

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. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID C. HEIDENREICH and THOMAS L. RICHARDS

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Appeal No. 1999-1065  
Application No. 08/754,379

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ON BRIEF

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Before FRANKFORT, NASE and GONZALES, Administrative Patent Judges.

GONZALES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 21 through 27 and 30 through 34, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a friction wear pad for a caliper disk brake. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Roth 1966	3,269,489	Aug. 30,
Chin et al. (Chin) 1981	4,276,969	Jul. 07,
Everett 1986	4,611,692	Sep. 16,

Claims 21 through 24, 30 and 31 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Everett.<sup>1</sup>

Claims 25 through 27 and 32 through 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Everett in view of Roth or Chin.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 11) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 10) for the appellants' arguments thereagainst.

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<sup>1</sup> Claims 30 and 31 are duplicates of claims 22 and 23, respectively, because claims 30 and 31 were amended to depend on claim 21 in the amendment of June 30, 1997 (Paper No. 6). In the event that these claims are held to be allowable, see Manual of Patent Examining Procedure (MPEP) § 706.03(k) (7th ed., rev. 1, Feb. 2000).

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OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

The § 102(b) rejection

We will not sustain the 35 U.S.C. § 102(b) rejection of claims 21 through 24, 30 and 31.

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. See Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984).

Claim 21 reads as follows:

A friction wear pad for a caliper disk brake, comprising:  
an elongated substantially elliptical body portion having a pair of orthogonal axes; semi-circular radiused end portions extending from and interrupting said substantially elliptical body portion at diametrically opposed ends of one of said orthogonal axes; and

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wherein said wear pad is symmetrical about each of said pair of orthogonal axes.

We agree with the appellants' argument (brief, p. 4) that the claimed friction wear pad comprising an elongated substantially elliptical body portion having a pair of orthogonal axes with semi-circular radiused end portions is not found in Everett. In the answer (p. 3), the examiner determined that the brake shoe member 10 in Figure 1 of Everett was "generally shaped in the form of an ovoid or ellipse as broadly recited in the instant claims." We do not agree. It is our view that Everett does not expressly or inherently describe the friction wear pad as comprising an elongated substantially elliptical body portion. The examiner relies on Figure 1 of Everett. We note, however, that Everett describes Figure 1 as a "perspective view" (col. 2, line 24). As such, we cannot say with the necessary degree of certainty that the body portion extending between the opposite curved ends of shoe member 10 is elliptical. We must resort to speculation in order to determine if Everett actually teaches that the body portion is elliptical and we cannot support a finding that Everett expressly or inherently describes each

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and every element of the claim on such speculation. Thus, the rejection under § 102 cannot be sustained.

Since all the limitations of claim 21 and of claims 22 through 24, 30 and 31, which are dependent on claim 21, are not disclosed in Everett, we will not sustain the examiner's rejection of claims 21 through 24, 30 and 31 under 35 U.S.C. § 102(b).

The § 103(a) rejection

We will not sustain the rejection of claims 25 through 27 and 32 through 34 under 35 U.S.C. § 103(a) over Everett in view of Roth or Chin.

In rejecting claims under 35 U.S.C. § 103 the examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. Id. If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In order to

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establish the prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

Independent claim 25 calls for a friction wear pad for a caliper disk brake including, inter alia, an elongated body portion formed from a pair of wear pad halves with each half having a pair of partial depth bores therein and a pin disposed in each bore to join the halves together. Similar language is found in claim 32, dependent on claim 21.

The examiner determined that Everett discloses the invention substantially as claimed in claims 25 and 32, except for "the use of a pair of pads sandwiched together by the use of a pin." See answer, p. 3.<sup>2</sup> The examiner describes each of Roth and Chin as teaching "a brake wear pad comprising a pair of wear halves joined together by the use of a pin." Id. The examiner then concluded that it would have been obvious to make the brake pad of Everett of a pair of wear halves joined

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<sup>2</sup> We note that claims 25 and 32 also require a pair of wear pad halves with each half having a pair of partial depth bores therein. The examiner has not identified where the pair of partial depth bores is taught in the applied prior art.

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together by a pin as taught by Roth and Chin, "since the use of a brake made of at least two or more portions provides for optimum wear and use of the brake material." Id. at 3, 4.

The appellants argue that a person of ordinary skill in the art would not have arrived at the claim invention based on the combined teachings of the applied prior art, except by the use of impermissible hindsight. See brief, p. 4.

We agree.

In our view, the only suggestion for modifying the bicycle brake of Everett in the manner proposed by the examiner to meet the limitations of claims 25 and 32 stems from hindsight knowledge derived from the appellants' own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It follows that we cannot sustain the examiner's rejection of claims 25 and 32 or of claims 26, 27, 33 and 34, dependent thereon.

#### CONCLUSION

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To summarize, the decision of the examiner to reject claims 21 through 24, 30 and 31 under 35 U.S.C. § 102(b) is reversed.

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The decision of the examiner to reject claims 25 through  
27 and 32 through 34 under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT	)	
Administrative Patent Judge	)	
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	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
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JOHN F. GONZALES	)	
Administrative Patent Judge	)	

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