

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHINICHI TAKIZAWA and YUZURU UCHIYAMA

Appeal No. 2006-0020
Application No. 09/984,009

HEARD: JANUARY 12, 2006

Before McQUADE, CRAWFORD and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13-17, 19, 23-25, 28-32 and 34, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a bicycle disc brake assembly comprising a bicycle frame portion, a bicycle disc brake caliper housing being removably coupled to the frame portion by fasteners, and at least one metal shim mounted between the bicycle frame portion and the disc brake caliper housing. Independent claims 13 and 28 are representative of the invention and are reproduced in the appendix to the appellants' brief.

The Evidence

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

Hoh et al. (Hoh)	4,232,068	Nov. 4, 1980
Lee	5,316,061	May 31, 1994

Shimano DEORE XT Disc Brake System (Service Instructions SI-8180D)(March 2000)
(Shimano)

McMaster-Carr Supply Co., Catalog 102, p. 2843 (McMaster)

The Rejections

The following rejections are before us for review.¹

Claims 13, 14, 16, 17, 19, 23-25, 28, 29, 31, 32 and 34 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimano in view of McMaster and Lee.

Claims 15 and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shimano in view of McMaster, Lee and Hoh.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer and response to reply brief for the examiner's complete reasoning in support of the rejections and to the brief (filed June 1, 2005) and reply brief (filed August 10, 2005) for the appellants' arguments thereagainst.

OPINION

¹ Page 2 of the examiner's response to appellants' reply brief (mailed September 1, 2005) explains inadvertent errors in the examiner's final rejection and answer (mailed July 15, 2005) and clarifies the evidence relied upon in the rejections.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims², to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. For the reasons which follow, we cannot sustain the examiner's rejections.

Each of appellants' independent claims 13 and 28 recites the limitation "each of said shim sections having a maximum transverse width that is smaller than said maximum predetermined width of said fastener opening as measured in a direction parallel to said predetermined minimum width of said open end of said fastener opening." None of the references relied upon by the examiner in rejecting the claims on appeal teaches or suggests a shim having such a dimensional relationship.

² Upon return of this application to the Technology Center, the examiner should consider whether the subject matter of claims 16, 17, 19, 31, 32 and 34 has written description support, as required under the first paragraph of 35 U.S.C. § 112, in the application as originally filed. Specifically, independent claims 13 and 28, and hence all of the claims depending therefrom, are directed to the second shim embodiment (Figures 11 and 12) and not to the first embodiment (Figures 8 and 9). The features of dependent claims 16, 17, 19, 31, 32 and 34 relate to the third shim embodiment (Figures 13 and 14), which is described as being identical to the first embodiment except that the shim includes a handle portion including indicia that acts as an indicator of the thickness of the shim (specification, page 14). There does not appear to be any indication in the original disclosure that the indicator features of the third embodiment are to be employed with a shim according to the second embodiment.

In rejecting the claims, the examiner has opined that there is no criticality to the above-noted limitation and simply dismissed it as a matter of design choice (answer, page 6). This approach, of course, is wholly inappropriate. It is elementary that to support an obviousness rejection, all of the claim limitations must be taught or suggested by the prior art applied (see In re Royka, 490 F.2d 981, 984-85, 180 USPQ 580, 582-83 (CCPA 1974)) and that all words in a claim must be considered in judging the patentability of that claim against the prior art (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)).

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although the suggestion more often comes from the teachings of the pertinent references. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing

alone, are not "evidence." In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In light of the above, the rejections of claims 13, 14, 16, 17, 19, 23-25, 28, 29, 31, 32 and 34 as being unpatentable over Shimano in view of McMaster and Lee and claims 15 and 30 as being unpatentable over Shimano in view of McMaster, Lee and Hoh are reversed.

CONCLUSION

To summarize, the decision of the examiner is reversed.

REVERSED

JOHN P. McQUADE)
Administrative Patent Judge)
)
)
)
)
)
MURRIEL E. CRAWFORD) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
)
)
)
JENNIFER D. BAHR)
Administrative Patent Judge)

Shinju Global IP Counselors, LLP
1233 20th Street, NW Suite 700
Washington, DC 20036-2680

Comment [jvn1]: Type address