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EXAMINER
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* GIUSEPPE GRASSO and NICOLAS OLLIER

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Appeal 2018-001911  
Application 14/107,281  
Technology Center 3700

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Before WILLIAM A. CAPP, FREDERICK C. LANEY, and  
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants<sup>1</sup> seek our review under 35 U.S.C. § 134(a) of the final rejection of claims 9 and 11–29. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

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<sup>1</sup> Valeo Systèmes d'Essuyage is the Applicant and real party in interest. Appeal Br. 4.

## THE INVENTION

Appellants' invention relates to windscreen-wiper blades. Spec. 1. Claim 9, reproduced below, is illustrative of the subject matter on appeal.

9. A windscreen-wiper blade for a motor vehicle, the blade comprising:

a first mounting element in a longitudinal direction in which a first housing and a first attachment rail are arranged parallel to a longitudinal axis of said first mounting element;

an elastically deformable spine arranged inside said first housing of the first mounting element; and

a wiping strip comprising a heel interlocked inside said first rail of the first mounting element,

wherein the first mounting element comprises at least one longitudinal end,

wherein the at least one longitudinal end of the first mounting element includes a cutting plane forming an acute angle with a bottom horizontal surface of the first mounting element,

wherein the at least one longitudinal end of the first mounting element including the cutting plane forming the acute angle with the bottom horizontal surface of the first mounting element does not protrude beyond the cutting plane after melting the at least one longitudinal end, the melting transforming the at least one longitudinal end into an at least one deformed longitudinal end, and

wherein the at least one deformed longitudinal end comprises a melted plastic material that obstructs the first housing and the first rail of said deformed longitudinal end, so as to longitudinally immobilise said spine and said wiping strip in at least one direction along said longitudinal axis, respectively inside said first housing and said first rail of the first mounting element.

## THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Kohler	US 3,995,347	Dec. 7, 1976
Fink	US 6,499,179 B1	Dec. 31, 2002
Nacamuli	US 2006/0037167 A1	Feb. 23, 2006
Beelen	FR 2,851,976	Sept. 4, 2010

The following rejections are before us for review:<sup>2</sup>

1. Claims 9, 11–13, 15–17, and 19–29 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kohler.
2. Claim 11 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Kohler.
3. Claims 9, 11, 12, 14, and 16–23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beelen and Fink.
4. Claims 24–28 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beelen, Fink, and Nacamuli.

## OPINION

### *Anticipation of Claims 9, 11–13, 15–17, and 19–29 by Kohler*

#### *Claim 9*

The Examiner finds that Kohler discloses all of the limitations of claim 9. Final Action 3–4. In particular, the Examiner finds that Kohler element 7 immobilizes the spline and wiping strip and notes that Kohler element 7 is structurally equivalent to a plastic element that has been deformed by melting. *Id.* at 4.

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<sup>2</sup> A rejection under 35 U.S.C. § 112, first paragraph, for lack of written description has been withdrawn. Ans. 2.

Appellants argue that Kohler fails to disclose a longitudinal end that is deformed by melting plastic material. Appeal Br. 10. Appellants dispute the Examiner's finding that Kohler's corresponding longitudinal end is a structural equivalent to the claimed deformed/melted plastic structure. *Id.* According to Appellants, more than just a "structural equivalent" of the claimed structure is required in order to anticipate a claim. *Id.* at 11.

In response, the Examiner takes the position that Appellants' deformation by melting limitations are product-by-process limitations. Ans. 3. The Examiner reiterates that the structure of Kohler is equivalent to that produced by Appellants' melting process. *Id.*

To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either expressly or inherently. *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1341 (Fed. Cir. 2016). Furthermore, disclosure of each element is not quite enough as anticipation also requires the presence in a single prior art disclosure of all the elements "arranged as in the claim." *Finisar Corp. v. DirectTV Grp., Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). However, "it has long been established that one cannot avoid anticipation by an earlier product disclosure by claiming the product as produced by a particular process." *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006).<sup>3</sup>

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<sup>3</sup> Ordinarily, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *See, e.g., In re Thorpe*, 777 F.2d 695, 697 (Fed. Cir. 1985). Thus, in determining the patentability of a product-by-process claim, the focus is ordinarily on the product and not the process of making it. *Amgen Inc. v. F. Hoffman–La Roche Ltd.*, 580 F.3d 1340, 1369 (Fed. Cir. 2009).

Kohler's wiper features a downturned flange 7 made of plastic. Kohler, col. 2, ll. 58–64, col. 3, ll. 47–51, Figs. 2–3. The flange operates to obstruct and longitudinally immobilize the wiping strip. *Id.* However, Appellants are correct that Kohler's flange is not disclosed as being formed by melting. The Examiner's finding that Kohler's flange is "structurally equivalent" to an obstruction that is formed by melting is not supported by any technical analysis and, therefore, is conclusory at best. In particular, the Examiner's Final Action and Answer are devoid of any detailed discussion of how the structure of plastic material is affected by melting.

Thus, the issue before us is whether we should construe "*one deformed longitudinal end*" and "*melted plastic material*" as structural, rather than process, limitations. In the past, terms such as "intermixed," "ground in place," "press fitted," "etched," "welded," and "interbonded by interfusion" have, at one time or another, been separately held capable of construction as structural, rather than process, limitations. *See Application of Garnero*, 412 F.2d 276, 279 (CCPA 1969). Given the lack of technical analysis in the record, the Examiner's finding that Kohler's flange 7 is "structurally equivalent" to Appellants' deformed/melted end is not supported by a preponderance of the evidence.<sup>4</sup>

Our holding is supported by two alternative rationales. First, the limitations at issue are susceptible to construction as structural limitations, not process limitations. *Garnero, supra.* Secondly and in the alternative,

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<sup>4</sup> In reaching the result obtained here, we emphasize that we do not hold that material that is affected by "melting" is, in all cases, structural in nature and can never be construed as a product-by-process limitation. Here, we simply conclude that there is insufficient evidence in the record before us to conclude that the Examiner's finding of structural equivalence is supported by a preponderance of the evidence.

even if construed as process limitations, there is insufficient evidence in the record to support a finding that the product produced by the process is structurally equivalent to that of Kohler.

In view of the foregoing, we do not sustain the Examiner's rejection that claim 9 is anticipated by Kohler.

*Claims 11–13, 15–17, and 19–28*

These claims depend, directly or indirectly, from claim 9. Claims App. The Examiner's rejection of these claims suffers from the same infirmity that was identified above with respect to claim 9. Thus, for essentially the same reason expressed above in connection with claim 9, we do not sustain the rejection of claims 11–13, 15–17, and 19–28.

*Claim 29*

Claim 29 is independent claim. Claims App. As with claim 9, it contains a limitation directed to a deformed longitudinal end formed, at least in part, by melting. *Id.* As such, the Examiner's rejection of claim 29 suffers from the same infirmity that was identified above with respect to claim 9 and, therefore, is not sustained.

*Unpatentability of Claim 11  
over Kohler*

The Examiner's alternative, section 103 rejection of claim 11 over Kohler is not supported by a preponderance of the evidence consistent with our previous discussion regarding the anticipation rejection. Thus, the Examiner's section 103 rejection of claim 11 over Kohler is not sustained.

*Unpatentability of Claims 9, 11, 12, 14, and 16–23  
over Beelen and Fink*

In rejecting claim 9 over Beelen and Fink, the Examiner finds that the end of Beelen element 140 is structurally equivalent to an element that has been melted to result in a deformed end. Final Action 7. The Examiner further finds that Fink teaches a spoiler 12, 17 made of plastic. *Id.* The Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Beelen element 140 to be made of plastic. *Id.* According to the Examiner, a person of ordinary skill in the art would have done this because plastic is a suitable material. *Id.*

Appellants traverse the rejection by arguing, among other things, that the longitudinal end of Beelen element 140 is not structurally equivalent to a longitudinal end that is deformed by melting as claimed. Appeal Br. 13–14. Appellants argue that this deficiency is not cured by Fink. *Id.* at 14. Appellants further argue that:

because the first housing and the first rail are obstructed by a melted plastic material of the at least one deformed longitudinal end, the spine and the wiping strip of the windscreen-wiper blade according to one or more embodiments of the present invention may be retained inside the first mounting element with optimized reliability and strength. *See* Specification, p. 2, ll. 26–29. Further, this combination of limitations reliably guarantees the stopping of the spine and the wiping strip at the longitudinal ends of the windscreen-wiper blade.

*Id.*

In response, the Examiner merely states that, since Fink uses plastic material, modifying Beelen element 140 so as to be plastic would render it

capable of being melted and deformed so that it could be made to obtain the claimed structure. Ans. 4–5.

Beelen element 140 is shown only in cross-section. Beelen, Fig. 3. There is no graphical depiction in the figures, and there is no teaching in the specification of Beelen regarding forming an obstruction at a longitudinal end of the wiper blade to inhibit longitudinal movement of the blade. The mere possibility that Beelen's element 140 could be made of plastic so that it is potentially capable of being melted and deformed in a manner that potentially could inhibit longitudinal movement of the blade is not sufficient to support a finding of fact that the claim limitation directed to obstructing and longitudinally immobilizing a wiping strip is either taught or suggested by the prior art. Furthermore, the Examiner does not adequately explain how or why a person of ordinary skill in the art would have modified the prior art references to provide structure to inhibit longitudinal movement of the blade.

The Examiner's findings of fact are not supported by a preponderance of the evidence, and there is no rationale that satisfactorily explains how or why a person of ordinary skill in the art would have modified Beelen and Fink to achieve the claimed invention. Accordingly, we do not sustain the Examiner's unpatentability rejection of claim 9 over Beelen and Fink, neither do we sustain the rejection of claims 11, 12, 14, and 16–23 that depend therefrom.

*Unpatentability of Claims 24–28  
over Beelen, Fink, and Nacamuli*

In rejecting these claims, the Examiner relies on the same erroneous findings of fact that we found deficient with respect to the section 103

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rejection of claim 9 discussed above. This deficiency is not cured by any findings of fact based on the Nacamuli reference. *See* Final Action 9. Accordingly, for essentially the same reasons discussed above with respect to claim 9, we do not sustain the Examiner's unpatentability rejection of claims 24–28 over Beelen, Fink, and Nacamuli.

#### DECISION

The decision of the Examiner to reject claims 9, 11–13, 15–17, and 19–29 as anticipated by Kohler is REVERSED.

The decision of the Examiner to reject claim 11 as obvious over Kohler is REVERSED.

The decision of the Examiner to reject claims 9, 11, 12, 14, and 16–23 as obvious over Beelen and Fink is REVERSED.

The decision of the Examiner to reject claims 24–28 as obvious over Beelen, Fink, and Nacamuli is REVERSED.

REVERSED