

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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AKIRA TANAKA and MASAMICHI HOSHI

Appeal No. 1998-0549
Application No. 08/661,711

ON BRIEF

Before COHEN, ABRAMS, and STAAB, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 10. Claims 3-7 and 11 have been withdrawn by the examiner as being directed to a non-elected species of the invention, and claims 8 and 9 have been canceled.

We REVERSE.

BACKGROUND

The appellants' invention relates to a gasket assembly for an internal combustion engine. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

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

Dickson	2,679,241	May 25, 1954
Yoshino	4,799,695	Jan. 24, 1989
Matsushita <u>et al.</u> (Matsushito)	5,161,809	Nov. 10, 1992
Japanese Kokai	63-149479	Jun. 22, 1988 ¹

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the Answer (Paper No. 25) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 24) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, 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. As a consequence of our review, we make the determinations which follow.

¹Our understanding of this foreign language reference has been obtained from a PTO translation, a copy of which is enclosed.

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).

Claim 1 reads as follows:

A metal gasket assembly comprising a substrate stainless steel sheet with at least one opening, and a peripheral member fitted into said at least one opening along the periphery thereof, said peripheral member being made of a metal plate having a thickness greater than that of substrate stainless steel sheet, and a weld between a radially innermost edge of said substrate metal sheet and a radially outermost edge of said peripheral member, said substrate sheet and said peripheral member being in edgewise abutting relationship, said peripheral member being of rectangular cross-sectional configuration and having a radial extent substantially greater than an axial extent thereof.

It is the examiner's opinion that Dickson discloses all of the subject matter recited in claim 1 except for welding together the edges of the substrate metal and the peripheral member and making the substrate sheet of stainless steel. However, the

examiner takes the position that the former would have been obvious in view of the Japanese reference, and the latter in view of Matsushita. The appellants argue that there is no suggestion to combine the references in the manner proposed by the examiner, and therefore the rejection is defective and should not be sustained.

Dickson discloses a cylinder head gasket construction which comprises a plurality of annular gaskets 22 that are placed in alignment with the walls of the cylinder. This alignment is accomplished during installation by either placing the annular gaskets in recesses 52 in the engine block (Figure 7), or by locating them in the proper position by means of a locating plate 44 that contains a plurality of openings corresponding with the cylinders in the engine block, which openings enable the gaskets to be located and held in position while the cylinder head is installed on the engine block (column 3, lines 28-54; Figures 2 and 3). Dickson does not disclose or teach attaching the peripheral members (gaskets) to the substrate sheet (locating plate), much less doing so by means of a weld, as is required by claim 1.

The Japanese reference discloses a gasket for an internal combustion engine wherein metal compensating members 30 that surround the cylinder openings can be “fused” to the gasket sheet 10 (translation, pages 9 and 10; Figures 4 and 5).

The examiner has taken the position that it would have been obvious to weld the Dickson annular gaskets to the locating plate in view of the teaching of the Japanese reference. We do not 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 case, we fail to perceive any teaching, suggestion or incentive which would have led one of ordinary skill in the art to modify the Dickson arrangement by welding the edges of the gaskets to the locating member. The examiner's reasoning in this regard is "since this [welding] is an extremely well known way to fasten metal parts" (Answer, page 4). However, in view of the fact that Dickson sees no need to attach the locating member to the gaskets in any manner, and in the absence of any evidence indicating that an advantage would be gained by doing so, we are not persuaded that one of ordinary skill in the art would have been motivated to perform the examiner's proposed modification.

Further consideration of Matsushita, which was applied for teaching making the gasket out of stainless steel, does not alter the foregoing conclusion.

It therefore is our position that the combined teachings of Dickson, the Japanese reference, and Matsushita fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection.

Claims 2 and 10, which depend from claim 1, stand rejected on the basis of the references applied against claim 1, taken further in view of Yoshino. However, it is our view that Yoshino fails to overcome the deficiency in the rejection of claim 1 which we pointed out above, and therefore we also will not sustain this rejection.

CONCLUSION

Neither rejection is sustained.

The decision of the examiner is reversed.

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

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