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for publication and is not binding precedent of the Board.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 NAOYO ISODA
and
MASAHIKO ENOYOSHI

Appeal No. 2005-2289
Application No. 10/064,508

HEARD: October 19, 2005

Before NASE, CRAWFORD, and BAHR, 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 9 and 11. Claims 10 and 12 to 20, which are the only other claims pending in this application, have been objected to as depending from a non-allowed claim.

We AFFIRM.

BACKGROUND

The appellants' invention relates to an engine control method and engine control structure for a vehicle and more particularly to an improved engine control that prevents unwanted transmission action such as clutch chatter (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

Claims 1, 5, 7 to 9 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,681,239 to Toukura.

Claims 1, 5, 7 to 9 and 11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,343,586 to Muto et al. (Muto).

Claims 1 to 9 and 11 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,701,893 to Isoda et al. (Isoda).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (mailed March 28, 2005) for the examiner's complete reasoning in support of the

rejections, and to the brief (filed September 13, 2004) and reply brief (filed April 1, 2005) for the appellants' arguments thereagainst.

OPINION

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. As a consequence of our review, we make the determinations which follow.

The anticipation rejections

We will not sustain the rejection of claims 1, 5, 7 to 9 and 11 under 35 U.S.C. § 102(b) as being anticipated by Toukura. Likewise, we will not sustain the rejection of claims 1, 5, 7 to 9 and 11 under 35 U.S.C. § 102(e) as being anticipated by Muto.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the United States Patent and Trademark Office (USPTO). See In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.

1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). To meet this burden of establishing a prima facie case of anticipation, the examiner must explain how the rejected claims are anticipated by pointing out where all of the specific limitations recited in the rejected claims are found in the prior art relied upon in the rejection.

In this case, the examiner has not pointed out where all of the limitations of claims 1 and 11 (the independent claims on appeal) are found in either Toukura or Muto. We have reviewed the portions of Toukura and Muto cited to by the examiner but fail to find the following limitations: (1) detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive and will cause difficulties in the transmission system and restricting engine output if the degree of change in rotational state of a shaft is excessive as recited in claim 1 and (2) an engine control for detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive and will cause difficulties in the transmission system, and restricting engine output if the degree of change in rotational state of the shaft is excessive as recited in claim 11.

For the reasons set forth above, the examiner has not pointed out where all of the limitations recited in the rejected claims are found in the prior art relied upon in the rejections. Thus, the examiner has not met the burden of establishing a prima facie case of anticipation. Accordingly, the decision of the examiner to reject claims 1, 5, 7 to 9 and 11 under 35 U.S.C. § 102 as being anticipated by Toukura or Muto is reversed.

The obviousness-type double patenting rejection

We sustain the rejection of claims 1 to 9 and 11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of Isoda.

The examiner's basis for this rejection is set forth on page 8 of the answer as follows:

> Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim an engine control having an engine transmitting rotation to driven wheels through a transmission system and detecting during engine acceleration variations in the rotational state of the shaft if the degree of change in variation of the shaft is excessive and restricting an engine output if the change is excessive.

The appellants' argument against this rejection is set forth on page 7 of the brief as follows:

Now the rejection which appellants attorney takes the most offense will be discussed, that of obviousness type double patenting. Where such a rejection is heaped upon an art rejection, it would invite a challenger to the earlier patent to state that the art rejections apply to it. There can actually be no alternative. The MPEP has several sections that deal with full faith and credit, but they all refer to subsequent actions in the same case. However it is submitted that the same should apply here. Assuming, however, that the Board, as appellants hope, will reverse those art rejections on their merits, appellants will discuss this ground of rejection. It is admitted that the method and apparatus here utilizes an inventive concept as disclosed in the earlier patent, that does not mean that other inventors of a common assignee can not make an invention in utilizing the same principle to solve a totally different problem. In fact most inventions apply previous features to solve different problems. This does not mean that all uses of the underlying principal are unpatentable.

The earlier patent relates to control of wheel slippage, but this [is] quite a different problem than transmission and specifically clutch control. However in that earlier case, the Examiner cited the art relied upon here and thus it is submitted that a rejection on art the earlier Examiner felt correctly was overcome itself should cause the Board to reverse the art rejections applied here.

Claim 10 of Isoda reads as follows:

A vehicle comprised of an internal combustion engine, a transmission driven by said engine, a driven wheel driven by said transmission, and an engine control comprised of a single sensor for detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive from the output of said single sensor, and restricting engine output if the degree of change in rotational state of said shaft is excessive.

Claim 11 on appeal reads as follows:

A vehicle comprised of an internal combustion engine, a transmission system driven by said engine, a driven wheel driven by said transmission system

> and an engine control for detecting during engine acceleration variations in the rotational state of a shaft, determining if the degree of change in rotational state variation is excessive and will cause difficulties in the transmission system, and restricting engine output if the degree of change in rotational state of said shaft is excessive.

Obviousness-type double patenting is a judge-made doctrine that prevents an unjustified extension of the patent right beyond the statutory time limit. It requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide an unjustified extension of the term of the right to exclude granted by a patent. In order to overcome an obviousness-type double patenting rejection, an applicant may file a "terminal disclaimer," foregoing that portion of the term of the second patent that extends beyond the term of the first. In re Berg, 140 F.3d 1428, 1431-32, 46 USPQ2d 1226, 1229 (Fed. Cir. 1998).

Thus, if a claim sought in the application is not identical to yet **not patentably distinct** from a claim in an inventor's earlier patent, then the claim must be rejected under obviousness-type double patenting rejection. See Berg, 140 F.3d at 1431, 46 USPQ2d at 1229; In re Braat, 937 F.2d 589, 592, 19 USPQ2d 1289, 1291-92 (Fed. Cir. 1991); In re Goodman, 11 F.3d 1046, 1052, 29 USPQ2d 2010, 2015 (Fed. Cir. 1993); In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). In determining

whether a claim sought in the application is **patentably distinct** from the claims in an inventor's earlier patent a variety of tests have been utilized. In Berg, 140 F.3d at 1433-34, 46 USPQ2d at 1230-31 and In re Emert, 124 F.3d 1458, 1461-62, 44 USPQ2d 1149, 1152 (Fed. Cir. 1997), a "one-way" test was applied. Under this "one-way" test, the examiner asks whether the application claims are obvious over the patent claims. In Goodman, 11 F.3d at 1052-53, 29 USPQ2d at 2015-16 and In re Van Ornum, 686 F.2d 937, 942-43, 214 USPQ 761, 766-67 (CCPA 1982), a test similar to the "one-way" test was applied. Under this test, the examiner asks whether the application claims are generic to any species set forth in the patent claims. In In re Dembiczak, 175 F.3d 994, 1002, 50 USPQ2d 1614, 1619-20 (Fed. Cir. 1999) and Braat, 937 F.2d at 593-94, 19 USPQ2d at 1292-93, a "two-way" test was applied. Under this "two-way" test, the examiner asks whether the application claims are obvious over the patent claims and also asks whether the patent claims are obvious over the application claims.

In our view, the examiner properly decided to apply the "one-way" test. Accordingly, the question then before us is whether application claim 11 is patentably distinct from claim 10 of Isoda. The appellants above-noted argument does not particularly point out why application claim 11 is patentably distinct from claim 10 of Isoda. In any event, our review of application claim 11 and claim 10 of Isoda leads us to

conclude that the examiner correctly determined that application claim 11 is not patentably distinct from claim 10 of Isoda for the reasons set forth by the examiner.

For the reasons set forth above, the decision of the examiner to reject claim 11 under the judicially created doctrine of obviousness-type double patenting is affirmed. The decision of the examiner to reject claims 1 to 9 is also affirmed since the appellants have not argued separately the patentability of any particular claim apart from the others, thus allowing claims 1 to 9 to fall with claim 11 (see In re Young, 927 F.2d 588, 590, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1, 5, 7 to 9 and 11 under 35 U.S.C. § 102(b) is reversed; the decision of the examiner to reject claims 1, 5, 7 to 9 and 11 under 35 U.S.C. § 102(e) is reversed; and the decision of the examiner to reject claims 1 to 9 and 11 under the judicially created doctrine of obviousness-type double patenting is affirmed.

Since at least one rejection of each of the appealed claims has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

JEFFREY V. NASE Administrative Patent Judge	)	
MURRIEL E. CRAWFORD Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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