

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte FRANK HOLM IVERSEN
and
PREBEN BJERRE

Appeal No. 2005-0341
Application No. 09/977,409

ON BRIEF

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

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 10, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellants' invention relates to a piston compressor, particularly a hermetically enclosed refrigerant compressor (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

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

Nikolaus	4,856,366	Aug. 15, 1989
Bushnell	6,024,548	Feb. 15, 2000

Claims 1 to 3 and 5 to 10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Nikolaus.

Claim 4 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nikolaus in view of Bushnell.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the final rejection (mailed January 30, 2004) and the answer (mailed June 15, 2004) for the

examiner's complete reasoning in support of the rejections, and to the brief (filed April 28, 2004) for the appellants' arguments thereagainst.

OPINION

Initially we note that the issue of whether the amendment to Figure 3 adds new subject matter relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review the issue raised by the appellants on pages 4 and 8-10 of the brief.

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants 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 to 10 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).

Claim 1, the only independent claim on appeal, reads as follows:

A hermetically enclosed refrigerant compressor comprising:
a compressor block having a bore extending therethrough;
a crank shaft positioned for rotation in the bore, the crank shaft defining an eccentric crank pin at one end thereof;
the crank shaft and crank pin cooperating to define an oil channel arrangement;
a connecting rod attached at one end to a bearing element such that there is no relative motion between the bearing element and the connecting rod, the connecting rod having a passage extending therethrough and in communication with a channel formed by the cooperation of the connecting rod and the bearing element the channel extending completely around a circumference of the bearing element;
the crank pin extending into the bearing element and being positioned for rotation relative thereto; and
a control arrangement providing communication between the channel and the oil channel arrangement, at least once per revolution of the crank pin.

In the final rejection (pp. 3-4), the examiner (1) set forth the pertinent teachings of Nikolaus; (2) ascertained¹ that Nikolaus fails to show the channel extending completely around a circumference of the bearing element; and (3) determined that:

It would have been obvious to modify the limited channel of Nikolaus by having the channel extend completely around the circumference, since applicant has not disclosed that having the channel extend completely around the circumference solves any stated problem or is for any particular purpose and since applicant disclosed that "(the) oil channel does not have to extend over the whole circumference" on page 11, lines 28-29, it appears that the oil distribution would perform equally well with the channel extended at any length as long as the channel connects two ports.

The appellants argue that the applied prior art does not suggest extending the limited channel of Nikolaus completely around the circumference of the bearing element. We agree. The limitation that the channel extends completely around the circumference of the bearing element is not suggested by the applied prior art. In that regard, while Nikolaus does teach a channel which extends partially around the circumference of the bearing element, Nikolaus does not teach or suggest using a channel which extends completely around the circumference of the bearing element. To supply this omission in the teachings of Nikolaus, the examiner made the determination quoted above that this difference would have been obvious to an artisan.

¹After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

However, this determination has not been supported by any evidence that would have led an artisan to arrive at the claimed invention. Under 35 U.S.C. § 103, the examiner must establish why it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have modified Nikolaus to arrive at the claimed subject matter. This the examiner has not done. Instead, the examiner determined that the appellants had not disclosed that having the channel extend completely around the circumference solves any stated problem or is for any particular purpose, and therefore not a patentable difference. Such is not the standard under 35 U.S.C. § 103.

In our view, the only possible suggestion for modifying Nikolaus in the manner proposed by the examiner to meet the above-noted limitation stems from hindsight knowledge derived from the appellants' own disclosure. In fact, the examiner's reference to the appellants' specification in the obviousness determination quoted above makes it clear to us that the examiner has relied on hindsight knowledge derived from the appellants' 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 claim 1, and claims 2 to 10 dependent thereon, under 35 U.S.C. § 103 is reversed.²

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 10 under 35 U.S.C. § 103 is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
JEFFREY V. NASE)	
Administrative Patent Judge)	

²We have also reviewed the reference to Bushnell additionally applied in the rejection of claim 4 but find nothing therein which makes up for the deficiencies of Nikolaus discussed above regarding claim 1.

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