Paper No. 20

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAAKI YOSHIKAWA

Appeal No. 98-1604
Application 08/354,539[1]

HEARD: JULY 15, 1998

Before McCANDLISH, ***Senior Administrative Patent Judge***, and MEISTER and STAAB, ***Administrative Patent Judges***.

MEISTER, ***Administrative Patent Judge***.

DECISION ON APPEAL

Masaaki Yoshikawa (the appellant) appeals from the final rejection of claims 16 and 18-40.[2] Claims 1-15 and 41-55, the only other claims present in the application, have been withdrawn

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[1] Application for patent filed December 13, 1994. According to appellant, this application is a continuation-in-part of Application 08/197,610, filed February 17, 1994.

[2] Claims 16 and 18 have been amended subsequent to final rejection.

from further consideration under the provisions of 37 CFR § 1.142(b) as be directed to a nonelected invention.

We REVERSE.

The appellant's invention pertains to an internal combustion engine. Independent claim 16 is further illustrative of the appealed subject matter and a copy thereof may be found in the appendix to the appellant's brief.[3]

The references relied on by the examiner are:

Ascari	5,095,858	Mar. 17, 1992
Yamada	5,099,812	Mar. 31, 1992
Toyoichi et al. (Japanese abstract)[4]	61190147	Aug. 23, 1986

[3] Although correct in the copy of claim 16 as it appears in the appendix to the brief, we observe that in the penultimate line of claim 16 (as it appears in the amendment filed March 31, 1997 (Paper No. 10)) "porting" should be --point--. At oral hearing, the appellant's counsel stated that in line 12 of claim 16 (as it appears in the appendix to the appellant's brief) "second plane" should be --first plane--. These obvious errors should be corrected.

[4] The examiner failed to include this reference in the listing of prior art in the answer. In the rejection of claim 26, wherein this reference is relied on, the examiner simply refers to it as "Japanese Patent publication no. JP 61190147 to Toyoichi et al." (as though it were the complete document). We observe, however, no Japanese ***document in its entirety*** has ever been made of record. The only "Toyoichi" of record is the ***abstract*** of this document, which was cited in the European search report submitted by the appellant in the information disclosure statement filed on August 11, 1995 (Paper No. 2). Accordingly, we presume the examiner intended to rely on this abstract.

Claims 16, 18, 20-24, 27-32 and 34-40 stand rejected under "the judicially created doctrine of double patenting" over claims 1-21 of the appellant's copending application Serial No. 08/197,610.[5]

Claims 16, 18-25 and 27-40 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamada in view of Ascari.

Claim 26 stands rejected under 35 U.S.C. § 103 as being unpatentable over Yamada in view of Ascari and Japanese abstract.

The rejection based on double patenting is explained on pages 2 and 3 of the final rejection.[6] The rejections under § 103 are explained on pages 4-6 of the answer. The arguments of the appellant and examiner in support of their respective positions may be found on pages 4-8 of the brief and pages 6 and 7 of the answer.

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[5] The examiner failed to include this rejection in the listing of the grounds of rejection which are "applicable" to the appealed claims in the answer, it appears from the examiner's comments in the paragraph bridging pages 2 and 3 of the answer, that the examiner did not intend to withdraw the final rejection of claims 16, 18, 20-24, 27-32 and 34-40 on this ground. Although not stated to be such, it is apparent that this is a provisional rejection.

[6] Although it is not entirely clear from the examiner's cryptic explanation, the examiner appears to have intended that the rejection be a provisional obviousness-type double patenting rejection (as distinguished from a provisional statutory double patenting rejection).

OPINION

We have carefully reviewed the appellant's invention as described in the specification, the appealed claims, the prior art applied by the examiner and the respective positions advanced by the appellant in the brief and by the examiner in the answer. As a consequence of this review, we will not sustain any of the above-noted rejections.

Considering first the provisional rejection of claims 16, 18, 20-24, 27-32 and 34-40 under "the judicially created doctrine of double patenting" over claims 1-21 of the appellant's copending application Serial No. 08/197,610, the appeal of claims 1-21 in that application has been dismissed. This being the case, the question of double patenting is moot and, accordingly, this rejection cannot be sustained.

We now turn to the rejections under 35 U.S.C. § 103 of claims 16, 18-25 and 27-40 as being unpatentable over Yamada in view of Ascari and claim 26 as being unpatentable over Yamada in view of Ascari and Japanese abstract. We initially note that in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. ***In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993); ***In re Oetiker***, 977 F.2d 1443, 1445, 24 USPQ2d 1443,

1444 (Fed. Cir. 1992). Only if that burden is met does the burden of coming forward with evidence or argument shift to the applicant. ***Id***. If the examiner fails to establish a ***prima facie*** case, the rejection is improper and will be overturned. ***In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Here, independent claim 16 expressly requires that the reciprocal axes of the poppet valves (which lie at acute angles with respect to both the first and second planes) intersect the first plane

> at a point below the bottom dead center position of said piston so that the flow into said cylinder bore from said side intake valve seats does not interfere.

The examiner recognizes that none of the relied on references teaches or suggests such an arrangement but, nevertheless, takes the position that "this angle of inclination is an obvious matter of design choice dictated by space constraints and desired flow direction" (answer, page 6). However, as stated on page 2 of the appellant's specification, the claimed arrangement overcomes the prior art problem of "interfering turbulence." Inasmuch as the claimed arrangement solves a stated problem compared with prior art arrangements, we do not believe it can be dismissed as an obvious matter of design choice as the examiner proposes to do.

Cf. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975). Since the examiner has failed to provide a proper factual basis for reaching a conclusion for concluding that the above-noted limitation would have been obvious (***see In re Fine, supra***), we will not sustain the rejections of claims 16 and 18-40 under 35 U.S.C. § 103.

The examiner's rejections are all reversed.

REVERSED

HARRISON E. MCCANDLISH, Senior Administrative Patent Judge	)	
JAMES M. MEISTER Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)	

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