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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SAMUEL BILLOT, MATHIAS FEIN, and
MARTIN MEZGER

Appeal 2018-006537
Application 14/130,312
Technology Center 2800

Before JEFFREY T. SMITH, JEFFREY B. ROBERTSON, and
MERRELL C. CASHION, JR., *Administrative Patent Judges*.

CASHION, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Pursuant to 35 U.S.C. § 134(a), Appellant¹ appeals from the Examiner's decision to reject claims 1–3, 6, 7, 10, 12–14, 16, and 18–22. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

The invention relates to “a shifting actuator, in particular a relay for an electric starter device for internal combustion engines.” Spec. ¶ 1. Claim 1 illustrates the subject matter claimed and is reproduced below:

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as SEG Automotive Germany GmbH. Appeal Br. 2.

1. A shifting actuator (16), comprising a casing (156), in which a movable armature (168) and an armature return element (171) are received, characterized in that the armature (168) is split into at least two armature parts (216, 218) and at least one damping element (220, 220a, 220b, 220c, 220d) is provided between the at least two armature parts (216, 218), wherein the at least one damping element (220, 220a, 220b, 220c, 220d) produces a fixed connection between a one (216) of the at least two armature parts (216, 218) and an other (218) of the at least two armature parts (216, 218), and wherein the one (216) of the at least two armature parts (216, 218) has a cylindrical recess (224) extending from an end face of the armature (168), and the recess (224) has a length at least equal to a length of a pull-in winding (162) or a hold-in winding (165).

The Examiner maintains the following rejections from the Examiner's Final Office Action dated August 17, 2017 (Final Act. 2–6; Ans. 2–4):

I. Claims 1–3, 6, 10, 12–14, 16, and 20–22 rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Isonaga (WO 2011/161919 A1, published December 29, 2011) and Masaki (US 7,504,916 B2, issued March 17, 2009).

II. Claims 7 and 14 rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Isonaga.

III. Claims 18 and 19 are rejected under pre-AIA 35 U.S.C. § 103(a) as unpatentable over Isonaga and Paessler (US 6,830,231 B2, issued December 14, 2004).

OPINION

After review of the respective positions that Appellant presents in the Appeal Brief and Examiner presents in the Final Office Action and the Answer, we REVERSE the Examiner's prior art rejections of claims 1–3, 6, 7, 10, 12–14, 16, and 18–22 under 35 U.S.C. § 103(a) for the reasons the Appellant presents. We add the following.

Independent claim 1 is directed to an actuator comprising an armature split into at least two armature parts with a damping element between the two armature parts, wherein one of the at least two armature parts has a cylindrical recess extending from an end face of the armature part, and the recess has a length at least equal to a length of a pull-in winding or a hold-in winding.²

The Examiner finds Isonaga discloses an actuator comprising at least two armature parts 4A, 4B and at least one damping element 17 between the at least two armature parts, wherein armature part 4A has a cylindrical recess extending from an end face of armature part 4A. Final Act. 2; Isonaga Figure 3, ¶¶ 37, 38. The Examiner finds that Isonaga's actuator differs from the claimed subject matter in that Isonaga does not teach the recess of armature part 4A has a length at least equal to a length of a winding. Final Act. 2-3; Ans. 2. The Examiner finds that Masaki's Figure 1 discloses an actuator 1 with an armature part 10 having a length that is at least equal to the length of the winding 7. Final Act. 3. The Examiner further finds that the lengths of Isonaga's armature part 4A and recess are result effective variables that can be optimized by one skilled in the art. Final Act. 3. The Examiner determines that it would have been obvious to one of ordinary skill in the art to modify armature part 4A of Isonaga's actuator so the recess has a length at least equal to a length of a pull-in winding or a hold-in winding in view of Masaki's Figure 1. *Id.*

Appellant contends that Masaki does not teach or suggest a relationship between the length of an armature part's recess and a length of a winding because Masaki does not teach a recess in an armature part and,

² We limit our discussion to independent claim 1.

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thus, Masaki would not lead one skilled in the art to modify the lengths of either Isonaga's windings or the recess of Isonaga's armature part as claimed. *Id.* at 7–8.

We agree with Appellant that there is reversible error in the Examiner's determination of obviousness. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

The Examiner asserts that Masaki's Figure 1 teaches a length relationship between the length of an armature part and a winding. Final Act. 3. The Examiner also recognizes that Masaki does not teach a recess in the armature part and asserts that “[t]here is no need for Masaki to teach the recess since the recess and second armature part is already taught by Isonaga.” Ans. 3. The Examiner's assertions misapprehend Appellant's arguments. In essence, Appellant's position is that the Examiner has not established that the cited art, as represented by Isonaga and Masaki, teach or suggest the claimed relationship of a “recess [of an armature part] ha[ving] a length at least equal to a length of a pull-in winding or a hold-in winding.” The Examiner's assertions do not address adequately Appellant's arguments. The Examiner has not explained adequately why one of ordinary skill would modify the recess length of Isonaga's armature part with respect to a winding length based on the relationship of Masaki's armature part, which

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lacks a recess, and winding illustrated in Masaki's Figure 1. Thus, the Examiner has not provided an adequate technical explanation with the requisite rational underpinning of how one skilled in the art, absent impermissible hindsight, would arrive at the claimed invention from the disclosures of the prior art.

Moreover, when drawings are used as prior art, the drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 914 (CCPA 1979). Further, when the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurements of the drawing features are of little value. *See Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”). The Examiner does not direct us to any portion of Masaki disclosing Figure 1 as drawn to scale. In addition, as we note above, the Examiner acknowledges that Masaki does not teach a recess in an armature part. Ans. 3. In other words, the Examiner does not evaluate Masaki's Figure 1 adequately for what Figure 1 reasonably discloses and suggests to one of ordinary skill in the art. That is, the Examiner has not shown adequately that Masaki's Figure 1 shows a relationship between the length of a recess of an armature part and the length of a winding.

Accordingly, we REVERSE the Examiner's prior art rejection of claims 1–3, 6, 7, 10, 12–14, 16, and 18–22 under 35 U.S.C. § 103(a) for the reasons the Appellant presents and we give above.

CONCLUSION

In summary:

Claims Rejected	35 U.S.C. §	Basis	Affirmed	Reversed
1-3, 6, 10, 12, 13, 16, 20-22	103(a)	Isonaga, Masaki		1-3, 6, 10, 12, 13, 16, 20-22
7, 14	103(a)	Isonaga		7, 14
18, 19	103(a)	Isonaga, Paessler		18, 19
Overall Outcome				1-3, 6, 7, 10, 12-14, 16, 18-22

REVERSED