



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
14/478,700	09/05/2014	Richard Larry SUNSDAHL	PLR-15-1688.02P-02-US-e	1010
93175	7590	06/02/2020	EXAMINER	
Faegre Drinker Biddle & Reath LLP - Polaris 300 N. Meridian Street Suite 2500 Indianapolis, IN 46204			VANAMAN, FRANK BENNETT	
			ART UNIT	PAPER NUMBER
			3616	
			NOTIFICATION DATE	DELIVERY MODE
			06/02/2020	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

int eas@faegredrinker.com
sue.meyer@polaris.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RICHARD LARRY SUNSDAHL, AARON DAVID DECKARD,
MARCUS JOHANNES TULLEMANS, JASON CARL PLUGGE,
ALAN A. MEYER, GEOFFREY G. WHITE, and
BRIAN MICHAEL SAFRANSKI

Appeal 2018-003407
Application 14/478,700
Technology Center 3600

Before PHILLIP J. KAUFFMAN, BRETT C. MARTIN, AND
JEREMY M. PLENZLER, *Administrative Patent Judges.*

MARTIN, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant,¹ Polaris Industries Inc.,
appeals from the Examiner’s decision to reject claims 22–26 and 28–46.
Final Act. 1. The Examiner withdrew the rejection of claims 47–51.

¹ We use the word “Appellant” to refer to “Applicant” as defined in 37
C.F.R. § 1.42(a). Appellant identifies the real party in interest as Polaris
Industries Inc. Appeal Br. 3.

Appeal 2018-003407
Application 14/478,700

Ans. 3. We have jurisdiction under 35 U.S.C. § 6(b).

AFFIRM; 37 C.F.R. § 41.50(b).

CLAIMED SUBJECT MATTER

The claims are directed to “side-by-side all terrain vehicles having at least a pair of laterally spaced apart seating surfaces.” Spec. ¶ 1. Claim 22, reproduced below, is illustrative of the claimed subject matter:

22. An all-terrain vehicle, comprising:
 - a frame;
 - a front suspension comprising at least one right front control arm and at least one left front control arm, the control arms being coupled to the frame, and a front torsion bar coupled between the front control arms;
 - at least two front wheels coupled to the front suspension;
 - a rear suspension comprising at least one right rear control arm and at least one left rear control arm, the control arms being coupled to the frame, and a rear torsion bar coupled between the rear control arms;
 - at least two rear wheels coupled to the rear suspension;
 - a seating area supported by the frame, comprising side by side seats each having a seat back and a seat bottom;
 - an engine supported by the frame, the engine positioned rearward of the seating area, and each seat bottom has a seating surface with a low point of the seating surface being lower than a top of the engine;
 - a transmission comprising a continuously variable transmission;
 - a front axle assembly supported by the frame and drivingly coupling the transmission to the front wheels;
 - a rear axle assembly supported by the frame and drivingly coupling the transmission to the rear wheels; and
 - outermost points of the vehicle in a width-wise direction define a width of less than 54 inches.

REFERENCES

The prior art relied upon by the Examiner is:

Vittone	US 3,366,411	Jan. 30, 1968
Hickey	US 3,709,314	Jan. 9, 1973
Enokimoto	US 5,251,713	Oct. 12, 1993
Furuhashi	US 5,327,989	July 12, 1994
Hypes	US 2005/0173180 A1	Aug. 11, 2005
Bataille	US 2006/0180383 A1	Aug. 17, 2006

REJECTIONS

Claims 22–26, 29, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey and Enokimoto. Final Act. 3.

Claim 28 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, and Bataille. Final Act. 5.

Claims 30, 31, and 33–35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, and Hypes. *Id.*

Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, and Vittone. Final Act. 6.

Claims 37–41 and 45 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, and Furuhashi. *Id.*

Claims 42 and 43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, Furuhashi, and Vittone. Final Act. 8.

Claims 44 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hickey, Enokimoto, Furuhashi, and Bataille. Final Act. 9.

OPINION

Obviousness

Hickey/Enokimoto – Claims 22–26, 29, and 32

Appellant argues these claims as a group.² We select claim 22 as representative. Claims 23–26, 29, and 32 stand or fall with claim 22. *See* 37 C.F.R. § 41.37(c)(iv). The Examiner finds that Hickey teaches the majority of features recited in claim 22, but fails to teach that “the vehicle width is less than 54 inches, or is approximately 50 inches.” *See* Final Act. 2–4. The Examiner reasons that it is desirable for an off-road vehicle to have a width permitting use of known trails that were 50 or 54 inches wide. *Id.* at 4. The Examiner elaborates that the Honda Foreman and Hart’s Hunter are examples of vehicles that illustrate the desirability of such off-road use. Ans. 5.

The Examiner also acknowledges that Hickey fails to teach a continuously variable transmission (CVT) and side-by-side seats with bottoms having a low point that is lower than the top of the engine. Final Act. 4. The Examiner finds that use of a CVT amounted to a simple substitution and that Enokimoto teaches the claimed seating arrangement. The Examiner reasoned that Enokimoto’s seat configuration would have been obvious “for providing as low as possible of a center of gravity to the vehicle.” *Id.*

² Appellant references certain other claims involved in the rejection, but those statements do not rise to the level of separate arguments. For example, Appellant states, generally, that “[e]ach of the claims discussing width is separately appealed hereby (claims 22–26, 37, 45, 47),” (Appeal Br. 22), which does not constitute separate argument. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011).

Appellant argues that the Examiner's reasoning for modifying Hype's teachings to have the recited width is "not supported by . . . actual evidence." Appeal Br. 21; *see also* Reply Br. 2 ("the Examiner still provides no evidence"). Appellant goes on to point out that the Honda Foreman is a straddle-type ATV with a single seat that sits above the engine and Hart's Hunter has a side-by-side configuration with the seats above the engine. Reply Br. 2.

Appellant's argument that the Examiner has not provided "actual evidence" to support the reason for combining the references is not persuasive because the law does not require "actual evidence." What is required is that the Examiner articulate reasoning with a rational underpinning to support the conclusion of obviousness. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) ("there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)); *see also Manual of Patent Examining Procedure* (MPEP) § 2144.06 (8th Ed., Rev. 9, Aug. 2012). The Examiner has provided reasoning with a rational underpinning by explaining that because trails were known to be 50 or 54 inches wide, it was desirable to configure vehicles to fit on those trails. Final Act. 4. Nothing in Appellant's argument undermines this reasoning. Further, Appellant's argument is not persuasive because the comments regarding the Honda Foreman and Hart's Hunter are inapposite. The Examiner relies on these references to illustrate the desirability of an off-road vehicle that fits trails that are 50 or 54 inches in width, not for disclosure of any of the limitations of the claimed subject matter. *See* Ans. 5.

Also regarding rationale, Appellant argues that the Examiner's reason for combining the references is hindsight because the source of that information is Appellant's Specification. Appeal. Br. 22. It is impermissible hindsight to imbue the person of ordinary skill in the art with knowledge that is not shown in the prior art. *See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983). That is not the case here. The Specification discloses, as background, that most side-by-side all-terrain vehicles (ATVs) have a width of at least 54 inches and most parks have a maximum trail width of about 50 inches. Spec. ¶ 3. This background disclosure reflects what was known in the art. Consequently, the Examiner's reasoning is not impermissible hindsight because it does not imbue the person of ordinary skill with knowledge that was not shown in the prior art. Stated in a positive sense, the Examiner only attributes knowledge of the prior art to the person of ordinary skill in the art. Given Appellant's argument, it is undisputed that these references show that narrow ATV's (those having a width of 50 or 54 inches), which include side-by-side ATV's, were known in the art.

In further support of the rejection rationale, the Examiner points out that "it is well held that the adjustment of dimensions or scale of a device, absent a positive teaching that such an adjustment cannot be made or is expressly shown as being prohibited, falls well within the skill level of the ordinary practitioner." Ans. 3-4. Appellant does not effectively counter this finding. In fact, Appellant never states what supposed challenges prohibit such narrowing other than to label various features as width-impacting. In addition, Appellant never points out any specific hurdle they overcame in designing a vehicle having a narrow width and the supposedly width-impacting features, nor does Appellant explain any specific solution, other

than to assert that they were the first to put all of the claimed features into a narrow ATV.

As an example, Appellant points out that achieving the claimed side-by-side seating and seat bottom below the top of the engine “has an impact on a needed width of the vehicle.” Appeal Br. 21. This is presumably so because once the seats are lowered below the top of the engine, various components that would normally run beneath the seat must be accommodated in different ways that previously led to vehicles wider than 50 or 54 inches. Appellant does not explain, however, nor does the Specification detail, any particular solutions to these problems.

Appellant further contends that the Examiner “continues to attempt to stuff additional width-impacting components into Hickey while continuing to state that the width is a feature that can just be chosen and implemented without consideration of the vehicle more generally.” *Id.* Appellant, however, does not explain how such consideration would present engineering challenges that could not be overcome through the ordinary skill in the art. Appellant also contends that fitting the claimed components into a vehicle having a width of no greater than 50 or 54 inches is not an obvious variation. Appellant even goes so far as to argue that the record is devoid of “any rear-engine vehicle having powered front wheels with side-by-side seating where a width of 54 inches or less was achieved.” Appeal Br. 22. This is basically an assertion that the Examiner did not show the claimed subject matter was anticipated. Such a contention carries little weight given the rejection is based on obviousness.

Generally, a change in the size or the dimensions of an apparatus is not a patentable distinction. *See e.g., In re Rose*, 220 F.2d 459, 463 (CCPA 1955) (“the size of the article under consideration . . . is not ordinarily a

Appeal 2018-003407
Application 14/478,700

matter of invention”), *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984) (where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device).

In sum, without any explanation of what specific problems arise and what the solutions are to such problems, Appellant’s labeling of various features as width-impacting amounts to nothing more than attorney argument. By not identifying in the Specification any particular solution to the purported problems associated with the recited width limitations, Appellant, itself, implicitly acknowledges that there is no particular challenge in designing a side by side ATV meeting these width limitations. *See* 35 U.S.C. § 112, first paragraph (“The specification shall contain a written description of the invention . . . to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.”). “The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” *U.S. v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). Here, because that information is not provided in the Specification, Appellant must be relying on the information being known in the art in order to comply with the enablement requirement.

Appellant also contends that the Declaration of Dr. John Moskwa shows the lack of a reasonable expectation of success. Appeal Br. 23. Dr. Moskwa testifies that vehicle design is not a matter of routine and common substitution; rather, modification to one component has a cascade

effect on the rest of the system. Moskwa Dec. 10. Dr. Moskwa adds that creation of a vehicle with a significantly lower center of gravity than prior art ATVs created the framework to permit making a narrower (50 or 54 inch) ATV because the lower center of gravity permitted more stable cornering. Moskwa Dec. 20–21. We appreciate, and agree with, the contention that vehicle design is a process where modification of one component impacts other components and performance. Yet, Appellant’s very general contention addresses all design changes and does not persuasively explain why the proposed modification in particular lacks a reasonable expectation of success.

Nor is the contention regarding a low center of gravity persuasive. Appellant contends that the claimed narrow width is only possible with a low center of gravity, yet claim 22, itself, undermines that assertion in that claim 22 does not require a low center of gravity. Further, we agree with the Examiner, and Appellant does not dispute, that Hart’s Hunter is a side-by-side ATV having a width of 50 inches, and there is no evidence in the record that Hart’s Hunter had a stability problem. Ans. 11; *see also* Reply Br. 2 (pointing out that Hart’s Hunter differs in some respects from the claimed subject matter, but making no contentions regarding stability). Because the Moskwa Declaration relies mainly on unclaimed features, we do not find the evidence persuasive of Examiner error.

Regarding the use of a CVT, “Applicant first notes that ‘old’ prior art is less probative of obviousness.” Appeal Br. 39 (citing *Leo Pharm. Prods., Ltd. v. Rea*, 726 F.3d 1346, 1356 (Fed. Cir. 2013)). Appellant explains that “Hickey was filed more than thirty years before the priority of the present application” and “Enokimoto was filed more than sixteen years before the priority of the present application (and CVT’s existed before then).” *Id.*

Appeal 2018-003407
Application 14/478,700

Appellant contends that “[t]he fact that no one ever thought to combine them is additional evidence that one of ordinary skill would not consider teachings of a CVT powertrain design to be obvious to include in a high-power military vehicle” and “[i]t is also strong evidence that Polaris’ invention, which did not occur until over 15 years later, was not obvious.” *Id.* Appellant’s reliance on *Leo Pharm.* is misguided.

“The mere age of the references is not persuasive of the unobviousness of the combination of their teachings, absent evidence that, notwithstanding knowledge of the references, the art tried and failed to solve the problem.” *In re Wright*, 569 F.2d 1124, 1127 (CCPA 1977); *see also Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004). This was not changed by *Leo Pharm.* *See Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1337–38 (Fed. Cir. 2016). Appellant’s general allegations regarding the age of the cited references, without more, is unpersuasive of error.

Appellant additionally disputes the Examiner’s rejection as it relates to claim 22’s recitation that “the transmission compris[es] a continuously variable transmission.” Appeal Br. 39–44. Specifically, Appellant disputes the Examiner’s rationale for use of a CVT. Appellant contends that “[o]ne of skill in the art would not combine a CVT with the vehicle of Hickey, doing so would make the vehicle unsuitable for its intended purpose.” *Id.* at 44. Appellant contends that “one of skill in the art recognizes that CVT’s are not desirable for high torque engines such as those used by Hickey,” and, therefore, “would readily recognize that it is not advisable/possible to combine a CVT with Hickey.” *Id.* at 40–41.

The Examiner explains that

[i]t is well known to be within the skill of the ordinary practitioner to substitute one transmission for another . . . and it would have been obvious . . . to provide the transmission taught by Hickey as a continuously variable transmission for the purpose of allowing an infinitely variable transmission ratio beneficially allowing more operational ratios than available with a fixed-speed transmission, and/or for the purpose of reducing costs over the use of a geared transmission.

Final Act. 4. The Examiner explains that although “Appellant refers to an engine having a particular displacement and being capable of delivering a particular torque,” these specific details are not disclosed in Hickey. Ans. 20. Rather, “Hickey . . . describes the engine as ‘an internal combustion engine 12’” and the engine’s “operating specification is not disclosed in the reference.” *Id.* (citing Hickey 1:63). That is, the Examiner is relying on these general teachings from Hickey when explaining that the features of claim 22 would have been obvious.

Appellant’s contentions regarding the use of a CVT are based on the use of a high torque engine, which is not the basis for the Examiner’s rejection, as explained above. Appellant also argues at length that the commercial embodiment of Hickey, the XR-311, has an engine that would be incompatible with an ATV engine. Appeal Br. 40–44. Again, the Examiner’s basis for the rejection is Hickey, which is not specific regarding the details of the engine other than it being an internal combustion engine. Furthermore, though not specifically stated by the Examiner, given that Enokimoto teaches an ATV also with an unspecified engine and that the claims at issue are to an ATV, we find that use of an appropriately sized engine for an ATV, i.e., not a high-power, low-torque engine as asserted by Appellant to be found in Hickey via the XR-311 would have been obvious,

Appeal 2018-003407
Application 14/478,700

thus rendering moot Appellant's arguments relating to compatibility with a CVT.

Appellant has not demonstrated error in the rejection of claim 22 regarding the prior art showing each limitation or in the reason for combining the references. Before making a conclusion on obviousness, we consider Appellant's arguments and evidence regarding objective indicia of nonobviousness. Appellant makes arguments regarding commercial success, industry praise, and copying.

To be relevant, secondary evidence of non-obviousness must be commensurate in scope with the claimed invention. *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). There must be a nexus between the merits of the claimed invention and the evidence of secondary considerations. *In re GPAC Inc.*, 57 F.3d 1573, 1580 (Fed. Cir. 1995). "Nexus" is a legally and factually sufficient connection between the objective evidence and the claimed invention, such that the objective evidence should be considered in determining non-obviousness. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988).

The burden of proving commercial success (and other types of secondary considerations) during prosecution is on the applicant. *See In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996) ("In the *ex parte* process of examining a patent application . . . the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sales constitute commercial success."); *see also In re DBC*, 545 F.3d 1373, 1384 (Fed. Cir. 2008). The burden of proving a nexus between the secondary considerations and the merits of the claimed invention during prosecution is also on the applicant or patent owner. *Huang*, 100 F.3d at 140 ("In sum, Huang simply has not carried his burden to prove that a nexus

existed between any commercial success and the novel features claimed in the application.”). “For objective evidence of secondary considerations to be accorded substantial weight, its proponent must establish a nexus between the evidence and the merits of the *claimed invention*.” *In re Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011) (citation omitted). “Where the offered secondary consideration actually results from something other than what is both claimed and *novel* in the claim, there is no nexus to the merits of the claimed invention.” *Id.* That is, the evidence of secondary considerations cannot be due to what is already known in the art.

Appellant contends that the evidence provided “show[s] the commercial success of the vehicles that embody the claims of U.S. Patent 8,596,405, which are the same vehicles that embody the claims of the present application.” Appeal Br. 24; *see also id.* at 26 (“while Dr. Jarosz shows a nexus between the success and the elements of the claims of the ’405 Patent, many of those same claim elements exist in the present application and the nexus between the success and the present application is also apparent”). Initially, we note that the evidence of secondary considerations submitted in this appeal was ultimately unpersuasive in the proceeding in which it was submitted for U.S. Patent 8,596,405 (“the ’405 patent”), even with a presumption of nexus. *See* IPR2014-001427, Paper 77.³ The only meaningful differences between the claims at issue in the ’405 patent determined unpatentable after considering the evidence of secondary considerations and claim 22 in this appeal are the recitation of the particular vehicle width and the use of a CVT. That is, the only purportedly novel features of claim 22 are the particular vehicle width and use of a CVT.

³ That decision is final and has not been appealed by the Patent Owner.

Appellant contends that “Dr. Jarosz establishes a nexus between the commercial success and the claims at issue by referring to a January 20, 2007 review of the Polaris RZR vehicle by Dave Beckstrom.” *Id.* at 26. Mr. Beckstrom’s review, however, is not evidence of commercial success that is tied to any particular feature of the claims, let alone the purportedly novel features of claim 22. In fact, Appellant offers no argument or evidence suggesting that the recited vehicle width or use of a CVT are responsible for any of the alleged commercial success. Rather, by Appellant’s own admission, the alleged commercial success is due to the unpatentable combination of features recited in the ’405 patent. That is, Appellant is essentially arguing that claim 22 is patentable based on the commercial success of a combination of elements already determined to be unpatentable. Appellant cannot argue patentability based on the combination of features recited in the claims from the ’405 patent, which were cancelled in IPR2014-01427. *See* 37 C.F.R. § 42.73(d)(3).

Dr. Jarosz declares that in 2008 when the North American Industry was down 23 percent to that point in the year, Polaris’s business grew 22 percent due to strength in high-margin product lines, including the side-by-side Ranger RZR. Appeal Br. 24; Jarosz Decl. ¶ 58. Dr. Jarosz states only that the Ranger was a product line that led to 22 percent growth for Polaris, but does not quantify what portion of that growth is attributable to the Ranger RZR. *See* Ans. 7 (noting the lack of market share data). Dr. Jarosz also stated that Polaris’s side-by-side sales “materially” outpaced the industry while the industry was in a market downturn in 2008 and also in 2010. Appeal Br. 31; Jarosz Decl. ¶¶ 59–60. Dr. Jarosz does not quantify what portion of Polaris’s side-by-side sales are attributable to the Ranger RZR.

Dr. Jarosz states that in October 2007, *ATV 4-Wheel Action* reported that the Ranger RZR would walk all over competition like the Yamaha Rhino because the RZR was narrower, handled better, and had a low center of gravity. Appeal Br. 25; Jarosz ¶ 62. Handling and a low center of gravity are not claimed features. Although claim 22 recites a width of 54 inches, the comparison to the Rhino is of little value without knowing the width of the Rhino. Further, Appellant provides no explanation as to how that width is tied to the alleged commercial success.

Dr. Jarosz states that *ATV 4-Wheel Action* reported that Polaris redefined the sport UTV category with introduction of the Ranger RZR 800 4x4. Appeal Br. 24; Jarosz Decl. ¶ 63. Although redefining a product category is praise and suggests commercial success, it is not quantifiable. For example, the comment does not provide statistical sales data in terms of total sales in dollars or market share. In sum, Dr. Jarosz's Declaration supports a general assertion that the Ranger RZR achieved some commercial success, but the Declaration lacks the specificity needed to put that success in context.

As noted above, Appellant also submits the Declaration of Dr. John J. Moskwa, which states, *inter alia*, that Polaris invented a unique ATV system that "resulted in a side-by-side vehicle with an extremely low center of gravity while still placing some components under the seats. The low center of gravity was the result of the particular system design that Polaris invented," namely "by placing the engine behind the seats" and locating "the seat bottoms below the top of the engine." Moskwa Dec. ¶ 42. Even with this Declaration evidence, Appellant does not provide any explanation as to how the design itself was innovative other than to point out that it provides a low center of gravity.

Nothing in the claims, however, requires a low center of gravity. Essentially the only requirement related to a low center of gravity is having the seat pan below the top of the engine, but because of the generic nature of the remainder of the limitations, this could be achieved simply by raising the engine rather than lowering the seats. In such an example, the vehicle would not have the low center of gravity touted by Dr. Moskwa. It might also provide room to accommodate features Appellant describes as width-impacting. Because the Declaration relies mainly on unclaimed features, we do not find the evidence persuasive.

As with the Moskwa Declaration, the Jarosz Declaration mainly touts the important feature of low center of gravity. Jarosz Dec. ¶ 31. Likewise, Rintamaki touts both the low center of gravity and trail compliant width. Rintamaki ¶ 4. Again, because nothing in the claims actually requires a low center of gravity and because Appellant does not explain any specific innovation to overcome the width issue, we do not find this evidence persuasive. As to the commercial success touted by Rintamaki, again much of this is tied to the RZR having a low center of gravity, which is not a claimed feature. *Id.* at ¶ 12.

With respect to the alleged industry praise, much of that evidence merely touts the Ranger RZR generally without respect to any specific feature, let alone claimed features. The little praise that is tied to specific features is directed toward the low center of gravity. *See, e.g.*, Jarosz Dec. ¶¶ 62, 70. As with commercial success, evidence of industry praise is only relevant when it is directed to the merits of the invention claimed. *See Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1311 (Fed. Cir. 2006). Accordingly, the alleged industry praise is weak evidence of patentability.

As to copying, Appellant lists five claimed features allegedly found in Arctic Cat's purportedly copied vehicle, but provides no analysis by showing the actual vehicle and how the alleged features are met. The list also omits numerous features found in the claims that Appellant does not address *viz.* an Arctic Cat vehicle. Moreover, there is no evidence that Arctic Cat actually copied Appellant's product. "[C]opying requires the replication of a specific product." *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004). Appellant's allegation of product similarity and infringement are not persuasive evidence of copying. *See Iron Grip*, 392 F.3d at 1325 ("Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent.").

Although Appellant includes a list of additional claims that recite features allegedly included in the Polaris Ranger RZR vehicle, there is no meaningful analysis how any of those features contributed to the alleged commercial success or industry praise. Weighing the evidence before us, the Examiner's strong case of obviousness outweighs Appellant's weak evidence of patentability. For the reasons set forth above, we sustain the Examiner's rejection of claims 22–26, 29, and 32. Because the Examiner appears to dismiss portions of the Declaration evidence, which we discuss in greater detail, we designate the affirmance as New Grounds of Rejection.

Hickey/Enokimoto/Bataille – Claim 28, 44, and 46

Claim 28 ultimately depends from claim 22 and claims 44 and 46 ultimately depend from claim 37, which further recite that "a battery [is] positioned underneath one of the seat bottoms." The Examiner finds that

Bataille teaches this additional feature and proposes further modifying the teachings of Hickey accordingly. Final Act. 5. Appellant argues that the Examiner has provided motivation for including a battery in the vehicle but not for the placement of that battery. Appeal Br. 45. The Examiner counters, however, that Bataille is used for the battery location and that:

The vertical height of the battery taught by Bataille is in no way specifically described by Bataille as being of such a height as to render [a] seat placed above it as somehow resultantly vertically displaced such that a lower point of the seating surface would no longer be lower than a top of an engine.

Ans. 25. Appellant does not address the more specific rationale provided in the Answer. Accordingly, we sustain the Examiner's rejection of claims 28, 44, and 46.

Hickey/Enokimoto/Hypes – Claims 30, 31, and 33–35

These claims ultimately depend from claim 22 and claim 30 recites that “the modular engine assembly is mounted to the frame by at least first and second mounting assemblies, where the first mounting assembly is coupled to the rear axle assembly.” The Examiner finds that Hypes teaches the features recited in claim 30 and proposes further modifying the teachings of Hickey accordingly. Final Act. 5–6. Appellant disputes the Examiner's finding related to Hypes, but does not allege any particular error in the rationale provided. Appeal Br. 45–46.

Appellant contends that the Examiner is in error because “bearing 48 and/or axle 50a of Hypes is received from below” while “oppositely, transaxle casing 72 appears to mount from above.” Appeal Br. 46. As such, Appellant argues that “[t]he orientation of the cited mounting structures of Hypes do not permit an engine, transmission, and portion of the rear axle to

be mounted as a unit” as claimed. *Id.* The Examiner responds that “Hypes is not relied upon to teach the functional aspect of the engine, transmission and portion of the rear axle assembly to be mountable as a unit (as this is deemed covered by the base reference to Hickey.” Ans. 26. The Examiner relies on “Hypes . . . to teach the first, second and third mounting assemblies as specified in claims 30, 31, and 33–35.” *Id.* The Examiner provides a detailed explanation of “the installation of transaxle 72 from below [being] fully allowed by the structure disclosed by the Hypes reference” (*id.* at 25), and explains that “the structure taught by Hypes [being] capable of being mounted as a unit . . . speaks favorably to the conceptual compatibility of the reference in the combination” (*id.* at 26).

Again, Appellant offers no rebuttal to the clarification of the rejection provided in the Examiner’s Answer, leaving effectively no dispute as to Hypes teaching the first and second mounting assemblies. And, as noted above, there is no dispute as to the Examiner’s rationale including those mounting assemblies in combination with the teachings of Hickey. Appellant does not argue claims 31 and 33–35 separately. As such, we are not persuaded of error in the Examiner’s rejection of claims 30, 31, and 33–35.

Hickey/Enokimoto/Vittone – Claim 36

Appellant relies on the arguments presented with respect to claim 22 for the patentability of claim 36. Appeal Br. 46. Those arguments are unpersuasive for the reasons set forth above.

Hickey/Enokimoto/Furuhashi – Claims 37–43 and 45

Appellant makes no separate argument for dependent claims 42 and 43 apart from that made in regard to claim 37. These claims therefore stand

or fall with claim 37. As to the rejection of claims 37–41 and 45 over Hickey, Enokimoto, and Furuhashi, regarding the recited fuel tank location, the Examiner reasons that it would have been obvious to position the tank underneath one of the seat bottoms as claimed because it would provide compact storage of the fuel source, permitting other vehicle spaces to be used for carrying cargo rather than storing fuel. Final Act. 7. Appellant urges that such a position would raise the seat, and it is a generic motivation that supports placing a fuel tank anywhere. Appeal Br. 47. We agree with the Examiner, however, that the proffered rationale is not generic. Rather, Furuhashi specifically illustrates a fuel tank below a seat. Ans. 7; Furuhashi, 12:23–26, Fig. 19, element 120. Appellant’s assertion that placing the fuel tank under a seat comes with the tradeoff of raising the seat does not negate the proffered rationale. *See Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1165 (Fed. Cir. 2006) (“a given course of action often has simultaneous advantages and disadvantages, and this does not necessarily obviate motivation to combine.”). Appellant simply points out a negative aspect without weighing it against the benefits. *See generally Winner Int’l Royalty Corp. v. Wang*, 202 F.3d 1340, 1349 n.8 (Fed. Cir. 2000) (“The fact that the motivating benefit comes at the expense of another benefit, however, should not nullify its use as a basis to modify the disclosure of one reference with the teachings of another. Instead, the benefits, both lost and gained, should be weighed against one another.”). Accordingly, we are not persuaded of error in the Examiner’s rejection.

DECISION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)	Affirmed	Reversed	New Ground
22–26, 29, 32	103	Hickey, Enokimoto	22–26, 29, 32		
28	103	Hickey, Enokimoto, Bataille	28		
30, 31, 33–35	103	Hickey, Enokimoto, Hypes	30, 31, 33–35		
36	103	Hickey, Enokimoto, Vittone	36		
37–41, 45	103	Hickey, Enokimoto, Furuhashi	37–41, 45		
42, 43	103	Hickey, Enokimoto, Furuhashi, Vittone	42, 43		
44, 46	103	Hickey, Enokimoto, Furuhashi, Bataille	44, 46		
Overall Outcome:			22–26, 28–46		22–26, 28–46

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (2012). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, 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. . . .

Appeal 2018-003407
Application 14/478,700

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

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,⁴ the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome. If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Patent Trial and Appeal Board for final action on the affirmed rejection, including any timely request for rehearing thereof.

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; 37 C.F.R. § 41.50(b)

⁴ 37 C.F.R. § 41.52(a)(1) provides “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”