

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. HUGGINS, JOSEPH D. REYNOLDS,
DAVID L. WADAS and SHARON L. GUALTIERI

Appeal No. 2000-0502
Application No. 08/890,438

ON BRIEF

Before CALVERT, COHEN, and FRANKFORT, Administrative Patent Judges.

CALVERT, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 21 to 26, all the claims remaining in the application.

The appealed claims are drawn to a change-gear transmission system and a microprocessor-based system

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controller for controlling range shifting in such a system. Claims 21 to 26 are reproduced in the appendix of appellants' brief, except that claim 26 should be dependent on claim 25.¹

Claims 21 to 26 stand finally rejected as being unpatentable for failure to comply with the written description requirement of 35 U.S.C. § 112, first paragraph.

On page 2 of the brief, appellants state that claims 21 to 26 stand or fall together. Accordingly, pursuant to 37 CFR § 1.192(c)(7), we select claim 21 and will decide the appeal based thereon.

Claim 21 recites, inter alia:

range shift sensing means for sensing shift selector positions indicative of an operator intent to shift (a) from a low-range ratio to a high-range ratio and providing a first input signal indicative thereof, and (b) from a high-range ratio to a low-range ratio and providing a second input signal indicative thereof,

¹ In reviewing claims 21 to 26, we note that in the event of further prosecution, the examiner should consider (1) whether to reject claims 22 and 23 under 35 U.S.C. § 112, second paragraph, since claim 22 is dependent on claim 1, which has been cancelled, See Ex parte Brice, 110 USPQ 560 (Bd. App. 1955), and (2) whether to reject claims 21 to 26 as unpatentable over claims 21 to 25 of Patent No. 5,673,592 on the ground of obviousness-type double patenting.

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and

a controller for receiving a plurality of input signals including said first, second and third input signals and processing same in a predetermined manner to issue command output signals to at least said actuator, said controller commanding a shift into the low-range condition

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only upon sensing (a) said shift selector position indicative of an operator intent to shift from a high-range ratio to a low-range ratio and (b) the magnitude of said third input signal being less than a first reference.

The examiner takes the position that (final rejection, page 2):

The subject matter of a controller commanding a shift into low only upon "sensing [(a) said] shift selector position indicative of an operator intent to shift [] from [a] high range ratio to a low range ratio", "sensing [(c) said] shift selector position indicative of an operator intent to shift [] from [a] low-range ratio to a high-range ratio", "range shift sensing means for sensing a shift lever movement indicative of an operator intent to shift. . ." [2] lack support in the originally filed application. This is a new matter rejection.

As further indicated on page 3 of the examiner's answer, the examiner considers that there is no written description support for the recitations of sensing shift selector positions "indicative of an operator intent to shift."

In the present case appellants have not pointed out, nor do we find, where in their application as filed there is any

² These quotations are taken from claim 21, lines 18 and 19, claim 22, lines 2 and 3, and claim 24, lines 6 to 8, respectively.

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express disclosure of sensing shift selector positions "indicative of an operator intent to shift." However, for compliance with the written description requirement of § 112, first paragraph, the claimed subject matter need not be described in haec verba in the specification, as long as the specification as originally filed would "convey clearly to those skilled in the art the information that the applicant has invented the specific subject matter later claimed. " In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 624 (CCPA 1978). See also Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)(application as filed must convey with reasonable clarity to those of ordinary skill in the art that the applicant was in possession of the invention now claimed). Thus, although the written description may be inherent rather than express, In re Mott, 539 F.2d 1291, 1297, 190 USPQ 536, 541 (CCPA 1976), in order for a disclosure to be inherent the missing descriptive matter must necessarily be present in the specification such that one skilled in the art would recognize such a disclosure. Tronzo v. Biomet, Inc., 156 F.3d 1154, 1159, 47 USPQ2d 1829, 1834 (Fed. Cir. 1998).

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In their answer (page 3) appellants cite page 7, lines 16 to 20 of the specification, as disclosing a sensor for sensing shift lever³ position and providing a signal GL indicative thereof. As understood from appellants' disclosure, when the shift lever is moved from the high-range to the low-range portion of the shift pattern (i.e., from the right leg to the center leg in Fig. 3)

³ The claims use the term "shift selector" instead of "shift lever."

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the sensor will cause the range clutch 182 to be moved from the high to low position; likewise, upon moving the shift lever from the low-range to high-range portion of the shift pattern (center leg to right leg in Fig. 3), the range clutch 182 will be moved from the low to high position. However, if the operator intended to move the shift lever from the 7/8 position to the 9/10 position, but instead erroneously or incorrectly moved it from the right leg to the center (or even left) leg, i.e., to the 5/6 position (or even to the 1/2 position), undue wear and/or damage would result. Similarly, wear or damage could result if the operator intended to upshift from the 1/2 position to the 3/4 position, and inadvertently moved the shift lever to the 7/8 position (page 6, lines 11 to 25). To prevent such wear or damage, appellants disclose a sensor which provides a signal OS indicative of the speed of the output shaft and thus, of the speed of the vehicle. This signal OS and shift lever position signal GL are fed to a controller 222 which is so programmed that if the shift lever is moved from the low-range to the high-range portion, the range clutch 182 will only be moved from low to high position if the vehicle speed is greater than

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a reference (predetermined) value; similarly, if the shift lever is moved from the high-range to the low-range portion, the range clutch 182 will only be moved from high to low position if the vehicle speed is less than a predetermined value (page 7, lines 20 to 31; Fig. 6⁴).

Appellants do not explain in their brief how the limitations questioned by the examiner are supported by their disclosure, but simply state on page 3:

If the shift lever is sensed as being in a range-high area of shift pattern while engaged in a range-low ratio (1, 2, 3, 4, 5 [,] 6), this is "sensing shift lever [sic: selector] position[s] indicative of an operator intent to shift [(a)] from a low-range ratio to a high-range ratio."

Similarly, if the shift lever is sensed as being engaged in a high-range ratio ("RANGE_H?-YES") with the lever in the low-range area (LEVER IN RANGE LOW AREA-YES"), this is sensing a lever position/movement indicative of an operator intent to shift from a high-range ratio to a low-range ratio.

These statements merely beg the question to be decided, and we are not persuaded by them that the rejection was improper. As discussed above, the application discloses a means for sensing

⁴ We do not find any explanation in the specification of the expression "M/S=N" in Fig. 6.

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when the shift selector position is changed from the low-range portion of the shift pattern to the high-range portion, and vice versa, but while this change in position of the shift selector may under normal circumstances be "indicative of an operator intent to shift" from a low-range ratio to a high-range ratio, or vice versa, it is not necessarily indicative of such an intent. In fact, as discussed above, appellants' disclosed apparatus is designed to prevent shifting from a low-range ratio to a high-range ratio (or vice versa) when the operator erroneously or inadvertently moves the shift selector from the low-range portion to the high-range portion of the shift pattern (or vice versa) without intending to shift from a low-range ratio to a high-range ratio (or vice versa). As such, the recitation that the shift selector position is "indicative of an operator intent to shift" seems to be virtually the antithesis of appellants' disclosed invention, and thus we do not consider that the application as filed would reasonably convey to one of ordinary skill that appellants were in possession of the invention as claimed. Vas-Cath, supra. In summary, while appellants' disclosed sensing means senses changes of position of the shift selector

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(lever) between the low- and high-range portions of the shift pattern, such changes of position are not necessarily indicative of the operator's intent to shift between the low-range and high-range ratios, as claimed.

The rejection will therefore be sustained.

Conclusion

The examiner's decision to reject claims 21 to 26 is affirmed.

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No period for taking any subsequent action in connection
with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
IRWIN CHARLES COHEN)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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CHARLES E. FRANKFORT)	
Administrative Patent Judge)	

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