

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER JARZYNA

Appeal No. 1999-0628
Application No. 08/806,503¹

ON BRIEF

Before STAAB, McQUADE, and BAHR, Administrative Patent Judges.
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-15, which are all of the claims pending in this application.

¹ According to the appellant, this application is a continuation of Application No. 08/502,979, filed July 17, 1995, now abandoned, which is a continuation of Application No. 08/161,045, filed December 3, 1993, now abandoned.

BACKGROUND

The appellant's invention relates to an arrangement comprising any of an automatic transmission housing, a manual transmission housing and a four-wheel drive transfer case having an output shaft having a set of splines and a yoke mounted on the splines. It is important to the appellant that the set of splines be completely external of the housing or transfer case. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the opinion section of this decision.

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

Ward et al. (Ward)	1,169,058	Jan. 18, 1916
Richter	2,226,388	Dec. 24, 1940
Keese	2,402,637	Jun. 25, 1946
Arbus	5,339,707	Aug. 23, 1994

The following reference is referred to in the remand section of this decision, infra:

Benson, Jr. (Benson)	3,636,909	Jan. 25, 1972 ²
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The following rejections are before us for review.

1. Claims 1-3, 6-9, 12 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keese in view of Arbus.

² This reference was cited by the appellant in an information disclosure statement filed July 17, 1995 in parent Application No. 08/502,979.

2. Claims 4 and 13 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keese in view of Arbus, as applied above, and further in view of Richter.

3. Claims 5, 10, 11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keese in view of Arbus, as applied above, and further in view of Ward.

Reference is made to the brief (Paper No. 22) and the answer (Paper No. 23) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.

OPINION

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

Independent claim 1, which is exemplary of the invention, reads as follows:

1. Any one of an automatic transmission housing, a manual transmission housing, and a four-wheel drive transfer case, each including an output shaft having only one set of splines adapted to connect with a yoke and formed on the end thereof, and only one yoke with said only one yoke being mounted on the only one set of splines of the output shaft, the improvement comprising said housings and said transfer case each formed to a length such that said output shaft extends outwardly therefrom with said only one set of splines completely external of said housings and transfer case, and said only one yoke is mounted

on said external set of splines, and a seal is mounted to the transmission housings and transfer case and contacting said output shaft.³

Before addressing the examiner's rejections based upon prior art, it is essential that the claimed subject matter be fully understood. Analysis of whether a claim is patentable over the prior art under 35 U.S.C. §§ 102 and 103 begins with a determination of the scope of the claim. The properly interpreted claim must then be compared with the prior art. Claim interpretation must begin with the language of the claim itself. See Smithkline Diagnostics, Inc. v. Helena Laboratories Corp., 859 F.2d 878, 882, 8 USPQ2d 1468, 1472 (Fed. Cir. 1988).

Accordingly, we will initially direct our attention to the appellant's claims to derive an understanding of the scope and content thereof.

Specifically, we note that each of the independent claims requires, inter alia,

an output shaft having only one set of splines adapted to connect with a yoke and formed on the end thereof, and only one yoke with said only one yoke being mounted on the only one set of splines of the output shaft [emphasis added].⁴

³ References in the claim to "said housings and transfer case" lack strict antecedent basis and should apparently be "said housing or transfer case." Although this inconsistency does not render the scope of the claims indefinite, it is deserving of correction in the event of further prosecution before the examiner.

⁴ This language was first introduced into the claims in a preliminary amendment filed July 17, 1995 (Paper No. 5) in parent Application No. 08/502,979 with the request for filing a continuation of earlier Application No. 08/161,045 under 37 CFR § 1.60, as then in effect. Since (1) the original application papers for Application No. 08/502,979 were filed under 37 CFR § 1.60 and identified the application as a "continuation" (not continuation-in-part) of the earlier application, (2) the 37 CFR § 1.63 declaration filed September 11, 1995 in Application No. 08/502,979 did not refer to this preliminary amendment, (3) the February 24, 1997 request for filing an application under 37 CFR § 1.62, as then in effect, (Paper No. 16) identified the instant application as a "continuation" of parent Application No. 08/502,979 and (4) no supplemental declaration under 37 CFR § 1.67 referring to the preliminary amendment filed July 17, 1995 has been filed, the preliminary amendment in question does not form part of the original disclosure of the application. See Manual of Patent Examining Procedure (MPEP) § 608.04(b).

In proceedings before it, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

In light of the appellant's underlying disclosure, we read the words "only one set of splines adapted to connect with a yoke and formed on the end thereof" of the claims together so as to denote that the shaft has only one set of splines which are "adapted to connect with a yoke and formed on the end thereof." We do not interpret this language as precluding the output shaft having another set of splines at a location thereon different from "the end thereof" which are not adapted to connect with a yoke or the housing or casing having another yoke which is not mounted on the one set of splines.⁵

In rejecting claims 1-3, 6-9, 12 and 15 under 35 U.S.C. § 103 as being unpatentable over Keese in view of Arbus, the examiner reads the claimed "output shaft" on the shaft (324) of Keese. Noting that the splined outer end portion of the shaft (324) is shown extending into the bearing cage (310) of the auxiliary reduction gear housing (300) and, thus, is not

⁵ If given the latter, more limited interpretation, the claims as now amended would appear to lack adequate descriptive support as required by the first paragraph of 35 U.S.C. § 112. Specifically, the appellant's specification and drawings (note the "fragmentary" views; specification, pages 2-3) disclose details only of the output end of the housing or casing and output shaft. Since the upstream portions of the shaft and housings or casings are neither illustrated nor described, the presence or absence of additional splines thereon cannot be determined.

"completely external of" the housing as required by the claims, the examiner takes the position that to provide the splines completely external of the housing would have been obvious in view of the teachings of Arbus (answer, pages 3 and 4).

It is clear from the disclosure of Keese that the shaft (324) is to be coupled (via a gear or sprocket or universal joint, for example) to the output of an engine, whereby power is transmitted from the output of the engine to the shaft (324) and hence to the reduction gear assembly and finally to the axle shafts. In other words, the shaft (324) is, with respect to the reduction gear assembly, an input shaft, and not an output shaft as the examiner contends. Therefore, it is our opinion that the examiner's reading of the claimed "output shaft" on the shaft (324) of Keese is unreasonable.

Accordingly, we cannot sustain the examiner's rejection of claims 1-3, 6-9, 12 and 15 as unpatentable over Keese in view of Arbus. With regard to the remaining claims, we have reviewed the teachings of Richter and Ward but we find nothing therein which overcomes the above-noted deficiencies of the combination of Keese and Arbus. It follows then that we shall also not sustain the examiner's rejections of claims 4 and 13 as unpatentable over Keese in view of Arbus and Richter and claims 5, 10, 11 and 14 as unpatentable over Keese in view of Arbus and Ward.

REMAND TO THE EXAMINER

Pursuant to 37 CFR § 1.196(e), we remand the application to the examiner to consider the patentability of the claims in view of the teachings of Arbus in view of other prior art, such as Benson, for example. Arbus discloses a manual transmission housing with an output shaft (29) having a set of splines formed on the tailshaft portion (30) thereof which is completely external of the housing. Given our interpretation, supra, of the limitation "an output shaft having only one set of splines adapted to connect with a yoke and formed on the end thereof," the additional splines (29b or 29e, for example) on the shaft (29) would not appear to be precluded by this limitation of the claims. With regard to at least independent claims 1 and 9, for example, Arbus appears to disclose the invention as claimed with the exception of a seal mounted to the housing, external to the exit bearing, contacting a journal surface of the shaft. It appears to us that Benson, for example, which discloses a transmission housing having a shaft extending outwardly from an opening of the housing, with the opening being provided with a seal and a bearing interior of the seal contacting a journal surface of the shaft and with the shaft being provided with a set of splines completely exterior of the housing or casing for mounting a yoke, would have suggested providing a seal at the exit end of the Arbus housing to maintain lubricant within the transmission housing. The examiner may also be aware of other prior art containing similar teachings. The application is remanded to the examiner to consider the patentability of the claims over Arbus in view of Benson or such other prior art references.

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