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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JAMES J. JARVIS

Appeal 2010-006442
Application 11/385,128
Technology Center 3600

Before LINDA E. HORNER, PATRICK R. SCANLON, and
MICHELLE R. OSINSKI, *Administrative Patent Judges*.

SCANLON, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

James J. Jarvis (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Saxton (US 5,743,192, iss. Apr. 28, 1998) and Beckerman (US 4,801,483, iss. Jan. 31, 1989). We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

THE INVENTION

The claimed subject matter “relates to railroad freight cars and in particular to a freight car for carrying motor vehicles on multiple levels.” Spec., para. [0002]. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. In combination with a railroad freight car body for transporting automobiles, said car body having a length, a deck having a selectively raisable end portion comprising:

(a) a core oriented lengthwise along said length of said car body; and

(b) a skin of fiber reinforced plastics adhered to and surrounding said core, wherein said core has a density less than that of said skin of fiber reinforced plastics, and wherein said skin of fiber reinforced plastics has a bottom surface.

ANALYSIS

Appellant argues independent claims 1, 14 and 15 as a group (App. Br. 6, 7) and does not present any separate arguments for the patentability of dependent claims 2-13, 16 and 17 apart from independent claim 1 (App. Br. 5-15). As such, we treat claims 1-17 as argued as a single group and select independent claim 1 as the representative claim in accordance with 37 C.F.R. § 41.37(c)(1)(vii)(2011).

The Examiner’s view is that Saxton discloses all of the features of the deck for an automobile-carrying railcar recited in independent claim 1 except for the raisable end portion of the deck being constructed of a core surrounded by a skin of fiber reinforced plastics. Ans. 3. The Examiner finds that Beckerman “discloses a composite plate comprised of a skin and a core for supporting vehicles over openings in the ground surface.” *Id.* The

Examiner concludes it would have been obvious to one of ordinary skill in the art to make the movable deck of Saxton of composite materials as taught by Beckerman with the expected result of lightening the deck. Ans. 4.

Appellant argues that Thoman¹, a third reference which is of record in the present application but not relied on by the Examiner, teaches away from constructing a suspended section of a deck from a composite material. App. Br. 5, 7, 12-14. Appellant asserts that Thoman discloses that a “composite material, if supporting cargo, *must* have a metal substructure beneath it so as to horizontally distribute the load carried upon the composite material.” App. Br. 7 (citing Thoman, col. 11, l. 67-col. 12, l. 4; col. 12, ll. 34-42) (emphasis added). From this, Appellant concludes that Thoman would lead one of ordinary skill in the art away from the claimed invention because the design requirements of automobile-carrying railcar decks prevent inclusion of supporting substructure. App. Br. 7.

Contrary to Appellant’s contention, Thoman does not teach that composite structure supporting cargo *must* have a supporting substructure. The passages of Thoman referred to by Appellant merely describe the substructure (particularly stringers 230) supporting the floor 100 and do not indicate that such structure is an unconditional requirement. *See* Thoman, col. 11, l. 67-col. 12, l. 4; col. 12, ll. 34-42. In fact, Thoman states “[f]or *some applications*, railway car underframe **200** *preferably* includes a plurality of longitudinal stringers **230**,” which indicates that the stringers are not necessary for all applications. Thoman, col. 11, ll. 11-12 (emphasis added). Thoman thus merely expresses a preference for using a supporting substructure in some applications and does not criticize, discredit, or

¹ US 6,138,580, iss. Oct. 31, 2000.

discourage the use of composite floors without such substructure. As such, Thoman does not teach away from combining the teachings of Saxton and Beckerman. *See DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc.*, 567 F.3d 1314, 1327 (Fed. Cir. 2009) (“A reference does not teach away, however, if it merely expresses a general preference for an alternative invention but does not ‘criticize, discredit, or otherwise discourage’ investigation into the invention claimed. *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004).”). Therefore, Appellant’s arguments regarding Thoman are not persuasive.

Appellant also argues that the Examiner’s rejection is improper because the composite material of Beckerman is unrelated and not relevant to railcar decks. App. Br. 5-6, 7. Appellant cites the 37 C.F.R. § 1.132 Declaration of the inventor, James J. Jarvis (hereinafter, the “Jarvis Declaration”), as evidence that Beckerman’s composite material is not relevant to automobile-carrying railcar decks. App. Br. 7-8 (citing Jarvis Decl. 4).

We are not persuaded by this argument or the declaratory evidence. As noted by the Examiner, the roadway cover plate disclosed by Beckerman is relevant to automobile-carrying railcar decks because both structures support vehicles. Ans. 4. We disagree with Appellant’s contention that this statement by the Examiner is a “non sequitur” (App. Br. 10 n.2; Reply Br. 5) or “absurd” (Reply Br. 7). One of ordinary skill would consider the teachings of Beckerman in connection with Saxton and would not have disregarded the proposed combination simply because the roadway cover plate of Beckerman and the railcar deck of Saxton provide slightly different automobile-carrying functions. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S.

398, 420 (2007) (finding error in assuming “a person of ordinary skill attempting to solve a problem will be led only to those elements of prior art designed to solve the same problem”). Thus, the Jarvis Declaration is not persuasive when balanced against the disclosure in Beckerman of using composite panels to support automobiles.

Furthermore, Appellant’s argument and the Jarvis Declaration are based on the inaccurate supposition that Beckerman is limited to roadway cover plates. *See* App. Br. 7 (Beckerman “discloses the use of a compositely-constructed plate to cover an opening in the road”); Jarvis Decl., para. 9 (“[t]he composite roadway covers disclosed in Beckerman are not relevant to the design of automobile-carrying decks of railcars”). Beckerman discloses structural composite panels 10 that “are particularly suitable for use as roadway opening cover plates” and are provided with anchor holes 23 “when such use is contemplated.” Beckerman, col. 6, ll. 3-7. As such, Beckerman contemplates that the structural composite panels can be used in applications other than roadway cover plates. In fact, the Background of the Invention section of Beckerman describes a variety of applications for fiber reinforced composites, including “floors of railroad cars.” Beckerman, col. 1, ll. 60-64.

Appellant further attacks the rejection of claim 1 on the basis that the composite material of Beckerman is not an appropriate material from which to construct an automobile-carrying railcar deck. App. Br. 5. Specifically, Appellant relies on the Jarvis Declaration as evidence that: (i) an automobile-carrying railcar deck made of the composite material of Beckerman would fail if having a thickness dictated by railcar design tolerances, (ii) it would not be feasible to increase the thickness of a

Beckerman composite panel to provide sufficient strength and rigidity, and (iii) the composite panels of Beckerman lack the resistance to fatigue needed in an automobile-carrying deck. App. Br. 8 (citing Jarvis Decl. 4-5); *see also* Reply Br. 4-5.

However, we find no factual evidence in the Jarvis Declaration, such as engineering calculations or comparative testing of Beckerman's disclosed composite materials, to support the opinion that the composite panels of Beckerman likely would fail if used in automobile-carrying railcar deck. Nor is there any factual evidence supporting the opinion that the material of Beckerman would not be expected to have the necessary resistance to fatigue. The lack of factual evidence with respect to resistance to fatigue is particularly conspicuous given the Declarant's statement that testing is essential "because the resistance to fatigue of any particular design of composite-constructed material is unpredictable." Jarvis Decl., para. 8. Therefore, we find that the opinion evidence in the Jarvis Declaration is entitled to little, if any, weight. *See In re Am. Acad. Of Sci. Tech. Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations.").

In addition, the opinion evidence relied on by Appellant is based on the Declarant's consideration of only one particular embodiment described in Beckerman; that is, the composite roadway covers that "are approximately 5' square," "are bolted down to the roadway on each side" and are "2" thick." Jarvis Decl., para. 9. However, Beckerman describes this embodiment as only a "typical" roadway cover (col. 6, l. 14), and, as noted *supra*, Beckerman's disclosure is not limited to just roadway covers.

Moreover, the Examiner relies on Beckerman for teaching that automobile-supporting plates can be made of composite materials.² Final Rej. 4.³ The rejection is not based on replacing Saxton's movable deck portion with the specific composite roadway cover disclosed by Beckerman, so whether the specific roadway cover would be unsuitable for use as an automobile-carrying railcar deck is not probative of whether Beckerman would cause one of ordinary skill to modify Saxton in the manner proposed. "The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425 (CCPA 1981) (citations omitted). The Examiner states "one of ordinary skill would understand the need to accommodate the size and dimension of the car and modify the movable deck of the car as needed." Final Rej. 4. We agree with the Examiner. An obviousness analysis "need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 550 U.S. at 418. Furthermore, "[a] person of ordinary skill is also a person of ordinary creativity, not an automaton." *Id.* at 421.

² We note that the actual language used by the Examiner is that Beckerman is used "as a teaching to show that composite plates can be made of a composite material." We understand this statement, when taken in context, to say that Beckerman teaches an automobile-supporting plate can be made of a composite material.

³ As used herein, "Final Rej." refers to the Office Action mailed March 27, 2009.

For these reasons, we determine the Jarvis Declaration does not sufficiently establish that the composite material of Beckerman is unsuitable for use in an automobile-carrying railcar deck. We are thus not persuaded by Appellant's argument on this point.

Appellant also argues that the Examiner's rejection lacks a supporting rationale of obviousness. App. Br. 9-12. Appellant asserts that the Examiner's rejection is supported only by improper conclusory statements (App. Br. 9) and lacks the required "predictability of success" (App. Br. 10 n.2, 12; Reply Br. 4). We disagree. The rationale given by the Examiner in concluding that it would have been obvious to modify Saxton as taught by Beckerman is that the modification would produce "the expected result of lightening the deck." Ans. 4. Given that Beckerman does disclose that use of composite materials provides reduced-weight structures (col. 1, ll. 7-13; col. 2, ll. 10-12), the Examiner's rationale provides adequate reasoning based on rational underpinnings to explain why one of ordinary skill would have been led to modify Saxton in the manner proposed.

Accordingly, for the reasons stated above, we do not find Appellant's arguments persuasive and sustain the Examiner's rejection of claim 1 as obvious over Saxton and Beckerman. Claims 2-17 fall with claim 1.

DECISION

The Examiner's rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Saxton and Beckerman is affirmed.

Appeal 2010-006442
Application 11/385,128

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

Klh