

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JERALD G. ZANZIG, MARCEL G. STRAGIER and
JOHN W. PICKRELL

Appeal No. 1998-2083
Application No. 08/471,584

ON BRIEF

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

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 17 and 75 through 81. Claims 19 and 20, the only other claims remaining in the application, are objected to as being dependent upon a rejected claim, but would be allowable

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if rewritten in independent form including all of the
limitations

of the base claim and any intervening claims.¹

We REVERSE.

The subject matter on appeal is directed to a refuse
loading assembly for a refuse collection vehicle (brief, page
4). Claim 17 is illustrative of the subject matter on appeal
and is reproduced in "Appendix A" attached to the brief.

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

Holtkamp	3,338,438	Aug. 29,
1967		
Worthington	4,227,849	Oct. 14,
1980		
Smith et al. (Smith)	5,470,187	Nov. 28,
1995		
		(filed Sep. 09,
1993)		

Claims 78 through 81 stand rejected under 35 U.S.C.

¹ Claims 17, 19, 20, 75, 78, 79 and 81 were amended subsequent to the
final rejection. See Paper No. 14. As a result, the 35 U.S.C. § 112, second
paragraph, rejection of claims 17, 19, 20 and 75 through 77 made in the final
rejection has been withdrawn. See Paper No. 15.

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§ 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 17, 75, 76, 78 and 79 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holtkamp in view of Worthington.

Claims 77 and 80 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Holtkamp in view of Worthington, as applied above to claims 75 and 79, and further in view of Smith.

The full text of the examiner's rejections and response to the arguments presented by the appellants appears in the final rejection (Paper No. 8, mailed April 9, 1997), the advisory action mailed August 26, 1997 (Paper No. 15) and the answer (Paper No. 19, mailed March 3, 1998), while the complete statement of the appellants' arguments can be found in the brief (Paper No. 18, filed December 8, 1997).

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and

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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 will not sustain the examiner's rejection of claims 78 through 81 under 35 U.S.C. § 112, second paragraph.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

The examiner determined (final rejection, page 3 and the advisory action mailed August 26, 1997) that the antecedent basis for "the lowered position" and "the raised position" of claims 78 and 79 was unclear (see claim 78, lines 23-25).²

The appellants argue (brief, pages 6 and 7) that claims

²All references in this decision to lines in the claims are to the claims as they appear in "Appendix A" of the brief.

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78 through 81 are not indefinite because the expressions "the lowered position" and "the raised position" find clear antecedent basis in lines 13-15 of claim 78 and refer to the positions of the horizontal arms 233, 234. We agree.

Since the metes and bounds of claims 78 through 81 are set forth with a reasonable degree of precision and particularity, the decision of the examiner to reject claims 78 through 81 under 35 U.S.C. § 112, second paragraph, is reversed.

The obviousness issues

Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 17 and 75 through 80 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

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USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to arrive at the claimed invention. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual 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). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379

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F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied,
389 U.S. 1057 (1968).

With reference to the appellants' Figures 21 and 22, each of independent claims 17 and 78 calls for, inter alia, a loader assembly 232 carried by a semi-trailer 230 with the loader assembly including a pair of horizontal arms 233, 234 overlying a cab 139 or an area occupiable by a cab. In addition, each horizontal arm is recited as having a first end coupled to the semi-trailer proximate the forward end of the semi-trailer, a second end extending forwardly past the cab or area, a first segment 250 and a second segment 252 extendibly coupled to the first segment for movement between an extended position and a retracted position.

The examiner describes Holtkamp as teaching all of the limitations of independent claims 17 and 78, except for the semi-trailer and the horizontal arms having a first segment and a second segment extendibly coupled to the first segment (final rejection, page 4). The examiner cites Worthington for a teaching of a telescopic horizontal arm assembly 74, 92 for

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use with a refuse collecting lift assembly (id.). In addition, the examiner asserts that "it is generally well known in the art to support vehicle transported structures on semi-trailer type chassis arrangements to allow for use of multiple tow vehicles" (id.). The examiner then concludes that it would have been obvious to construct the rear chassis of Holtkamp as a semi-trailer coupled to a cab or tow vehicle, in order to provide more system flexibility, and, in view of Worthington, to fabricate Holtkamp's horizontal arms with two telescopic segments, in order to extend the reach of the engaging forks (id. at 3 and 4).

The appellants argue that the combination of Holtkamp and Worthington is improper because neither reference teaches a semi-trailer or a collection device for use on a semi-trailer and there is no motivation in either reference for the claimed combination (brief, page 9). We agree.

In this regard, we share the appellants' view that there is nothing in the cited Holtkamp and Worthington references to suggest the claimed invention. In particular, there is no teaching or suggestion of a loader assembly carried by a semi-

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trailer much less of a loader assembly including a pair of horizontal arms overlying a cab or an area occupiable by a cab and with each arm having a first end coupled to the semi-trailer proximate the forward end of the semi-trailer and a second end extending forwardly past the cab or area.

Essentially, it is the examiner's position that one of ordinary skill in the art would have found it prima facie obvious to modify Holtkamp by substituting a semi-trailer for Holtkamp's fixed cab and body arrangement while retaining Holtkamp's attachment of the loader assembly to the forward end of the body without evidence or prior art in support thereof. In the absence of evidence or compelling argument in support thereof, however, we are not persuaded that this would have been the case.³

In light of the foregoing, we will not sustain the standing § 103 rejection of independent claims 17 and 78 and dependent claims 75, 76 and 79.

We have also reviewed the Smith reference applied along

³The 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).

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with Holtkamp and Worthington by the examiner against claims 77 and 80 on appeal. However, we find nothing in Smith which makes up for the deficiencies of Holtkamp and Worthington discussed above regarding claims 17 and 78.

Accordingly, we will also not sustain the 35 U.S.C. § 103 rejection of dependent claims 77 and 80.

CONCLUSION

To summarize, the decision of the examiner to reject claims 78 through 81 under 35 U.S.C. § 112, second paragraph, is reversed. The decision of the examiner to reject claims 17 and 75 through 80 under 35 U.S.C. § 103 is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
JEFFREY V. NASE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
JOHN F. GONZALES)	
Administrative Patent Judge)	

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