

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. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JON M. HUBER et al.

Appeal No. 2000-0865
Application No. 08/910,822

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 4, 7 to 11, 17 and 18. Claims 13 to 16 have been allowed. Claims 5, 6, 12 and 19, the only other claims pending in this application, have been objected to as depending from a non-allowed claim.

We REVERSE.

Appeal No. 2000-0865
Application No. 08/910,822

BACKGROUND

The appellants' invention relates to a method of controlling a current torque value in a vehicle transmission. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Sakaki et al. 1994 (Sakaki)	5,303,614	Apr. 19,
Kuriyama et al. 1996 (Kuriyama)	5,505,675	Apr. 9,
Takasaki et al. 1997 (Takasaki)	5,631,829	May 20,

Claims 1 to 4, 7 to 11, 17 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Takasaki in view of Kuriyama.

Claims 1 to 4, 7 to 11, 17 and 18 stand rejected under

35 U.S.C. § 103 as being unpatentable over Takasaki in view of Sakaki.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 17, mailed January 7, 2000) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 15, filed December 13, 1999) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejections of claims 1 to 4, 7 to

11, 17 and 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

The appellants argue (brief, pp. 3-7) that the applied prior art does not suggest the claimed subject matter. We agree.

All the claims under appeal require the following steps:
(1) determining a desired torque value for use during a portion of a shifting operation; (2) changing the current

torque value at a first rate of change until the desired torque value is obtained or a preselected period of time elapses; (3) when the current torque value does not correspond to the desired torque value and the preselected period of time has elapsed, changing the current torque value at a second rate of change until the desired torque value is obtained. However, these limitations are clearly not suggested by the applied prior art. In that regard, while it may have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the torque control system of Takasaki by incorporating features of either the control system of Kuriyama or the shift control system of Sakaki, we see no suggestion in the applied prior art for modifying Takasaki to arrive at the claimed invention. In fact, the examiner never ascertained the differences between the applied prior art and the claims at issue and never determined that it would have been obvious to arrive at the claimed invention.

In our view, the only suggestion for modifying the applied prior art to arrive at the claimed invention stems from hindsight knowledge derived from the appellants' own

disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

In summary, we see no motivation in the applied prior art of why one skilled in the art would have modified the torque control system of Takasaki to make the modifications necessary to arrive at the claimed invention. Thus, the examiner has failed to meet the initial burden of presenting a prima facie case of obviousness. It follows that we cannot sustain the examiner's rejections of claims 1 to 4, 7 to 11, 17 and 18.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 4, 7 to 11, 17 and 18 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
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)	
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