

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS MARK LOUZON, JOSE FELIPE PELAEZ,
and KEVIN MICHAEL ALLEN

Appeal No. 2001-0609
Application No. 08/903,484

ON BRIEF

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

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claim 16. Claims 1 through 11, 13 through 15 and 18 through 22 stand allowed. Claim 17, the only other claim remaining in the application, has been objected to and indicated by the examiner to be allowable if rewritten in independent form. Claim 12 has been canceled.

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As noted on page 2 of the specification, appellants' invention relates to an output bearing assembly for a transmission in which a pair of output bearings are spaced apart and at least one speedometer sensor is mounted between the bearings. See Figure 1B of the application drawings. Appellants indicate that such an arrangement with the speedometer sensor between the bearings allows the bearings to be separated by a greater distance than in the prior art without any necessary increase in the total length of the transmission. The increase in distance between the bearings of the output bearing assembly is also said to be advantageous in that it reduces radial displacement of the output shaft. A copy of independent claim 16 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 claim is:

Dougherty '358
27, 1996

5,494,358

Feb.

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Claim 16 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over applicants' prior art Figure 1A in view of Dougherty '358.

Rather than reiterate the examiner's statement of the above-noted rejection and the conflicting viewpoints advanced by the examiner and appellants regarding the rejection, we make reference to the Office action mailed September 22, 1999 (Paper No. 10, the final rejection) and the examiner's answer (Paper No. 23, mailed October 25, 2000) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 21, filed September 1, 2000) and reply brief (Paper No. 25, filed December 27, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claim 16, to the applied prior art, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the

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examiner's above-noted rejection will not be sustained. Our reasons follow.

After having reviewed appellants' prior art Figure 1A and the associated disclosure at pages 1 and 4 of the specification and the patent to Dougherty, we are of the opinion that there is no teaching, suggestion or incentive in Dougherty '358, or otherwise specified by the examiner, which would have led one of ordinary skill in the art at the time of appellants' invention to modify the transmission in Figure 1A or, more specifically, the output bearing assembly and speed sensor arrangement thereof in the manner urged by the examiner. The examiner's assertion (final rejection, page 3) that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to provide the Figure 1A prior art transmission with a speed sensor mounted axially between a pair of tapered bearings in view of the teachings of Dougherty '358 so as to prevent contamination, assumes a problem with the transmission of Figure 1A that the evidence of record does not suggest exists. Nothing in this record provides any indication that contamination of the

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output bearing assembly or speedometer sensor arrangement in the prior art transmission was a problem. Thus, we do not see that the teachings of Dougherty '358 regarding preventing contamination with respect to a speed sensor of an antilock brake system (col. 1, lines 53-57) or the bearing assembly for mounting a road wheel of an automotive vehicle provides any reason, suggestion or motivation for attempting a modification of the transmission seen in appellants' Figure 1A.

In regard to the foregoing, we note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1264, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). In this case, like appellants, we consider that the modification of the transmission in Figure 1A of appellants' application urged by the examiner is merely a hindsight reconstruction based on the impermissible use of appellants' own disclosure and teachings as a blueprint

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for piecing together the relied upon prior art. In that regard, we are in general agreement with appellants' arguments as presented in their brief at page 3. Thus, we will not sustain the examiner's rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Figure 1A of the present application taken in view of Dougherty '358.

In accordance with the foregoing, the decision of the examiner rejecting claim 16 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
)

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JOHN P. MCQUADE
Administrative Patent Judge

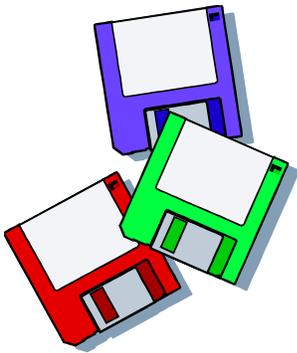
JEFFREY V. NASE
Administrative Patent Judge

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DECISION: REVERSED

Prepared: September 23, 2002

Draft Final

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PALM / ACTS 2 / BOOK

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