

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCO LEONARDI,
JOHN MATHEWS GINDER and ROBERT CORBLI MCCUNE

Appeal No. 2005-1134
Application 10/064,583

ON BRIEF

Before WARREN, OWENS and KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

Decision on Appeal and Opinion

We have carefully considered the record in this appeal under 35 U.S.C. § 134, including the opposing views of the examiner in the answer and appellants in the brief and reply brief, and based on our review, find that we cannot sustain the rejections advanced on appeal: appealed claim 1 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over British Patent 1 444 858 ('858 patent) (answer, page 3); and appealed claims 2 through 10 under 35 U.S.C. § 103(a) as being unpatentable over the '858 patent (answer, page 4).¹

¹ Appealed claims 1 through 10 are all of the claims in the application. See the appendix to the brief.

In order to consider the examiner's application of the '858 patent to the claims, we must first interpret the language of appealed claim 1, which determination is controlling with respect to the disposition of this appeal. The plain language of appealed claim 1, styled in product-by-process format, *see generally, In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir. 1985), given the broadest reasonable interpretation in light of the written description of the specification as it would be interpreted by one of ordinary skill in this art, provides that the claimed electric motor comprises at least a first component formed from a composite admixture of permanent magnetic material and a binder kinetically sprayed atop a carrier, wherein the composite admixture has microstructures of permanent magnet material embedded in the binder material. Thus, the claim encompasses any electric motor having any component that is formed from any permanent magnetic material and any binder material therefor which can be kinetically sprayed to form a composite admixture having the specified microstructure on the top of any carrier. *See In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989). Accordingly, as appellants point out and contrary to the examiner's position, the process limitation of claim 1 must be given weight because such limitations characterize the claimed product.

We agree with appellants that the '858 patent does not utilize permanent magnetic material and a binder therefor which can be kinetically sprayed and thus does not form a composite admixture having microstructures of such permanent magnet material embedded in such binder material as specified in claim 1. Thus, as appellants argue, the fact that the claimed component of the claimed motor may have similar generic properties to the structure prepared from a paste of material in a polymer binder which is subsequently magnetized, does not alone constitute evidence that the claimed electric motor and the product of the '858 patent are identical or substantial identical. *See, e.g., In re Spada*, 911 F.2d 705, 708-09, 15 USPQ2d 1655, 1657-58 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255-56, 195 USPQ 430, 433-34 (CCPA 1977); *In re Skoner*, 517 F.2d 947, 950, 186 USPQ 80, 82 (CCPA 1975).

Accordingly, on this record, and the absence of rebuttal evidence by the examiner establishing that the claimed and prior art products are identical or substantially identical in response to appellants' arguments, *See generally, Spada*, 911 F.2d at 707 n.3, 15 USPQ2d at 1657 n.3; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re*

Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984), the examiner has failed to again establish a *prima facie* case of anticipation, *see generally*, *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); *Spada*, 911 F.2d at 707, 15 USPQ2d at 1657; *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78, 7 USPQ 1315, 1317 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984), and a *prima facie* case of obviousness. *See generally*, *In re Rouffet*, 149 F.3d 1350, 1358, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998); *Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1629-30 (Fed. Cir. 1996); *In re Fine*, 837 F.2d 1071, 1074-76, 5 USPQ2d 1596, 1598-1600 (Fed. Cir. 1988); *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Therefore, we reverse all of the grounds of rejection.

The examiner's decision is reversed.

Reversed

CHARLES F. WARREN)	
Administrative Patent Judge)	
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