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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/267,963	09/16/2016	Edward Riggs Monfort	126673	6498
23363	7590	09/30/2019	EXAMINER	
Lewis Roca Rothgerber Christie LLP PO BOX 29001 Glendale, CA 91209-9001			WALTERS, JOHN DANIEL	
			ART UNIT	PAPER NUMBER
			3618	
			NOTIFICATION DATE	DELIVERY MODE
			09/30/2019	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* EDWARD RIGGS MONFORT

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Appeal 2019-002320  
Application 15/267,963  
Technology Center 3600

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Before JENNIFER D. BAHR, STEFAN STAICOVICI, and  
JEREMY M. PLENZLER, *Administrative Patent Judges*.

BAHR, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant<sup>1</sup> appeals from the Examiner's decision rejecting claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

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<sup>1</sup> 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 Adomani, Inc. Appeal Br. 1.

### CLAIMED SUBJECT MATTER

Appellant’s invention is directed “generally to systems and methods for converting an internal combustion engine vehicle into an electric vehicle.” Spec. ¶ 1. Claim 1, reproduced below, is representative of the claimed subject matter.

1. A system for converting an internal combustion engine vehicle having an arrangement of vehicle accessories into an electric vehicle, the system comprising:

an accessory plate having a plurality of openings for coupling the vehicle accessories to the accessory plate, wherein the plurality of openings are arranged corresponding to the arrangement of the vehicle accessories in the internal combustion engine vehicle such that the vehicle accessories are supported in the same configuration in the electric vehicle as in the internal combustion engine vehicle.

### REFERENCE

The prior art relied upon by the Examiner is:

Monfort                                      US 9,102,221 B1                      Aug. 11, 2015

### REJECTIONS

- I. Claims 1–7, 9, 10, 12, 13, 15, 16, 19, and 20 stand rejected under 35 U.S.C. § 102(a)(1) as anticipated by Monfort.
- II. Claims 8, 11, 14, 17, and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Monfort.

### OPINION

#### *Rejection I—Anticipation*

Appellant groups claims 1–7, 9, 10, 12, 13, 15, 16, 19, and 20 together in contesting this rejection. *See* Appeal Br. 3–7. We decide the appeal of this rejection on the basis of claim 1, and the remaining claims stand or fall

with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv) (permitting the Board to select a single claim to decide the appeal as to a single ground of rejection of a group of claims argued together).

The Examiner finds that Monfort discloses a system comprising an accessory plate (bracket 44) as recited in claim 1. *See* Final Act. 2–3.

Appellant argues that Monfort fails to teach, and in fact teaches away from, maintaining the accessories in the same configuration in the converted electric vehicle (EV) as in the internal combustion engine (ICE) vehicle. Appeal Br. 4–5. In support of this argument, Appellant relies on a Declaration Under 37 C.F.R. § 1.132 by Edward Riggs Monfort dated October 18, 2017 (hereinafter “Monfort Declaration” or “Monfort Decl.”). *Id.* at 4. Appellant’s teaching away argument is inapposite here because “[t]eaching away is irrelevant to anticipation.” *Seachange Int’l, Inc. v. C-COR, Inc.* 413 F.3d 1361, 1380 (Fed. Cir. 2005) (citing *Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998); *Bristol–Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1378 (Fed.Cir.2001)).

Moreover, the statements in the Monfort Declaration regarding the offset vertical section of Monfort’s bracket 44 and the bracket conforming closely to the cylindrical side wall of the electric motor do not relate to any limitation of claim 1 and, in particular, are unrelated to the configuration of openings in the accessory plate. *See* Monfort Decl. ¶ 4. Monfort discloses a kit for allowing one to replace an internal combustion engine in a vehicle with an electric motor by removing the internal combustion engine, attaching the electric motor to the transmission with an adaptor plate, and “attach[ing] the accessories in an internal combustion engine pattern” using

bracket 44. Monfort 3:55; 4:49–54. Bracket 44 is provided with a plurality of openings for mounting accessory devices such as an alternator, an air conditioning compressor, and a power steering pump “to be kept as if [the vehicle] were running on an internal combustion engine.” *Id.*, Fig. 5; 3:65–4:2; 4:56–62. Appellant does not persuasively explain why Monfort’s bracket does not satisfy the limitations of claim 1.

Appellant also argues that “[t]he Monfort Declaration also contains evidence that the claimed apparatus and method of supporting the OEM accessories in the same configuration in the converted EV as in the ICE vehicle proceeds contrary to accepted wisdom in the automotive EV conversion kit art.” Appeal Br. 5 (citing Monfort Decl. ¶ 7). This argument is unavailing because proceeding contrary to accepted wisdom in the art may be evidence of nonobviousness, but is not relevant to anticipation.

Moreover, paragraph 7 of the Monfort Declaration, cited by Appellant, does not support Appellant’s assertion and, in fact, provides no enlightenment whatsoever. In this paragraph, Declarant Monfort states: “I am **not fully** familiar with the state of the art in the electric vehicle conversion kit industry, including kits supplied by EV West . . . , and supporting OEM accessories in the converted electric vehicle in the same configuration as in the internal combustion engine vehicle runs counter to the accepted wisdom in this industry.” Monfort Decl. ¶ 7.

Appellant argues that the passage in column 5 of Monfort (cited by the Examiner on page 3 of the Final Action) discussing variations in size, shape, and form would not result in the claimed arrangement of vehicle accessories. Appeal Br. 6; *see* Monfort 5:5–12. Although we agree with Appellant that this passage provides no specific guidance as to the

configuration of the accessories, Appellant’s argument does not identify with specificity a distinction between the structure recited in claim 1 and Monfort’s bracket 44. In this regard, we note that claim 1 recites an accessory plate having a plurality of openings for coupling vehicle accessories to the accessory plate, wherein the “openings are arranged corresponding to the arrangement of the vehicle accessories in the internal combustion engine vehicle such that the vehicle accessories are supported in the same configuration in the electric vehicle as in the internal combustion engine vehicle.” Appeal Br. 8 (Claims App.); *see* Spec. ¶ 16 (disclosing that supporting in the same arrangement as the vehicle accessories were supported in the internal combustion engine vehicle prior to conversion to an electric vehicle encompasses either a centerline-to-centerline alignment between the position of the accessories in the converted electric vehicle and the position of the accessories in the internal combustion vehicle prior to conversion or simply the same relative alignment and spacing that the accessories had in the internal combustion engine vehicle prior to the conversion, but not the same absolute position). However, claim 1 does not specify any particular pre-conversion configuration of accessories, and, thus, does not effectively restrict the configuration of the claimed openings to any particular arrangement.

For the above reasons, Appellant does not apprise us of error in the rejection of claim 1 as anticipated by Monfort. Accordingly, we sustain the rejection of claim 1, as well as claims 2–7, 9, 10, 12, 13, 15, 16, 19, and 20, which fall with claim 1, as anticipated by Monfort.

*Rejection II—Obviousness*

Appellant does not present any additional arguments specifically contesting the rejection of claims 8, 11, 14, 17, and 18 under 35 U.S.C. § 103 as unpatentable over Monfort.<sup>2</sup> *See* Appeal Br. 3–7. Thus, for the reasons set forth above, Appellant fails to apprise us of error in the rejection of claims 8, 11, 14, 17, and 18 as unpatentable over Monfort, which we, thus, sustain.

DECISION

The Examiner’s decision rejecting claims 1–20 is **AFFIRMED**.

CONCLUSION

In summary:

<b>Claims Rejected</b>	<b>Basis</b>	<b>Affirmed</b>	<b>Reversed</b>
1–7, 9, 10, 12, 13, 15, 16, 19, 20	§ 102(a)(1) Monfort	1–7, 9, 10, 12, 13, 15, 16, 19, 20	
8, 11, 14, 17, 18	§ 103 Monfort	8, 11, 14, 17, 18	
<b>Overall Outcome</b>		1–20	

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).

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<sup>2</sup> The Examiner’s obviousness rejection does not propose any modification of Monfort, or provide any obviousness rationale, related to the configuration of the openings in the accessory plate.

Appeal 2019-002320  
Application 15/267,963

AFFIRMED