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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
13/451,401	04/19/2012	Bert Pingen	83235241	6100
36865	7590	10/18/2017	EXAMINER	
MCCOY RUSSELL LLP 806 S.W. BROADWAY, SUITE 600 PORTLAND, OR 97205			AMICK, JACOB M	
			ART UNIT	PAPER NUMBER
			3747	
			MAIL DATE	DELIVERY MODE
			10/18/2017	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte BERT PINGEN, HANS GUENTER QUIX,
MICHAEL TOBERGTE, KAY HOHENBOEKEN, and JAN MEHRING

Appeal 2016-001153
Application 13/451,401
Technology Center 3700

Before MICHAEL C. ASTORINO, BRADLEY B. BAYAT, and
AMEE A. SHAH, *Administrative Patent Judges*.

SHAH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

The Appellants² appeal under 35 U.S.C. § 134(a) from the Examiner’s final decision rejecting claims 1–13 and 15–21. We have jurisdiction under 35 U.S.C. § 6(b). The Appellants’ representative appeared for oral hearing in this appeal on October 10, 2017. We REVERSE.

¹ Throughout this opinion, we refer to the Appellants’ Appeal Brief (“Appeal Br.,” filed Mar. 23, 2015), Reply Brief (“Reply Br.,” filed Oct. 28, 2015), and Specification (“Spec.,” filed Apr. 19, 2012), and to the Examiner’s Answer (“Ans.,” mailed Aug. 28, 2015) and Final Office Action (“Final Act.,” mailed Oct. 22, 2014).

² According to the Appellants, the real party in interest is Ford Global Technologies, LLC. Appeal Br. 3.

STATEMENT OF THE CASE

The Appellants' invention relates to "a method for operation of a lubrication circuit in an internal combustion engine." Spec. 2, ll. 10–11.

Claims 1, 9, and 20 are the independent claims on appeal. Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A method for operating a lubrication circuit, comprising:

during a first operating condition, operating a hydrodynamic retarder including two rotationally symmetrical and opposing vane wheels to mechanically increase a turbulence of oil in the lubrication circuit, the hydrodynamic retarder positioned upstream of cylinder block lubricant-receiving components and downstream of an oil pump in a supply line, the circuit, including the pump, hydrodynamic retarder, and components positioned in an internal combustion engine.

Appeal Br. 22 (Claims App.).

REJECTIONS ON APPEAL

Claims 1–3, 5–7, 9–13, 15–19, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Christiansen (GB 750,037, iss. June 6, 1956) and Lo (US 2005/0235760 A1, pub. Oct. 27, 2005). Final Act. 2.

Claims 4 and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Christiansen, Lo,³ and Ruf (US 4,114,571, iss. Sept. 19, 1978). *Id.* at 10.

Claim 20 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Christiansen and Ruf. *Id.*

³ Although the Examiner states the claims are rejected as unpatentable over Christiansen and Ruf (Final Act. 10), claims 4 and 8 depend from claim 1 and are thus understood as unpatentable over Christiansen, Lo, and Ruf.

ANALYSIS

The Appellants contend that the Examiner’s rejections of the independent claims 1, 9, and 20 are in error because the prior art does not teach that the elements, i.e., the pump, hydrodynamic retarder, and component(s), are positioned in the engine, as required by the claims. *See* Appeal Br. 9–12, 16, 19. We agree.

The Examiner relies on Christiansen for this limitation and finds, in relevant part, that Christiansen teaches “the circuit, including an oil pump, hydrodynamic retarder, and lubricant-receiving components positioned in an internal combustion engine,” as recited in claim 1 and similarly recited in claims 9 and 20. Final Act. 3; *see also id.* at 6, 12. Specifically, the Examiner finds that “[a]ll the components of Christiansen are part of and operate together to form an engine. All said components of [sic] are considered to be ‘positioned in’ the internal combustion engine of Christiansen, as generally claimed.” *Id.* As such, the Examiner considers that being within the same engine system corresponds to being “in an internal combustion engine,” as claimed. *Id.*; *see also* Ans. 15–16.

However, we find persuasive the Appellants’ argument that Christiansen’s engine system is not equivalent to the claimed internal combustion engine within which the components are positioned. *See* Appeal Br. 10–12. The Specification provides for “an oil circuit 1 in an internal combustion engine 50.” Spec. 3, ll. 14–15. Circuit 1 comprises head oil circuit 1a, block oil circuit 1b, and oil sump 1c. *Id.* at 3, ll. 17–19. Figure 1 depicts engine 50 as a box within which are the connected circuits 1a and 1c, hydrodynamic retarder 12, cylinder block lubricant-receiving components 5, oil pump 2, and supply line 4. Thus, we agree with the Appellants that the

Specification and the “explicit wording” of the claim require that the components be “entirely therewithin” the internal combustion engine, and not simply within the system. Appeal Br. 10.

Christiansen discloses “a main internal combustion engine 1 to the casing of which is connected an oil-conveying conduit 2.” Christiansen 1, ll. 70–73. Conduit 2 comprises valve 3, which is opened and connected to conduit 4 and device 5, i.e., a pump, dynamometer, or brake, which is driven by an auxiliary motor, separate from the main engine. *See id.* at 1, ll. 73–82, Fig. 1. As such, we find persuasive the Appellants’ argument that Christiansen does not teach that the claimed components are positioned within the combustion engine. *See* Appeal Br. 11.

Therefore, we are persuaded that the Examiner erred in the rejections of independent claims 1, 9, and 20 under 35 U.S.C. § 103, and we do not sustain the rejections. For the same reasons, we also do not sustain the Examiner’s rejections of dependent claims 2–8, 10–13, 15–19, and 21, for which the Examiner relies on the same erroneous finding regarding Christiansen.

DECISION

The Examiner’s rejections of claims 1–13 and 15–21 under 35 U.S.C. § 103(a) are REVERSED.

REVERSED