

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DETLEF KETTNER and WERNER SCHILLER

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Appeal No. 2001-1350  
Application No. 09/188,766

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ON BRIEF

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Before ABRAMS, FRANKFORT, and MCQUADE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 9, all of the claims pending in this application.

As noted on page 1 of the specification, appellants' invention is directed to a method for setting the suction pressure of a compressor in a refrigerant circuit of an automobile, in which a current suction pressure is determined and

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is compared to a suction pressure to be set, and wherein the delivery rate of a refrigerant in the refrigerant circuit is set as a function of that comparison, and to a device for carrying out the method. More particularly, the speed of a drive element of the compressor, operated independently of the automobile engine, is determined as a function of the suction pressure to be set on the compressor. Independent claims 1 and 3 are representative of the subject matter on appeal and a copy of those claims can be found in the Appendix to appellants' brief.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

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| Isaji et al. (Isaji) | 5,537,831 | Jul. 23, 1996 |
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In addition, the examiner has relied upon the admitted prior art (APA) set forth on page 1 of appellants' specification.

Claims 1 through 3 and 5 through 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Isaji.

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Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Isaji as applied above, and further in view of Official Notice.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the final rejection (Paper No. 11, mailed January 19, 2000) and examiner's answer (Paper No. 14, mailed October 23, 2000) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 13, filed July 17, 2000) and reply brief (Paper No. 15, filed December 21, 2000) for the arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

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With regard to the rejection of claims 1 through 3 and 5 through 9 under 35 U.S.C. § 103(a) as being unpatentable over the APA and Isaji (final rejection, pages 2-3), we agree with appellants' arguments in their brief and reply brief that the examiner has disregarded the teachings of the Isaji patent as a whole and instead improperly attempted to extract a generalized concept from Isaji and then apply that general concept to the clearly different refrigeration system of the APA, without any teaching, suggestion, or incentive in the prior art itself for any such combination. More particularly, we agree with appellants' arguments, analysis of the applied prior art and commentary on the examiner's attempted combination of the APA and Isaji as set forth on pages 8-12 of the brief and pages 2-12 of the reply brief, and we adopt those positions as our own.

Like appellants, it is our opinion that the examiner has improperly used the hindsight benefit of appellants' own disclosure to fabricate a broad concept from the applied Isaji patent and then selectively combine that broad concept with the distinctly different refrigeration system of the APA in an attempt to reconstruct appellants' claimed subject matter. However, as our court of review indicated in In re Fritch,

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972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), it is impermissible to use the claimed invention as an instruction manual or "template" in attempting to piece together isolated disclosures and teachings of the prior art so that the claimed invention is rendered obvious.

Since we have determined that the teachings and suggestions found collectively in the APA and Isaji would not have made the subject matter as a whole of independent claims 1 and 3 on appeal obvious to one of ordinary skill in the art at the time of appellants' invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 and 5 through 9 under 35 U.S.C. § 103(a) on that same basis will likewise not be sustained.

We have additionally reviewed the examiner's rejection of dependent claim 4 under 35 U.S.C. § 103(a) based on the APA, Isaji and Official Notice. However, the examiner's invocation of Official Notice concerning the prior existence of hermetically sealed motor/compressor structural units does nothing to supply that which we have found above to be lacking in the basic

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combination of the APA and Isaji. Thus, it is clear that the examiner has not set forth a *prima facie* case of obviousness with respect to dependent claim 4, and the rejection of that claim under 35 U.S.C. § 103(a) will not be sustained.

In view of the foregoing, the examiner's decision rejecting claims 1 through 9 of the present patent application under 35 U.S.C. § 103(a) is reversed.

REVERSED

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| NEAL E. ABRAMS              | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| CHARLES E. FRANKFORT        | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| JOHN P. MCQUADE             | ) |                 |
| Administrative Patent Judge | ) |                 |

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