

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. BELLINGER and DAVID J. MUNT

Appeal No. 2001-0034
Application 08/944,807

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 1, 4, 6, 8 and 9. Claims 10 and 11 have been allowed. Claims 2, 3, 5 and 7, the only other claims pending in the application, have been indicated by the examiner to contain allowable subject matter, but currently stand objected to until such time that they are rewritten in independent form.

Appellants' invention pertains generally "to systems for controlling semiautomatic transmissions, and more specifically to systems for switching between manual and automatic control modes of a number of top gears of a semiautomatic transmission" (specification, page 1). A further understanding of appellants' invention can be derived from a reading of exemplary claim 1, reproduced below (with emphasis added):

1. A system for selecting between automatic and manual control of a number of gear ratios of a semiautomatic transmission comprising:

an internal combustion engine coupled to a semiautomatic transmission having a number of manually selectable gear ratios and a number of automatically selectable gear ratios;

means for determining an engine fueling rate;

a switch having a first switch position and a second switch position;

a memory unit including a software algorithm for controlling shifting between the number of automatically selectable gear ratios; and

a control computer responsive to said first switch position to execute said software algorithm and thereby control shifting between the automatically selectable gear ratios, said control computer responsive to said second switch position *to inhibit execution of said software algorithm such that said number of automatically selectable gear ratios are manually selectable* if said engine is currently engaged with any of said number of automatically selectable gear ratios and said fueling rate is less than a threshold fueling rate.

Appeal No. 2001-0034
Application 08/944,807

The sole reference cited in the final rejection against the claims is:

White et al. (White) Re. 36,186 Apr. 6, 1999

Claims 1, 4, 6, 8 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over White.

White pertains to "[a] control system for controlling automatic shifting of a manual/automatic transmission . . . including a cruise control system and an auto-shift mode for controlling automatic upshift and downshift operations between the top two gears of a heavy duty truck transmission" (abstract). In rejecting the appealed claims as being unpatentable over White, the examiner notes several of the similarities between the system of White and that of the claims, including, a semiautomatic transmission having a number of manually selectable gear ratios and a number of automatically selectable gear ratios, a memory unit including a software algorithm for controlling shifting between the number of automatically selectable gear ratios, and a control computer for switching between an operational mode wherein the transmission is shifted between the automatically selectable gear ratios under the control of the

Appeal No. 2001-0034
Application 08/944,807

software algorithm and an operational mode wherein the transmission is manually shifted between the manually selectable gear ratios.

What passes for the examiner's analysis of the differences between the appealed claims and the system of White, and the examiner's conclusions of obviousness with respect to those differences, is found in the sentence spanning pages 3 and 4 of the answer, which we reproduce below:

While White et al does not specifically disclose the limitations in the same manner as claimed, it would have been obvious to one skilled in the art at the time of the invention to be motivated to modify the control system of White et al because such modification will provide maximum fuel economy and engine performance, while minimizing driver's fatigue and improving the overall vehicle performance.

The examiner amplifies on this position at the bottom of page 6 of the answer, wherein it is stated:

Contrary to Appellant's assertion, White et al. discloses the software algorithm being executed by a control computer or electronic control unit. The software is executed under certain conditions and prohibited in others. See column 7. The White et al. patent allows manual shifting in the automatically selectable transmission gears. Appellant's attention is directed to columns 5, 7-12 of the White et al patent.

The only other place in the answer where the examiner attempts to support the standing rejection with specific teachings from the White reference is found in the second paragraph on page 7 of the answer, wherein the examiner provides what appears at first blush to be a large block quotation from White, but which is actually a series of no less than four (4) separate and distinct short quotes from various locations in White's specification.¹ Notably missing is any explanation of the relevance of these quotes to the obviousness issue at hand. In particular, there is no explanation of precisely where White teaches "allow[ing] manual shifting in the automatically selectable transmission gears" as asserted by the examiner in the last paragraph on page 6 of the answer.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532. 28 USPQ2d 1955,

¹As a courtesy to both the Board and counsel for appellants, the examiner should in the future more clearly identify the source of short quotations taken from references. This can be accomplished by separating individual passages from each other by their own set of quotation marks, and by pinpointing their location within the document by using *both* the column number *and* the specific line numbers where they appear.

Appeal No. 2001-0034
Application 08/944,807

1956 (Fed. Cir. 1993) and *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1446 (Fed. Cir. 1990). A *prima facie* case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See *In re Bell*, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) and *In re Rinehart*, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

In the present case, the examiner has made no findings of fact regarding, among other things, the scope and contents of the applied prior art, or *the differences* between the prior art and the appealed claims. In this regard, the examiner's statement that White does not specifically disclose "the limitation in the same manner as claimed" (answer, page 3, last 2 lines) does not suffice. Moreover, the examiner has not specifically set forth *how* the control system of White is to be modified, or a convincing line of reasoning as to *why* the artisan would have been motivated to make any such modification. Hence, the

Appeal No. 2001-0034
Application 08/944,807

examiner's statement that it would have been obvious "to modify the control system of White" because "such modification" would provide "maximum fuel economy and engine performance," while "minimizing driver fatigue and improving the overall vehicle performance" (answer, sentence bridging pages 3 and 4) also does not suffice. Also lacking is a clear and precise explanation of how the examiner's "modified" White system, whatever that may be, would satisfy each and every element of, for example, claim 1. It is therefore our conclusion that the examiner has not met his initial burden of establishing that White presents a *prima facie* case of obviousness with regard to the subject matter of independent claim 1. This constitutes a first reason necessitating reversal of the examiner's rejection of claims 1, 4, 6, 8 and 9.

In addition, we see the requirement of claim 1 that the control computer is responsive to the second switch position to *inhibit execution of said software algorithm such that said number of automatically selectable gear ratios are manually selectable* as being a difference between the system of claim 1 and the system of White. The examiner's assertion (answer, page 6, last line) that this is taught by White at columns 5 and 7-12

Appeal No. 2001-0034
Application 08/944,807

is simply too broad to be informative as to where White teaches this mode of operation. Contrary to the examiner, we read White in the same manner as appellants as providing only for automatic shifting of automatically selectable gear ratios. Support for this position is found in White at, for example, column 5, line 64, through column 6, line 4; column 6, lines 19-32; column 6, lines 39-50; and column 8, lines 25-33. In that we are unaware of any teaching or suggestion in White of inhibiting execution of the software algorithm such that the automatically selectable gear ratios are manually selectable as called for in claim 1, and in that the examiner has failed to direct us as to where any such teaching or suggestion might be found in White, we must agree with appellants that this claimed feature is not taught or suggested by White. This constitutes an additional reason necessitating reversal of the examiner's rejection of the claims 1, 4, 6, 8 and 9.

Appeal No. 2001-0034
Application 08/944,807

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

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Appeal No. 2001-0034
Application 08/944,807

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