

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YUICHI ONO, MITSUAKI HATORI,
and HIROSHI INOUE

Appeal No. 96-1835
Application 08/207,116¹

HEARD: DECEMBER 9, 1997

Before STONER, Chief Administrative Patent Judge, McQUADE and NASE, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

This appeal is from the final rejection of claims 1, 2, 14, 18 and 19, all of the claims pending in the application.

¹ Application for patent filed March 7, 1994. According to appellants, the application is a continuation of Application 08/007,486, filed January 22, 1993, now abandoned, which is a division of Application 07/750,480, filed August 27, 1991, now abandoned.

The invention relates to a fluid clutch. Claim 1 is illustrative and reads as follows:

1. A fluid clutch comprising a driving section, a rotation shaft rotatably driven by said driving section, a driving disc rigidly mounted to and rotationally driven by said rotational shaft, a casing in which said driving disc is incorporated and which is rotatably disposed around said rotational shaft as a center of rotation, such that a torque transmission gap is defined between said driving disc and the casing, and an oil filled in the torque transmission gap defined between said driving disc and the casing for transmitting a driving torque from said driving disc to said casing, wherein

a non-rotatable oil supply pipe communicates from a location external of the casing into the casing and wherein an oil supply means is non-rotatably mounted to the portion of the oil supply pipe external of the casing for selectively supplying and returning said oil between the outside and the inside of said casing and for selectively increasing and decreasing the driving torque transmitted from the driving disc to the casing, said casing further including at least one breather extending through said casing between the torque transmission gap and atmospheric air for releasing gas from said torque transmission chamber when pressure in said torque transmission chamber exceeds a predetermined upper limit value and for enabling inflow of atmospheric air to said torque transmission chamber when pressure in the torque transmission chamber is less than a predetermined lower limit value.

Claims 1, 2, 14, 18 and 19 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which purportedly fails "to provide an adequate written description of the invention" (answer, mailed June 13, 1995, page 3).² The

² In the final rejection, claims 1, 2, 14, 18 and 19 were also rejected under 35 U.S.C. § 103. The examiner has since withdrawn all such prior art rejections (see the advisory action dated April 19, 1995).

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examiner explains that

[t]he description is insufficient in regard to the structure of the breather. What material is the breather formed of? Is it formed from cork, cotton, or perhaps a specific type of synthetic material? Is there a presently preferred embodiment of the breather which permits only gas to escape from the torque transmission chamber when the pressure in the chamber exceeds an upper limit value while preventing fluid from leaking therefrom, but which also allows air from outside the clutch to pass into the torque transmission chamber when the pressure therein is below a predetermined lower limit? [answer, page 3]

As indicated above, independent claim 1 recites a fluid clutch comprising, inter alia,

at least one breather extending through said casing between the torque transmission gap and atmospheric air for releasing gas from said torque transmission chamber when pressure in said torque transmission chamber exceeds a predetermined upper limit value and for enabling inflow of atmospheric air to said torque transmission chamber when pressure in the torque transmission chamber is less than a predetermined lower limit value.

Claims 2 and 14, the other independent claims on appeal, contain like recitations of the "at least one breather."

The examiner's explanation of the rejection indicates that the issue on appeal is whether the appellants' specification complies with the enablement requirement of 35 U.S.C. § 112, first paragraph, with regard to the claimed fluid clutch having the at least one breather. The breather is described on page 20 of the appellants' specification as follows:

[a] breather 30 is disposed passing through the casing 4 in the torque transmission chamber 7. The breather 30 is adapted such that when the pressure in the torque transmission chamber 7 increases in excess of a predetermined upper limit value, only the gas in the torque transmission chamber 7 is released through the breather 30 out of the casing 4, and such that when the pressure in the torque transmission chamber 7 is lower[ed] to less than the predetermined lower limit value, atmospheric air flows through the breather 30 into the torque transmission chamber 7.

To support their position that the specification does comply with the enablement requirement, the appellants have made of record and relied upon a number of references which disclose various breather structures in assorted devices such as valves, engines and pumps (see pages 4 through 11 in the main brief filed on May 22, 1995³). According to the examiner, however,

[w]hile there is no doubt that the prior art shows that breathers and filters made from metal, plastic and numerous other materials are commonly used in many different environments, none show[s] a breather mounted on a rotatable housing where it would be subjected not only to the pressure of the fluid in the housing but also the effects of centrifugal forces acting thereon.

The examiner therefore submits that none of the prior art of record provides any evidence that one

³ It is noted, however, that not all of the references cited in the brief have publication dates early enough to support the appellants' position. It is also noted that the appellants filed a reply brief on July 3, 1995 in response to the examiner's answer, and that the examiner refused entry of same (see the advisory action dated August 7, 1995). Accordingly, we have not considered the arguments advanced in the reply brief in assessing the merits of the appealed rejection.

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skilled in the clutch art even with the assistance of one skilled in the breather art could, without undue experimentation, select a suitable breather for use in conjunction with a rotatable housing of a fluid clutch which would prevent fluid from escaping while allowing gas to escape and air to enter [answer, page 7].

The test for compliance with the enablement requirement is whether the appellants' disclosure, considering the level of ordinary skill in the art as of the date of the appellants' application, would have enabled a person of such skill to make and use the appellants' invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). The specification need describe the invention only in such detail as to enable a person skilled in the most relevant art to make and use it. When an invention, in its different aspects, involves distinct art, that specification is adequate which enables the adepts of each art, those who have the best chance of being enabled, to carry out the aspect proper to their specialty. In re Naquin, 398 F.2d 863, 866, 158 USPQ 317, 319 (CCPA 1968).

As essentially conceded by the examiner, the reference evidence relied upon by the appellants establishes that breather structures of the sort disclosed by the appellants were widely used in the mechanical arts at the time of the appellants' application to allow the passage of gases but not of liquids.

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The appellants' evidence also shows that such breather structures are rather simple and straightforward mechanisms. Although the appellants have not disclosed any specific breather material for use in their fluid clutch, it is not apparent, nor has the examiner cogently explained, why one of ordinary skill in the clutch art, given the widespread application of breather structures demonstrated by the appellants' evidence, would not have been able to make and use without undue experimentation a fluid clutch having at least one breather as recited in the appealed claims. To the extent that the breather art is distinct from the clutch art, it is also not apparent why one of ordinary skill in the breather art would not have been able to design such a breather without undue experimentation. While the appellants' evidence does not disclose a breather for use in the specific environment set forth in the appealed claims, i.e., a fluid clutch, this evidence taken as a whole indicates that breathers are relatively uncomplicated devices which are used in a number of diverse environments. In this light, the construction without undue experimentation of a breather suitable for use in a fluid clutch as recited in the appealed claims would appear to have been well within the level of ordinary skill in the art, be it the clutch art or the breather art, at the time of the

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appellants' application.

Accordingly, we shall not sustain the standing 35 U.S.C.
§ 112, first paragraph, rejection of claims 1, 2, 14, 18 and 19.

The decision of the examiner is reversed.

REVERSED

BRUCE H. STONER, JR.)	
Chief Administrative Patent Judge)	
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)	
JOHN P. McQUADE)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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