

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 SAMUEL S. PRATT, DAN SHAFFER, TIM A. DAVIS,
ASHLEY HEIPLE and PETER N. LALOS

Appeal No. 1999-0616
Application 08/443,152¹

ON BRIEF

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

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1-10, 12 and 13. Claims 11 and 14-27, the only other remaining claims in the application, stand withdrawn from further consideration under 37 CFR § 1.142(b)

¹ Application for patent filed May 17, 1995.

as not being readable on the elected species.

Appellants' invention pertains to a device for connecting an implement such as a bucket to the operating arm of an excavator machine or the like. With respect to Figures 2-4, the device includes a coupler 13 having brackets 31, 32 for detachably securing the coupler to an operating arm 15 of a machine, and a depending section 33 for insertion through an opening 28 in the wall of bucket implement 12. In the Figures 2-4 embodiment, ring segments 41, 43 fit into annular recess 39 of the depending section 33 after the depending section has been inserted through opening 28 to secure the bucket implement to the coupler. Independent claim 1 is illustrative of the appealed subject matter and reads as follows:²

1. An assembly connectable to an operating arm of a machine for performing work functions comprising:

an implement having a wall provided with an opening therein; and

a coupler including a main body portion, means for detachably securing said main body portion to said operating arm and means carried on and secured to

² In reproducing claim 1, we have added subparagraphs solely for appellate review.

Appeal No. 1999-0616
Application 08/443,152

said main body portion insertable into said wall opening and maneuverable by said operating arm to an operative position having a selected angular relationship with said implement relative to a given axis and means for securing said insertable means in said operative position having said selected angular relationship.

The references of record relied upon by the examiner in support of the rejections are:

Moser et al (Moser) 2, 1976	3,941,262	Mar.
Vail 30, 1993	5,197,212	Mar.
Nickels et al (Nickels) 1995	5,411,102	May 2,

The following rejections under 35 U.S.C. § 103 are before us for review:

- a) claims 1 and 12, unpatentable over Moser alone;
- b) claims 2-10, unpatentable over Moser in view of Vail;
- c) claim 13, unpatentable over Moser in view of Vail and further in view of Nickels.

The rejections are explained in the examiner's answer (Paper No. 19, mailed May 26, 1998).

The opposing viewpoints of appellants are set forth in the brief (Paper No. 18, filed March 20, 1998) and the supplemental brief (Paper No. 20, filed June 15, 1998).

Appeal No. 1999-0616
Application 08/443,152

Moser, the examiner's primary reference in each of the rejections, pertains to a mounting means 36 for mounting a bucket 32 to the operating arm 16 of an earth moving machine 10. The mounting means comprises a bracket 20 mounted to the operating arm 16 by a pin 28, a bearing means 38 connected to the bucket, and a retaining pin 40. Moser describes the relationship between these parts as follows:

The mounting means 36 comprise a large-diameter-bearing means 38 connected to bucket 32 and having an inner surface defining a bore. Such bore accepts a centrally disposed retaining pin 40 in a pivotal relationship to retain bucket 32 on mounting bracket 20 during the digging-loading operation. The bearing means 38 serve to aid in withstanding high radial loads, and pin 40 operates to retain the bucket 32 axially to bracket 20. Through said mounting means 36 the bucket 32 is pivotable about a pivot axis determined by pin 40. [Column 2, lines 20-30.]

Moser also provides a lock pin 48 for locking the bucket in a selected pivotal position relative to the bracket 20.

Moser describes the operation of the lock pin as follows:

Means to selectively positionally lock the bucket 32 in a chosen pivotal attitude are included. Such means comprise a coupling member 42 formed integrally with bearing 36 and defining a plurality of bores 44. The mounting bracket 20 defines one or more bores 46 which may be aligned with one or more respective bores 44 in the coupling member 42, upon

Appeal No. 1999-0616
Application 08/443,152

rotation of the bucket 32 about the pivot axis determined by pin 40. A lock pin 48 (or pins) may be disposed in such aligned bores 44 and 46, respectively, to retain bucket 32 in a chosen pivotal attitude. [Column 2, lines 31-42.]

In rejecting claims 1 and 12 as being unpatentable over Moser alone, the examiner admits that Moser does not disclose the subject matter of claim 1. Specifically, the examiner has taken the position that Moser "discloses the claimed invention except for the bucket wall to include the hole for receiving pin 40 carried on the . . . the coupler [20]" (answer, page 4). Thus, it appears to be the examiner's position that Moser does not disclose "an implement having a wall provided with an opening therein," as called for in claim 1, and "means carried on and secured to said main body portion [of the coupler] insertable into said wall opening," as also called for in claim 1. The examiner considers, however, that it would have been obvious to one of ordinary skill in the art to modify Moser

to include the pin 40 attached and carried by the coupler 20 and be insertable into a hole in the bucket wall where the pin 40 would be rotatably secured adjacent the rear bucket wall, since it has been held that mere reversal of the essential working parts of a device would be obvious since

Appeal No. 1999-0616
Application 08/443,152

this only requires routine skill in the art.
[Answer, page 4.]

Legal conclusions of obviousness must be supported by facts. *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). An examiner has the initial burden of supplying the requisite factual basis and may not, because of doubts that the claimed invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *Id.*

In the present case, the examiner has failed to advance any factual basis to support his conclusion that it would have been obvious to one of ordinary skill in the art to reverse selected elements of Moser's device in order to derive a facsimile of the claimed invention. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (*see In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). In essence, the examiner's conclusion of obviousness is based on nothing more than speculation.

Appeal No. 1999-0616
Application 08/443,152

Concerning the examiner's theory of obviousness based upon a conclusion that appellants' claimed combination is an obvious reversal of parts of the coupling taught by Moser, while there is some support for this proposition in case law, it is not a mechanical rule and its application was never intended to short circuit the determination of obviousness mandated by 35 U.S.C. § 103. See *Ex parte Giles*, 228 USPQ 866, 867 (Bd. Pat. App. & Int. 1985) (§ 103 rejection based on obvious reversal of parts reversed because evidence proffered by examiner is devoid of teaching that would have suggested the particularly claimed combination of elements set forth in claims); *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351 (Bd. Pat. App. & Int. 1984) (the mere fact that an ordinarily skilled artisan could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness; the prior art must provide a motivation or reason for the artisan, without the benefit of appellants' specification, to make the necessary changes in the reference device). See also *Ex parte Grasenick*, 158 USPQ 624 (Bd. App.

1967). The examiner's failure to advance any factual basis whatsoever to support his conclusion that it would have been obvious to rearrange certain parts of Moser to arrive at the combination set forth in appellants' claims constitutes a first reason necessitating reversal of the standing § 103 rejection of claim 1.

Furthermore, the Moser reference is ambiguous. In this regard, the specification of Moser describes the bearing means 38 as being connected to the bucket and having a centrally located bore for accepting the retaining pin 40 *in a pivotal relationship*

(column 2, line 21-24). One would reasonably infer from this that the retaining pin is secured *to the bracket 20* and that the bearing means is secured to the bucket 32.³ However, Figure 1 appears to show the retaining pin as being secured at its right hand end *to the bucket*, extending through an unidentified bore in the bracket 20, and being retained on the

³This inference is buttressed by claim 1 of Moser, which expressly calls for "bearing means secured to the bucket and defining a bore, and a retaining pin member secured *to the bracket* and accepted in said bore" (emphasis added).

bracket 20 at its left hand end by an unidentified element that the examiner regards as a ring-like washer. This inconsistency regarding which element the retaining pin is secured to, and how the retaining pin is retained in operative position, makes it difficult to determine exactly how Moser's arrangement differs from the claimed invention, and accordingly what must be modified in order to arrive at the claimed subject matter. This ambiguity regarding the teaching of the primary reference in the critical area of the retaining pin constitutes an additional reason necessitating reversal of the standing § 103 rejection of claim 1.

For these reasons, we shall not sustain the standing 35 U.S.C. § 103 rejection of claim 1, or claim 12 which depends therefrom, based on Moser.⁴

Turning to the rejection of claims 2-10 as being

⁴In light of our conclusion that the examiner's foundation position concerning the obviousness of reversing certain parts of Moser to arrive at the claimed subject matter is flawed, it is not necessary for us to address the examiner's additional determination that the securing means of Moser (i.e., the "ring-like washer means" found by the examiner to be present at the left hand end of Moser's retaining pin 40) constitutes a 35 U.S.C. § 112, sixth paragraph, equivalent of appellants' claimed "means for securing said insertable means in said operative position" (claim 1, last mentioned means).

Appeal No. 1999-0616
Application 08/443,152

unpatentable over Moser in view of Vail, and the rejection of claim 13 as being unpatentable over Moser in view of Vail and Nickels, we have carefully reviewed the additional references cited against the claims but find nothing therein to make up for the deficiencies of Moser noted above. Therefore, the standing § 103 rejections of these claims also shall not be sustained.

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Appeal No. 1999-0616
Application 08/443,152

LJS/pgg
Peter N. Lalos
Lalos & Keegan
1146 Nineteenth Street N.W.
Washington, DC 20036-3703