



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

Table with 5 columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO.
13/680,968 11/19/2012 Marie Roell Van Drueten 007938.00185 9881

115800 7590 11/23/2016
Banner & Witcoff, LTD
and attorneys for client 007938
1100 13th Street NW
Suite 1200
Washington, DC 20005

EXAMINER

BISHOP, ERIN D

ART UNIT PAPER NUMBER

3655

NOTIFICATION DATE DELIVERY MODE

11/23/2016

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO-115800@bannerwitcoff.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MARIE ROELL VAN DRUTEN,
ALEXANDER FRANCISCUS ANITA SERRARENS, and
BAS GERARD VROEMEN

Appeal 2015-001493
Application 13/680,968
Technology Center 3600

Before JENNIFER D. BAHR, LINDA E. HORNER, and
BRANDON J. WARNER, *Administrative Patent Judges*.

HORNER, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Marie Roell Van Druten et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Examiner's decision rejecting claims 1–11 and 14–20, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellants' claimed subject matter "relates to a transmission for an electric or hybrid drive mechanism." Spec. 1, ll. 15–16. Claims 1, 4, and 16 are independent. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A transmission for an electric or hybrid drive mechanism, said transmission having an input which can be connected to an electromotor/generator, and an output which can be connected to a load, said transmission comprises a first planetary gear set comprising at least three rotational members formed by a sun gear, a carrier on which planet gears are present and an annulus gear, of which first planetary gear set a first rotational member is connected to the input, a second rotational member is connected to the output and a third rotational member is connected to a first brake, and a second planetary gear set comprising at least three rotational members of which second planetary gear set a first rotational member is connected to the input, a second rotational member is connected to the output and a third rotational member is connected to a second brake, wherein the first brake is arranged as a friction brake and the second brake is arranged as a dog clutch having two parts of which one part is connected to a fixed housing.

EVIDENCE

The Examiner relied upon the following evidence:

Klemen	US 2007/0072723 A1	Mar. 29, 2007
Tabata	US 2009/0098969 A1	Apr. 16, 2009

REJECTIONS

Appellants appeal from the Final Action, dated February 12, 2014 (“Final Act.”), which includes the following rejections:

1. Claims 1–11 and 14–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.¹
2. Claims 1–11 and 14–20 under 35 U.S.C. § 112, second paragraph, as indefinite.
3. Claim 11 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form.
4. Claims 1–11 and 14–20 under 35 U.S.C. § 103(a) as unpatentable over Klemen and Tabata.

ANALYSIS

First, Second, and Third Grounds of Rejection

Appellants do not present any arguments contesting the Examiner’s first, second, and third grounds of rejection under 35 U.S.C. § 112 of claims 1–11 and 14–20. Ans. 3–6; Br., *passim* (presenting arguments only as to the rejection under 35 U.S.C. § 103(a), and as to the withdrawn basis for the

¹ The Examiner withdraws one basis of the rejection of claims 1–11 and 14–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. *See* Ans. 11–12 (the Examiner withdrawing the ground of rejection regarding the recitation of “a dog clutch” in independent claims 1, 4, and 16). The Examiner maintains additional bases of the rejection of claims 1–11 and 14–20 under 35 U.S.C. § 112, first paragraph. *See id.* 3–4 (stating grounds of rejection regarding the recitation of “consisting of” in claim 1 and “a combined planetary gear set comprising at least four rotational members” in claims 4 and 16).

written description rejection under 35 U.S.C. § 112, first paragraph).² Accordingly, we summarily sustain the rejections of: claims 1–11 and 14–20 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1–11 and 14–20 under 35 U.S.C. § 112, second paragraph, as indefinite; and claim 11 under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form.

Fourth Ground of Rejection: Obviousness

Appellants argue the claims subject to the fourth ground of rejection as a group. Br. 9–10. We select claim 1 as the representative claim, with claims 2–11 and 14–20 standing or falling with claim 1. *See* 37 C.F.R. § 41.37(c)(1)(iv).

The Examiner found that Klemen discloses a transmission for an electric or hybrid drive mechanism, substantially as claimed, including a first planetary gear set having a third rotational member (sun gear 20) connected to a first brake (C3). Final Act. 7 (citing Klemen, Fig. 1). The Examiner also found that Klemen discloses:

[A] second planetary gear set comprising at least three rotational members of which second planetary gear set a first rotational member is connected to the input (e.g., right side of ring 22, fig. 1), a second rotational member is connected to the output (e.g., right side of carrier 24, fig. 1) and a third rotational member is connected to a second brake (e.g., sun 28 connected to brake C6, fig. 1), wherein the first brake is arranged as a friction brake and the second brake is arranged as a brake having two parts of

² We note that the Appeal Brief does not include page numbers. For reference convenience, we designate the cover page of the Brief as page 1 and number the pages consecutively therefrom, including the Appendices.

which one part is connected to a fixed housing (e.g., both brakes function using friction, and both brakes lock up the member they are directly connected to, fig. 1).

Id. The Examiner acknowledged that Klemen does not disclose that the second brake is arranged as a dog clutch. *Id.* at 8. However, the Examiner found that Tabata “discloses a brake arranged as a dog clutch,” and determined that it would have been obvious to one of ordinary skill in the art at the time of the invention “to use a dog-type clutch as disclosed by Tabata . . . for the brake disclosed by Klemen . . . in order to yield the predictable result of clutching an element to the housing.” *Id.* (citing Tabata, para. 299).

Appellants argue that “Tabata does disclose a transmission having two planetary gear sets in parallel but a rotational member of only one of the planetary gear sets being connected to a brake.” Br. 10 (emphasis omitted). In particular, Appellants assert that “Tabata does not disclose . . . a rotational member of one of the planetary gear sets being connected to a friction brake and a rotational member of the other planetary gear set being connected to a dog clutch.” *Id.* (emphasis omitted). According to Appellants, paragraph 299 of Tabata does “not suggest[] that the brakes and clutches can be of differ[ent] type (form fitting clutches and force fitting clutches).” *Id.*

Appellants’ argument as to Tabata is not persuasive because it fails to address the Examiner’s rejection as presented, which is based on a determination of what would have been obvious to one of ordinary skill in the art in view of the combined teachings of the prior art. Final Act. 7–8. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *See In re*

Appeal 2015-001493
Application 13/680,968

Merck & Co., 800 F.2d 1091, 1097 (Fed. Cir. 1986) (citing *In re Keller*, 642 F.2d 413, 425 (CCPA 1981)). As discussed *supra*, the Examiner relied on Klemen for disclosing a transmission having first and second planetary gear sets, wherein each planetary gear set includes a third rotational member connected to a corresponding brake. Final Act. 7. The Examiner relied on Tabata for disclosing a brake arranged as a dog clutch. *Id.* at 8; *see also* Ans. 12–13 (the Examiner explaining that Tabata discloses “that frictional engaging devices may be replaced by a plurality of clutch types, including a mechanical type clutch and a meshing type dog clutch”). Appellants’ argument does not address the Examiner’s determination that it would have been obvious to one of ordinary skill in the art to use a dog clutch for a brake in Klemen “in order to yield the predictable result of clutching an element to the housing.” Final Act. 8; *see also* Ans. 13 (the Examiner explaining that “it is well within the grasp of one of ordinary skill in the art to select the most appropriate clutch type for any given clutch in a transmission,” and that “it is well within the grasp of a person of ordinary skill in the art to select any combination of clutch types based on the teaching of Tabata”). *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“when a patent [application] claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result”) (citing *United States v. Adams*, 383 U.S. 39, 50–51 (1966)).

Appellants do not contend that the proposed modification of Klemen to replace one of the friction brakes with the dog-type clutch of Tabata would lead to unpredictable results. Rather, Appellants argue that the

Appeal 2015-001493
Application 13/680,968

Examiner's proposed combination of Klemen and Tabata is improper because the "Examiner has cited no teaching/suggestion/motivation to make such a combination." Br. 10. Appellants also assert that, "even if one skilled in the art would make such a combination, than [sic] he would replace all friction brakes in Klemen with dog clutches as suggested in Tabata, and would not arrive at the unique combination taught in claim 1." *Id.*

Appellants' arguments are unpersuasive. The first argument urges us to apply a strict teaching, suggestion, or motivation (TSM) test for obviousness. Rigid application of the TSM test was explicitly disavowed by the Supreme Court in *KSR*, 550 U.S. at 419. The second argument does not address the Examiner's articulated reasoning as to why it would have been obvious to one of ordinary skill in the art to use a dog clutch, as taught by Tabata, as the second brake in Klemen's transmission. *See* Final Act. 8 (the Examiner determining that such a modification would "yield the predictable result of clutching an element to the housing"). Moreover, Appellants do not offer any evidence or technical explanation as to why one of ordinary skill in the art would necessarily have been led to replace all of Klemen's friction brakes with dog clutches in view of Tabata's disclosure. In this regard, Appellants' conclusory assertion is insufficient to persuade us of error in the Examiner's rejection. *See In re Pearson*, 494 F.2d 1399, 1404 (CCPA 1974) ("Attorney's argument in a brief cannot take the place of evidence") (citation omitted).

Appeal 2015-001493
Application 13/680,968

For the above reasons, we sustain the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as unpatentable over Klemen and Tabata. Claims 2–11 and 14–20 fall with claim 1.

DECISION

The decision of the Examiner to reject claims 1–11 and 14–20 is
AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED