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EXAMINER
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FLUHART, STACEY A

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* DAVID A. JANSON and JEFFREY E. MAURER

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Appeal 2015-000708  
Application 13/052,362  
Technology Center 3600

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Before: LINDA E. HORNER, THOMAS F. SMEGAL, and  
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from a Final Rejection of claims 1–18. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

### CLAIMED SUBJECT MATTER

The claims are directed to an automatic transmission. Claim 1, reproduced below, is illustrative of the claimed subject matter:

1. An assembly, comprising:
  - a one-way transmission control element including first and second races;
  - first discs secured to the first race; and
  - second discs interleaved with the first discs and secured to the second race.

### REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yesnik	US 5,048,654	Sep. 17, 1991
Trasorras	US 2007/0081915 A1	Apr. 12, 2007
Kimes	US 2009/0233755 A1	Sep. 17, 2009

### REJECTIONS

Claims 1, 3, 4, 6, 7, 9, 10, 12, 13, 15, 16, and 18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Kimes.

Claims 2, 8, and 14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimes and Trasorras.

Claims 5, 11, and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Kimes, Trasorras, and Yesnik.

### OPINION

*Claims 1, 3, 6, 7, 12, 13, and 18*

In rejecting claim 1, the Examiner finds the phrase “discs secured to the [] race” to allow for the discs to be connected to an intermediate member

which is connected to the race. Final Act. 11; Answer 2. Thus, the Examiner finds that Kimes teaches this feature as “plates 90 are splined to the casing (60) and . . . the race 24 is splined to the casing. Thus, the outer race 24 is indeed secured to the discs 90.” Final Act. 11.

Appellants argue that claim 1 is not anticipated because “[t]he discs being secured to the casing and then in turn the race being secured to the casing is not language of claim 1.” Appeal Br. 7–8.

The Examiner responds by further explaining:

Since the claim does not recite more narrowly tailored language defining a direct connection, contact, direct engagement, etc., between the first discs and the first race, any manner of securing the first discs to the first race including using an intermediary member such as the case, meets the limitations of claim 1.

Answer 2.

Appellants further argue that the Examiner’s interpretation of “secured to” is inconsistent with the understandings of one of skill in the art would after reading the Specification. Reply Br. 3. Appellants point to a number of locations in the Specification that discuss how disks are “secured to” a race, arguing that “components secured to each other . . . are shown as in contact with each other—not through another component.” *Id.* at 3–4 (citing Specification 1:24–2:3, 2:8–11 and 17–24, 3:18–22, and 10:3–27).

But in each case, the embodiment described is not as broadly worded as claim 1. For example, each embodiment cited by Appellants states that the disks are “secured to” a race through a “reaction spline” or “a spline connection.” Such a spline is not part of claim 1. In contrast, dependent claim 4 further limits claim 1 to include first and second spline connections securing the discs to either the first or second race. Thus, the evidence offered by Appellants does not have the same scope as claim 1.

For these reasons we are not informed of error in the rejection of claim 1.

Appellants offer the same arguments for independent claims 6 and 12 as for claim 1. Appeal Br. 8–11. Thus, we affirm the rejections of claims 6 and 12 for the same reasons. Claims 3, 7, 13, and 18 depend from one of claims 1, 6, and 12 and are not separately argued. Thus, claims 3, 7, 12, and 18 fall for the same reasons as the independent claims from which they depend. *See* 37 C.F.R. § 41.37(c)(1)(iv).

*Claims 4, 9, 10, 15, and 16*

Claim 4 depends from claim 1 and as noted above adds, among other features, “discs are secured to the first [second] race by a first [second] spline connection.” The Examiner relies on the same teachings of Kimes discussed above in claim 1 for these additional features. Final Act. 3.

The Examiner further explains “the claim language does not recite that the first discs are directly secured to the first race by a first spline, and thus the same reasoning with regard to the meaning of ‘secured to’ in reference to claim 1 applies.” Answer 3.

Appellants argue that “[t]he friction plates (90) in Kimes are clearly shown adjacent to the outer race, not splined to it.” Appeal Br. 8. Appellants further argue that “in Kimes the spline that secures the outer race (24) (see figure 2) to the transmission case (60) is not the same spline that secures the friction plates (90) to the transmission case (60), and no spline secures the friction plates (90) to the outer race (24).” Reply Br. 4.

Here, in contrast to claim 1, the claim requires the discs be secured to the race “by a [] spline connection.” “A claim is anticipated only if each and

every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. Of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Examiner has not shown that Kimes teaches that “discs are secured to the first [second] race by a first [second] spline connection” as required by claim 4. Rather, the Examiner has shown only that a spline secures the outer race to the transmission case and a different spline secures the friction plates to the transmission case. For these reasons we do not sustain the anticipation rejection of claim 4.

Claims 9, 10, 15, and 16 recite limitations similar to claim 4. Thus, we do not sustain the rejections of claims 9, 10, 15, and 16 for the same reasons.

*Claims 2, 8, 14*

Appellants provide no additional substantive arguments with respect to the rejections of claims 2, 8, and 14. Appeal Br. 11 (relying on arguments presented for independent claims). Because claims 2, 8, and 14 depend from claims 1, 6, and 12 respectively, for which we sustain the Examiner’s rejection for the reasons described above, we also sustain the Examiner’s decision rejecting claims 2, 8, and 14.

*Claims 5, 11, and 17*

Appellants provide no additional substantive arguments with respect to the rejections of claims 5, 11, and 17. Appeal Br. 12 (relying on arguments presented for independent claims). Because claims 5, 11, and 17 depend from 1, 6, and 12 respectively, for which we sustain the Examiner’s

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rejection for the reasons described above, we also sustain the Examiner's decision rejecting claims 5, 11, and 17.

#### DECISION

The Examiner's rejection of claims 1–3, 5–8, 11–14, 17 and 18 is affirmed.

The Examiner's rejection of claims 4, 9, 10, 15, and 16 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART