

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEF SCHNEID

Appeal No. 2001-1405
Application No. 09/207,766

HEARD: September 13, 2001

Before CALVERT, COHEN, and NASE, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 to 3, 10 to 22, 27 to 30 and 32. The other claims in the application, 4 to 9, 23 to 26, 31 and 33 to 40, stand withdrawn from consideration under 37 CFR §1.142(b) as being directed to nonelected inventions.

The claims on appeal are drawn to a process for production of fittings, and are reproduced in the appendix of appellant's brief.

The prior art applied in the rejection before us is:

Tillenburg discloses a method for producing a brake pad for a disc brake which will dampen or absorb vibration. The carrier plate 1 is made of two metal parts 2, 3 which have a resilient bonding and dampening material 4 interposed between them, the friction lining 5 of the brake pad being attached to part 3. The bonding material 4 between parts 2 and 3 is "slightly compressible, vibration-dampening, heat-insulating, elastic and non-swelling" (col. 4, lines 18 and 19), and may be cyclized rubber (col. 4, lines 34 and 35) or other rubber related materials (col. 5, lines 9 to 17).

The examiner takes the position that (answer, page 5):

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided the invention of [AAPA-1] with the steps of placing an elastic bonding material between contact surfaces of the at least one base and the at least one fibrous material processing element and elastically bonding the at least one base and the at least one fibrous material processing element, in light of the teachings of Tillenburg, in order to reduce vibration between the fibrous material processing element and the base.

Appellant argues on pages 7 to 9 of the reply brief that Tillenburg constitutes nonanalogous art. However, under the view we take of this case, it is unnecessary to decide this issue, and we will assume for the purpose of argument that it is analogous art.

While we appreciate the examiner's position, we do not consider the rejection of claim 1 to be well taken. The examiner contends that if one of ordinary skill were faced with the problem of reducing vibration between a base and a fibrous material

processing element, that person would look to plural (other) technologies, not just the fibrous material processing element art, in order to determine how to reduce vibration (answer, page 11). While this may be so, however, we do not consider that one of ordinary skill would derive from Tillenburg a teaching or suggestion to elastically bond the separate parts, i.e., the base and processing element(s), of a fitting for mechanical processing of fibrous material as disclosed by AAPA-1. As appellant notes at pages 5 to 7 of the reply brief, Tillenburg discloses resiliently bonding two parts (2 and 3) of a carrier (base) member, on which the friction material 5 is mounted, rather than between the carrier and the friction material carried thereon. Thus, we do not perceive any teaching in Tillenburg to resiliently (elastically) bond the processing element(s) to the base in the AAPA-1 fitting. Any such modification of AAPA-1 would appear to be based on impermissible hindsight derived from appellant's own disclosure.

We therefore conclude that claim 1 is unobvious over the combination of AAPA-1 and Tillenburg. The other claims on appeal, being dependent on claim 1, are likewise unobvious.³

Conclusion

³ At the oral hearing, we pointed out to appellant's counsel that the relationship of the step recited in claim 10 to parent claim 1 was not clear, and that the meaning of the recitation "the remaining gap . . . the elastic bonding material" in claim 20 was not apparent. These matters should be attended to upon return of the application to the examiner.

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The examiner's decision to reject claims 1 to 3, 10 to 22, 27 to 30 and 32 is reversed.

REVERSED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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