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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MICHAEL L. CRABTREE

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Appeal 2009-009630  
Application 11/552,397  
Technology Center 3600

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Before LINDA E. HORNER, MICHAEL W. O'NEILL, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown in the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

Michael L. Crabtree (Appellant) seeks our review under 35 U.S.C. § 134 of the rejection of claims 1, 5, 6, and 14-20. Appellant cancelled claims 2-4 and 7-13. We have jurisdiction under 35 U.S.C. § 6(b).

### *The Invention*

The claimed invention is to an air spring having an annular barrier for deflecting debris and ice.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. An air spring comprising:
  - a spring seat including an annular axially extending collar;
  - a flexible sleeve connected to said spring seat, said flexible sleeve forming a compression chamber and including a lobe that rolls along a surface of said spring seat during compression of said flexible sleeve; and
  - an annular compressible barrier disposed on said spring seat between said lobe of said flexible sleeve and said annular axially extending collar, wherein said barrier is adapted to compress as said lobe rolls along said surface of said spring seat and is adapted to deflect debris from said spring seat.

### *The Rejections*

The following Examiner's rejections are before us for review:

Claims 1, 5, and 6 are rejected under 35 U.S.C. § 102(b) as anticipated by Weitzenhof (U.S. Patent No. 6,637,733 B1, issued Oct. 28, 2003).

Ans. 3.

Claims 1, 5, 6, and 14-20 are rejected under 35 U.S.C. § 103(a) as unpatentable over Appellant's Admitted Prior Art (hereinafter "APA") as

depicted in figures 4 and 5 within the Specification, Weitzenhof, and Hirtreiter (U.S. Patent No. 3,596,895, issued Aug. 3, 1971). Ans. 4.

## SUMMARY OF DECISION

We AFFIRM-IN-PART.

### OPINION

#### *Issues*

In light of the Appellant's contentions and the Examiner's positions, the issues before us are as follows:

(1) Did the Examiner err in finding Weitzenhof's air spring to be "adapted to compress as said lobe rolls along said surface of said spring seat" and "adapted to deflect debris from said spring seat"?

(2) Did the Examiner err in determining that it is inherent that Weitzenhof's elastomeric isolator 23 is resistant to water?

(3) Did the Examiner err in determining that the combination of the APA, Weitzenhof, and Hirtreiter results in the claimed invention?

#### *Analysis*

##### *Issue 1*

Appellant contends that Weitzenhof<sup>2</sup> fails to anticipate claim 1 under 35 U.S.C. § 102(b) because the elastomeric isolator 23, described at column 3, lines 30-35, is "for absorbing vibrations" and "[t]here is no disclosure relative to deflecting debris." App. Br. 7. Appellant also contends that

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<sup>2</sup> Although Appellant referred to "Weitzenhoff" throughout the Appeal Brief, we are assuming that Appellant meant to refer to the correct reference name of "Weitzenhof."

because Weitzenhof acknowledges the need to protect the sleeve from debris, but uses cylindrical portion 45 to deflect debris and not elastomeric isolator 23, Weitzenhof does not anticipate claim 1. App. Br. 7-8.

Appellant also contends that Weitzenhof's elastomeric isolator 23 is completely shielded from the external environment and thus, is not subjected to external debris and is incapable of deflecting debris. App. Br. 8. Finally, Appellant also contends that Weitzenhof includes a rigid outer member 20 and rigid inner member 21 which prevent the sleeve 5 from compressing the elastomeric isolator 23 so that Weitzenhof's barrier does not satisfy the claim limitation of being adapted to compress as the lobe rolls along the surface. Reply Br. 6.

The Examiner's position is that Weitzenhof anticipates claim 1. Ans. 3. The Examiner posits that Weitzenhof's Figure 1 shows a gap between protective collar 27 and sleeve 5 that would allow debris to be deflected by elastomeric isolator 23 from entering spring seat 2, 25, 27 and that satisfies the claim recitation of being adapted to deflect debris. Ans. 6.

"It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (citations omitted). Although "[a] patent applicant is free to recite features of an apparatus either structurally or functionally . . . choosing to define an element functionally, i.e., by what it does, carries with it a risk." *Id.* at 1478.

We agree with the Examiner that Weitzenhof anticipates claim 1. Claim 1's language that the barrier "is adapted to compress as said lobe rolls along said surface of said spring seat and is adapted to deflect debris from said spring seat" are recitations of intended use and as such, the air spring of

Weitzenhof only needs to be capable of performing the recited intended uses. Although Weitzenhof's elastomeric isolator 23 is disclosed as being for vibration isolation, it is capable of compressing as the lobe rolls along the surface of the spring seat and deflecting debris from the spring seat. We are not persuaded by Appellant's argument that rigid inner and outer members 21, 20 prevent Weitzenhof's elastomeric isolator 23 from compressing as it appears that the pressurized fluid in the chamber 15 could expand to move the sleeve 5 to compress the isolator 23. We are also not persuaded by Appellant's argument that Weitzenhof's elastomeric isolator 23 is incapable of deflecting debris because it is completely shielded from the external environment because there appears to be a gap between the end of the inwardly tapered flange 27 and the sleeve 5. Thus, the recitations of intended use in claim 1 do not distinguish the structural apparatus over Weitzenhof.

Appellant does not provide separately arguments for the patentability of claim 5. As such, claim 5 falls with claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

In view of the foregoing, we sustain the Examiner's rejection of claims 1 and 5 under 35 U.S.C. § 102(b) as anticipated by Weitzenhof.

#### *Issue 2*

Appellant contends that dependent claim 6 recites that the barrier is resistant to water and that the Examiner has failed to address this feature. App. Br. 8. Appellant also contends that Weitzenhof is completely silent with respect to whether the elastomeric isolator 23 is resistant to water and that since water resistance is neither taught nor suggested, Weitzenhof fails to anticipate claim 6. App. Br. 8-9. Appellant also contends that "[o]ne skilled in the art of elastomers would readily acknowledge that an elastomer

is not necessarily resistant to water.” Reply Br. 7. Appellant also contends that since Weitzenhof fails to set forth any exemplary elastomeric materials that the isolator 23 is made of, a person of ordinary skill in the art would not be able to determine whether the elastomeric material of the elastomeric isolator 23 is resistant to water. *Id.*

Under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference. *See Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). When relying on the theory of inherency, the examiner has the initial burden of providing a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic reasonably flows from the teachings of the applied prior art. *See In re King*, 801 F.2d 1324, 1327 (Fed. Cir. 1986).

We agree with Appellant that it is not inherent that the elastomeric isolator 23 of Weitzenhof is resistant to water. The Examiner has failed to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic (i.e., Weitzenhof’s elastomeric isolator 23 is resistant to water) necessarily flows from the teachings of the applied prior art. As pointed out by Appellant, a person of ordinary skill in the art would know that not all elastomeric materials are resistant to water. In addition, Weitzenhof fails to indicate any particular elastomeric materials that the elastomeric isolator 23 is made of and thus, a person of ordinary skill in the art cannot determine whether Weitzenhof’s elastomeric isolator 23 is resistant to water.

In view of the foregoing, we do not sustain the Examiner's rejection of claim 6 under 35 U.S.C. § 102(b) as anticipated by Weitzenhof.

*Issue 3*

Appellant contends that claims 1 and 14 are not obvious in view of Appellant's APA, Weitzenhof, and Hirtreiter because combining the air spring 10 of Appellant's APA, the elastomeric isolator 23 of Weitzenhof, and the protective member 1 of Hirtreiter does not yield the features recited in the last paragraph of claims 1 and 14. App. Br. 9-10. Appellant also contends that Weitzenhof's elastomeric isolator 23 is not equivalent to the claimed barrier that is adapted to compress and adapted to deflect debris because the elastomeric isolator 23 is used for vibration attenuation and because there is no teaching or suggestion in Weitzenhof that the elastomeric isolator 23 may compress or deflect debris. App. Br. 10-11. Appellant also contends that Hirtreiter teaches flexing of the protective member 1 to deflect debris, but that flexing is not equivalent to compressing so that modification by Hirtreiter does not yield the structure of the claimed invention. App. Br. 11.

The Examiner's position is that Appellant's APA discloses an air spring substantially as claimed, "but lacks a specific showing of the debris barrier." Ans. 4. The Examiner posits that it is well known to provide an air spring with protection devices to eliminate the detrimental effects of debris and moisture and cites to Hirtreiter. *Id.* The Examiner also posits that it is well known to provide an elastomeric isolator or seal in the area between the seat 14 and the lobe 28 of Appellant's APA to absorb vibration and that Weitzenhof shows this and also shows that the isolator 23 is capable of

acting as a sealing/barrier device. *Id.* The Examiner concludes that it would have been obvious to one of ordinary skill in the art to modify Appellant's APA with a barrier or sealing element as taught by Hirtreiter and Weitzenhof "for one of the reasons above." *Id.*

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness." *In re Rijckaert*, 9 F.3d 1531, 1532 (Fed. Cir. 1993) (citing *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). "A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art." *In re Bell*, 991 F.2d 781, 783 (Fed. Cir. 1993) (quoting *In re Rinehart*, 531 F.2d 1048, 1051 (CCPA 1976)).

We agree with Appellant that the Examiner's combination of the teachings of Appellant's APA, Weitzenhof, and Hirtreiter does not result in the claimed invention. The Examiner has not met the burden of setting forth a *prima facie* case of obviousness because the Examiner has failed to sufficiently articulate how a person of ordinary skill in the art would combine the air spring 10 of Appellant's APA, the elastomeric isolator 23 of Weitzenhof, and the protective member 1 of Hirtreiter in order to render the claimed air spring obvious. For instance, it is unclear whether the Examiner is proposing to modify the air spring of Appellant's APA to have both the elastomeric isolator 23 of Weitzenhof and the protective member 1 of Hirtreiter or is proposing to modify one of the elastomeric isolator 23 of Weitzenhof and the protective member 1 of Hirtreiter to have a feature of the other one. It appears that on page 10 of the Reply Brief, Appellant resorted to speculation that the Examiner was modifying the combination of APA

and Weitzenhof to make the elastomeric isolator 23 flex like the protective member 1 of Hirtreiter. However, it is not at all clear that Appellant's speculation is how the Examiner combined Appellant's APA, Weitzenhof, and Hirtreiter. Without a clear articulation from the Examiner of how Appellant's APA, Weitzenhof, and Hirtreiter are being combined, we conclude that the Examiner has failed to establish a prima facie case of obviousness.

In view of the foregoing, we do not sustain the rejection of claims 1, 5, 6, and 14-20 under 35 U.S.C. § 103(a) as unpatentable over Appellant's APA, Weitzenhof and Hirtreiter.

#### CONCLUSIONS

The Examiner did not err in finding Weitzenhof's air spring to be "adapted to compress as said lobe rolls along said surface of said spring seat" and "adapted to deflect debris from said spring seat."

The Examiner erred in determining that it is inherent that Weitzenhof's elastomeric isolator 23 is resistant to water.

The Examiner erred in determining that the combination of the APA, Weitzenhof, and Hirtreiter results in the claimed invention.

#### DECISION

We affirm the Examiner's rejection of claims 1 and 5 under 35 U.S.C. § 102(b) as anticipated by Weitzenhof. We reverse the Examiner's rejection of claim 6 under 35 U.S.C. § 102(b) as anticipated by Weitzenhof and the Examiner's rejection of claims 1, 5, 6, and 14-20 under 35 U.S.C. § 103(a) as unpatentable over Appellant's APA, Weitzenhof, and Hirtreiter.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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