

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
\_\_\_\_\_

Ex parte AGNE APPELQUIST AND GLENN HERMANSSON

\_\_\_\_\_  
Appeal No. 96-3011  
Application No. 08/165,313<sup>1</sup>  
\_\_\_\_\_

HEARD: January 12, 1999  
\_\_\_\_\_

Before MEISTER, FRANKFORT, and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

\_\_\_\_\_  
<sup>1</sup> Application for patent filed December 10, 1993.

Appeal No. 96-3011  
Application No. 08/165,313

This is a decision on appeal from the examiner's final rejection of claims 1 through 14, which are all of the claims pending in the application.

Appellants' invention is directed to an oil cooler for motor vehicles. Independent claims 1 and 8 are representative of the subject matter on appeal and a copy of those claims, reproduced from the Appendix to appellants' brief, is attached to this decision.

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

Burne et al. (Burne)	3,339,260	Sep. 5, 1967
Roberts	3,664,928	May 23, 1972

Claims 1 through 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Burne in view of Roberts.

Rather than reiterate the examiner's full statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the examiner's answer (Paper

Appeal No. 96-3011  
Application No. 08/165,313

No. 16, mailed January 3, 1996) for the examiner's reasoning in support of the rejection, and to appellants' brief (Paper No. 15, filed November 24, 1995) for appellants' arguments thereagainst.

Appeal No. 96-3011  
Application No. 08/165,313

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 determination that we will not sustain the examiner's rejection of the appealed claims under 35 U.S.C. § 103. Our reasoning follows.

In reviewing the teachings of Burne and Roberts, we must agree with appellants (brief, pages 5-14) that the applied prior art references do not teach, suggest or render obvious the oil cooler set forth in the above enumerated claims on appeal. Even if we were to conclude that the distillation apparatus of Roberts would have commended itself to the attention of one of ordinary skill in the oil cooling art involved in this application and in Burne, we see no reasonable teaching or suggestion in the applied references which would have led one of ordinary skill in the art to use the specialized dimpled heat transfer structures (e.g., 19,

Appeal No. 96-3011  
Application No. 08/165,313

19a) of the distillation apparatus of Roberts, or the  
teachings regarding the dimples therein, in the oil cooler of

Appeal No. 96-3011  
Application No. 08/165,313

Burne. In this regard, we are of the view that the examiner's position is based on impermissible hindsight gleaned from appellants' own disclosure and not from any fair teaching or suggestion found in the applied prior art references themselves. More specifically, we consider that the examiner has used appellants' own disclosure and the claimed invention itself as a blueprint for piecing together unrelated elements from disparate references in the prior art so as to defeat patentability of the invention as defined in appellants' claims on appeal.

Absent the disclosure of the present application, it is our opinion that one of ordinary skill in the art would not have been motivated by the collective teachings of the applied Burne and Roberts patents to use the sophisticated and specialized dimpled evaporating surface of Roberts in the relatively simple oil cooler of Burne, where there is no evaporation of the medium flowing through the cooler and wherein the importance of a low (minimum) pressure drop has been emphasized. Thus, the examiner's rejection of claims 1

Appeal No. 96-3011  
Application No. 08/165,313

through 14 under 35 U.S.C. § 103 based on Burne and Roberts  
will not be sustained.

Appeal No. 96-3011  
Application No. 08/165,313

In accordance with the foregoing, the decision of the  
examiner is reversed.

REVERSED

JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
MURRIEL E. CRAWFORD	)	
Administrative Patent Judge	)	

CEF/sld

Appeal No. 96-3011  
Application No. 08/165,313

Appendix

1. An oil cooler for motor vehicles, having an outer tube and an inner tube which is disposed within the outer tube and whose outer surface, together with the inner surface of the outer tube are spaced from each other to establish a gap therebetween and thus to form an annular channel, sealed in both ends, for feeding oil to be cooled, from an inlet at a first end of the tubes to an outlet at a second end of said tubes, a means provided in the annular channel for ensuring heat transfer from the passing oil to the surrounding tube walls, and a turbulence-generating means provided on the outer surface of the outer tube for a coolant, in which the oil cooler is submerged, characterized in that the turbulence-generating means consists of cup-shaped dimples formed on the outer surface of the outer tube, said cup shaped dimples also being spaced from said outer surface of said inner tube.

8. An oil cooler for motor vehicles, having an outer tube and an inner tube which is disposed within the outer tube and whose outer surface, together with the inner surface of the outer tube are spaced from each other to establish a gap therebetween and thus to form an annular channel, sealed in both ends, for feeding oil to be cooled, from an inlet at a first end of said tubes to an outlet at a second end of the tubes, a means provided in the annular channel for ensuring heat transfer from the passing oil to the surrounding tube walls, and a turbulence-generating means provided on the outer surface of the outer tube for a coolant, in which the oil cooler is submerged, characterized in that the turbulence-generating means consists of bump-like projections formed on the outer surface of the outer tube, said bump-like projections also being spaced from said outer surface of said inner tube.

Appeal No. 96-3011  
Application No. 08/165,313

Morgan & Finnegan  
345 Park Avenue  
New York, NY 10154

# ***Shereece***

Appeal No. 96-3011  
Application No. 08165,313

APJ FRANKFORT

APJ CRAWFORD

APJ MEISTER

REVERSED

Prepared: November 9, 1999