

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

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

*Ex parte* DIETER HOETZER and MARTIN EISENHARDT

---

Appeal No. 2006-0448  
Application No. 10/432,753  
Technology Center 3600

---

ON BRIEF

---

Before GROSS, BAHR, and NAPPI, *Administrative Patent Judges*.  
GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 9 through 20 and 23 through 25. Claims 1 through 8 have been canceled, and claims 21 and 22 have been objected to by the examiner.

Appellants' invention relates to an electric machine coupled to an internal combustion engine, wherein the machine switches from an optimal efficiency operating state to a dynamically optimal operating state before operating procedures in the motor vehicle require a rapid torque setting. Claim 9 is illustrative of the claimed invention, and it reads as follows:

9. An electric machine coupled to an internal combustion engine in a motor vehicle, comprising:

a control device for specifying at least one of an optimal efficiency operating state and a dynamically optimal operating state for the electric machine; and

Appeal Number: 2006-0448  
Application Number: 10/432,753

means for switching over the usually-specified optimal efficiency operating state to the dynamically optimal operating state before operating procedures in the motor vehicle which require a rapid torque setting.

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

Boberg	US 5,959,420	Sep. 28, 1999
Henneken	US 6,263,273 B1	Jul. 17, 2001
Takaoka	EP 1 127 730 A1	Aug. 29, 2001

Claims 9, 10, 13, and 14 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Boberg.

Claims 9 through 12, 15 through 17, 19, 20, and 23 through 25 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Takaoka.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Takaoka in view of Henneken.

Reference is made to the Examiner's Answer (mailed July 22, 2005) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (filed June 13, 2005) and Reply Brief (filed September 26, 2005) for appellants' arguments thereagainst.

## OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellants and the examiner. As a consequence of our review, we will reverse the anticipation rejections of claims 9 through 17, 19, 20, and 23 through 25 and also reverse the obviousness rejection of claim 18.

As pointed out by appellants (Brief, page 10 and Reply Brief, page 4), independent claim 9 requires a means for switching from an optimal efficiency operating state to a dynamically optimal operating state "before operating procedures in the motor vehicle which require a rapid torque setting." Appellants assert (Brief, page 11) that in Boberg "there are no statements as to when such a switching should take place," and (Reply Brief, page 4) that nowhere did the Answer specifically address how the Boberg

reference identically describes (or even suggests) the claim 9 feature of means for switching over . . . before operating procedures in the motor vehicle which require a rapid torque setting.”

The examiner (Answer, page 4), in the statement of the rejection, paraphrases claim 9 and thereby asserts that Boberg teaches switching before operating procedures of the motor vehicle which require a rapid torque setting. However, the examiner fails to direct our attention to any particular passage of Boberg that would suggest this limitation. Further, in responding to appellants’ arguments (Answer, pages 7-10), the examiner explains how Boberg discloses a usually specified optimal efficiency operating state and a dynamically optimal operating state and a means for switching between the two states. However, we agree with appellants that the examiner never addresses the argument that Boberg fails to disclose the limitation of switching before operating procedures which require a rapid torque setting.

Boberg states (column 6, lines 21-26) that “when the vehicle is operated in an aggressive manner, as represented by the accelerator position APOS exceeding a predetermined value, the limits imposed on the rate of torque rise are reduced in order to provide the necessary torque response as required by the accelerator position APOS.” Thus, Boberg suggests that the switch to a dynamically optimal operating state occurs when, not before, a rapid torque setting is required. As we find no teaching in Boberg, and the examiner has pointed to none, that the switching from the optimal efficiency operating state to the dynamically optimal operating state is before operating procedures in the motor vehicle require a rapid torque setting, we cannot sustain the anticipation rejection of claim 9 or claims 10, 13, and 14, which depend therefrom, over Boberg.

With regard to Takaoka, again the examiner (Answer, page 5) repeats all of the words of claim 9, stating that Takaoka teaches the entire claim, without indicating where Takaoka discloses switching before a rapid torque setting is required. Appellants (Brief, page 14, and Reply Brief, pages 5, 6, and 8-10) argue that Takaoka fails to disclose switching before a rapid torque setting is required. In responding to appellants’ arguments (Answer, pages 10-13), the examiner explains how Takaoka discloses a usually specified optimal efficiency operating state and a dynamically optimal operating

state and a means for switching between the two states. However, again the examiner fails to address the limitation of switching before operating procedures which require a rapid torque setting.

Takaoka states (column 2, lines 38-42) that “[t]he drive controller is operable, in response to the command from the command generating unit, to control driving of the electric motor with the driving characteristic that exceeds the rated value for a limited period of time.” Takaoka further states (column 5, lines 26-35) that the electronic control unit 60 receives signals via the input port such as an accelerator position AP and “an ON/OFF signal received from a dash switch 76 for generating a command to produce high torque only for a short period of time.” However, we find no suggestion, and the examiner has pointed to none, that a switching to a dynamically optimal operating state occurs before operating procedures which require a rapid torque setting. Accordingly, we cannot sustain the anticipation rejection of claim 9 or the claims which depend therefrom, claims 10 through 12, 15 through 17, 19, 20, and 23 through 25, over Takaoka.

The examiner adds Henneken to the Takaoka to reject claim 18. As claim 18 includes all of the limitations of claim 9 and Henneken fails to cure the deficiencies of Takaoka regarding those limitations, we cannot sustain the obviousness rejection of claim 18 over Takaoka in view of Henneken.

Appeal Number: 2006-0448  
Application Number: 10/432,753

## CONCLUSION

The decision of the examiner rejecting claims 9 through 17, 19, 20, and 23 through 25 under 35 U.S.C. § 102(b) is reversed. The decision of the examiner rejecting claim 18 under 35 U.S.C. § 103 is reversed.

REVERSED

ANITA PELLMAN GROSS )  
Administrative Patent Judge )  
 )  
 )  
 )  
 )  
 )  
 ) BOARD OF PATENT  
JENNIFER D. BAHR ) APPEALS  
Administrative Patent Judge ) AND  
 ) INTERFERENCES  
 )  
 )  
 )  
 )  
ROBERT E. NAPPI )  
Administrative Patent Judge )

Appeal Number: 2006-0448  
Application Number: 10/432,753

KENYON & KENYON LLP  
ONE BROADWAY  
NEW YORK NY 10004

APG/ki