

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 DAVID CORBA

Appeal No. 2006-1770
Application No. 10/271,236
Technology Center 3700

ON BRIEF

Before OWENS, GROSS, and HORNER, *Administrative Patent Judges*.
GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 5 and 8 through 23. On page 2 of the Answer, the examiner states that appellant's arguments with respect to claims 14 through 19 and 21 are persuasive and that claims 14 through 19 are allowable and that claim 21 would be allowable if rewritten in independent form. We note, however, that the examiner maintains a rejection of claim 19 under 35 U.S.C. § 112, second paragraph. Accordingly, the claims remaining before us on appeal are claims 1 through 5, 8 through 13, 19, 20, 22, and 23.

Appellant's invention relates to an engine having an intercooler bypass for preventing air from flowing through the intercooler when an idle state for the engine is detected. Claim 1 is illustrative of the claimed invention, and it reads as follows:

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1. A method comprising the steps of:
 - detecting an idle condition for an engine; and
 - based on engine speed and load, inducing air to bypass an intercooler for the engine and preventing air from entering the intercooler such that air is input to an intake manifold of the engine through an intercooler bypass that excludes the intercooler.

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

Jenny	4,513,571	Apr. 30, 1985
Nakao	4,716,734	Jan. 05, 1988

Claims 10, 19, 20, and 23 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Claims 1 through 5, 8 through 11, 13, 20, 22, and 23 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nakao.

Claim 12 stands rejected under 35 U.S.C. § 103 as being unpatentable over Nakao in view of Jenny.

Reference is made to the Examiner's Answer (mailed August 26, 2005) for the examiner's complete reasoning in support of the rejections, and to appellant's Brief (filed June 30, 2005) and Reply Brief (filed October 31, 2005) for appellant's arguments thereagainst.

OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by appellant and the examiner. As a consequence of our review, we will reverse the indefiniteness rejection of claims 10, 19, 20, and 23, the anticipation rejection of claims 1 through 5, 8 through 11, 13, 20, 22, and 23, and the obviousness rejection of claim 12.

With regard to the rejection under 35 U.S.C. § 112, second paragraph, the examiner asserts (Answer, page 3) that in claims 10, 19, 20, and 23, it is unclear whether

the phrase “air temperature” refers to the temperature of ambient air, air leaving the compressor, or air in the engine intake manifold. We agree with appellant (Brief, page 11) that the phrase covers all types of air temperature and is, therefore, broad, not indefinite. Therefore, we cannot sustain the rejection of claims 10, 19, 20, and 23 under 35 U.S.C. § 112, second paragraph.

As to the anticipation rejection, appellant contends (Brief, pages 12-13, and Reply Brief, pages 2-3) that Nakao fails to disclose preventing air from entering the intercooler. Specifically, appellant indicates that in Figure 1 of Nakao, there is nothing to prevent air from flowing into the intercooler’s input, and in Figure 4 of Nakao, there is nothing to prevent air from flowing into the intercooler’s output. Accordingly, appellant concludes that Nakao does not anticipate claims 1 through 5, 8 through 11, 13, 20, 22, and 23.

The examiner (Answer, page 8) directs our attention to Nakao, column 7, lines 15-23, which states:

Under such a control for the air flow control valve **18** provided to the bypass channel **17**, the intake air introduced into the inlet channel **5** is supplied through the bypass channel **17** to the combustion chamber **4** *without passing through the intercooler **10*** on the occasion of the start of operation and during the idle operation. Accordingly, on the occasion of the start of operation and during the idle operation, *the intake air is not cooled by the intercooler **10**.* (Italics added for emphasis.)

The examiner relies on the above-noted passage as proof that Nakao’s engine prevents air from entering the intercooler, as recited in each of the independent claims.

We agree with the examiner that the text of the Nakao patent appears to substantiate the examiner’s assertion that Nakao discloses preventing air from passing through the intercooler. However, as pointed out by appellant, there is no structure disclosed in Nakao to support the statements relied upon by the examiner. There is nothing to prevent air from entering intercooler 10 through its input in Figure 1 or through its output in Figure 4 of Nakao. Accordingly, Nakao fails to satisfy all the limitations of each independent claim. Consequently, we cannot sustain the anticipation rejection of independent claims 1, 11, 20, and 22, nor of their dependents, claims 2 through 5, 8 through 10, 13, and 23.

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As to claim 12, we find no teaching or suggestion in Jenny, and the examiner has pointed to none, that would overcome the shortcomings of Nakao. Therefore, we cannot sustain the obviousness rejection of claim 12 over the combination of Nakao and Jenny.

CONCLUSION

The decision of the examiner rejecting claims 10, 19, 20, and 23 under 35 U.S.C. § 112, second paragraph, claims 1 through 5, 8 through 11, 13, 20, 22, and 23 under 35 U.S.C. § 102(b), and claim 12 under 35 U.S.C. § 103 is reversed.

REVERSED

TERRY J. OWENS)
Administrative Patent Judge)
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ANITA PELLMAN GROSS) BOARD OF PATENT
Administrative Patent Judge) APPEALS
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