

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.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 PER LANGE, KJELL ISAKSSON,
HAKAN FRANSSON, SIGVARD ORRE and RUNE WIDLUND

Appeal No. 97-0963
Application No. 08/439,515¹

ON BRIEF

Before FRANKFORT, NASE, and CRAWFORD, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 6 through 11.² Claim 12 has been allowed and claims 1 through 5 have been canceled.

¹ Application for patent filed May 11, 1995.

² Claims 6 and 7 have been amended subsequent to the final rejection.

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We REVERSE.

BACKGROUND

The appellants' invention relates to a combustion engine of the turbocompound type having an exhaust gas brake. An understanding of the invention can be derived from a reading of exemplary claim 6, which appears in the appendix to the appellants' brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Woon et al. (Woon) 5,142,868 Sept. 1, 1992

Claims 6 through 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Woon.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the final rejection (Paper No. 7, mailed December 26, 1995) and the examiner's answer (Paper No. 17, mailed August 23, 1996) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 16, filed July 26, 1996) 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 reference, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. See Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 633, 2 USPQ2d 1051, 1054 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming, but only that the claims on appeal "read

on" something disclosed in the reference (see Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984)).

The claims on appeal are all drawn to a combustion engine of the turbocompound type comprising, inter alia, a turbocharger turbine receiving exhaust gases from the engine, a power turbine receiving exhaust gases from the turbocharger turbine, and an exhaust gas brake throttle receiving exhaust gases from the power turbine. Independent claim 6 recites that the exhaust gas brake throttle is structured and arranged to selectively throttle the exhaust gases to brake the engine. Independent claim 7 and its dependent claims 8 to 11 recite that the exhaust gas brake throttle is operable to a closed position in which the exhaust gases are blocked from passing to an outlet to exhaust gas brake the engine.

Woon discloses a turbocompound engine with power turbine bypass control. As shown in Figure 1, the turbocompound engine 1 includes a supercharger turbine 6 receiving exhaust gases from the engine, a power turbine 8 receiving exhaust gases from the supercharger turbine 6, an exhaust passage 12, a bypass passage

14, and a valve 16 for directing exhaust gases from the supercharger turbine 6 to the exhaust passage 12 either through the power turbine 8 or through the bypass passage 14. As shown in Figure 2B, the valve 16 can be a flapper valve arranged downstream of the outlet of the power turbine.

The examiner concluded (final rejection, p. 2) that Woon structurally anticipated the appealed claims. Specifically, the examiner determined that the engine braking set forth in the claims is a functional and not a structural differentiation because the claims do not preclude a power turbine bypass. Thus, the examiner found that the braking recitations in the claims are merely recitations of a desired result which are not patentably limiting. We do not agree for the reasons set forth infra.

We agree with the appellants argument (brief, pp. 3-5) that Woon does not disclose the claimed exhaust gas brake throttle. The claims on appeal recite an engine having an exhaust gas brake throttle. An exhaust gas brake throttle is structure that an engine possesses that permits exhaust braking of the engine. The arrangement of Woon's bypass valve 16 shown in Figure 2B is not an exhaust gas brake throttle since that structure does not

permit exhaust braking of the engine as set forth by the appellants. Furthermore, it is our view that a power turbine bypass such as taught by Woon wherein the bypass would operate to prevent exhaust gas braking is precluded by the claims on appeal.

For the reasons set forth above, the decision of the examiner to reject claims 6 through 11 under 35 U.S.C. § 102(b) is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 6 through 11 under 35 U.S.C. § 102(b) is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JEFFREY V. NASE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

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APPLICATION NO. 08/439,515

APJ NASE

APJ CRAWFORD

APJ FRANKFORT

DECISION: **REVERSED**

Prepared By: Gloria Henderson

DRAFT TYPED: 14 Aug 98

FINAL TYPED: