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Foley & Lardner LLP 3000 K STREET N.W. SUITE 600 WASHINGTON, DC 20007-5109			GOLOBOY, JAMES C	
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JEAN MICHEL MARTIN, MAKOTO KANO,  
TAKUMARU SAGAWA, MASAHIKO WATANABE, and  
YUTAKA MABUCHI

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Appeal 2015-000718  
Application 13/797,346  
Technology Center 1700

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Before ROMULO H. DELMENDO, JEFFREY W. ABRAHAM, and  
JENNIFER R. GUPTA, *Administrative Patent Judges*.

GUPTA, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants<sup>1</sup> appeal under 35 U.S.C. § 134(a) from the Examiner's decision<sup>2</sup> finally rejecting claims 1–10, 13, and 14. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE and enter a NEW GROUND OF REJECTION pursuant to 37 C.F.R. § 41.50(b).

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<sup>1</sup> Appellants identify the real party in interest as Nissan Motor Co., Ltd. Appeal Brief filed May 27, 2014 (“App. Br.”), 2. Oral arguments were heard on November 10, 2016.

<sup>2</sup> Final Office Action mailed December 31, 2013 (“Final Act.”).

The subject matter on appeal relates to a low friction lubrication assembly. Claim 1, reproduced below, is illustrative of the claims on appeal.

1. A low-friction lubrication assembly comprising:

a first member relatively slidable against a second member, the first member having chemical affinity with an OH-group on its sliding surface; and

one or more oxygen-containing compounds located on the sliding surface of the first member and being able to produce a tribofilm to be located on the sliding surface of the first member having the chemical affinity, through hydrogen bond interactions with the OH-group,

wherein the first member includes a coating formed of a diamond-like carbon of ta-C type on its sliding surface,

wherein the one or more oxygen-containing compounds include glycerol,

wherein the second member has a chemical affinity with an OH-group on its sliding surface, and the tribofilm is able to be formed on the sliding surface of the second member through hydrogen bond interactions with the OH-group in response to a sliding motion of the first member against the second member, and

wherein the second member includes a coating formed of a diamond-like carbon of the ta-C type on its sliding surface.

App. Br. (Claims Appendix), 17.

## DISCUSSION

Claims 1–10, 13, and 14 are rejected under 35 U.S.C. § 102(b) as anticipated by Martin et al. (US 2006/0263604 A1, published Nov. 23, 2006) (hereinafter “Martin”) in view of evidence provided by J. Robertson, *Classification of Diamond-like Carbons, in* TRIBIOLOGY OF DIAMOND-LIKE CARBON FILMS: FUNDAMENTALS AND APPLICATIONS 13–24 (C. Donnet & A. Erdemir eds., 2008) (hereinafter “Robertson”).

“[R]ejections under 35 U.S.C. § 102 are proper only when the claimed subject matter is identically disclosed or described in the prior art.” *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis and internal quotation marks omitted).

As argued by Appellants at pages 9 through 15 of the Appeal Brief, Martin does not sufficiently direct one skilled in the art to a low-friction lubrication assembly that includes two tetrahedral amorphous carbon (ta-C) coated sliding members with glycerol, acting as a lubricant, located on one of the sliding members. Rather, one of ordinary skill in the art would need to at once envisage and select a particular Diamond-Like Carbon (DLC) coating (i.e., ta-C type) as a member of the generic DLC coatings disclosed in Martin for each sliding member (Martin ¶¶ 37 and 46; Robertson 14) as well as choose glycerol from among the long list of possible oxygen-containing organic containing compounds disclosed in Martin (Martin ¶¶ 54–142) as a lubricant for one of the sliding members to arrive at the assembly recited in claim 1. Thus, Martin does not describe the claimed lubrication assembly with sufficient specificity to constitute anticipation within the meaning of 35 U.S.C. § 102(b). Because claims 2–10, 13, and 14 depend from claim 1, our basis for reversal applies to all claims on appeal. Accordingly, we do not sustain the Examiner’s rejection of claims 1–10, 13, and 14 under 35 U.S.C. § 102(b) as anticipated by the disclosure of Martin in light of evidence provided by Robertson.

Picking and choosing, however, is “entirely proper in making a [section] 103 obviousness rejection.” *Arkley*, 455 F.2d at 587. Therefore, pursuant to our authority under 37 C.F.R. § 41.50(b), we enter a new ground of rejection for claims 1–10, 13, and 14 under 35 U.S.C. § 103(a) as

unpatentable over Martin in light of evidence provided by Robertson. For the new ground of rejection, we adopt the Examiner's findings regarding Martin and Robertson (Final Act. 2–4; Ans. 4–5) with the exception that we find that Martin teaches or suggests, rather than discloses, a low-friction assembly that includes two slidable members with each member having a ta-C type DLC coating and one slidable member having glycerol on its sliding surface. *See* Martin ¶¶ 36, 37, 46, 68, and 69; *see also* Robertson 14.

#### DECISION

For the above reasons, the Examiner's anticipation rejection of claims 1–10, 13, and 14 is REVERSED.

We enter a NEW GROUND OF REJECTION, pursuant to 37 C.F.R. § 41.50(b), rejecting claims 1–10, 13, and 14 under 35 U.S.C. § 103(a) as unpatentable over Martin in light of Robertson.

Section 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Section 41.50(b) also provides:

When the Board enters such a non-final decision, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new Evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the prosecution will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new Evidence not previously of Record is made which, in the opinion of the examiner, overcomes the new ground of rejection

designated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart.

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same Record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and also state all other grounds upon which rehearing is sought.

Further guidance on responding to a new ground of rejection can be found in the Manual of Patent Examining Procedure § 1214.01.

REVERSED;  
37 C.F.R. § 41.50(b)