

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 33

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND MARTIN

Appeal No. 2001-0025
Application No. 08/751,980

HEARD: APRIL 11, 2001

Before COHEN, McQUADE, and LAZARUS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 9 through 14 and 21 through 31. These claims constitute all of the claims remaining in the application.

Appellant's invention pertains to a brake disk for a vehicle brake. A basic understanding of the invention can be

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derived from a reading of exemplary claim 9, a copy of which appears in the appendix to the brief (Paper No. 28).

As evidence of obviousness, the examiner has applied the documents listed below:

Stehle	3,809,192	May 7, 1974
Goodyear (Great Britain)	1,433,090	Apr. 22, 1976
Oyano ¹ (Japan) ² (JP '237)	58[1983]-13237	Jan. 25, 1983

The following rejections are before us for review.

¹ The examiner refers to this document as JP '237, while appellant uses the first name of the inventor, i.e., Sadataka, to identify this reference. We shall refer to this Japanese reference as JP '237.

² Our understanding of this document is derived from a reading of a translation thereof prepared in the United States Patent and Trademark Office, which translation we refer to in the opinion set forth below. A copy of this translation is appended to this opinion. We are aware of a translation of this document provided by appellant (Paper No. 23).

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Claims 9 through 12 and 21 through 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over JP '237 in view of Goodyear.

Claims 13, 14, and 31 stand rejected under 35 U.S.C. § 103 as being unpatentable over JP '237 in view of Goodyear and Stehle.

The full text of the examiner's rejections and response to the argument presented by appellant appears in the office action dated September 2, 1998 and the answer (Paper Nos. 18 and 29), while the complete statement of appellant's argument can be found in the brief (Paper No. 28).

In the Grouping of Claims section of the brief (page 5), appellant groups the claims on appeal as follows. As to the first ground of rejection, claims 9 through 12 and 21 through 28 are indicated to stand or fall together, while claims 29 and 30 are considered to be separately patentable and do not stand or fall with the former claims. With respect to the second ground of rejection, appellant specifies that claims

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13, 14, and 31 stand or fall together. In light of the above, and consistent with 37 CFR 1.192(c)(7), we shall focus our attention, infra, exclusively upon selected claims 9, 29, and 13. The remaining claims shall respectively stand or fall with the claim selected from their group.

OPINION

In reaching our conclusion on the obviousness issues raised in this appeal, this panel of the board has carefully assessed appellant's specification and claims, the applied teachings,³ the declaration of inventor and appellant Roland

³ In our evaluation of the applied prior art, we have considered all of the disclosure of each document for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

(continued...)

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Martin (Paper No. 20), which declaration was executed December 16, 1998, and the respective argued points of view of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The rejection of claims 9 through 12
and claims 21 through 28

We sustain the rejection of claim 9. It follows that we likewise sustain the rejection of claims 10 through 12 and 21 through 28 since, as earlier indicated, these claims stand or fall with claim 9.

Claim 9 reads as follows.

A brake disk for a vehicle disk brake comprising a material selected from the carbon group and configured as an internally ventilated brake disk, including:

a pair of friction rings, and

³(...continued)

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a plurality of pins connecting the friction rings together, said friction rings being connected together only by said plurality of pins,

said pins each having a thickened center part serving to space the friction rings from one another and respective end parts secured in respective bores in the friction rings by a heating process.

It is worthy of noting at this point that in our obviousness evaluation of the content of claim 9, relative to the collective teachings of JP '237 and Goodyear, we have weighed declarant Martin's stated perceptions of the applied prior art as set forth in the declaration (paragraphs 8 through 12).

In applying the test for obviousness,⁴ we reach the conclusion it would have been obvious to one having ordinary

⁴ The test for obviousness is what the combined teachings of references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

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skill in the art, from a combined consideration of the applied teachings, to fabricate the two annular disks (rings) 8_A, 8_B of JP '237 (Figs. 1 through 3) from a carbon group material following the suggestion therefor that would have been derived from the teaching of Goodyear (page 2, lines 11 through 16). This conclusion is buttressed by the express disclosure in the JP '237 document itself of the alternative of "carbon fiber" for the two annular disks (translation, page 6, lines 7 and 8). As so modified, we appreciate the resulting brake disk plate of JP '237 as being responsive to the structure of the brake disk set forth in claim 9.

The argument advanced by appellant in the brief and the statements of declarant Martin simply do not persuade us that the examiner erred in rejecting claim 9 under 35 U.S.C. § 103.

Appellant argues (brief, page 6) that the examiner's understanding of the JP '327 is not correct in the assertion that the rings (disks) are connected only by way of pins (hollow rivets). As appellant sees it, the disks of JP '327 are connected together by "both hollow rivets 11 and legs 2-

6". We disagree with appellant's point of view. The JP '327 document (translation, page 3, lines 14, 15) makes it quite apparent to us that leg parts (2-6) are merely "sandwiched between" the annular disks (Fig. 2), while only hollow rivets⁵ structurally connect the disks(rings) together.

Responsive to appellant's and declarant's commentary regarding the Goodyear reference (brief, page 7), we simply point out that the Goodyear teaching was not relied upon by the examiner for a disclosure of a connection between friction rings "only" by a plurality of pins, as now claimed.

It is also asserted in the brief (pages 7 through 9) that there is no suggestion in the applied art for pins "secured in respective bores. . . by a heating process" as in claim 9. In the declaration (paragraphs 8, 10, and 12), declarant likewise addresses a lack of suggestion for securement by a heating process. The argument appears to be premised upon the view that the process limitation in article claim 9 is

⁵ In the declaration (paragraphs 8 and 12), declarant Martin references the rivets as "pins" or "bolts".

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determinative of the patentability of that claim. We do not share that viewpoint. The patentability of claim 9 must be predicated upon the structure of the claimed article and not the argued method by which the article may have been made. In other words, the determination of patentability in a product-by-process claim is based on the product itself, even though the claim may be limited and defined by the process. The product or article in such a claim is unpatentable if it is the same as or obvious from the product of the prior art, even if the prior product or article was made by a different process. See In re Thorpe, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985). With the above particularly in mind, we note that neither appellant nor declarant has pointed to any structural securement difference that would be perceived in the final disk brake product resulting from the broadly claimed "heating process" that would distinguish the secured pin and bore structure of the claimed brake disk from the secured pin and bore structure of JP '237, and we perceive none. Thus, the examiner's rejection of claim 9, in particular, under 35 U.S.C. § 103 is well founded.

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The rejection of claims 29 and 30

We reverse the rejection of claims 29 and 30.

In appellant's specification (page 2, line 22 to page 3, line 2), it is indicated that the combination of pocket bores and through-bores for accommodating the end parts of the distancing pieces (pins) is contemplated according to certain embodiments of the invention. Further, appellant teaches (specification, page 4) and shows this combination in detail in Figure 3.

Like the examiner (answer, page 5), we fully appreciate that the applied teachings reveal that pocket bores for isolation parts (Figures 10(b),(c),(d),(e),(f), and (g) of JP '327) and through-bores for hollow rivets (JP '327; Figure 3) were well known at the time of appellant's invention. However, the difficulty we have with the rejection of claim 29 (and claim 30) is that the evidence of obviousness before us would clearly not have been suggestive to one having ordinary skill in the art of using other than either all pocket bores

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or all through-bores for the respective hollow rivets and isolation parts. As such, we are constrained to reverse the rejection of claims 29 and 30.

The rejection of claims 13, 14, and 31

We sustain the rejection of claim 13. We also sustain the rejection of claims 14 and 31 since these claims stand or fall with claim 13 as mentioned above.

Claim 13 addresses "open through bores" interposed along radially extending channels between rows of pins.

As seen in appellant's Figs. 1 through 3, friction rings 2,3 have "through-bores 7" (specification, page 4, line 3). Fig. 2 shows a distribution of pins 30 with through-bores 7 therebetween.

From our perspective, it would have been obvious to one having ordinary skill in the art, at the time of appellant's invention, to provide the two annular disks of JP '327 with

through-bores (recesses) between the rows of rivets 11 (Fig. 1), following the teaching of Stehle. More specifically, it is clear to us that the incentive on the part of one having ordinary skill in the art for making the noted modification would have simply been to gain the recognized cooling benefit through-bores or recesses (Fig. 8) would provide, as discussed by Stehle (column 1, lines 44 through 47).

Appellant acknowledges that Stehle does illustrate through-bores, but faults the rejection as being hindsight based since Stehle does not include pins (brief, pages 10 and 11). Therefore, according to appellant, Stehle could not possibly suggest interposing through-bores in any particular location with respect to pins in an already ventilated disk such as in JP '327. For the reasons given above, we are not in accord with appellant's conclusion that the rejection is based upon impermissible hindsight. To reiterate the point made, the combined prior art teachings themselves clearly would have been suggestive of the addition of through-bores in the ventilated brake disk of JP '327 for cooling purposes.

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In summary, this panel of the board has sustained the rejection of claims 9 through 12 and 21 through 28 under 35 U.S.C. § 103 as being unpatentable over JP '237 in view of Goodyear, but has not sustained the rejection of claims 29 and 30 on the same statutory ground. Additionally, we have sustained the rejection of claims 13, 14, and 31 under 35 U.S.C. § 103 as being unpatentable over JP '237 in view of Goodyear and Stehle.

The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

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AFFIRMED-IN-PART

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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