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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte JOHANNES WIMMER

Appeal 2014-009160
Application 13/355,508¹
Technology Center 3600

Before CHARLES N. GREENHUT, THOMAS F. SMEGAL, and
PAUL J. KORNICZKY, *Administrative Patent Judges*.

SMEGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Johannes Wimmer (Appellant) seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection² of claims 1 and 12 under 35 U.S.C. § 103(a) as obvious over Vignocchi (US 6,260,832 B1, iss. July 17, 2001) and Costa (US 6,520,524 B1, iss. Feb. 18, 2003).³ We have jurisdiction under 35 U.S.C. § 6(b).

¹ According to Appellant, the real party in interest is WP Suspension Austria GmbH. App. Br. 3.

² Appeal is taken from the adverse decision of the Examiner as set forth in the Final Action, dated August 5, 2013 ("Final Act.").

³ Claims 13–20 have been allowed and claims 2–11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any

We REVERSE.

CLAIMED SUBJECT MATTER

Claim 1, the only independent claim, is reproduced below and illustrates the claimed subject matter, with disputed limitations emphasized.

1. A telescopic suspension fork leg comprising:
 - an inner tube and an outer tube;
 - a damping arrangement;
 - a spring arrangement disposed inside a first chamber defined in the outer tube and resting opposite a second chamber defined by the damping arrangement and arranged beneath the first chamber, which second chamber receives a damping fluid;
 - wherein the damping arrangement has a piston, resting on a piston rod, the piston comprising an upper piston surface and a lower piston surface, and
 - wherein the piston is movable within a damping tube arranged substantially concentrically to the inner tube, and the damping tube is surrounded by an annular space chamber arranged substantially concentrically to the damping tube, and
 - wherein the telescopic suspension fork leg has a compressible equalizing volume for a damping fluid volume which is displaced by the piston rod; and
 - wherein the equalizing volume is defined substantially concentrically between the damping tube and a separating piston that fluidically separates the equalizing volume from the annular space chamber.*

intervening claims. *See* Final Act. 4; *see also* Pre-Brief Appeal Conference decision, dated February 7, 2014.

ANALYSIS

Obviousness over Vignocchi and Costa

We are persuaded by Appellant’s arguments that the Examiner erred in rejecting claims 1 and 12 over Vignocchi and Costa. *See* Appeal Br. 5–12; *see also* Reply Br. 2–5.

In rejecting claim 1, the Examiner determines that Vignocchi teaches “wherein the equalizing volume is defined substantially concentrically between the damping tube and a separating piston that fluidically separates the equalizing volume from the annular space chamber,” because “the separating piston (16) is within the damping tube (13), wherein an equalizing volume (B) . . . can be seen as being concentrically between the damping tube, the separating piston and the piston (38) [as] both the separating piston and the damping tube share the same center axis and can be seen as axially concentric.” Final Act. 2, 3. The Examiner also finds Vignocchi discloses that “damping tube [13] is surrounded by an annular space chamber [C] arranged substantially concentrically to the damping tube, and wherein the shock absorber has a compressible equalizing volume (B) for a damping fluid volume (A) which is displaced by the piston rod and piston,” as recited by claim 1.⁴ *Id.* at 3.

⁴ The Examiner relies on Costa only for “showing a spring inside a first chamber of the outer tube,” and reasons that it would have been obvious “to modify Vignocchi's invention by switching the outer tube from being down close to the connection to the wheel, to up high close to the connection to the handle, in order to have a separate variation of the shock absorber that would operate similarly.” *Id.* at 3–4.

In taking issue with the analysis and conclusions presented in the Final Office Action, Appellant argues that “Vignocchi does not disclose or suggest an equalizing volume defined substantially concentrically between the damping tube and a separating piston.” Appeal Br. 8. Thus, while not disputing the Examiner’s findings that “Vignocchi’s chamber (B) corresponds to Appellant’s claimed ‘equalizing volume,’” that “Vignocchi’s barrel (13) is the same as the claimed ‘damping tube,’” and that “Vignocchi’s plug (16) is said to be the claimed ‘separating piston,’” Appellant points out Vignocchi’s Fig. 2A shows that “while the ‘equalizing volume’ B is within the damping tube (13), it at all times is *axially* below the ‘separating piston’ (16).” *Id.* at 8–9. From the foregoing, Appellant concludes that “Vignocchi’s equalizing volume (B) is never ‘substantially concentrically between the damping tube and a separating piston’ as required by Appellant’s claim 1.” *Id.*

The Examiner disagrees, pointing out that “the equalizing volume (B) of Vignocchi is substantially concentrically between a separating piston (16) and a damping tube (13),” as is illustrated by the Examiner’s annotated figure 2B of Vignocchi provided “to help explain why the equalizing volume can be considered to be substantially concentrically in between the damping tube and the separating piston.” Ans. 4–5.

However, Appellant explains that “there is no showing [in the Examiner’s annotated drawing] that Vignocchi discloses an equalizing volume substantially *concentrically* between his damping tube (13) and his separating piston (15) as recited in Appellant’s claim,” merely “because Vignocchi’s separating piston (16), equalizing volume (B), and damping tube (13) share a common central axis.” Reply Br. 2. By way of further

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explanation, Appellant submits a colored version of Fig. 2B from Vignocchi, highlighting the location of equalizing volume relative to the separating piston and damping tube. *See* Exhibit 1. We agree, finding that the Examiner's legal conclusion of obviousness is not supported by evidence and, thus, cannot stand. *See In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967) (Holding that "[t]he legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.").

For the foregoing reasons, we do not sustain the Examiner's rejection of claims 1 and 12 over Vignocchi and Costa.

DECISION

We REVERSE the Examiner's rejection.

REVERSED