portion 48, and a radial portion in the form of an annular support plate portion 50 which is welded to the sleeve portion 48 such that the support plate portion extends from an axially intermediate part of the sleeve portion 48 in the radially outward direction. The annular support plate portion 50 has a peripheral portion 52 which is bent in an upward direction, namely, in one of the axially opposite directions toward the vehicle body 36 when the body mount 30 is installed on the vehicle.

The first cylindrical elastic body 40 of Kanda is bonded at its outer circumferential surface to a substantially entire area of the inner circumferential surface of the sleeve portion 48 of the first support member 34, by vulcanization of a rubber material. The first elastic body 40 has a cylindrical wall having a substantially constant radial thickness over the entire axial length. As shown in Figure 3, the second cylindrical elastic body 42 is bonded by vulcanization of a rubber material to an upper surface of the annular support plate portion 50 of the first support member 34.

Kanda teaches (column 6, lines 12--27) that

the first and second cylindrical elastic bodies 40, 42 are formed integrally with each other, and cooperate with the first support member 34 to constitute a first intermediate product 58 as shown in FIGS. 2 and 3. The sleeve portion 4B and the support plate portion 50 of the first support member 34 have a suitable number of through-holes 60 formed therethrough, so that the rubber material flows through these through-holes 60 onto the outer circumferential surface of the sleeve portion 48 and the lower surface of the support plate portion 50, in the process of vulcanization, so that the above-indicated outer circumferential surface and lower surface are covered at the substantially entire areas thereof with thin rubber layers, which contribute to an increase in the durability of the sleeve and support plate portions 48, 50, and an increase in the strength of bonding of the first and second elastic bodies 40, 42 to the sleeve and support plate portions 48.

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 the admitted prior art and claim 7, it is our opinion that the only difference<sup>3</sup> is the limitation that

at least said lower rubber ring portion and said coil spring receiving rubber ring portion being formed as an integral structure molded to said plate by vulcanization molding thereby defining a joining portion interconnecting said lower rubber ring portion and said coil spring receiving rubber ring portion, said joining portion overlying at least an area portion of said lower side of said plate.

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<sup>3</sup> The examiner ascertained (answer, pp. 2-3) that the admitted prior art "discloses all the element recited here . . . but for the lower rubber ring and coil spring rubber ring being integral."

With regard to the difference, the examiner determined (answer, p. 4) that to make the lower rubber ring and coil spring rubber ring of the admitted prior art integral is an obvious matter of engineering choice and that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the admitted prior art with integral rubber sections as shown by Kanda to increase the durability of the rubber sections and the support plates, and to protect the support plates.

The appellant argues throughout both briefs that there is no suggestion in the applied prior art to have modified the admitted prior art to arrive at the claimed invention. We agree.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against

its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In

addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Broad conclusory statements standing alone are not "evidence." Id. When an examiner relies on general knowledge to negate patentability, that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

In the rejection before us in this appeal, the examiner has failed to provide any evidence as to why the making of the lower rubber ring and coil spring rubber ring of the admitted prior art integral is an obvious matter of engineering choice and that such a modification would have arrived at the claimed subject matter. In that regard, we note that the lower rubber ring 101 and coil spring rubber ring 102 of the admitted prior art could be

made integral without being molded to the plate 5 by vulcanization molding. In addition, it is our opinion that there is no suggestion, incentive or motivation in the applied prior art to have modified the admitted prior art to arrive at the claimed invention. In that regard, it is our view that the teachings of Kanda would not have provided any suggestion or motivation to have modified the admitted prior art to make the selection made by the appellant due to the disparate teachings of the applied prior art. The manner in which they are proposed to be combined indicate, in our view, that the examiner has engaged in an impermissible hindsight reconstruction of the appellant's invention using the claims as a template to selectively piece together isolated disclosures in the prior art.

For the reasons set forth above, the decision of the examiner to reject claim 7, and claims 8 to 10 dependent thereon, under 35 U.S.C. § 103 is reversed.

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 7 to 10 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN  
Administrative Patent Judge

LAWRENCE J. STAAB  
Administrative Patent Judge

JEFFREY V. NASE  
Administrative Patent Judge

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