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for publication and is not binding precedent of the Board.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. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte Ralph W. Baxter JR.

Appeal No. 2004-1076
Application No. 09/684,893

HEARD: July 13, 2004

Before ABRAMS, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1, 6 and 7. The rejection of claims 2, 4 and 5, the only other claims pending in this application, was withdrawn by the examiner in the answer.

We REVERSE.

BACKGROUND

The appellant's invention relates to an oil pan and transfer case housing assembly (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

Claims 1, 6 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Japanese Published Unexamined Patent Application No. 03-043626 to Kondoo et al.[1] (Kondoo) in view of U.S. Patent No. 5,941,136 to Kusukawa et al.[2] (Kusukawa).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the answer (Paper No. 16, mailed September 9, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed February 13, 2003) and reply brief (Paper No. 18, filed November 10, 2003) for the appellant's arguments thereagainst.

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[1] Published February 25, 1991. In determining the teachings of Kondoo, we will rely on the translation of record provided by the USPTO.

[2] Issued August 24, 1999.

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 (Kondoo and Kusukawa), and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1, 6 and 7 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Kondoo discloses a transfer case integrally formed with an oil pan to increase hardness by which the number of intrinsic vibrations is increased. Kusukawa discloses,

at best, a conventional oil pan and a transfer case completely separate from the oil pan. Kusukawa's transfer case 40 comprises a case body 40a integrally connected with a transmission case 26c, a side case 40c integrally connected with the case body 40a through an adapter 40b by means of connecting bolts 41a and a rear case 40d integrally connected with the case body 40a by means of connecting bolts 41b.

In the rejection before us in this appeal, the examiner concluded (answer, p. 3) that it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the transfer case of Kondoo with "a first transfer case housing portion and a second transfer case housing portion as in order to ensure a clearance with respect to adjacent apparatus and to further improve the sealing performance of the structural case as taught by Kusukawa et al (col. 7 lines 27-34)."

In our view, the combined teachings of Kondoo and Kusukawa would not have made it obvious at the time the invention was made to a person of ordinary skill in the art to have arrived at the subject matter of claims 1, 6 and 7. The applied prior art fails to disclose or suggest an engine oil pan unitarily formed with a first transfer case housing portion adapted to be secured to a second transfer case housing portion wherein the first and second transfer case housing portions combine to form a complete transfer case housing. The applied prior art is devoid of any engine oil pan integrally

formed with a portion of a transfer case housing apart from a separate second transfer case housing portion which together are connected to form a complete housing. The unitary arrangement of Kondoo eliminates the ability to separately install the engine oil pan and the transfer case assembly, a noted benefit of the appellant's invention. The teachings of Kusukawa provide no motivation or suggestion for a person of ordinary skill in the art to have modified the unitary arrangement of Kondoo to have arrived at the subject matter of claims 1, 6 and 7. In our view, the only suggestion for modifying Kondoo in the manner proposed by the examiner to arrive at the claimed invention stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

For the reasons set forth above, the decision of the examiner to reject claims 1, 6 and 7 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 6 and 7 under 35 U.S.C. § 103 is reversed.

REVERSED

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

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