

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD A. LOGAN

Appeal No. 95-5059
Application 08/157,872¹

ON BRIEF

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

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the decision of the examiner finally rejecting claims 1 through 5 and 9 through 12. Claims 6 and 7 have been allowed, and claim 8 has been indicated as containing allowable subject matter.

¹ Application for patent filed November 24, 1993. According to appellant, this application is a continuation of Application 07/978,830 filed November 19, 1992, now abandoned.

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The appellant's invention is directed to a vehicle body extension for mounting upon the exterior fender surface of a vehicle. The subject matter on appeal is illustrated by reference to claim 1, which appears in an appendix to the appellant's Brief.

THE REFERENCES

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

Rantala	3,580,628	May 25, 1971
Purcell	4,115,974	Sep. 26, 1978
Jacobson	5,044,688	Sep. 3, 1991
Italian patent (Daimler Benz) ²	621,392	Jun. 7, 1961

THE EXAMINER'S REJECTIONS

Claims 1 through 3 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Daimler Benz.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Daimler Benz in view of Purcell.

² Our understanding of this reference has been obtained through a PTO translation, a copy of which is enclosed.

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Claims 5, 11 and 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Daimler Benz in view of Jacobson.

Claims 9 and 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Daimler Benz in view of Jacobson and Rantala.

The rejections are explained in the Examiner's Answer and Paper No. 11.

The opposing viewpoints of the appellant are set forth in the Brief.

OPINION

The Examiner's Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of the claimed invention. See *RCA Corp. v. Applied Digital Data Systems, Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.), cert. dismissed sub nom., *Hazeltine Corp. v. RCA Corp.*, 468 U.S. 1228 (1984). A reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention. *In re Graves*, 69 F.3d 1147, 1152, 36 USPQ2d

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1697, 1701 (Fed. Cir. 1995), cert. denied, 116 S.Ct. 1362 (1996), quoting from *In re LeGrice*, 301 F.2d 929, 936, 133 USPQ 365, 372 (CCPA 1962).

According to the examiner, Daimler Benz discloses a fender flare extension unit "having an inner edge **15**¹ which generally conforms to the shape of the wheel opening; [and] an outer edge **15**²" (Paper No. 11, page 2). All of the other components of the body extension as defined by claim 1 are located between these two landmarks. This means that in order for claim 1 to be anticipated by Daimler Benz, the "exposed" contour of the claimed device, that is, the "protuberant region," the "shoulder region," the "reverse-turned region" and "a nonprotuberant border flange region," all must be found in portion 14 of the disclosed device, which is pictured in several embodiments in Figures 2, 3 and 4. The examiner has described how he reads the various portions on the Daimler Benz device on page 3 of the Answer. Because of how the examiner is reading the claimed structure on the reference, we find some deficiencies, which cause us not to sustain the Section 102 rejection of claims 1 through 3.

Claim 1 requires an inner edge, which the examiner reads on the lower of the two edges 15 of Daimler Benz, and an outer edge, which he reads on the upper one of the edges 15. According to

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the examiner, the "protuberant region" reads on the "bulge" directly below the upper finger 15, the "reverse-turned region" between the bulge and the tip of the upper edge 15, and the "nonprotuberant border flange region" between that and upper edge 15. The examiner has not stated where the "shoulder region" is located, which constitutes a deficiency in his rejection. The rejection clearly fails, however, because the claim requires that the "protuberant region" be adjacent the inner edge of the extension and not the outer edge, where it has been located by the examiner in his analysis of Daimler Benz. Moreover, to call the protuberant region the bulge adjacent to the inner edge 15 would cause it to be on the opposite surface of the device from the other components, thus not being in conformance with the other requirements of the claim.

For the reasons expressed above, it is our conclusion that the examiner's rejection of claims 1 through 3 under Section 102(b) should not be sustained.

The Examiner's Rejections Under 35 U.S.C. § 103

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 *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). All three of the examiner's rejections under

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Section 103 are based upon the application of Daimler Benz as discussed above with regard to the Section 102 rejection. Since the secondary references cited by the examiner against other aspects of the claimed subject matter fail to alleviate the shortcoming in the manner in which Daimler Benz was applied above, it is our view that in none of the rejections is a *prima facie* case of obviousness established against the claimed subject matter.

This being the case, none of the Section 103 rejections are sustained.

REJECTIONS MADE BY THIS PANEL OF THE BOARD OF PATENT APPEALS AND INTERFERENCES PURSUANT TO 37 CFR § 1.196(b)

New Rejection Under 35 U.S.C. § 102(b)

Claims 1 through 4 are rejected as being anticipated by Daimler Benz. At the outset, we point out that the appellant's claims are directed to a vehicle body extension "for" mounting on an exterior fender surface, and not to the combination of a vehicle body extension and an exterior fender surface of a vehicle. That is, the intended use of the body extension is upon a vehicle in a particular location.

Using the language of claim 1 as a guide, Daimler Benz discloses a vehicle body extension that is capable of being mounted on the exterior surface of a vehicle in the region surrounding a wheel opening. While Daimler Benz does not show a wheel opening *per se* in the drawings, the shape of the body extension (Figure 1) clearly indicates that it is complementary to a wheel opening, and a wheel is shown in Figure 2. The Daimler Benz unit is in the form of a contoured sheet-like body having an inner edge (the lower right-hand edge of panel 11 in Figure 2) which generally conforms to the shape of a wheel opening (see Figure 1), and an outer edge (generally at the upper 15 in Figure 2) which is nonconforming to the shape of the wheel opening and which is capable of fitting generally conformingly to a vehicle fender. The contour of the body being exposed, when mounted on a vehicle, reveals a protuberant region adjacent the inner edge (the lowermost of the downwardly curved portion of element 11 in Figure 2), a shoulder region extending from the protuberant region toward the outer edge (the uppermost of the downwardly curved portion of element 11), a reverse-turned region between the shoulder and selected portions of the outer edge (the upwardly curved corner portion immediately beneath the lead line to the numeral 14 in Figure 2), and a nonprotuberant border

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flange region which will extend substantially parallel with a vehicle body when installed thereon and which will terminate immediately adjacent the outer edge of the unit (the flange immediately beneath upper edge 15 in Figure 2). The Daimler Benz unit will provide a smooth visual transition between the exterior surfaces of a vehicle fender when installed thereon.

With regard to claim 2, as shown in Figure 1, the outer edge of the Daimler Benz device includes rectilinear segments encompassing major portions of the length of the outer edge. Looking to claim 3, the outer edge includes a generally straight horizontal segment encompassing a major portion of the uppermost edge, and a vertical segment encompassing a major portion of the outer edge. These segments are "generally perpendicular" (Figure 1), giving the unit a "generally squared-off appearance," as required by claim 4.

New Rejections Under 35 U.S.C. § 103

Claims 5, 11 and 12 are rejected as being unpatentable over the combined teachings of Daimler Benz and Jacobson. Daimler Benz has been discussed above with regard to our Section 102 rejection. That reference discloses the unit mounted over a vehicle wheel (Figure 2), and behind what appears to be a door opening. Daimler Benz fails to teach providing the unit with an

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opening in registration with a fuel access port in the vehicle, as is added to the basic structure by claim 5.

However, such a feature was known in the prior art at the time of the appellant's invention, as exemplified by Jacobson (see the fuel opening, unnumbered, in Figures 1 and 2). It would have been obvious to one of ordinary skill in the art to modify the Daimler Benz unit by adding such an access opening in registration with an access port on the vehicle, suggestion being found in the self-evident advantages thereof, such as permitting the continued use of the existing fuel port, which would have been known to the artisan, who is presumed to possess a reasonable level of skill rather than the lack thereof. See *In re Sovish*, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985).

Claim 11 adds to claim 1 the limitation that the extension unit be secured to the vehicle via an adhesive, and independent claim 12 effectively adds the same limitation to the structure also recited in claim 1. Daimler Benz discloses securing the unit to the vehicle by means of fasteners that fit through openings in the vehicle body. Jacobson discusses several means for attaching panels to the outer surface of a vehicle, including fasteners (column 1), and suggests a preference for using an adhesive at the edges (column 2, lines 32 and 33). From our

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perspective, it would have been obvious to one of ordinary skill in the art to utilize such a known alternative fastening system as a substitute for the one disclosed in Daimler Benz, for the self-evident advantages thereof. In this regard, while it is true that the Daimler Benz unit is attached by means which render it more easily removable than one attached by adhesive, it is our view that one of ordinary skill in the art would have recognized from the discussion in Jacobson that both fastener and adhesive systems were known in the art at the time of the appellant's invention, thus suggesting the use of either, depending upon the objectives of the artisan.

Claims 9 and 10 are rejected as being unpatentable over the combined teachings of Daimler Benz, Jacobson and Rantala. In addition to the matters discussed immediately above, Jacobson discloses a panel 14 which overlies the entire lower portion of the side of a vehicle body. It includes a front fender panel 16, which surrounds the front wheel opening, and a box panel 24, which surrounds the rear wheel opening (Figures 1 and 2). Panel 14 further comprises a rocker panel 20 mounted on the body beneath the door and a cowl panel 22 behind the door, which together comprise an elongate generally rigid member which extends between the two fender units, as is required by claim 9.

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Such also is created by considering door panel 18 and cowl panel 22 as the elongate generally rigid extension.

It is our opinion that one of ordinary skill in the art would have found it obvious to utilize two units as disclosed in Daimler Benz, one to surround the front wheel opening and the other to surround the rear wheel opening, and to connect the two together by an extension unit, suggestion being found in the teachings of Jacobson as well as in the self-evident advantage of providing the protection and appearance of such to both wheel openings as well as to the intermediate parts of the vehicle body. To the extent that the Jacobson structure does not include a "molding strip," evidence of such a well-known feature in the art is provided by Rantala, and it would have been *prima facie* obvious to install it where deemed necessary for protection on the extension unit constructed in accordance with the teachings of Daimler Benz and Jacobson.

As for claim 10, we note that Jacobson discloses the required lower strip, and Rantala attaches a molding at such a location.

SUMMARY

In formulating the new rejections set forth above, we considered the arguments presented by the appellant in response to the examiner's rejections, as they might apply to the positions we have taken. They have not dissuaded us, however, from making these new rejections. We wish to reiterate that the appellant's claims are directed to a body extension for use upon a vehicle, and it is well settled that the manner in which a device is to be used is not germane to the issue of the patentability of the device itself. See *In re Casey*, 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967), and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963). The fact is that the body extension disclosed in Daimler Benz is capable of being used in the manner recited in the appellant's claims.

None of the examiner's rejections are sustained.

Pursuant to 37 CFR § 1.196(b) the following new rejections are entered:

Claims 1 through 4 are rejected under 35 U.S.C. § 102(b) as being anticipated by Daimler Benz.

Claims 5, 11 and 12 are rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Daimler Benz and Jacobson.

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Claims 9 and 10 are rejected under 35 U.S.C. § 103 as being unpatentable over the combined teachings of Daimler Benz, Jacobson and Rantala.

The decision of the examiner is reversed. 37 CFR § 1.196(b).

This decision contains a new ground 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 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 ground 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. . . .

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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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)	
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