

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. 43

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANN JACKEL and WOLFGANG REIK

Appeal No. 1999-1484
Application No. 07/963,109

ON BRIEF

Before COHEN, McQUADE, and NASE, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 57 through 87, 89, 99 through 101, 103, 109, and 111 through 128. These claims constitute all of the claims remaining in the application.

Appellants' invention pertains to an apparatus for damping vibrations between an engine and a clutch in a power train, to an apparatus for damping vibrations, and to an apparatus for damping torsional vibrations. A basic understanding of the invention can

Appeal No. 1999-1484
Application No. 07/963,109

be derived from a reading of exemplary claims 57, 111, and 120, respective copies of which appear in the APPENDIX to the brief (Paper No. 41).

In support of a rejection under 35 U.S.C. § 102(f), the examiner has referenced the document specified below:

Freidmann et al	5,242,328	Sep. 7, 1993
(Freidmann and Zapf)	(filed Apr. 24, 1990, a continuation of Ser. No. 69,525, filed July 2, 1987) ¹	

The following rejection is the sole rejection before us for review.

Claims 57 through 87, 89, 99 through 101, 103, 109, and 111 through 128 stand rejected under 35 U.S.C. § 102(f) for the reason that appellants did not invent the claimed subject matter.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper

¹ The effective filing date of the present application is likewise July 2, 1987. Further, the Freidmann and Zapf patent and the present application reference the same foreign priority documents.

Appeal No. 1999-1484
Application No. 07/963,109

No. 42), while the complete statement of appellants' argument can be found in the brief (Paper No. 41).

OPINION

In reaching our conclusion on the issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claims, the patent to Freidmann and Zapf, and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We do not sustain the rejection of appellants' claims under 35 U.S.C. § 102(f).

According to 35 U.S.C. § 102(f), a person shall be entitled to a patent unless he did not invent the subject matter sought to be patented.

The examiner relies upon Fig. 1 of the patent to Freidmann and Zapf in concluding that appellants Jackel and Reik did not invent the subject matter now sought to be patented. It is

Appeal No. 1999-1484
Application No. 07/963,109

noteworthy that the record reveals that the patentees and the appellants are assignors to LUK Lamellen and Kupplungsbau and that, as set forth in the brief, appellants work at times "in close cooperation with other inventors, such as the inventors of the Freidmann patent" (brief, page 12). A terminal disclaimer (Paper No. 24) is present in the application file disclaiming the terminal part of any patent that would extend beyond the expiration date of the full statutory term of U.S. Patent No. 5,242,328, i.e., the patent to Freidmann and Zapf, at issue.

The issued patent to Freidmann and Zapf must include, of course, an oath, consonant with 35 U.S.C. § 115, as to the belief that they are the original and first inventors of the subject matter for which a patent is solicited, i.e., their claimed invention. Similarly, the oath of appellants Jackel and Reik in the instant application comports with 35 U.S.C. § 115 as to their now claimed subject matter, which as pointed out by appellants in the brief differs from the invention claimed by Freidmann and Zapf. In the current circumstance, strong evidence is required to reach the contrary conclusion that Jackel and Reik are not the inventors of the now claimed invention. See Ex parte Kusko, 215 USPQ 972, 974 (Bd. App. 1981).

Appeal No. 1999-1484
Application No. 07/963,109

As MPEP Section 706.02(g) points out, an examiner should presume proper inventorship unless there is proof that another or others made the invention and that an inventor(s) derived the invention from the true inventor(s). In the present case, and contrary to the view of the examiner (answer, pages 3 and 5), it is quite apparent to this panel of the Board that the showing in Fig. 1 of the Freidmann and Zapf patent, in and of itself, fails to provide the requisite proof that the now claimed invention, broad or otherwise, was in fact made by patentees Freidmann and Zapf, and that appellants' Jackel and Reik derived the invention from the latter inventors. Lacking the noted proof, the rejection under 35 U.S.C. § 102(f) is not sound and cannot be sustained.

In summary, this panel of the board has not sustained the rejection on appeal.

Appeal No. 1999-1484
Application No. 07/963,109

The decision of the examiner is reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JEFFREY V. NASE)	
Administrative Patent Judge)	

Appeal No. 1999-1484
Application No. 07/963,109

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