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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte FRANK BAEHRLE-MILLER and SIMON HAUBER

Appeal 2019-004287
Application 15/317,075
Technology Center 3600

Before CHARLES N. GREENHUT, ANNETTE R. REIMERS, and
WILLIAM A. CAPP, *Administrative Patent Judges*.

REIMERS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE¹

Appellant² appeals under 35 U.S.C. § 134(a) from the Examiner's decision to reject claims 1–16 under 35 U.S.C. § 112(a) for lack of written

¹ The Examiner indicates that claim 14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112(a), “[as] set forth in [the] Office action and to include all of the limitations of the base claim and any intervening claims.” Final Office Action (“Final Act.”) 4, dated June 14, 2018.

² We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as “Robert Bosch GmbH.” Appeal Brief (“Appeal Br.”) 2, filed Nov. 13, 2018.

description and to reject claims 1–13, 15, and 16 under 35 U.S.C. § 102(a)(1) as anticipated by Takahashi (US 5,348,123, issued Sept. 20, 1994). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

CLAIMED SUBJECT MATTER

The claimed subject matter “relates to a braking device for a motor vehicle and to a method for controlling the braking device.” Spec. 1:7–9, Figs. 2, 3A–3C. Claims 1 and 7 are independent.

Claim 1 is illustrative of the claimed subject matter and recites:

1. A braking device for a motor vehicle, comprising:
 - at least one brake, including:
 - at least one brake pad; and
 - a brake disk; and
 - an elastic element selectively operable to move the at least one brake pad relative to the brake disk;
 - wherein the braking device, in a first non-braking operating state, is configured to operate the elastic element to move the at least one brake pad into contact with the brake disk such that the at least one brake pad and the brake disk generate either no braking force or a relatively small braking force acting on the motor vehicle.

ANALYSIS

Written Description

Claims 1–16

The Examiner determines that as “the claims have been amended to state that the spring ‘moves’ the brake pad,” the Specification “appears to lack any definitive description of the act of the spring ‘moving’ the brake pad from a released state with a release clearance, and into contact with the

rotor.” Final Act. 2. Rather, according to the Examiner, the Specification “appears to define that the spring force is substantial enough to keep the brake pad in contact the rotor, overcoming the release clearance force of the retracted piston.” *Id.* at 2–3.

To satisfy the written description requirement, the specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991). Specifically, the specification must describe the claimed invention in a manner understandable to a person of ordinary skill in the art and show that the inventor actually invented the claimed invention. *Id.* at 1562–63; *Ariad*, 598 F.3d at 1351. The drawings in an application can be relied upon to show that an inventor was in possession of the claimed invention as of the filing date. *See Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1565 (Fed. Cir. 1991) (“[D]rawings alone may be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.”).

In this case, Appellant’s Specification describes that (1) “[a]s regards [to] its elasticity, the elastic element is designed to be sufficiently powerful to ensure that the elastic force resulting from the actuator movement in the elastic element is sufficient *to move* the brake piston in the direction of the brake disk” (Spec. 3:33–4:1 (emphasis added)) and that (2) “[p]rovision is made here for a brake actuator of the parking brake *to move the brake piston*

by means of the elastic element and thus to place the brake pad against the brake disk” (Spec. 6:2–5 (emphases added)).

The Specification also describes:

The parking brake advantageously places the brake pad against the brake disk by means of the elastic element. This should be taken to mean that the parking brake is activated and undergoes a change, e.g. a change in length. On the basis of this change, it is possible for the parking brake to produce a change, e.g. change in length, in the elastic element. By virtue of the characteristic of the elastic element, *said element likewise transmits such a change, if only to a limited extent, to the brake pad and places the latter against the brake disk.*

Spec. 7:13–23 (emphasis added); *see also* Appeal Br. 5.

The Specification further describes that “[t]he spring constant of the spring system 13 is chosen in such a way that the spring system 13 can *push* the brake piston 5 in the direction of the brake disk 7 *during application*,” in that “[t]he brake piston 5 is thereby *moved* axially in the direction of the brake disk 7.” Spec. 20:5–9 (emphases added), Figs. 2, 3A–3C; *see also* Appeal Br. 6–10.

Upon review of Appellant’s Specification and drawings, we agree with Appellant that “the Specification as originally filed supports a braking device that is ‘configured to operate [an] elastic element in order to move [a] brake pad into contact with [a] brake disk’ as required by claim 1.” Appeal Br. 5.

In the Final Office Action, the Examiner states that “[t]he closes[t] [Appellant’s] [S]pecification comes to *enablement*” for the claim language “the spring ‘moves’ the brake pad” “is page 10 line 34 – page 11 line 10, and which the spring can overcome the bad clearance distance.” Final Act. 2

(emphasis added); *see also* Ans. 3–5³ (The Examiner explaining that the brake assembly of the subject invention “contains no other described or depicted structure which would *enable* the brake piston and brake pad to be spaced away from the brake disk and compress the spring in an initial spaced position (i.e. the distance in which the brake pad must ‘move’, fig[s]. 3A and 3B)”) (emphasis added); *see also* Ans. 8–9.

Based on the foregoing statements from the Examiner, it appears the Examiner intended to make an enablement rejection rather than a written description rejection. However, the written description requirement is separate and distinct from the enablement requirement. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1340 (Fed. Cir. 2010) (en banc).

When rejecting a claim under the enablement requirement of section 112, the PTO bears an initial burden of setting forth a reasonable explanation as to why it believes that the scope of protection provided by that claim is not adequately enabled by the description of the invention provided in the specification of the application.

In re Wright, 999 F.2d 1557, 1561–62 (Fed. Cir. 1993). Here, the Examiner fails to carry that burden. The rejection does not articulate why the disclosure provides insufficient information to enable a skilled artisan to make and use the invention without undue experimentation, such as by analysis of the *Wands* factors. *See* Final Act. 2–3; *see also* Ans. 3–6; *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988).

Moreover, in response to the Examiner’s position, Appellant points out that the Specification “discloses a sealing ring (12) that, when a braking operation ends, pulls the brake pad backwards from the state in Fig. 3c in

³ Examiner’s Answer (“Ans.”), dated Mar. 5, 2019.

which the brake pad is in contact with the brake disk to the state in Fig. 3a in which the brake pad is separated from the brake disk by an air gap.” Reply Br. 2–3⁴ (citing Spec. 21:13–20). As such, we agree with Appellant that “the Specification as originally filed clearly and expressly includes an example of a structure that applies a force to move the brake pad axially away from the brake disk.” Reply Br. 3.

In summary, upon review of Appellant’s Specification and drawings, we agree with Appellant that the Specification as originally filed describes that the elastic element is configured to move the brake pad in order to place the brake pad into contact with the brake disk. *See* Appeal Br. 5–7. Thus, we also agree with Appellant that “the [S]pecification reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Id.* at 7.

Accordingly, we do not sustain the Examiner’s rejection of claims 1–16 for lack of written description.

Anticipation by Takahashi

Claims 1–13, 15, and 16

Independent claim 1 is directed to a braking device for a motor vehicle, “wherein the braking device, in a first non-braking operating state, is configured to operate the elastic element to move the at least one brake pad *into contact with* the brake disk.” Appeal Br. 24 (Claims App.) (emphasis added). The Examiner finds that “the braking device assembly [of Takahashi] is the same as [Appellant’s] invention. . . . More specifically,

⁴ Reply Brief (“Reply Br.”), filed May 2, 2019.

the braking device of Takahashi . . . encompasses and fully teaches all of the structure and function of [Appellant’s] claims.” Ans. 7; *see also* Final Act. 3–4. The Examiner finds that Takahashi’s spring element “functions in exactly the same fashion as [Appellant’s] invention: constantly providing a biasing force between the spindle nut and brake piston to move the piston relative to the spindle nut, and therefore the brake pad, towards the brake rotor.” Ans. 7 (citing Takahashi 5:56); *see also* Final Act. 3–4. According to the Examiner:

The axially fixed spindle (109) [of Takahashi] rotates to cause the spindle nut (107, 110) to move axially towards and away from the axially facing surface of the brake piston (106). An elastic element, spring (111), is disposed axially between the spindle nut and the brake piston. The brake piston contacts and causes a brake pad (102) to move towards/away from a brake disk (104).

Ans. 7 (citing Takahashi, Fig. 5).

Appellant contends that “Takahashi does not disclose or suggest a braking device[□] that, ‘is configured to operate [an] elastic element to move [a] brake pad into contact with [a] brake disk’ as required by claim 1.” Appeal Br. 13. Specifically, Appellant contends that “Takahashi only includes disclosure where the brake pad 102 is in contact with the brake disk 104,” that Figure 5 of Takahashi “depicts a braking device prior to activation by a brake pedal or brake lever,” and that in Figure 5 of Takahashi “the brake pad 102 is already in contact with the brake disk 104.” *Id.* (citing Takahashi 6:10–59). According to Appellant, “[a]ctivating the braking device via the pedal 130 or lever 118 causes the piston 106 to move rightwardly so as to increase the force of the brake pad 102 on the brake disk 104 However, since the brake pad 102 is already in contact with

the brake disk 104, there is no movement of the brake pad 102.” Appeal Br. 13 (citing Takahashi 6:14–26)

Appellant has the better position here. As an initial matter, we acknowledge the Examiner’s position that “claim 1 does not actually require any ‘gap’ and makes no mention of one existing.” Ans. 7. However, upon review of claim 1, a skilled artisan would intuitively recognize that in order for the brake pad to be moved “into contact with” the brake disk, some sort of a space/gap would necessarily already have to be present between the brake pad and the brake disk. Appeal Br. 24 (Claims App.). In fact, Appellant correctly points out that the Examiner acknowledges that for the spring of the subject invention to be able to “move the at least one brake pad” “there must necessarily exist a time/position wherein the brake pad and brake piston *are spaced at least some gap distance* from the brake disk and are *not in contact with* the brake disk (i.e. the distance in which the brake pad must ‘move’, [Appellant’s] figs. 3A and 3B).” Ans. 4 (emphases added); *see also* Reply Br. 3. Moreover, as discussed above, the Specification describes a gap between brake disk 7 and brake pads 8, 8' and how the gap is established. Spec. 21:27–35, Fig. 3A; *see also* Appeal Br. 7–10; Reply Br. 2–3.

Takahashi discloses:

The rotation of the screw member 109 causes the nut member 107 to slide in the cylindrical part of the piston 106, and when the nut member 107 moves rightwardly of FIG. 5 the sleeve 110 also moves rightwardly against an elastic force of the spring 111 and finally comes into abutment against the bottom of the piston 106. From this condition, if the nut member 107 further moves rightwardly the first brake pad 102 *depresses one side* of the rotor 104 and, further, the second brake pad 103 *depresses the other*

side of the rotor 104 by a reaction of the depression of the first brake pad 102, thereby to brake the rotor 104.

Takahashi 6:14–26 (emphases added) (bolding omitted), Fig. 5.

Based on Takahashi’s disclosure and Figure 5, we agree with Appellant that “brake pad 102 [and brake pad 103 are] already in contact with the brake disk 104 in the position in Fig[ure] 5, and will remain in contact with the brake disk 104 while the sleeve 110 moves rightward toward and into contact with the piston 106.” Appeal Br. 16. In addition, the Examiner does not provide sufficient evidence or technical reasoning to establish that a gap/space inherently exists between brake pad 102 and/or brake pad 103 and brake disk 104 of Takahashi, such that sleeve 110’s movement against an elastic force of spring 111 and into contact with piston 106 would necessarily result in spring 111 moving brake pad 102 and/or brake pad 103 into contact with brake disk 104. *See* Final Act. 3–5; *see also* Ans. 7–9; Appeal Br. 14–15; Reply Br. 4–5. For these reasons, the Examiner fails to establish by a preponderance of the evidence that Takahashi anticipates the braking device of claim 1.

Similar to independent claim 1, independent claim 7 is directed to a method for controlling a braking device for a motor vehicle and includes the step of “operating an elastic element in a first non-braking configuration to move at least one brake pad into contact with a brake disk.” *See* Appeal Br. 26 (Claims App.). The Examiner relies on the same unsupported findings in Takahashi as those discussed above for claim 1. *See* Final Act. 3–4. As such, the Examiner’s findings with respect to Takahashi are deficient for claim 7 as well.

Accordingly, for the foregoing reasons, we do not sustain the Examiner's rejection of claims 1-13, 15, and 16 as anticipated by Takahashi.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Reference(s)/Basis	Affirmed	Reversed
1-16	112(a)	Written Description		1-16
1-13, 15, and 16	102(a)(2)	Takahashi		1-13, 15, and 16
Overall Outcome				1-16

REVERSED