

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH A. KING

Appeal No. 2000-1582
Application 08/697,034

ON BRIEF

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 20, all the claims in the application.

The claims on appeal are drawn to a laminated truck bumper, and are reproduced in appendix A of appellant's

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brief.^{1,2}

The references applied in the final rejection are:

Shanok et al. (Shanok) 1997	3,590,769	Jul. 6,
Buettner er al. (Buettner) 1980	4,225,167	Sep. 30,
Demastro et al (Delmastro) 1984	4,466,646	Aug. 21,
Placek 1986	4,569,865	Feb. 11,
Fleming 1991	5,067,759	Nov. 26,
Matthysse et al. (Matthysse)	5,131,702	Jul.
21, 1992		
Hagiwara (Japanese Kokai) 1980 ³	55-110639	Aug. 26,

The appealed claims stand finally rejected on the

¹All references herein to appellant's brief are to the revised brief filed on October 12, 1999.

²In reviewing the application, we note that in the specification on page 4, lines 15 to 21, it is stated that should the chrome plating on series 304 stainless steel fracture, corrosion "simply does not form" under the fractured chrome plating. On the other hand, at page 10, lines 6 to 8, appellant states that "Chrome plating is applied on the No. 8 finish of series 304 stainless steel to prevent corrosion from propagating therethrough." These apparently contradictory statements should be reconciled during any further prosecution.

³A translation of this reference, prepared by the PTO, is forwarded to appellant herewith.

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following grounds:

(A) Claims 1, 5, 6, and 8, anticipated by Hagiwara, under 35 U.S.C. § 102(b).

(B) Claims 2 to 4, 7 and 9 to 20, unpatentable under 35 U.S.C. § 103(a) over the following combinations of references:

(1) Claim 2, Hagiwara in view of Shanok.

(2) Claims 3, 4, 12, 14, 15 and 20, Hagiwara in view of Matthyse.

(3) Claim 7, Hagiwara in view of Fleming.

(4) Claim 9, Hagiwara in view of Delmastro.

(5) Claims 10 and 13, Hagiwara in view of Buettner.

(6) Claim 11, Hagiwara in view of Placek.

(7) Claims 16 to 19,⁴ Hagiwara in view of Matthyse and Placek.

(A) REJECTION UNDER § 102(b)

There seems to be no disagreement that Hagiwara discloses all the subject matter recited in claim 1, except for the limitation that an exterior surface of the outer sheet has "a

⁴In claim 19, it appears that --ones-- should be inserted after "selected".

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mechanical finish." Before considering the merits of the rejection, it is necessary to construe this term.

As held in In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997):

the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification.

Accordingly, looking to appellant's specification for disclosure relative to the term "mechanical finish", we find on page 9, lines 18, to page 10, line 8:

The mechanical finishes described herein are based on American Iron and Steel Institute, Washington D.C. (AISI) standard finishes for stainless steel. As defined, mechanical finishes are produced by various mechanical processes such as hot or cold rolling. Mirror-bright finishes are commonly produced by cold rolling on polished rolls or by successive well-known polishing and buffing operations. Rolled mill finishes result from the initial forming of a metal, usually by a rolling process and range in appearance from rough dull to mirror-bright. . . . A No. 2BA finish is a bright annealed finish and is a highly reflective finish obtained by final annealing in a controlled atmosphere furnace. Final buffing is often employed with the No. 2BA finish. Polished mill finishes are produced by successive steps of grinding, polishing, and also buffing. The simpler polished finishes are the No. 3 and

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4 sheet finishes [which] are considered herein as reflective mechanical finishes. . . . The No. 7 and No. 8 polished finishes of stainless steel are highly reflective mechanical finishes, the No. 8 being the most reflective finish commonly produced. The No. 7 and No. 8 are also considered herein as mirror finishes which are both bright and reflective. The No. 8 finish utilizes a buffing operation with a very fine buffing compound. Chrome plating is applied on the No. 8 finish of series 304 stainless steel to prevent corrosion from propagating therethrough.

In view of this disclosure, we construe the claim term "mechanical finish" as a finish produced by a mechanical process such as rolling, grinding, polishing and/or buffing. However, we do not construe "mechanical finish" as being limited to a finish on a metal part, contrary to what appellant seems to assume (see brief, page 5, first four lines), since non-metallic materials may also be ground, polished, buffed, etc. Also, at page 10, lines 14 and 15 of the specification, appellant specifically discloses that the outer and reinforcing sheets may be made out of non-metals, i.e., "[p]lastic, fiberglass, carbon fiber, or polymer."

Reading claim 1 on Hagiwara in light of the foregoing

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construction, we find no express disclosure in the reference of a mechanical finish on the exterior surface of the outer sheet 11, which is elastic and molded from rubber or synthetic resin (translation, page 4, line 3). Hagiwara may however still anticipate claim 1 if such mechanical finish would nonetheless be inherent therein. Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946-47 (Fed. Cir. 1999).

In the examiner's answer (but not in the final rejection), the examiner finds inherency per the statement at page 6 that (emphasis added):

Although the Hagiwara reference does not specifically recite that the bumper has a "mechanical finish", it is inherent to the construction of the bumper and clearly desirable that the outside surface of the bumper be aesthetically appealing and thus include some type of sanding, which is a "mechanical finish", to either prepare the bumper for painting or to simply provide the bumper with a smooth appearance.

We do not agree with this finding. Under the principles of inherency, a reference does not anticipate unless it necessarily includes the limitation alleged to be inherent. Atlas Powder Co., supra. Here, although the examiner theorizes that the exterior surface of the outer sheet 11 of

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the Hagiwara bumper would be mechanically finished (sanded) after molding to prepare it for painting or to provide it with a smooth appearance, there is no indication in the reference that the bumper is to be painted or that its as-molded surface is not sufficiently smooth, nor has the examiner cited any evidence⁵ that molded bumpers as disclosed by Hagiwara would necessarily be sanded. Since inherency "may not be established by probabilities or possibilities," In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981), the possibility that under some scenarios the bumper of Hagiwara might be mechanically finished does not establish that a mechanical finish would necessarily be present, and thus, does not establish inherency.

The § 102(b) rejection therefore will not be sustained.

(B) REJECTIONS UNDER § 103(a)

Rejection (1)

Claim 2 reads:

⁵When the reference is silent about the asserted inherent limitation, such gap in the reference may be filled by recourse to extrinsic evidence. See MPEP § 2131.01, part III (Feb. 2000), and cases cited therein.

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2. The laminated, truck bumper of claim 1 wherein said mechanical finish is a bright finish.

The examiner takes the position that in view of Shanok's disclosure that aluminum foil "simulates the appearance of chromium trim such as is commonly used as decoration for automobiles" (col. 2, lines 24 to 27), it would have been obvious to apply a foil finish to the bumper of Hagiwara "to make the appearance of the bumper more aesthetically pleasing" (final rejection, page 3).

We will not sustain this rejection. Assuming that the examiner's proposed combination would meet the "mechanical finish" limitation of parent claim 1, we do not consider that one of ordinary skill would have derived any suggestion or motivation from Shanok to modify Hagiwara as the examiner proposes. Since the aluminum foil 16 of Shanok is disclosed as being encapsulated in a clear plastic molding strip 12 used as border trim for the rear window of an automobile, one skilled in the art would not have been taught thereby to apply it to a rubber or plastic bumper as disclosed by Hagiwara.

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Rejection (2)

In the group of claims to which this rejection applies, claims 3, 4, and 20 call for, inter alia, the outer sheet of the bumper to be stainless steel.

Matthysse discloses a laminated bumper in which the outer sheet 12 is 301 stainless steel (col. 4, lines 4 to 8), 20 to 30 mils (.02 to .03 inches) thick (col. 3, lines 64 to 67), and the reinforcing sheet 20 is fiber-reinforced plastic. Both sheets are in the form of elongated channels (see drawings), and the outer sheet may be buffed before it is chrome plated (col. 4, lines 62 and 63). The examiner has explained the basis of the rejection on page 8 of the answer as:

The combination proposed by the examiner in the rejection includes modifying the outer layer of Hagiwara to be a stainless steel channel, as taught by Matthysse, and not simply plating the plastic outer layer of Hagiwara, which is not taught by the reference. The examiner has in no way suggested that the plastic outer layer of Hagiwara could be chrome plated.

From this explanation, we understand the examiner's position to be that it would have been obvious, in view of Matthysse, to make Hagiwara's outer sheet 11 out of stainless steel

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instead of rubber or synthetic resin.

We do not consider this rejection to be well taken. In the first place, the Hagiwara bumper is described as an "elastic bumper," and its elastic character would be nullified if its outer sheet 11 were made of stainless steel. Secondly, the laminated bumpers of Hagiwara and Matthyse are both made up of metal and plastic laminations; there is no disclosure in either of an all-metal laminated bumper. For these reasons, Matthyse would not in our view provide any teaching, suggestion or motivation to one of ordinary skill in the art to utilize stainless steel for the outer sheet of the Hagiwara bumper.

We therefore will not sustain the rejection of claims 3, 4 and 20, nor of claims 12, 14 and 15, the other claims included in this rejection.

Rejections (3), (4), (5) and (6)

As discussed above in connection with rejection (1), the outer sheet 11 of the Hagiwara bumper would not inherently

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have a mechanical finish on its exterior surface, as required by claim 1. Since rejections (3) to (6) are of claims which are dependent on claim 1, and none of the secondary references applied in these rejections would have rendered obvious the application of such a

mechanical finish to the Hagiwara bumper (or is cited by the examiner as evidence thereof), rejections (3) to (6) will not be sustained.

Rejection (7)

This rejection will not be sustained for the same reasons as rejection (2) above, since Placek, the additional reference, does not overcome the deficiencies noted in the combination of Hagiwara and Matthyse.

REJECTIONS PURSUANT TO 37 CFR 1.196(b)

Pursuant to 37 CFR 1.196(b), we enter the following new grounds of rejection.

(a) Claims 16 to 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Matthyse in view of Placek. The relevant

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disclosure of Matthyse is discussed above in relation to rejection (2). Placek discloses a laminated bumper with a plurality of concentric apertures 32 therethrough for receiving lights (col. 4, lines 32 to 34). In view of Placek, it would have been obvious to one of ordinary skill to provide the bumper of Matthyse with such apertures, this being simply the selection of a location taught by Placek for mounting the vehicle's side lights.

As noted previously, the outer sheet 12 of Matthyse has a mechanical finish, in that it is buffed (col. 4, lines 62 and 63). The particular degree to which Matthyse's outer sheet was finished would be but an obvious matter of design choice or aesthetics, depending on how shiny the designer of the vehicle on which the bumper was to be mounted wanted the bumper to be; as appellant discloses at page 9 and 10 of the specification, highly reflective, mirror and bright annealed finishes are all standard finishes for stainless steel, and each includes the step of buffing.

(b) Claims 16 and 19 are rejected under 35 U.S.C. § 102(b) as

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anticipated by Placek. The bumper disclosed by Placek includes an elongated stainless steel channel 16 which is chrome plated and then buffed (col. 2, lines 47 and 48). Reading this disclosure on claim 16, the chrome plating constitutes a metallic outer sheet configured into an elongated channel with a recess, the exterior surface of the chrome having a highly reflective mechanical (buffed) finish, the elongated channel 16 is a reinforcing sheet in the outer sheet's recess, and both sheets have concentric apertures 32 therethrough for light fixtures.

Conclusion

The examiner's decision to reject claims 1 to 20 is reversed. Claims 16 to 19 are rejected pursuant to 37 CFR 1.196(b).

This decision contains new grounds of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203

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Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED; 1.196(b)

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