

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(2) is not binding precedent of the Board.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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SEIJI NAKATANI
and
MICHIHARU YOKOI

Appeal No. 97-2645
Application 08/448,638¹

HEARD: July 14, 1999

Before CALVERT, FRANKFORT and SCHAFER, Administrative Patent
Judges.

¹ Application for patent filed May 23, 1995.

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FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1, 2 and 6 through 8. Claims 3, 4, 5, 9 and 10, the only other claims remaining in the application, stand allowed.

Appellants' invention relates to a pressure plate for use in a friction clutch. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim may be found in Appendix A of appellants' brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Japanese Patent Publication No. 1-210620
1989

Aug. 24,

(Japanese '620)

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Claims 1, 2 and 6 through 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japanese '620.²

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper No. 12, mailed February 21, 1997) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 11, filed November 20, 1996) for appellants' arguments there-against.

OPINION

² As for the four references cited by the examiner on page 3 of the answer as being "considered pertinent to applicant's [sic] invention because each reference discloses a pressure plate made from multiple pieces," we note that these patents have not been set forth in the statement of any § 102 or § 103 rejection before us on appeal and therefore form no part of the issues presently before us for review. As pointed out by the Court in In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970), where a reference is relied upon to support a rejection, whether or not in a minor capacity, there would appear to be no excuse for not positively including the reference in the statement of the rejection.

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In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the examiner's rejection will not be sustained. Our reasons follow.

Even if, as has been urged by the examiner, it would have been obvious to one of ordinary skill in the art to make the one-piece, unitary pressure plate (1) of Japanese '620 in multiple pieces, we share appellants' view (brief, pages 17-18) that there is no teaching, suggestion or incentive in the applied Japanese reference, or otherwise specified by the examiner, which would have led one of ordinary skill in the art to modify the pressure plate of Japanese '620 to be in the particular multi-piece form specified in claim 1 on appeal.

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Appellants' claim 1 requires that the pressure plate therein be comprised of a ring-shaped first plate having a friction surface for frictionally contacting a clutch disc and "a plurality of fan-shaped second plates circumferentially disposed with respect to said first plate," with each respective fan-shaped second plate having at least one support portion that is formed integrally with the second plate. The prior art relied upon by the examiner is completely devoid of any teaching or suggestion regarding the problems confronted and solved by appellants and is utterly silent concerning any possible modifications to the conventional one-piece pressure plate seen therein, let alone any modifications of such a one-piece pressure plate that would have

resulted in the particular multi-piece pressure plate claimed by appellants.

In our opinion, the examiner's position in this case is clearly based on impermissible hindsight gained only from appellants' disclosure, and for that reason will not be sus-

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tained. The decision of the examiner is, accordingly, re-
versed.

REVERSED

	IAN A. CALVERT)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	CHARLES E. FRANKFORT)	APPEALS AND
	Administrative Patent Judge)	INTERFER-
ENCES)	
)	
)	
	RICHARD E. SCHAFER)	
	Administrative Patent Judge)	

CEF:psb

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