

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. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND MARTIN

Appeal No. 1999-1057
Application No. 08/848,719

HEARD: OCTOBER 25, 2000

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 2, 5, 7, 9, 10, 12 through 16, and 18 through 20. These claims constitute all of the claims remaining in the application.

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

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derived from a reading of exemplary claims 18 and 19. Since the copies of claims 18 and 19 in the brief are not accurate copies of those claims, we rely upon the actual claims in the file, as amended (Paper Nos. 3 and 5).

As evidence of obviousness, the examiner has applied the documents listed below:¹

Buyze	3,486,218	Dec. 30, 1969
Stehle	3,809,192	May 7, 1974
Moore et al	4,263,992	Apr. 28, 1981
(Moore)		
Fisher et al	4,742,948	May 10, 1988
(Fisher)		
Tait et al	2,228,053	Aug. 15, 1990
(Tait)(Great Britain)		

¹ On page 2 of the answer, a patent to Gassiat is listed. Since none of the examiner's rejections rely upon this document, it appears to us that its inclusion was inadvertent and in error. Thus, no further comment will be made relative thereto.

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The following rejections are before us for review.

Claims 18 through 20, 15, and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Tait.

Claims 2 and 5² stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait in view of Buyze.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait in view of Fisher.

Claims 9, 10, and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait in view of Moore.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Tait in view of Stehle.

² In the answer (page 4), the inclusion of claim 4 in the statement of this rejection is clearly in error since claim 4 was earlier canceled.

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The full text of the examiner's rejections and response to the argument presented by appellant appears in the main answer (Paper No. 10), while the complete statement of appellant's argument can be found in the brief (Paper No. 9).

OPINION

This panel of the board has carefully considered appellant's specification and claims,³ the declaration of Roland Martin dated February 27, 1998, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

³ This appeal was taken from the final rejection of claim 12, inter alia; the summary cover sheet of the final rejection (Paper No. 7) indicates that claim 12 was rejected. However, the rejections set forth in the final rejection (as well the rejections set forth in the first office action of November 19, 1997, for that matter) do not include claim 12. Thus, a rejection of claim 12 is not before us. The status of claim 12 should be clarified by the examiner.

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We procedurally reverse each of the rejections on appeal for the reasons articulated below.

Claim 18 is drawn to a method of making a brake disk for a motor vehicle, comprising, inter alia, discrete ribs unreleasably connecting two individual friction rings (from a material selected from the carbon group) with each other in a form-locking and force-locking manner to form the brake disk with internal ventilation.

Claim 19 sets forth a disk for a vehicle disk brake, comprising, inter alia, generally radially extending ribs for form-lockingly force-lockingly connecting individual carbon friction rings with each other and configured to form air ducts for internal ventilation.

We are unable to comprehend the meaning of the language "in a form-locking and force-locking manner" (claim 18) and "form-lockingly force-lockingly" (claim 19) in the context in which each recitation is used in the respective claims. Each of these recitations does not appear in the original

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disclosure.⁴ Further, when the referenced language of each claim is read in light of the overall disclosure, we conclude that a reasonably definite meaning therefor cannot be ascertained. As such, it is our view that these recitations render the claimed subject matter indefinite under 35 U.S.C. § 112, second paragraph. We enter a NEW GROUND OF REJECTION, infra, addressing this matter.

To assess the noted indefinite claimed subject matter relative to the prior art applied in the examiner's respective rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) would require considerable speculation and assumptions on our part as to what in fact is being claimed. Since rejections on prior art cannot be based on speculation and assumptions, we are constrained to procedurally reverse each of the examiner's rejections on appeal. See In re Steele, 305 F.2d 859, 862-63, 134 USPQ 292, 295-96 (CCPA 1962) and In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Being a

⁴ The Martin declaration of February 27, 1998 uses the language "form fitting" and "force fitting" (paragraph 8), "form-locking" and "force-locking" (paragraph 13), and "form-locking and/or force-locking" (paragraph 14).

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procedural reversal, it should be abundantly clear that the merit of each appealed rejection has not been assessed.

NEW GROUND OF REJECTION

Under the authority of 37 CFR 1.196(b), this panel of the Board enters the following new ground of rejection.

Claims 2, 5, 7, 9, 10, 12 through 16, and 18 through 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite in meaning. We incorporate herein our analysis above of claims 18 and 19 as to particular language therein for which no definite meaning can be attributed based upon appellant's underlying disclosure.

At such time that the claimed subject matter is definite in meaning, prior art may then be appropriately applied by the examiner.⁵

⁵ As to claims 18 and 19, for example, it is apparent to us that the examiner should assess the patentability thereof under 35 U.S.C. § 103 based upon the combined teachings of
(continued...)

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In summary, this panel of the board has procedurally reversed each of the examiner's rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a). Additionally, we have entered a NEW GROUND OF REJECTION in accordance with 37 CFR 1.196(b).

⁵(...continued)
Buyze and Tait. Together, these references reveal the knowledge in the brake disk art of the alternatives of a more permanent connection (welding, brazing, adhesives) for assembling separately fabricated components of a disk brake (Buyze) and of a less permanent connection (bolts and rivets) for assembling separately fabricated components of a brake disc (Tait). Considering the overall knowledge in the art reflected by the Buyze and Tait references, the examiner should evaluate, for example, whether it would have been obvious to one having ordinary skill in the art to replace the individual brake plates 12 of Buyze with a pair of individual carbon-carbon annular friction facings 12, 13, as disclosed by Tait.

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The decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b) (amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. and Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides that "a new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new grounds of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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

REVERSED; 37 CFR 1.196(b)

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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)	
RICHARD B. LAZARUS)	
Administrative Patent Judge)	

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APPLICATION NO. 08/848,719

APJ COHEN

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DECISION:

Prepared By:

DRAFT TYPED: 20 Dec 01

FINAL TYPED: