

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN KREMSMAIR and GERHARD HARTNER

Appeal No. 1999-0721
Application No. 08/683,826

ON BRIEF

Before ABRAMS, FRANKFORT and McQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 5 through 8, which are all of the claims remaining in this application.¹ Claims 1 through 4 have been

¹ A minor amendment to claim 5 was made subsequent to the final rejection in a paper filed March 18, 1998 (Paper No. 10).

Appeal No. 1999-0721
Application No. 08/683,826

anceled.

Appellants' invention is directed to a method of manufacturing a flat friction ring. Claim 5 is representative of the subject matter on appeal and a copy of that claim appears in the Appendix to appellants' brief.

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

Taylor	2,037,440	Apr. 14, 1936
Winter	2,046,988	Jul. 07, 1936
Nels	4,260,047	Apr. 07,
1981		
Bauer	4,878,282	Nov. 07, 1989

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer in view of Taylor or Winter.

Claims 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bauer in view of Taylor or Winter as applied above and further in view of Nels.

Reference is made to the examiner's answer (Paper No. 14,

Appeal No. 1999-0721
Application No. 08/683,826

mailed July 7, 1998) for the examiner's reasoning in support of the above-noted rejections and to the appeal brief (Paper No. 13, filed June 10, 1998) for appellants' arguments thereagainst.

OPINION

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellants' specification and claims, the applied prior art references, and the respective positions advanced by appellants and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejections of the appealed claims under 35 U.S.C. § 103(a) are not well founded and, therefore, will not be sustained.

Turning first to the examiner's rejection of claims 5 and 6 as being unpatentable over Bauer in view of Taylor or Winters, we note that Bauer discloses a flat friction ring including a supporting ring (1) and a friction lining (3) on at least one side of the supporting ring, with the friction

Appeal No. 1999-0721
Application No. 08/683,826

lining defining approximately radial oil grooves (4). As recognized by the examiner, the friction lining (3) of Bauer is in the form of a single continuous ring of friction material that is glued onto the supporting ring (1) and which includes at least one rim of lining material (e.g., 8) that is used to maintain the position of the individual parts (e.g., 7) of the friction lining (3) upon application thereof to the supporting ring (1). The at least one rim (8), seen in Figure 3, is removed only after the friction lining (3) is applied to the supporting ring (1). Thus, the method of manufacturing the flat friction ring of Bauer is entirely different than that set forth in appellants' claims before us on appeal.

Noting the clear differences between appellants' method in claims 5 and 6 on appeal and that taught in Bauer, the examiner turns to the teachings of either Taylor or Winter which relate to the manufacture of non-metallic gears or pulleys by using a continuous strip of fabric, paper, felt or the like that is impregnated or coated with a suitable binder

Appeal No. 1999-0721
Application No. 08/683,826

and helically wound into a stack, with certain parts of the strip overlapping one another in the stack to ultimately form a thickened rim, comparatively thin web portions and a thick hub for the gear or pulley when the stack is subjected to heat and pressure in a mold (see, for example, Fig. 4 of Taylor and Fig. 3 of Winter). According to the examiner, it would have been obvious to one of ordinary skill in the art

to have provided in Bauer that the continuous strip making up lining 3 is formed by cutting the strip as a straight strip with slits 4 extending from one side, not in ringed form, where this strip is then bent at the connecting webs about axes extending perpendicu-larly to the plane until the sectors form a polygon producing an annular friction lining because Taylor, and in the alternative Winter, teach that it is well-known to form a ringed structure in this manner and it is obvious to replace one means for providing the ringed structure (i.e., that of Bauer) with an art recognized alternative means for providing a ringed structure (i.e., that of Taylor or Winter).

Like appellants, we are of the view that the patents to Taylor and Winter regarding the formation of gears and pulleys are non-analogous to the art area relating to forming of flat friction rings as in Bauer and appellants' claimed subject matter. Moreover, it is our opinion that the examiner has used the claimed invention as a blueprint to piece together the

Appeal No. 1999-0721
Application No. 08/683,826

various unrelated and disparate teachings of the Bauer and Taylor or Winter patents in an attempt to arrive at the claimed subject matter. In this regard, we consider that the examiner's proposed modifications of the particular method of forming the flat friction ring structure of Bauer in view of either of the methods disclosed in Taylor or Winter for making a gear or pulley are based on hindsight reconstruction of the claimed subject matter using appellants' own teachings and disclosure. In addition, we note that the examiner's proposed modification of Bauer, i.e., by eliminating the connecting rims (8) of Bauer in favor of the strips seen in Taylor or Winter, would destroy the capability of the Bauer reference to form a flat friction ring like that seen in Figure 2 of Bauer where there are continuous oil grooves (4) that are open at both ends. As for the examiner's treatment of claim 6 on appeal, we are in agreement with appellant's arguments set forth in the paragraph bridging pages 13-14 of the brief.

Appeal No. 1999-0721
Application No. 08/683,826

For the above reasons, we refuse to sustain the examiner's rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Bauer in view of Taylor or Winter.

Nor shall we sustain the examiner's other rejection under 35 U.S.C. § 103(a). We have carefully reviewed the patent to Nels applied by the examiner in the rejection of dependent claims 7 and 8, but find nothing therein which would provide for the teachings and/or suggestions which we have already determined to be lacking in the examiner's stated basic combination of Bauer and Taylor or Winter.

In regard to the examiner's attempted combination of Bauer and Taylor or Winter, we note that it is well settled that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation,

Appeal No. 1999-0721
Application No. 08/683,826

the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). cert. denied, 389 U.S. 1057 (1968).

As should be apparent from the foregoing, we have refused to sustain either of the rejections before us on appeal. Thus the decision of the examiner rejecting claims 5 through 8 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	
)	BOARD OF PATENT
CHARLES E. FRANKFORT)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
JOHN P. McQUADE)	
Administrative Patent Judge)	

Appeal No. 1999-0721
Application No. 08/683,826

Kurt Kelman
Collard & Roe
1077 Northern Boulevard
Roslyn, NY 11576

cef/vsh