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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/678,630	08/16/2017	Ralph Norfleet	1379-011 Cont.	7813
1009	7590	06/11/2020	EXAMINER	
KING & SCHICKLI, PLLC 800 CORPORATE DRIVE, SUITE 200 LEXINGTON, KY 40503			PEDDER, DENNIS H	
			ART UNIT	PAPER NUMBER
			3612	
			NOTIFICATION DATE	DELIVERY MODE
			06/11/2020	ELECTRONIC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte RALPH NORFLEET and JASON NORFLEET

Appeal 2020-000047
Application 15/678,630¹
Technology Center 3600

Before MICHAEL C. ASTORINO, BRUCE T. WIEDER, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

WIEDER, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1–7 and 9–20. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART and enter a NEW GROUND OF REJECTION pursuant to our authority under 37 C.F.R. § 41.50(b).

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Backsaver International, Inc. (Appeal Br. 2.)

CLAIMED SUBJECT MATTER

Appellant’s invention “relates to the vehicle arts and, more particularly, to a handle for assisting in raising or lowering a tailgate, a fixed guide arrangement for a tailgate lift-assist device, and safety bumpers for the tailgate.” (Spec. ¶ 1.)

Claims 1, 11, and 19 are the independent claims on appeal. Claim 1 is illustrative. It recites:

1. A tailgate lift assembly, comprising:
 - an elongated housing;
 - a spring anchored at one end at a first end of the housing;
 - a connector having a first end affixed to the opposite end of said spring and extending through said housing; and
 - first and second stationary guides for engaging the connector.

REJECTIONS

Claims 1–7, 10–17, 19, and 20 are rejected under 35 U.S.C. § 103 as unpatentable over Rayburn (US 6,126,223, iss. Oct. 3, 2000), and Nguyen (US 6,126,222, iss. Oct. 3, 2000) or Ehret (US 2,572,847, iss. Oct. 30, 1951.)

Claims 9 and 18 are rejected under 35 U.S.C. § 103 as unpatentable over Rayburn, Nguyen or Ehret, and Norfleet (US 7,309,094 B2, iss. Dec. 18, 2007).

ANALYSIS

Claims 1, 2, 6, 10–17, and 19

Obviousness is a legal conclusion involving a determination of underlying facts.

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007) (quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966)).

With regard to the scope and content of the prior art, the Examiner finds that Rayburn teaches “housing 20, spring 19, connector 15 and first and second rotatable guides 22, 23 on the housing sidewalls.” (Final Action 2; *see also* Rayburn, Figs. 2, 3.) The Examiner also finds that Nguyen “teach[es] that a cable guide may be structured as a semi-circular fixed guide 50.” (*Id.* (citing Nguyen, Fig. 3.) The Examiner also finds that “Ehret teaches that a cable guide may be structured as a semi-circular stationary guide 49, 50 fixed in position at fastener 51.” (*Id.*; *see also* Ehret, Fig. 4.) The Examiner determines that “[i]t would have been obvious at the time of filing of applicant to provide in Rayburn a fixed guide as taught by either Nguyen et al. or Ehret saving material and the possibility of wear at the roller bearing.” (Final Action 2.) The Examiner determines that it would have been obvious to make the combination for the additional reasons of “‘prolong[ing] the service life of the assembly and also allow[ing] for robust performance under harsh operating conditions’, a goal of applicant, page 10, lines 3-5.” (*Id.* at 2–3.)

Appellant argues that “the Examiner has failed to provide sufficient rationale for combining the Nguyen reference with Rayburn” (Appeal Br. 5),

and that the Examiner improperly relied on hindsight to make the combination because the Examiner relied on “precisely the result of the combination stated in the Appellant’s specification” (*Id.* (emphasis omitted); *see also* Spec. ¶ 46). Thus, Appellant argues, the Examiner has not presented a *prima facie* case of obviousness. (Appeal Br. 5; *see also* Reply Br. 2.)

“Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR Int’l Co.*, 550 U.S. at 420. Here, even if we were to accept Appellant’s *sub silentio* contention that prolonging the assembly’s service life and allowing for robust performance under harsh conditions were neither needs nor problems known in the field, the Examiner still provides the separate motivation of “saving material and the possibility of wear at the roller bearing.” (*See* Final Action 2.) Appellant does not persuasively argue why “saving material and the possibility of wear at the roller bearing” do not individually and/or collectively provide a sufficient reason to combine the prior art elements in the manner claimed.

The USPTO carries its procedural burden of establishing a *prima facie* case when its rejection satisfies the requirements of 35 U.S.C. § 132 by notifying the applicant of the reasons for rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *In re Jung*, 637 F.3d 1356, 1362 (Fed. Cir. 2011) (brackets in original) (quoting 35 U.S.C. § 132(a)). In view of the above, we do not agree that the Examiner failed to notify Appellant of the reasons for the rejection.

Therefore, we are not persuaded that the Examiner erred in rejecting claim 1. Claims 2, 6, 10–17, and 19 are not separately argued and fall with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

Claim 3

Claim 3 recites: “The assembly of claim 1, further including a pair of fasteners for connecting each stationary guide to the housing.”

The Examiner finds that Nguyen uses multiple fasteners (Answer 5 (citing Nguyen, Fig. 4)), and that multiple fasteners are also used in Ehret “at [rivets] 51 and [] aperture 60” (*id.*, citing Ehret, Fig. 4). The Examiner also finds that the use of “multiple fasteners in Ehret is deemed to be an obvious duplication of parts.” (Final Action 3.)

Appellant argues that the Examiner provides “no rationale explaining why a skilled artisan would combine the fasteners of Nguyen with the guide of Rayburn. Rather, the Examiner merely notes that both Nguyen and Ehret teach fasteners. *See Examiner's Answer p. 6.* Lacking is any justification whatsoever for combining the references in this manner.” (Reply Br. 2.)

The Supreme Court in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398 . . . (2007), explained that, “because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known,” “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 418–19.

Personal Web Techs., LLC v. Apple, Inc., 848 F.3d 987, 991–92 (Fed. Cir. 2017). Here, the Examiner does not sufficiently identify a reason that would

have prompted a person of ordinary skill in the art to make the claimed combination. Therefore, we will reverse the rejection of claim 3.

Claim 4

Claim 4 recites: “The assembly of claim 1, wherein the first stationary guide is exposed to an open end of the housing through which the connector passes.”

Appellant argues that the Final Action “does not appear to provide a basis for rejecting claims 4 or 5.” (Appeal Br. 6.) We agree that, in the Final Action, the Examiner does not provide a sufficient explanation for the rejection of claim 4. In the Answer, the Examiner determines that “figure 2 of Rayburn is self-explanatory.” (Answer 6.)

Appellant argues that “[s]imply alleging that the cited references are ‘self-explanatory’ fails to provide Appellant with any useful information which may be used to judge the merits of the rejection[.]” (Reply Br. 3.)

As an initial matter, we note the striking similarities between Appellant’s Figures 7 and 9, and Rayburn’s Figures 2 and 3, respectively. Appellant’s Specification describes the end of housing 120 nearest guide 123 as “the open end of housing 120.” (See Spec. ¶ 51; *see also id.* at Figs. 7, 9, 10, 12.) This corresponds to the open end of housing 20 in Figure 2 of Rayburn (marked as aperture 27 in Figure 3 of Rayburn). (See Rayburn, col. 5, ll. 7–10; *see also id.* at Figs. 2, 3.) We also note that Appellant’s Specification discloses that “connector 50 may be a stainless steel cable capable of withstanding high pound force” (Spec. ¶ 41); and that Rayburn’s specification discloses that “cable 15 may be a stainless steel cable capable of withstanding high pound force.” (Rayburn, col. 3, ll. 37–

39.) Also, Appellant's Figures 7 and 9 show connector 50 passing through the open end of the housing; and Rayburn's Figures 2 and 3 show the connector (i.e., cable 15) passing through the open end of the housing (i.e., aperture 27). Moreover, there can be no question that Appellant's Figures 7, 9, 10, and 12 show guide 123 exposed to the open end of the housing through which the connector passes; and that Rayburn's Figures 2 and 3 show guide 23 exposed to the open end of the housing (i.e., aperture 27) through which the connector (i.e., cable 15) passes.

In view of the above, including the discussion of claim 1, it is clear that claim 4 would have been obvious to one of ordinary skill in the art in view of Rayburn, and Nguyen or Ehret.

However, we agree with Appellant that the Examiner's minimal explanation that "figure 2 of Rayburn is self-explanatory" (Answer 6) does not sufficiently explain the basis for the Examiner's rejection of claim 4. In other words, the Examiner did not sufficiently notify Appellant of the reasons for rejection, "together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application." *In re Jung*, 637 F.3d at 1362 (brackets in original) (quoting 35 U.S.C. § 132(a)).

Therefore, we will reverse the Examiner's rejection of claim 4, and pursuant to our authority under 37 C.F.R. § 41.50(b), enter a NEW GROUND OF REJECTION of claim 4 under 35 U.S.C. § 103.

Claim 5

Claim 5 recites: “The assembly of claim 1, wherein the first stationary guide includes a semi-circular cross-section having a rounded face for engaging the connector.”

In the Final Action, the Examiner does not specifically discuss claim 5. In the Answer, the Examiner states that “[t]he term semi-circular was discussed in the rejection above [regarding claim 1]. ‘Rounded face’ is implicit in ‘semi-circular’ and self-evident from the secondary references.” (Answer 6.)

Appellant argues that “the Examiner has still failed to provide rationale sufficient to maintain a rejection.” (Reply Br. 2; *see also id.* at 3.)

As discussed above with regard to claim 1, the Examiner has provided sufficient reason to combine the prior art elements in the manner claimed in claim 1. And with regard to the additional requirement of claim 5 that the first guide include a semi-circular cross-section, the Examiner finds that both Nguyen and Ehret teach such a guide. (*See* Final Action 2, Answer 4.)

In this case, Appellant does not persuasively argue why the Examiner’s explanations in the Final Action and Answer (*see* Final Action 2, Answer 4, 6), do not provide sufficient reasons for the rejection, “together with such information and references as may be useful in judging of the propriety of continuing the prosecution of [the] application.” *In re Jung*, 637 F.3d at 1362 (brackets in original) (quoting 35 U.S.C. § 132(a)).

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 5.

Claim 7

Claim 7 recites: “The assembly of claim 1, wherein the first stationary guide comprises inwardly sloping sides, the inwardly sloping sides configured to form a center channel to loosely guide the connector.”

Appellant argues that “[t]he Examiner completely fails to account for the requirement of a ‘central channel’ anywhere in the rejection statement, and such feature is not present in any of the cited references.” (Appeal Br. 6.) Appellant further argues that, in view of Figure 3 of Nguyen, “the cable guide 50 of Nguyen is in no way a ‘central channel,’ as required by claim 7.” (Reply Br. 4.)

The Examiner finds that Nguyen “has a groove for engaging the cable as seen in figure 5 with inwardly sloping sides, claim 7, the groove forming a recess, claim 11. Ehret has a groove formed by the disclosed side flanges 52, 53, col. 3, lines 45-49.” (Final Action 3.) The Examiner also finds that “[a]s to 7 and 17, the clearance between recess or groove and cable is an obvious expedient to one of ordinary skill in this art . . . to avoid excessive friction.” (*Id.*)

Figure 5 of Nguyen shows cable guide 50 having inwardly sloping sides forming a center channel. (*See* Nguyen, Fig. 5.) Further, Ehret discloses that, as shown in Figure 2, “[t]he bearing blocks 49 to 50 are preferably provided with side flanges 52, 53, respectively, which extend over the curved bearing edges of the blocks and provide bearing grooves or channels for the cables 20 to 21.” (Ehret, col. 3, ll. 44–49.)

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 7.

Claims 9 and 18

Claim 9 recites: “The assembly of claim 1, wherein the first stationary guide is configured to keep the connector in an aligned position in relation to the housing, and the second stationary guide is configured to allow a deviation from the aligned position.” Claim 18 contains similar language and is argued together with claim 9. Claim 18 will stand or fall with claim 9. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner determines that it would have been obvious

to provide in the combination [discussed above regarding claim 1] a modified second stationary guide 52/70 as taught by Norfleet in order to allow cable 42 deviation from aligned position at 58, figure 4, to a deviated position at the right side of figure 4 in order to “permit articulation between the cable 42 and the tailgate 20 as the tailgate is moved ...”, col. 4, lines 56-60.

(Final Action 3.)

Appellant argues that

[t]he Examiner’s citation to col. 4, lines 56-60 of Norfleet as indicating that this arrangement “permit[s] articulation between the cable 42 and the tailgate 20 as the tailgate is moved” has absolutely no bearing on whether the **guide** itself is “configured to allow a deviation from the aligned position” achieved by another guide, as claims 9 and 18 require. Indeed, the arrangement [shown in Figure 4 of Norfleet] would actually prevent the lateral displacement from occurring.

(Appeal Br. 8.) We are not persuaded of error.

Norfleet teaches “[a] lift assembly [to] assist[] in raising or lowering a tailgate, such as one found on a utility trailer.” (Norfleet, Abstract.)

Figure 4 of Norfleet is reproduced below.

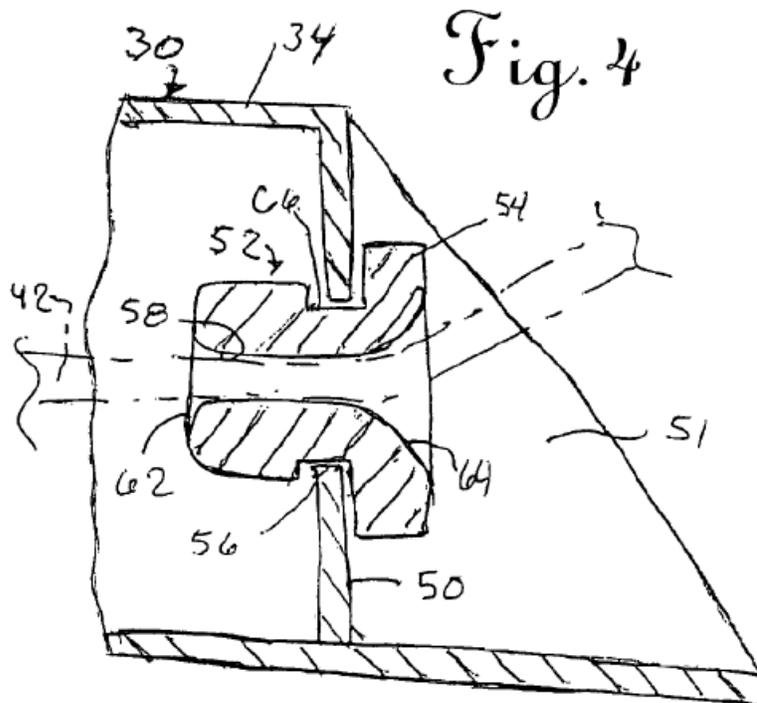


Figure 4 shows “a side elevational view in section of the rearward end of the elongated enclosure housing with an insert or grommet extending therethrough to function as a cable guide therein.” (*Id.* at col. 3, ll. 64–67.) In particular, Figure 4 shows flexible cable 42 (in dotted outline) in an aligned position in relation to the housing 30. After cable 42 passes through the insert/grommet (from left to right in Figure 4), the cable deviates from the aligned position. In short, the insert/grommet performs the function of the second stationary guide as recited in claim 9, i.e., “to allow a deviation from the aligned position.” Thus, we agree with the Examiner that “guide 52[] as taught by Norfleet . . . allow[s] cable 42 deviation from aligned position at 58, figure 4, to a deviated position at the right side of figure 4.” (*See* Final Action 3.)

We do not find persuasive Appellant’s argument that the arrangement shown in Figure 4 of Norfleet would “prevent the lateral displacement from

occurring.” (See Appeal Br. 8.) Claim 9 recites “a deviation from the aligned position.” It is not limited to a lateral displacement. Appellant’s argument is not commensurate with the scope of the claim.

In view of the above, we are not persuaded that the Examiner erred in rejecting claim 9. Claim 18 falls with claim 9. See 37 C.F.R. § 41.37(c)(1)(iv).

Claim 20

Claim 20 recites: “The assembly of claim 19, further including a pair of fasteners for fixing the position of one of at least the first and second stationary guides.”

Appellant argues that “[t]he Examiner fails to address this claim in the Office Action, in violation of Section 132 of the Patent Act. Hence, reversal is in order.” (Appeal Br. 8.)

The Examiner determines that “[c]laims 1-7, 10-17, 19-20 is/are rejected under 35 U.S.C. 103 as being unpatentable over Rayburn, US 6,126,223 in view of Nguyen et al. or Ehret.” (Final Action 2, Answer 3.) The Examiner does not otherwise refer to claim 20 in either the Final Action or the Answer. We note that although claim 20 is similar to claim 3, the Examiner’s discussion of claim 3 does not include any reference to claim 20. (See Final Action 5, Answer 5.)

In view of the above, we will reverse the Examiner’s rejection of claim 20.

CONCLUSION

The Examiner's rejections of claims 1, 2, 5–7, and 9–19 under 35 U.S.C. § 103 are affirmed.

The Examiner's rejection of claims 3, 4, and 20 under 35 U.S.C. § 103 is reversed.

Pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a NEW GROUND OF REJECTION against claim 4 under 35 U.S.C § 103.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). Section 41.50(b) provides that, “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.” Section 41.50(b) further provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THIS 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.

Specifically:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed	New Ground
1-7, 10-17, 19, 20	103	Rayburn, Nguyen, Ehret	1, 2, 5-7, 10-17, 19	3, 4, 20	4
9, 18	103	Rayburn, Nguyen, Ehret, Norfleet	9, 18		
Overall Outcome			1, 2, 5-7, 9-19	3, 4, 20	4

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-IN-PART; 37 C.F.R. § 41.50(b)