

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GARWIN B. McNEILUS and WILLIAM P. BARTLETT

Appeal No. 1999-1535
Application No. 08/752,220¹

ON BRIEF

Before COHEN, MEISTER, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 19 through 36, which are all of the claims pending in this application.²

¹ Application for patent filed November 19, 1996.

² The appellant canceled claims 1 through 18 and presented new claims 19 through 36 in an amendment after final rejection (Paper No. 6, filed May 27, 1998). While the examiner has approved entry of this amendment upon filing of a Notice of Appeal and an Appeal Brief (see the Advisory Action, Paper No. 7, mailed June 17, 1998), we note that this amendment has not

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We AFFIRM-IN-PART.

²(...continued)
been clerically entered.

BACKGROUND

The appellants' invention relates generally to a self-lubricating collection vehicle. An understanding of the invention can be derived from a reading of exemplary claim 19, which appears in the appendix to the appellants' brief.

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

Statz 1982	4,361,367	Nov. 30,
Ellingsen 17, 1990	4,941,671	July
Horning et al. 31, 1994 (Horning)	5,316,430	May

Claims 29 and 30 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 appellants regard as the invention.

Claims 19 through 36 stand rejected under 35 U.S.C. § 103 as being unpatentable over Horning in view of Ellingsen and Statz.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed October 2, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed August 31, 1998) and reply brief (Paper No. 11, filed December 7, 1998) 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.

The indefiniteness issue

We sustain the rejection of claims 29 and 30 under 35 U.S.C. § 112, second paragraph.

The examiner determined (answer, p. 3) that claim 29 was indefinite since it was dependent on itself and that claim 30 was indefinite since it was dependent on canceled claim 11.

The appellants responded to this rejection (reply brief, pp. 1-2) by stating that the examiner is correct and requesting leave to amend these claims to change the dependency of claim 29 from claim 29 to claim 25 and to change the dependency of claim 30 from claim 11 to claim 29 to overcome this rejection.

Since the appellants have not contested this rejection, we summarily sustain the rejection of claims 29 and 30 under 35 U.S.C. § 112, second paragraph.³

³ In view of decision below with regard to the rejection of claims 19 through 36 under 35 U.S.C. § 103, we believe it would be appropriate for the examiner to permit the appellants to amend claims 29 and 30 to overcome the rejection under 35 U.S.C. § 112, second paragraph. For purposes of reviewing the
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The obviousness issue

We will not sustain the rejection of claims 19 through 36 under 35 U.S.C. § 103.

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). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

All the claims under appeal require at least one surface area to comprise

³(...continued)
rejection of claims 29 and 30 under 35 U.S.C. § 103, infra, we will assume that the dependency of claim 29 has been changed from claim 29 to claim 25 and the dependency of claim 30 has been changed from claim 11 to claim 29.

a non-metallic, low coefficient of friction material which autogenously provides a lubricious bearing surface requiring no separate lubricating material.⁴

The examiner ascertained (answer, p. 4) that Horning discloses all the subject matter of the independent claims on appeal (i.e., claims 19, 25 and 31) except for the above-noted limitation. The examiner then determined (answer, pp. 4-5) that

[i]t would have been obvious to one of ordinary skill in the art at the time of the instant invention to have formed the bushings and other bearing surfaces (such as hinges and joints) of the collection vehicle of Horning et al. from a non-metallic, self lubricating and low coefficient of friction material because Ellingsen teaches the use of self lubricating bearings in the industrial vehicle environment and Statz teaches forming a self lubricating bearing from a non-metallic microporous polymer material.

The appellants argue (brief, pp. 10-12, reply brief, pp. 2-5) that the applied prior art does not suggest the claimed subject matter. We agree.

⁴ See claim 19, paragraph (d); claim 25, paragraph (e); and claim 31, paragraph (f).

In our view, the above-noted claim limitation is not taught or suggested by any of the applied prior art for the reasons set forth below.

Clearly Horning does not teach or suggest any of his surface areas comprising a non-metallic, low coefficient of friction material which autogenously provides a lubricious bearing surface requiring no separate lubricating material.

While Ellingsen does teach self-lubricating bushings 54 used in a vehicle, Ellingsen does not teach or suggest that the self-lubricating bushings 54 comprise a non-metallic, low coefficient of friction material which autogenously provides a lubricious bearing surface requiring no separate lubricating material.

While Statz does teach a self lubricating bearing, Statz does not teach or suggest that the self lubricating bearing comprise a non-metallic, low coefficient of friction material which autogenously provides a lubricious bearing surface requiring no separate lubricating material. In that regard,

Statz teaches that his self lubricating bearing 14 includes a body 16 comprised of sintered powdered metal such as powdered iron impregnated with lubricating oil. The body 16 defines a bore 18 housing a shaft 12. Statz further teaches that his self lubricating bearing 14 also includes polymer bearing members 30 housed in cavities in the body 16 (see Figures 2 and 3). Statz discloses (see column 2, last line, to column 3, line 26) that the polymer bearing members 30 are comprised of a molded microporous polymer material impregnated with lubricating oil having the characteristics of being comprised of a low friction material and of secreting oil onto the surface of the shaft 12 to form a film of oil between the shaft and the wall of the bore 18. From these teachings we conclude that Statz's body 16 does not comprise a non-metallic, low coefficient of friction material which autogenously provides a lubricious bearing surface requiring no separate lubricating material. Likewise, we conclude that Statz's polymer bearing members 30 do not comprise a non-metallic, low coefficient of friction material **which autogenously provides a lubricious bearing surface requiring no separate lubricating material.**

In our view, the only suggestion for modifying Horning in a manner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons stated above, the decision of the examiner to reject claims 19 through 36 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 29 and 30 under 35 U.S.C. § 112, second paragraph, is affirmed and the decision of the examiner to reject claims 19 through 36 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
JAMES M. MEISTER)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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APPEAL NO. 1999-1535 - JUDGE NASE
APPLICATION NO. 08/752,220

APJ NASE

APJ MEISTER

APJ COHEN

DECISION: **AFFIRMED-IN-PART**

Prepared By: Gloria Henderson

DRAFT TYPED: 16 Sep 99

FINAL TYPED: