

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(2) is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DONALD W. SCHONHOFF,
GERALD P. POKRIEFKA, and JOHN A. DIGASBARRO

Appeal No. 97-4212
Application 08/630,031¹

ON BRIEF

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.

ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the decision of the examiner
finally rejecting claim 6, which is the only claim remaining
of record in the application.

¹ Application for patent filed April 9, 1996.

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The appellants' invention is directed to a composite bumper structure for an automotive vehicle. The claim has been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Killea, Jr.	3,655,231	Apr. 11, 1972
Enomoto et al. (Enomoto) (JP)	5-310092 ²	Nov. 22, 1993

THE REJECTION

Claim 6 stands rejected under 35 U.S.C. § 103 as being unpatentable over Enomoto in view of Killea.

The rejection is explained in Paper No. 5 (the final rejection).

OPINION

In reaching our decision on the issues raised in this appeal, we have carefully assessed the claim, the prior art applied against the claim, and the respective views of the

² A PTO translation of the reference is enclosed.

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examiner and the appellants as set forth in the Answer and the Brief. As a result of our review, we have determined that the rejection should not be sustained. Our reasoning in support of this conclusion follows.

The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a *prima facie* case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), *cert. denied*, 488 U.S. 825 (1988).

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The appellants' invention is directed to a bumper for an automobile that is light weight, strong and elastic, and which can absorb frontal impact and then return to its original shape. As manifested in the claim, the invention comprises an elongated tubular aluminum bumper beam that is curved in a continuous arc between its ends, and an elongated steel reinforcing plate having a length of about one-third of the beam and being centered and rigidly secured to the back of the beam. The steel plate is recited as being elastic and having a relatively high elongation while the beam has a relatively low elongation. It is the examiner's view that all of the claimed bumper structure is disclosed by Enomoto, except for the reinforcing steel plate. It is the examiner's position, however, that this is taught by Killea, and that it would have been obvious to one of ordinary skill in the art to provide the Enomoto bumper beam with an elongated reinforcing plate rigidly secured to its rear surface.

Enomoto discloses an aluminum bumper that appears from the drawings to be curved over its entire length, although that is not confirmed in the written description. It is stated in the specification that aluminum has been adopted for

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automobile bumpers owing to its high impact absorption (translation, page 2). The Enomoto bumper is a beam of hollow box construction within which is installed a plurality of laterally oriented internal panel walls 2 that provide "high impact absorption" (translation, page 7). Enomoto does not disclose or teach installing a reinforcing plate behind the beam.

The automobile bumper assembly disclosed in Killea comprises a channel beam 11 that has an essentially straight center section flanked by curved end sections. Beam 11 is mounted to the vehicle by means of a pair of braces 19 that are fixedly attached to the end sections. A "stabilizer bar" 12 is mounted behind the beam, and is attached to the vehicle through a pair of impact cylinders 16, which are bolted to bar 12. There is no disclosure that bar 12 is attached to the beam; the extent of the teaching is that it is "adjacent" to the rear surface thereof (column 1, line 36). The examiner opines, however, that these two elements must be attached together, on the theory that not to do so would adversely affect the operation and the safety of the impact absorbing

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system. However, there is no evidence to support this conclusion.

The major argument advanced by the appellants is that there is no suggestion to combine the references in such a manner as to render the subject matter of the claim obvious. We agree. The mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See ***In re Gordon***, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In the present situation, the problem of absorbing impact already has been recognized and solved by Enomoto by the use of an aluminum box extrusion having laterally oriented inner walls. We therefore fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to provide the Enomoto bumper beam with an additional means for absorbing impact, such as that disclosed by Killea. Moreover, even considering, *arguendo*, that suggestion exists to add the reinforcing plate behind the bumper beam, it is our opinion that it would not extend to rigidly securing that plate to the bumper beam, in view of the

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fact that such a teaching is lacking in both of the applied references.

For the reasons expressed above, we conclude that the combined teachings of Enomoto and Killea fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in the claim, and it is on this basis that we will not sustain the rejection.

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The decision of the examiner is reversed.

REVERSED

	Neal E. Abrams)	
	Administrative Patent Judge)	
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	Lawrence J. Staab)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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	Jeffrey V. Nase)	
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