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SEAGER, TUFTE & WICKHEM, LLP
100 SOUTH 5TH STREET
SUITE 600
MINNEAPOLIS, MN 55402
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EXAMINER

FERGUSON, MICHAEL P

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBERT S. CUTSFORTH

Appeal 2018-004407
Application 14/220,489¹
Technology Center 3600

Before STEFAN STAICOVICI, SEAN P. O'HANLON, and
ALYSSA A. FINAMORE, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision in the Final Office Action (dated Jan. 20, 2017, hereinafter "Final Act.") rejecting claims 1–4 and 22.² We have jurisdiction over this appeal under 35 U.S.C. § 6(b).

¹ Cutsforth, Inc. is the applicant and identified as the real party in interest in Appellant's Appeal Brief (filed Aug. 31, 2017, hereinafter "Appeal Br."). Appeal Br. 3.

² The Examiner indicates claims 5–21 and 23 as allowable. *See* Final Act. 12.

SUMMARY OF DECISION

We REVERSE.

INVENTION

Appellant's invention is related "to a mounting fixture for positioning a workpiece in a desired relationship with an apparatus." Spec. 1, ll. 9–10.

Claim 1, the sole independent claim, is representative of the claimed invention and reads as follows:

1. A mounting fixture comprising:
 - a first tubular member having a first end, a second end, and a central longitudinal axis extending therethrough;
 - a second tubular member having a first end, a second end, and a central longitudinal axis extending therethrough; and
 - an articulation joint coupled between the first tubular member and the second tubular member to position the longitudinal axis of the first tubular member at a desired angle relative to the longitudinal axis of the second tubular member, the articulation joint including a first articulation member pivotably coupled to a second articulation member at a pivot point;
 - wherein a first end portion of the articulation joint is operatively configured to exert a radially outward clamping force against an inner surface of the first tubular member;
 - wherein a second end portion of the articulation joint is operatively configured to exert a radially outward clamping force against an inner surface of the second tubular member;
 - and
 - wherein the articulation joint is operatively configured to exert an inward clamping force against the first articulation member and the second articulation member to clamp the first articulation member from pivotable movement relative to the second articulation member.

REJECTION³

The Examiner rejects claims 1–4 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Andersen (US 1,232,473, iss. July 10, 1917) and Walter (EP 0 399 371 A1, publ. May 17, 1990).⁴

ANALYSIS

The Examiner finds that Andersen discloses a mounting fixture including, *inter alia*, “a first tubular member (not shown; receiving threaded end portion 11) . . . a second tubular member (not shown; receiving threaded end portion 11) . . . and an articulation joint **12** coupled between the first tubular member and the second tubular member.” Final Act. 9. The Examiner further finds that “the articulation joint includ[es] a first articulation member **12** pivotably coupled to a second articulation member **12** at a pivot point **15**.” *Id.* However, the Examiner further finds that Andersen fails to disclose that “a first end portion of the articulation joint is operatively configured to exert a radially outward clamping force against an inner surface of the first tubular member” and “a second end portion of the articulation joint is operatively configured to exert a radially outward

³ The rejections under 35 U.S.C. § 112, second paragraph, of claims 1–23, as being indefinite, and of claims 5 and 16–18 as being incomplete for omitting essential structural elements, are withdrawn by the Examiner. *See* Examiner Answer (dated Jan. 22, 2018, hereinafter “Ans.”) at 6; *see also* Final Act. 2–8.

⁴ We derive our understanding of this reference from the English language translation contained in the image file wrapper of this application. All references to the text of this document are to portions of the translation.

clamping force against an inner surface of the second tubular member.” *Id.* at 10. Nonetheless, the Examiner finds that Walter discloses a mounting fixture including, *inter alia*, threaded stud 50 “for exerting a radially outward clamping force against the inner surface of a tubular member 7 with an end portion 6, 16 of a joint.” *Id.* Thus, the Examiner concludes that

[I]t would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the mounting fixture disclosed by Andersen wherein the first and second end portions of the articulation joint each exert a radially outward clamping force against an inner surface of the second tubular member via a first or second threaded stud, respectively, as taught by Walter in order to enable one to use the articulation joint with readily available unthreaded tubular members, providing for quicker, easier manufacturing and assembly[.]

Id. at 11.

Appellant argues that the Examiner’s modification of the end portions of Andersen’s ball joint, according to Walter, is based on impermissible hindsight. Reply Brief (filed Mar. 21, 2018, hereinafter “Reply Br.”) at 3. According to Appellant, “[t]he Examiner has failed to identify any deficiency in the ball joint of Andersen for its intended purpose that would necessitate or inspire the proposed modification,” but rather, “appears to have merely identified independently disclosed elements and pieced them together using Appellant’s disclosure as a guide.” Appeal Br. 7; *see also* Reply Br. 3.

In response, the Examiner notes that

[t]he Walter reference has only been relied upon to teach or suggest modifying the first and second end portions of the articulation joint disclosed by Andersen wherein each exert a

radially outward clamping force against an inner surface of the second tubular member *via a first or second threaded stud.*

Ans. 8–9 (emphasis added). The Examiner further reiterates the reasoning for modifying Andersen’s articulation joint, according to Walter; namely, “to enable one to use the articulation joint with readily available unthreaded tubular members, providing for quicker, easier manufacturing and assembly.” *Id.* at 8.

Although we appreciate the Examiner’s position that Walter discloses an end portion **6, 16** of a joint that “is configured to exert a radially outward clamping force **50** against an inner surface of a tubular member **7,**” nonetheless, we find the Examiner’s rejection insufficient. *See* Ans. 8; *see also* Walter, Fig. 5. Specifically, the Examiner’s rejection does not adequately explain what would have prompted a person having ordinary skill in the art to modify the end portions of Andersen’s joint 12 to include Walter’s threaded stud. We agree with Appellant that the Examiner has not provided any findings that Andersen recognized a problem with its ball joint 12 in coupling first and second tubular members. *See* Reply Br. 2. Appellant is correct that “nowhere does Andersen indicate that the bushing 10 and/or nipple [11] are required to be ‘quickly assembled’ or ‘easily manufactured.’” *Id.*

Furthermore, the Examiner does not provide any factual support for the allegation that modifying the end portions of Andersen’s joint 12 to include Walter’s threaded stud “provid[es] for quicker, easier manufacturing and assembly.” *See id.* at 2–3; *see also* Final Act. 11. Rather, as Appellant correctly notes, “using the cited clamping system of Walter” to couple

Andersen's first and second tubular members to ball joint 12, a skilled artisan would require a tool to rotate threaded stud 50, and, thus, would not make for a "quicker, easier . . . assembly." Appeal Br. 8. Stated differently, the Examiner does not provide any factual support for the position that Walter's clamping system constitutes a quicker and easier assembly method than the threaded connections of Andersen. Moreover, the Examiner does not adequately explain how the end portions of Andersen's joint 12 would be modified to include Walter's threaded stud 50 such that "a radially outward clamping force" is exerted against an inner surface of the first and second tubular members, as called for by independent claim 1. The Examiner also fails to adequately explain how the end portions of Andersen's joint 12 would be modified to include three threaded studs. *See* Ans. 10 ("The Walter reference has only been relied upon to teach or suggest modify[ing] the means **15,16** [of Andersen] . . . to comprise a third threaded stud.").

As such, for the foregoing reasons, the Examiner's articulated reason for combining the disclosures of Andersen and Walter is not supported by a preponderance of the evidence. *See* Final Act. 11. Accordingly, absent hindsight, we fail to see why a person having ordinary skill in the art would modify the end portions of Andersen's joint 12 to include Walter's threaded stud.

Lastly, we agree with Appellant that "it is unclear [from the Examiner's rejection] how the bushing or nipple 11 [of Andersen] may be received by *both* the first tubular member and the second tubular member." Appeal Br. 6 (emphasis added); *see also* Final Act. 9.

Appeal 2018-004407
Application 14/220,489

In conclusion, for the foregoing reasons, we do not sustain the rejection under 35 U.S.C. § 103(a) of claims 1–4 and 22 as unpatentable over Andersen and Walter.

SUMMARY

The Examiner's decision to reject claims 1–4 and 22 under 35 U.S.C. § 103(a) is reversed.

REVERSED