

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL J. O'BRIEN, GEORGE C. YANG
and MICHAEL COLLINS

Appeal No. 2003-1723
Application 09/849,705

ON BRIEF

Before HAIRSTON, FRANKFORT, and STAAB, 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 8, all of the claims pending in this application. On page 2 of the answer, the examiner indicates that claims 4 through 6 are now "objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of

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the base claim and any intervening claims." Accordingly, the appeal as to claims 4 through 6 is dismissed, and only the examiner's rejection of claims 1 through 3, 7 and 8 remains for our consideration on appeal.

Appellants' invention is directed to a system for monitoring the operation of a heater (10) for heating oil used in lubricating the moving parts of a compressor (14). As noted on page 2 of the specification,

[T]he sensing is preferably accomplished by a transformer in combination with an amplifier providing a feedback signal to the programmed microprocessor. The transformer is installed in the line which carries the electrical current flowing through the resistance heater. The microprocessor checks for the presence of an appropriate voltage level from the amplifier. In the event that the voltage level is not above a threshold level, the microprocessor sends an alarm signal indicating that the crankcase heater is not operating properly.

Independent claim 1 is representative of the subject matter on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

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

Saunders et al. (Saunders)	4,307,775	Dec. 29, 1981
Schwecke	5,054,293	Oct. 8, 1991

Claims 1 through 3, 7 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schwecke in view of Saunders.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted § 103 rejection and the conflicting viewpoints advanced by appellants and the examiner regarding the rejection, we make reference to the final rejection (Paper No. 6, mailed October 4, 2002) and the examiner's answer (Paper No. 9, mailed March 24, 2003) for the reasoning in support of the rejection, and to appellants' brief (Paper No. 8, filed February 11, 2003) 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

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articulated by appellants and the examiner. As a consequence of our review, we have made the determination that the above-noted § 103 rejection will not be sustained. Our reasons follow.

In the rejection of claims 1 through 3, 7 and 8 under 35 U.S.C. § 103(a) based on the combined teachings of Schwecke and Saunders, the examiner urges (final rejection, page 2) that Schwecke discloses the invention "substantially as claimed," noting only that Schwecke discloses a system for stopping the compressor of a refrigeration system/heat pump when the oil heater (36) of the compressor fails to operate. Although failing to identify any specific differences between the system of Schwecke and appellants' claimed subject matter, the examiner next points to Saunders and observes that this patent teaches use of a transformer (14) in a heating element circuit in order to monitor the failure of the heater to operate. Following such observation, the examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of appellants' invention to have modified the system of Schwecke "such that it included the use of a transformer in the oil heater circuit in order to monitor the failure of the heater in view of the teachings of Saunders" (final rejection, page 3). However,

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on page 3 of the answer, the examiner belatedly puts forth the somewhat different view that Saunders is not applied in order to provide an additional current sensor to the system of Schwecke, but rather to replace the heater failure circuit taught in Schwecke with a transformer current sensor arrangement like that in Saunders.

Appellants argue, and we strongly agree, that the examiner's attempted combination of the disparate systems of Schwecke and Saunders is merely an exercise in hindsight reconstruction of the claimed invention based on appellants' own teachings. In that regard, we note, as our court of review indicated in In re Fritch, 972 F.2D 1260, 1266, 23 USPQ2d 1780 (Fed. Cir. 1992), that it is impermissible for the examiner 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.

In the present case, while appellants and Schwecke are attempting to solve the same general problem of protecting a compressor operating in a refrigeration device/heat pump from damage due to failure of the heater for maintaining lubricating

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oil contained in a crankcase of the compressor at a predetermined temperature, they each solve that problem in an entirely different way. Saunders, on the other hand, is concerned with the larger problem of protecting a temperature conditioning system as a whole and detecting and indicating the failure of one or more of the main devices of the system (Figs. 1-3) and then locking out operation of such one or more failed devices, as well as de-energizing other devices which are dependent on the continued operation of the failed one or more devices. Saunders makes no mention of protecting a compressor operating in a refrigeration device/heat pump from damage due to failure of a heater for maintaining lubricating oil contained in a crankcase of the compressor at a predetermined temperature and, in our view, provides no teaching or suggestion of modifying such a compressor/oil heater system.

In that regard, we additionally note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such a modification obvious unless the prior art suggested the desirability of the modification. See, for example, In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this case, it is our opinion that the

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prior art does not contain such a suggestion and that the examiner has impermissibly drawn from appellants' own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Since we have determined that the teachings and suggestions found in Schwecke and Saunders would not have made the subject matter as a whole of independent claim 1 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 that claim under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2, 3, 7 and 8 under 35 U.S.C. § 103(a) on the basis of the combined teachings of Schwecke and Saunders will likewise not be sustained.

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Accordingly, the decision of the examiner to reject claims 1 through 3, 7 and 8 of the present application under 35 U.S.C. § 103(a) is reversed.

REVERSED

KENNETH W. HAIRSTON)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
CHARLES E. FRANKFORT)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
LAWRENCE J. STAAB)	
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