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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER D. ROBERTS, DOUGLAS A. MARCINIAK,
JOEL R. LEE, TODD HENNEIKE, DOUGLAS P. WENDLING,
DAVID J. BONADONA, and TODD I. CALLISTER

Appeal 2018-002716
Application 13/469,347
Technology Center 1700

Before BRADLEY R. GARRIS, ADRIENE LEPIANE HANLON, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ This Decision includes citations to the following documents: Specification filed May 11, 2012 (“Spec.”); Final Office Action dated Dec. 27, 2016 (“Final”); Appeal Brief filed July 27, 2017 (“Appeal Br.”); Examiner’s Answer dated Nov. 27, 2017 (“Ans.”); and Reply Brief filed Jan. 17, 2018 (“Reply Br.”).

Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1, 4, 5, 7–16, 21–39, 43–46, and 49–55. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a new ground of rejection.

The invention relates to plastic parts having decorated surfaces, such as an automotive door handle assembly, and to processes for providing a desired surface finish on such parts. Spec. ¶ 2. At the time of the invention, it was known in the art to provide a skin or covering on outer surfaces of plastic parts to provide simulated chrome, simulated wood grain, color, or other surface finishes. *Id.* ¶ 5. According to the Specification, a drawback of known processes for applying such skin or covering is that the edges of the parts remain uncovered. *Id.* Further, in cases where two, separate, covered parts are joined to form a component, the base material can be visible along abutting adjacent surfaces due to the absence of the skin or covering along the edges. *Id.*

The inventors are said to have discovered a method that results in complete coverage of the edges of parts, such that the base material of the part is not visible. *Id.* ¶ 6. In the inventive method, a film is vacuum thermoformed to form a skin having the exterior shape of the part, including a complete wrap at edges that will be visible in the completed assembly. *Id.* ¶ 26. After the skin is formed and re-hardened, it is removed from the thermoforming mold, trimmed, and loaded into an injection molding machine. *Id.* ¶¶ 30, 32. The body of the part is formed by injection molding into, on, and/or against the pre-formed skin. *Id.* ¶ 25. According to the

² Appellants identify Illinois Tool Works Inc. as the real party in interest. Appeal Br. 2.

Specification, the inventive, in-mold, decorating process eliminates the need for secondary operations such as painting, plating, or other graphic application techniques. *Id.* ¶ 35.

The Examiner maintains the following grounds of rejection on appeal:

1. claims 50–52 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as indefinite;
2. claims 1, 5, 7, 8, 28,³ 29, 32, 34, 36, 38, 49 and 52 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamamoto (US 5,599,608, iss. Feb. 4, 1997);
3. claims 21–25, 30–33, 37, and 39 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamamoto;
4. claim 4 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Ohlinger (US 2008/0290683 A1, iss. Nov. 27, 2008);
5. claims 9–16, 26, 27, 35, 51, 53, and 54 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Smith (US 2008/0073813 A1, iss. Mar. 27, 2008);
6. claim 43 under 35 U.S.C. § 103(a) as obvious over Yamamoto;
7. claim 44 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Song (US 2004/0094974 A1, iss. May 20, 2004);

³ The Examiner’s failure to include claim 28 in the list of claims subject to this ground of rejection (*see* Final 4; Ans. 6) is considered harmless error. Claim 28 is discussed in the body of the rejection (*see* Final 6) and Appellants’ arguments in support of patentability of claim 28 (*see* Appeal Br. 50–53) evidence that they are aware claim 28 is subject to this ground of rejection.

8. claim 45 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Smith and Song;

9. claim 46 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Nagano (US 5,715,966, iss. Feb. 10, 1998); and

10. claims 50 and 55 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Nagano.

Alleged Procedural Violations

Appellants argue the Examiner has not met the burden to show that the claims are drafted in product-by-process format, and that the Examiner fails to provide an analysis to support findings that the claimed and prior art structures are the same despite differences in the processes. *See* Appeal Br. 99–103; *see generally id.* at 31–98 (arguing the Examiner has never shown Yamamoto’s decorative element and the claimed decorative element are indistinguishable).

[W]hen the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.

In re Brown, 459 F.2d 531, 535 (CCPA 1972).

We find the Examiner has identified a disclosure or suggestion in the prior art of a decorated part and an assembly of decorated parts having the claimed structural features and, therefore, has met the requisite burden to show that the claimed and prior art products appear to be identical or only slightly different. *See, e.g.*, Final 4, 8, 12–13.

Appellants argue the rejections rely on improper official notice. Appeal Br. 105–108. We agree with the Examiner that the rejections are based on a determination that the claims are drafted in product-by-process format, not on official notice of any facts. *See* Ans. 41.

Any additional arguments regarding alleged procedural violations or alleged error in the Examiner’s rejections are addressed below and/or have been fully addressed by the Examiner and are found unpersuasive for the reasons explained in the Final Office Action and the Answer.

Rejection Of Claims 50–52 Under 35 U.S.C. § 112(b) Or 35 U.S.C. § 112
(Pre-AIA), Second Paragraph

Appellants do not address, and, therefore, we summarily sustain this ground of rejection.

The Examiner determined claims 50–52 are indefinite due to insufficient antecedent bases. Final 3. The Examiner also determined claim 51 is indefinite because the limitation “the portion extending from the center to a location of extension back towards the center” is unclear. *Id.* The Examiner, however, made a reasonable interpretation of this claim language (*see id.*) that is not contested by Appellants (*see* Appeal Br. 80–83) and that we find adequate for purposes of resolving the prior art rejection of claim 51.

Rejection Of Claims 1, 5, 7, 8, 28, 29, 32, 34, 36, 38, 49, And 52 Under 35
U.S.C. § 102(b) As Anticipated By Or, In The Alternative, Under 35 U.S.C.
§ 103(a) As Obvious Over Yamamoto

Of the claims subject to this ground of rejection, claim 1 is the only independent claim. Claim 1 is reproduced below:

1. A decorated part for an assembly including the part; said decorated part comprising:
 - a pre-formed hardened skin made from a film having a desired decorative appearance, said skin formed independently of an injection molding tool, said preformed hardened skin having a predetermined defined final shape in the form of a desired visible surface of the assembly; and
 - a body of the part formed by molding against said pre-formed hardened skin.

Appeal Br. 115.

Yamamoto discloses a method of making injection-molded parts comprising a paint film laminate fused to a plastic substrate for use, e.g., as automobile body and trim parts. Yamamoto 1:24–25, 3:20–21. The outer surface of the paint film laminate has a desirable color and finish. *Id.* at 3:21–22. Yamamoto’s method of making the parts includes preforming the film laminate to a desired shape that includes re-entrant edge portions, positioning the preformed film laminate in a mold cavity, closing the mold, and injecting molten resin into the mold cavity against the film laminate. *Id.* at [57]. Yamamoto discloses that “[t]he force of the closing of the mold and the injection of the resin causes the re-entrant edge portions to curl up under the solidifying resin to ensure complete coverage of the longitudinal edges of the plastic substrate by the film laminate.” *Id.* Yamamoto discloses that the step of preforming the film laminate involves shaping an unformed film on a pattern block and trimming the shaped film. *Id.* at 3:32–34. More specifically, the film is unwound from a roll, heated until easily deformable, and laid over a form. *Id.* at 3:65–4:1. Suction is applied to the film through vacuum ports. *Id.* at 4:2–5. The film is then allowed to cool and harden over the form. *Id.* at 4:5.

Claims 1 and 34

Claim 1 requires that the skin is “formed independently of an injection molding tool” and that the preformed hardened skin has “a predetermined defined final shape.” Appeal Br. 115. Claim 34 depends from claim 1 and requires that the skin is “formed *entirely* independently of an injection molding tool” and that the preformed hardened skin has the same predetermined defined final shape both before and after forming the body of the part. *Id.* at 119 (emphasis added). Appellants argue these processing requirements are neither explicitly disclosed nor inherent in Yamamoto’s method, and that, as a result, Yamamoto’s final product differs from the claimed product. *See generally id.* at 32–49. Appellants argue the ordinary artisan would recognize from Yamamoto Figures 5 and 6 that Yamamoto’s skin is not formed independently of an injection molding tool because it undergoes some deformation, i.e., the ends are bent, during the injection molding process. *Id.* at 35–37. Appellants argue the ordinary artisan would recognize that the edges of the preformed hardened skin were rounded when placed in the injection molding tool, but sharp after the molding operation. *Id.* at 42. According to Appellants, “[s]tretch sections and compression sections from when the upwardly bent ends were deformed downward would be present in the material” after the injection molding process. *Id.* at 35–36; *see also id.* at 38–39 (identifying tests that would evidence deformation of the skin). Appellants argue the ordinary artisan would see trace residue from Yamamoto’s injection molding process on the surface of

Yamamoto's final product, and provide a photograph as evidence thereof. *Id.* at 39–40.

As indicated by the Examiner, Appellants' arguments are not persuasive because they are not commensurate in scope with the claims. Ans. 23–24. Because claim 34 depends from claim 1, and specifies that the skin is formed *entirely* independently of an injection molding tool, there is a presumption that claim 1 encompasses skin formed in part by an injection molding machine. 35 U.S.C. § 112, ¶ 4 (“[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify *a further limitation of the subject matter claimed.*” (emphasis added)); *In re Tanaka*, 640 F.3d 1246, 1250 (Fed. Cir. 2011) (“Claims of narrower scope can be useful to clarify the meaning of broader, independent claims under the doctrine of claim differentiation.”). Therefore, Appellants' argument that the edges of Yamamoto's skin are modified further in the injection molding machine does not persuade us of error in the Examiner's finding that Yamamoto's decorated part would not differ from the decorated part in claim 1.

Appellants' argument also is unpersuasive as to both claims 1 and 34 because, as explained by the Examiner, the claims recite only that initial formation of the skin is independent of an injection molding tool. Ans. 23–24. The claims do not specify, with any degree of particularity, the features of the preformed hardened skin and do not preclude additional modification to the skin once combined with the body. Further, Appellants' arguments that the claimed product differs from Yamamoto's product (*see, e.g.*, Appeal Br. 110, 113) are not convincing because they are not supported by

persuasive evidence. *See In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997) (explaining that argument by counsel cannot take the place of evidence).

Claims 5, 8, and 36

Claim 5 depends directly from claim 1. Appeal Br. 115. Claims 8 and 36 depend indirectly from claim 1. *Id.* at 115, 119. Each of claims 5, 8, and 36 requires that the body is bonded to the skin. *Id.* Appellants argue the Examiner reversibly erred in finding Yamamoto discloses this feature because Yamamoto fuses the skin to the substrate (body) which is not the same as bonding. *See id.* at 67–68. Appellants’ arguments present an issue as to the scope and meaning of the claim term “bonded.” More specifically, we consider whether the broadest reasonable interpretation of “said body being bonded to said skin” (claims 5, 8, and 36) encompasses Yamamoto’s paint film laminate fused to an elongated plastic substrate. *See Vivid Techs., Inc. v. American Science & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

Appellants argue that a definition of “fused” is “to stitch by applying heat or pressure,” and a definition of “stitch” is to “unite by means of staples.” *Id.* at 67 (emphasis omitted). Appellants thus maintain “Yamamoto essentially staples the alleged outer skin about the alleged inner body.” *Id.* at 68. Appellants do not identify the source of their proposed definition of fused. The American Heritage Dictionary defines “fused” as “to become physically joined together, as by melting.” *Fused Definition*, The American Heritage dictionary, <https://www.ahdictionary.com/word/search.html?q=fused> (last visited Dec. 21, 2018). We determine the American Heritage Dictionary definition is

consistent with the manner in which the term “fused” is used in Yamamoto. *See* Yamamoto 4:51–5:23 (describing a method of producing a fused film-plastic part by flowing a resin into a mold cavity containing a film laminate and allowing the resin to flow into cutouts in the film laminate and solidify).

Turning to the claim phrase “said body being bonded to said skin,” we note that the present claims do not specify how bonding is effected. *See generally*, Appeal Br. 115–121. The Specification discloses that when substrate material is injected into a mold containing a pre-formed skin, the substrate material bonds to the inner surface of the skin. Spec. ¶ 33. The Specification discloses that “[s]uitably compatible films and plastic-based materials are used to achieve permanent chemical bonding between the film and the molded part.” *Id.* ¶ 34. However, there is no indication in the Specification that the inventors intended to limit the invention to chemical bonding and/or permanent bonding. *See, e.g., id.* ¶ 37. A dictionary definition of “bond” is “[t]o join securely, as with glue or cement.” *Bond Definition*, The American Heritage Dictionary, <https://www.ahdictionary.com/word/search.html?q=bond> (last visited Dec. 21, 2018).

Based on our analysis, we determine the broadest reasonable interpretation of the claim phrase “said body being bonded to said skin” requires that the body is joined securely to the skin, and that the scope of this phrase encompasses Yamamoto’s paint film laminate that is physically joined to an elongated plastic substrate in either the manner explicitly described in Yamamoto (*see* Yamamoto 4:51–5:23) or via stapling. Accordingly, we are not convinced of error in the Examiner’s rejections of claims 5, 8, and 26.

Claims 28 and 32

Claim 28 depends from claim 1 and recites “wherein the skin has a bend of about 90 degrees established entirely by vacuum forming.” Appeal Br. 118. Claim 32 depends from claim 1 and recites “wherein the skin wraps towards itself beginning at respective bends of the skin, the bends being formed entirely due to a vacuum flow path.” *Id.* at 119. Appellants argue the skin in Yamamoto is bent by vacuum forming, but the bends are then further bent by injection molding, resulting in tight radii/sharp bends that do not occur when bending is effected by vacuum forming alone. *See id.* at 50–53.

As indicated by the Examiner, Appellants’ argument is not persuasive because it is not commensurate in scope with the claims. *See Ans. 29.* Appellants’ argument is based on an alleged absence of a 90 degree bend at either end of Yamamoto’s skin. *See Appeal Br. 51.* Claims 28 and 32, however, do not specify the location of the 90 degree bends. Appellants do not refute the Examiner’s finding that Yamamoto’s skin includes a bend of about 90 degrees in at least one location between the ends. *Ans. 29* (citing Yamamoto Figures 4, 6). Therefore, we are not persuaded of error in the Examiner’s rejections of claims 28 and 32.

Claim 29

Claim 29 depends from claim 1 and recites that the skin has a concave side and a convex side, “wherein the skin is formed entirely without the convex side contacting a mold.” Appeal Br. 118. Appellants contend Yamamoto Figures 5 and 6 illustrate that the mold presses on the convex side of the skin and that the ordinary artisan would have recognized “that the ends of the skin were pressed downward to establish their final

configuration, which could happen only with a component at the outside.”
Id. at 76.

The Examiner has explained why this argument is unpersuasive. *See* Ans. 34. We add that Appellants’ argument amounts to nothing more than attorney argument, and is not persuasive for this additional reason. *See Geisler*, 116 F.3d at 1471.

Claim 38

Claim 38 depends from claim 1 and recites “wherein said skin is a cut vacuum formed inlay from the film having the desired decorative appearance and hardened to form the pre-formed skin of the desired shape and cut from a vacuum formed mold after the vacuum forming.” Appeal Br. 119–120. Appellants argue that in the claimed decorative part the cuts would be visible, but the cuts in Yamamoto’s decorative part would disappear, citing the Examiner’s finding that in Yamamoto the skin is at least partially melted such that sharp edges and unevenness go away. Appeal Br. 69–70. Appellants’ argument is not persuasive for the reasons explained in the Answer (*see* Ans. 33), and because Appellants have not identified evidence to support their contention that cuts made during manufacturing would be present in the claimed product, but not in Yamamoto’s product. *See Geisler*, 116 F.3d at 1471.

Claims 49 and 52

Claim 49 depends from claim 1 and recites “wherein the skin has end faces facing towards each other, and the body is directly against the end faces.” Appeal Br. 120. Appellants provide an annotated copy of Yamamoto Figure 2 to illustrate that Yamamoto’s body is positioned away from the end faces, and argue the Examiner’s rejection is based on an overly-broad

interpretation of “end faces.” Appeal Br. 62–63; Reply Br. 5–7. We disagree. The term “end faces” is not explicitly defined, nor does it appear in the written description. The Examiner’s finding that Yamamoto’s Figure 2 describes the feature recited in claim 49 (*see* Final 8) is consistent with the illustration of the positioning of end body part 122 against end part skin 124 in Appellants’ Figure 5 (*compare* Yamamoto Figure 2, *with* Appellants’ Figure 5).

Claim 52 depends from claim 1 and recites that the bends are “formed so as to have a curved outer profile at the respective bends.” Appeal Br. 121. Appellants provide an annotated copy of Yamamoto Figure 6 to illustrate that Yamamoto’s bends are sharp. Appeal Br. 63–64. This argument is not persuasive for the reasons explained by the Examiner. *See* Ans. 31–32.

Summary

For the reasons stated above, in the Final Office Action, and in the Answer, we are not convinced of reversible error in the Examiner’s rejection of claims 1, 5, 7, 8, 28, 29, 32, 34, 36, 38, 49, and 52 as anticipated by Yamamoto. Accordingly, we sustain the rejection of these claims under 35 U.S.C. § 102(b). Appellants rely on the same arguments in traversing the alternative ground of rejection based on obviousness, and do not present evidence of secondary considerations of non-obviousness. Accordingly, we also sustain the rejection of these claims under 35 U.S.C. § 103(a).

Rejection Of Claims 21–25, 30–33, 37, And 39 Under 35 U.S.C. § 102(b)
As Anticipated By Or, In The Alternative, Under 35 U.S.C. § 103(a) As
Obvious Over Yamamoto

Of the claims subject to this ground of rejection, claim 21 is the only independent claim. Claim 21 is reproduced below:

21. A decorated part for an assembly including the part, said decorated part comprising:

a pre-formed hardened skin made from a film having a decorative appearance, said pre-formed hardened skin having a predetermined defined final shape in the form of a visible surface of the assembly, said pre-formed hardened skin being concave on a side opposite from the visible surface of the assembly, said concavity being entirely formed by at least one of vacuum molding or by forming against a male mold component; and

a body of the part formed by molding against said pre-formed hardened skin, wherein said body has an edge, and said pre-formed hardened skin encompasses at least a portion of said edge, and wherein said pre-formed hardened skin has the same predetermined defined final shape after said body is formed there against as said pre-formed hardened skin had prior to said body being formed there against.

Appeal Br. 117.

Claim 21

Similar to the arguments made in support of patentability of the claims subject to the first prior art ground of rejection, Appellants argue Yamamoto fails to teach or suggest that the pre-formed hardened skin has the same, predetermined, defined, final shape before and after the body is formed. Appeal Br. 58. Appellants' arguments are based on the structure of an intermediate product formed during the process of making the final, claimed product. Appellants have failed to demonstrate persuasively that the

final, claimed product of claim 21 differs from that of Yamamoto. *See Geisler*, 116 F.3d at 1471.

Claims 22 and 33

Claim 22 depends from claim 21 and requires that “the concavity is established without press forming.” Appeal Br. 117. Claim 33 depends from claim 21 and recites that the “pre-formed hardened skin [is] being made entirely independently from press molding.” *Id.* at 119. Appellants rely on Yamamoto Figures 5 and 6 as evidence that Yamamoto uses the force of the mold to establish the concavity of the skin. *Id.* at 64–65. Appellants argue the ordinary artisan would have recognized that press forming was used to make Yamamoto’s cavity. *Id.* at 65.

As explained by the Examiner, Appellants’ arguments are directed to process limitations. *See* Ans. 11, 32. Appellants have failed to demonstrate persuasively that the products of claims 22 and 33 differ from that of Yamamoto. *See Geisler*, 116 F.3d at 1471.

Claims 23 and 39

Claim 23 depends from claim 21 and recites that the “ends of the skin are cut edges.” Appeal Br. 117. Claim 39 is identical to claim 38, discussed above, with the exception that claim 39 depends from claim 21. *Id.* at 120. Appellants contend claims 23 and 39 are patentable for the same reasons discussed in support of patentability of claim 38. *Id.* at 71, 75.

These arguments have been addressed by the Examiner and are unpersuasive for the reasons explained in the Answer. Ans. 33.

Claim 25

Claim 21 recites “said concavity being entirely formed by at least one of vacuum molding or by forming against a male mold component.” Appeal

Br. 117. Claim 25 depends from claim 21 and requires that the “concavity is entirely formed by forming the skin against the male mold component.” *Id.* Appellants contend the ordinary artisan would have recognized the concavity of Yamamoto’s skin was produced using more than a male mold component because “the ends of the skin were pressed downward to establish their final configuration, which could happen only with a component at the outside.” *Id.* at 73.

As indicated by the Examiner, Appellants’ arguments are not commensurate in scope with the claim language. *See* Ans. 33. The process limitation recited in claim 25 relates to the formation of the cavity portion of the pre-formed hardened skin. Appellants’ arguments relate to the structure of the ends of the skin, and fail to explain how the structure of the cavity of Yamamoto’s skin differs from the structure of the cavity of the claimed pre-formed hardened skin.

Claim 30

Claim 30 depends from claim 21 and recites that all surfaces of the skin’s concave side are formed by a mold pressing against the concave side. Appeal Br. 118. Appellants contend Yamamoto Figures 5 and 6 “clearly show that the skin is deformed without a mold pressing against the concave side.” *Id.* at 78. Appellants argue the ordinary artisan would have recognized that “the ends of the skin were pressed downward to establish their final configuration, and would [have been] able to analyze how those ends were bent to determine that there was nothing on the inside of the concavity that reacted against the bending.” *Id.*

As explained by the Examiner, Appellants’ arguments are directed to process limitations. *See* Ans. 34–35. Appellants have failed to demonstrate

persuasively that the product of claim 30 differs from that of Yamamoto. *See Geisler*, 116 F.3d at 1471.

Claims 31, 33, 37, and 39

Appellants contend claims 31, 33, 37, and 39 are patentable for the same reasons discussed in support of patentability of claims 32, 22, 5, and 38, respectively. Appeal Br. 60–61, 68–69, 75. Appellants’ arguments have been addressed above and likewise are considered unpersuasive as to claims 31, 33, 37, and 39.

Summary

For the reasons stated above, in the Final Office Action, and in the Answer, we are not convinced of reversible error in the Examiner’s rejection of claims 21–25, 30–33, 37, and 39 as anticipated by Yamamoto.

Accordingly, we sustain the rejection of these claims under 35 U.S.C. § 102(b). Appellants rely on the same arguments in traversing the alternative ground of rejection based on obviousness, and do not present evidence of secondary considerations of non-obviousness. Accordingly, we also sustain the rejection of these claims under 35 U.S.C. § 103(a).

Rejection of Claim 4 Under 35 U.S.C. § 103(a) As Obvious Over Yamamoto
In View Of Ohlinger

Claim 4 depends from claim 1 and requires that the film include an electrically conductive layer. Appeal Br. 115. The Examiner finds one of ordinary skill in the art would have modified Yamamoto’s decorated part to include an electrically conductive layer based on Ohlinger’s teaching that an electrically conductive layer in a vehicle trim is useful for switching, sensor, or transmission elements. Final 12 (citing Ohlinger ¶¶ 4, 13–22). Appellants argue Yamamoto’s disclosure does not relate to electronic components and,

therefore, the Examiner's rejection is based on improper hindsight reasoning. Appeal Br. 86. Appellants' argument is not persuasive because Appellants have not identified error in the Examiner's finding that Yamamoto's invention relates to automotive parts and Ohlinger's invention is said to provide a benefit to automotive parts. *See, e.g.*, Ohlinger ¶¶ 18, 23 (noting the electrically conductive layer is useful in the dashboard of a car); Yamamoto 1:24–27 (“[I]njection molded parts have been made and used for . . . dashboards . . .”).

The rejection of claim 4 is sustained.

Rejection Of Claims 9–16, 26, 27, 35, 51, 53, And 54 Under 35 U.S.C.
§ 103(a) As Obvious Over Yamamoto In View Of Smith

Of the claims subject to this ground of rejection, claim 9 is the only independent claim. Claim 9 is reproduced below:

9. An assembly of decorated parts; comprising:
 - at least a first part and a second part, each said part having a skin and a body;
 - each said skin being a vacuum formed inlay from a film having a desired decorative appearance and hardened to form a pre-formed skin of a desired shape;
 - each said body formed by molding plastic onto one of the pre-formed hardened skins;
 - said parts having adjacent edges; and
 - said pre-formed hardened skins encompassing at least portions of said adjacent edges.

Appeal Br. 115–116.

Claim 9

The Examiner finds Yamamoto fails to teach a second part as required by claim 9. Final 13. The Examiner finds, however, that Smith teaches first

and second decorated parts for a vehicle wherein the parts have adjacent edges and the skins encompass at least portions of the adjacent edges. *Id.* at 14 (citing Smith ¶¶ 30, 39–40, Figs. 2, 8). The Examiner finds Smith teaches that in forming vehicle components, it can be beneficial to employ a molded article having two or more areas or portions of different decorative elements. *Id.* (citing Smith ¶ 26). The Examiner finds, based on Smith’s teaching, that one of ordinary skill in the art would have formed a second decorated part having the structural elements of Yamamoto’s first decorated part wherein each skin has a different desired decorative appearance, and wherein the parts have adjacent edges. *Id.* The Examiner concludes the invention as recited in claim 9 would have been obvious. *Id.*

Appellants argue Smith discloses a single part having two portions, and, therefore, the Examiner erred in finding Smith discloses first and second decorated parts. Appeal Br. 95.

We have reviewed the claim language in light of the Specification and agree with the Examiner’s interpretation of the first and second parts as broadly encompassing Smith’s elements 18 and 20 which, though formed in the same coverstock and substrate, are distinct parts because they are “separated . . . by a first recess 30” (Smith ¶ 30). *See* Ans. 38. The claims do not require that the first and second parts are physically separated. *Compare* claim 9 (“at least a first part and a second part”), *with* Spec. ¶ 22 (“Fig. 1 shows an automobile door handle assembly 100 that includes three *separate* parts, a main outer part 110, an end part 120 and an inside grip part 130 that are *manufactured individually* and then joined to form door handle assembly 100.” (emphasis added)).

Claims 11, 12, 14, 26, and 35

Appellants contend claims 11, 12, and 14 are patentable for the same reasons discussed in support of patentability of claim 5. Appeal Br. 69. Appellants contend claims 26 and 35 are patentable for the same reasons discussed in support of patentability of claims 22 and 33, respectively. *Id.* at 75. Appellants' arguments have been addressed above and likewise are considered unpersuasive as to claims 11, 12, 14, 26, and 35.

Claims 51, 53, and 54

The Examiner has addressed Appellants' arguments with respect to claims 51, 53, and 54 and explained why they are unpersuasive. *See* Ans. 35. We add that Appellants' arguments also are unpersuasive because they are not supported by evidence. *See Geisler*, 116 F.3d at 1471. As to claim 54, we note that the additional arguments advanced in the Reply Brief are based on a misunderstanding of the Examiner's rejection. *See* Reply Br. 4. The rejection of claim 54 is not based on physically combining features of Yamamoto and Smith, as suggested by Appellants. *See id.* Rather, the rejection is based on modifications to Yamamoto as suggested by the teachings of Smith. *See* Final 14 (¶¶ 50–51), 18 (¶ 66).

Summary

For the reasons stated above, in the Final Office Action, and in the Answer, we are not convinced of reversible error in the Examiner's rejection of claims 9–16, 26, 27, 35, 51, 53, and 54 as obvious over Yamamoto and Smith. Accordingly, we sustain the rejection of these claims under 35 U.S.C. § 103(a).

Rejections Of Claims 43–45 Under 35 U.S.C. § 103(a)

Claims 43 and 44 depend from claim 21 and recite that the decorated part is part of an automobile door handle. Appeal Br. 120. Claim 45 depends from claim 27 and recites that the assembly is part of an automobile door handle. *Id.* Appellants argue the Examiner’s rejections of claims 43–45 are based on a finding that Yamamoto’s parts are capable of being used as a door handle. Appeal Br. 87–92. Appellants cite *In re Giannelli*, 735 F.3d 1375 (Fed. Cir. 2014), in support a contention that the proper inquiry under 35 U.S.C. § 103(a) is not whether Yamamoto’s device is capable of being utilized as a door handle, but “whether it would have been obvious to modify Yamamoto to arrive at the claimed door handle.” Appeal Br. 90.

The Examiner argues the claim recitations relating to the automobile door handle are an intended use of the decorated part/assembly. *See* Ans. 37. The Examiner thus maintains a prima facie case of obviousness has been established because Yamamoto discloses that its parts may be used in making automobile body or trim parts (*id.*) such as “bumpers, body panels, doors, filler panels, wheel covers, dashboards, arm rests . . . , body side moldings, beltline moldings, roof moldings and window moldings” (Yamamoto 1:26–30).

The respective positions of the Examiner and Appellants are based on an underlying disagreement over the scope of claims 43–45. We conclude that it is not reasonably possible to interpret these claims with sufficient clarity to satisfy 35 U.S.C. § 112, ¶ 2. *See In re Packard*, 751 F.3d 1307, 1313 (Fed. Cir. 2014) (*per curiam*). In particular, we are unable to ascertain whether the claims are intended to encompass an automobile door handle or whether the door handle is recited as an intended use for the decorated part

or assembly. We find that either interpretation is consistent with the Specification, which indicates that the invention is not only directed to parts for use in an automobile door handle or other automobile body or trim parts, but also to the automobile door handle assembly. *See, e.g.*, Spec. ¶ 23.

“If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious—the claim becomes indefinite.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). Accordingly, we do not sustain the rejections of claims 43–45 under 35 U.S.C. § 103(a), but enter a new ground of rejection of claims 43–45 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as indefinite. *See In re Zletz*, 893 F.2d 319, 321–22 (Fed. Cir. 1989) (“[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed [T]his way . . . uncertainties of claim scope [can] be removed, as much as possible, during the administrative process.”); *In re Steele*, 305 F.2d 859, 862 (CCPA 1962) (reversing obviousness rejection because it was based on speculation as to the meaning of claim terms and assumptions as to claim scope).

Rejections Of Claim 46 And Of Claims 50 And 55 Under 35 U.S.C.
§ 103(a) As Obvious Over Yamamoto In View Of Nagano

Claim 50 depends from claim 1 and requires that the body is against all portions forming the concave inside portion of the skin and against any transition regions between the concave portion and the convex outside portion of the skin. Appeal Br. 120–121.

The Examiner finds Yamamoto discloses the body is positioned against the concave portion of the skin, but is silent regarding positioning of

the body against any transition regions between concave and convex portions. The Examiner finds one of ordinary skill in the art would have modified Yamamoto to position the body against the transition regions to fix the skin in place as taught by Nagano. Final 21 (citing Nagano Fig. 1, 4:29–34, 54–60).

Appellants argue Yamamoto already fixes the skin in place and the Examiner’s finding that the ordinary artisan would have had a reason to modify the transition regions is based on improper hindsight reasoning. Appeal Br. 84.

Appellants’ argument is not persuasive because it fails to address the Examiner’s finding that the ordinary artisan would have modified Yamamoto in the manner taught by Nagano to fix Yamamoto’s skin in place more firmly. Ans. 36.

Appellants argue claim 46, which depends from claim 21, is patentable for the same reasons discussed in support of patentability of claim 50. Appeal Br. 93. We have considered these arguments to the extent applicable to the limitations in claim 46, but do not find them persuasive because they do not identify reversible error in the Examiner’s finding that the ordinary artisan would have modified Yamamoto in the manner claimed based on the advantage taught by Nagano. *See* Final 20–21.

Appellants do not present separate arguments in support of patentability of claim 55. *See generally* Appeal Br. 27–113.

Summary

For the reasons stated above, in the Final Office Action, and in the Answer, we are not convinced of reversible error in the Examiner’s rejections of claims 46, 50, and 55 as obvious over Yamamoto and Smith.

Accordingly, we sustain the rejections of these claims under 35 U.S.C. § 103(a).

ORDER

We AFFIRM the following rejections:

claims 50–52 under 35 U.S.C. § 112(b) or 35 U.S.C. § 112 (pre-AIA), second paragraph, as indefinite;

claims 1, 5, 7, 8, 28, 29, 32, 34, 36, 38, 49 and 52 under 35 U.S.C. § 102(b) as anticipated by Yamamoto, and under 35 U.S.C. § 103(a) as obvious over Yamamoto;

claims 21–25, 30–33, 37, and 39 under 35 U.S.C. § 102(b) as anticipated by Yamamoto, and under 35 U.S.C. § 103(a) as obvious over Yamamoto;

claim 4 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Ohlinger;

claims 9–16, 26, 27, 35, 51, 53, and 54 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Smith

claim 46 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Nagano; and

claims 50 and 55 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Nagano.

We REVERSE the following rejections:

claim 43 under 35 U.S.C. § 103(a) as obvious over Yamamoto;

claim 44 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Song; and

claim 45 under 35 U.S.C. § 103(a) as obvious over Yamamoto in view of Smith and Song.

Pursuant to 37 C.F.R. § 41.50(b), we enter a new ground of rejection of claims 43–45 under pre-AIA 35 U.S.C. § 112, second paragraph, or 35 U.S.C. § 112(b), as indefinite.

37 C.F.R. § 41.50(b) provides that Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

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-IN-PART;
37 C.F.R. § 41.50(b)