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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TOMOHIKO BABA, SHIGERU KOJIMA, and
SYUSAKU NOGAMI

Appeal 2015-000341
Application 13/265,561¹
Technology Center 3600

Before KEVIN W. CHERRY, CYNTHIA L. MURPHY, and
KENNETH G. SCHOPFER, *Administrative Patent Judges*.

SCHOPFER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the rejection of claims 1–4. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

BACKGROUND

According to Appellants, “[the] invention relates to a horizontally disposed multi-cylinder hydraulic shock absorber.” Spec. 1.

¹ According to Appellants, the real party in interest is Kayaba Industry Co., Ltd. Appeal Br. 2.

CLAIMS

Claims 1–4² are on appeal. Claim 1 is the only independent claim on appeal and recites:

1. A multi-cylinder hydraulic shock absorber comprising:
 - a cylinder disposed such that a central axis thereof is oriented in a horizontal direction;
 - a piston rod that expands and contracts relative to the cylinder in a central axis direction;
 - a working chamber that expands and contracts within the cylinder based on the expansion and contraction of the piston rod and has a substantially incompressible working fluid sealed therein;
 - an outer tube covering an outer periphery of the cylinder;
 - and
 - a reservoir connected to the working chamber and storing the working fluid, the reservoir including a space between the outer tube and the cylinder, and a gas chamber housing that projects upward from an upper end of the outer tube and has a gas sealed therein;
 - wherein the outer tube includes an opening portion and a wall surface that surrounds the opening portion and is formed upwardly in an upper end of the outer tube; and
 - wherein the gas chamber housing is formed in a closed-end tubular shape, and is fitted to the wall surface and welded thereto.

Appeal Br., App. A 1.

REJECTIONS

1. The Examiner rejects claims 1 and 2 under 35 U.S.C. § 103(a) as unpatentable over De Bruijn.³

² Claim 5 has been cancelled. *See* Appeal Br. 3.

³ De Bruijn, US 4,673,068, iss. June 16, 1987.

2. The Examiner rejects claim 3 under 35 U.S.C. § 103(a) as unpatentable over De Bruijn in view of Kamei.⁴
3. The Examiner rejects claim 4 under 35 U.S.C. § 103(a) as unpatentable over De Bruijn in view of Lutz.⁵
4. The Examiner rejects claims 1–4 under 35 U.S.C. § 103(a) as unpatentable over Pradel⁶ in view of Kamei.

DISCUSSION

With respect to claim 1, the Examiner finds that De Bruijn discloses a hydraulic shock absorber as claimed, except that De Bruijn does not disclose that the gas chamber is fitted to the wall surface of the outer tube by a weld. Final Act. 2–3 (citing De Bruijn Fig. 1). The Examiner also finds that De Bruijn’s “gas chamber is fixedly attached to the outer tube as if it was welded on.” *Id.* at 5. Further, the Examiner asserts that the method of attachment of the gas chamber to the wall surface, i.e. that it is welded thereto, is a product-by-process limitation and the “patentability of a product, i.e. a shock absorber, does not depend on its method of production, i.e. welding a gas chamber.” *Id.*

Appellants argue that “a weld is a structural feature, and should not be considered a product-by-process limitation.” Appeal Br. 6. Thus, Appellants assert that the Examiner failed to consider all elements of the claim by giving the “welded thereto” limitation no patentable weight. *Id.* Further, with respect to De Bruijn, Appellants assert:

⁴ Kamei et al, JP 08-074912, pub. Mar. 19, 1996.

⁵ Lutz, US 2002/0003073 A1, pub. Jan. 10, 2002.

⁶ Pradel et al., US 5,441,132, iss. Aug. 15, 1995.

[De Bruijn] apparently discloses an additional air chamber 22 built onto a housing 1 in order to increase the air volume of the housing. *See* [De Bruijn] at col. 3 at lines 20-21. However, [De Bruijn] does not appear to disclose a structure that joins additional air chamber 22 and housing 1. Also, [De Bruijn] does not appear to disclose a wall surface of housing 1 to which additional air chamber 22 is fitted and welded. Lutz does not appear to cure the deficiencies of [De Bruijn].

Therefore, [De Bruijn does] not disclose or suggest at least “[an] outer tube [that] includes an opening portion and a wall surface that surrounds the opening portion and is formed upwardly in an upper end of the outer tube; and wherein [a] gas chamber housing is formed in a closed-end tubular shape, and is fitted to the wall surface and welded thereto,” as recited in claim 1.

Id. at 6–7.

We are not persuaded of error by Appellants’ arguments. We agree with the Examiner’s identification of the claimed structures in De Bruijn. Final Act. 4–5. We also agree that, although De Bruijn does not specifically disclose that the gas chamber is welded onto the wall surface, De Bruijn’s depiction of an integral connection between the gas chamber 22 and the wall surface of cylinder 1 shows “that the gas chamber is fixedly attached to the outer tube as if it was welded on.” *Id.* at 5. Thus, we find that De Bruijn discloses a structure that joins the gas chamber to the housing, contrary to Appellants’ assertion, and would at least suggest to one of ordinary skill in the art that the gas chamber could be welded onto the wall surface, as required by the claims.

Accordingly, we sustain the rejection of claim 1 as obvious over De Bruijn. Appellants do not present any separate arguments regarding the patentability of claims 2–4 with respect to the rejections over De Bruijn. Thus, we also sustain the rejections of claims 2–4 over De Bruijn or

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De Bruijn in view of Kamei or Lutz. Further, because our decision with respect to the rejections over De Bruijn is dispositive with respect to all claims on appeal, we do not reach the rejection over Pradel in view of Kamei.

CONCLUSION

For the reasons set forth above, we AFFIRM the rejection of claims 1 and 2 as obvious over De Bruijn; we AFFIRM the rejection of claim 3 as obvious over De Bruijn in view of Kamei; and we AFFIRM the rejection of claim 4 as obvious over De Bruijn in view of Lutz. We do not reach the rejection of claims 1–4 as obvious over Pradel in view of Kamei.

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

AFFIRMED