

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opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KOJI AKIOKA, TATSUYA SHIMODA,
TOSHIYUKI ISHIBASHI, RYUICHI OZAKI,
and OSAMU KOBAYASHI

Appeal No. 1996-1777
Application No. 08/034,009

HEARD: February 10, 2000

Before OWENS, LIEBERMAN, and KRATZ, Administrative Patent Judges.

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's refusal to allow claims 1 through 24, which are all of the claims pending in this application.

BACKGROUND

The appellants' invention relates to a process of preparing a permanent magnet and product thereof. An

understanding of the invention can be derived from a reading of exemplary claims 1 and 24, which are reproduced below.

1. A method for preparing a permanent magnet having as principal constituents at least one rare earth metal, iron, boron and copper, comprising:

providing a magnet alloy composition including at least one rare earth metal, iron, boron and copper;

melting the magnet alloy composition including the rare earth metal, iron, boron and copper,

casting the alloy composition into an ingot,

hot working the alloy ingot at a temperature of at least about 500EC with a strain rate of from about 10^{-4} to 10^2 per second.

24. The permanent magnet formed by the method of claim 1.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---|-------------|---------------|
| Kobayashi et al. (Kobayashi) | 5,816,761 | Feb. 16, 1993 |
| Akioka et al. (PCT/JP) (Akioka '797) | WO 88/06797 | Sep. 7, 1988 |
| Akioka et al. (UK) (Akioka '241) | 2 206 241 | Dec. 29, 1988 |

Claims 1-23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Akioka '241¹. Claim 24 stands rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative,
under 35 U.S.C. § 103 as obvious over Akioka '797². Claim 24 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kobayashi.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we find that the examiner has not carried the burden of presenting a *prima facie* case of anticipation under 35 U.S.C. § 102 or a *prima facie* case of obviousness under 35 U.S.C. § 103. Accordingly, we will not sustain the examiner's rejections.

¹published UK patent application No. 2 206 241

²published PCT application (WO 88/06797). All subsequent references in this opinion to Akioka '797 are references to the English language translation of the published PCT application of record.

§ 103 Rejection of Claims 1-23

The examiner acknowledges that Akioka '241 does not teach the use of a copper containing alloy as is used in the claimed process. According to the examiner, however, "... the application of a known process such as the process taught by Akioka et al. to a different starting material does not lend patentability to the newly claimed process ..." (answer, page 3). We disagree. In our view, the case law cited by the examiner in support of this proposition, *In re Durden*, 763 F.2d 1406, 226 USPQ 359 (Fed. Cir. 1985) and *In re Kanter*, 399 F.2d 249, 158 USPQ 331 (CCPA 1968) at page 3 of the answer does not establish a universal rule regarding the obviousness of process claims that distinguish over a prior art process by the processing of different materials therein. As stated by our reviewing court in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." Since the only rationale proffered by the examiner is premised on such a *per se* rule, we will not sustain the stated rejection.

Rejections of Claim 24

At the outset, we note that appellants urge that neither Akioka '797 or Kobayashi as separately applied by the examiner against claim 24 is available as prior art thereto (reply brief, pages 3, 4, 7, and 8). The examiner contends otherwise. However, even if both of the above-noted references were available as prior art to appealed claim 24, we determine that the examiner has not presented a *prima facie* case of anticipation or obviousness, on the present record. Accordingly, we will not sustain the stated rejections for the reasons as follows.

With regard to the examiner's stated rejection of claim 24 under either 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over Akioka '797, we observe that the examiner acknowledges that Akioka '797 does not teach appellants' claimed strain rate (answer, page 4). Notwithstanding that acknowledged process difference, the examiner maintains that Akioka '797 anticipates or renders obvious the claimed product magnet since, according to the examiner, the magnet of Akioka '797 is of the same composition as appellants'

and the process of producing the magnet of Akioka '797 is substantially the same as that of appellants except for the strain rate limitation.

The flaw in the examiner's position, however, is that appellants have reasonably established, on the present record, that variations in the strain rate during the manufacturing process results in product magnets with different properties (See, e.g., Table 13, specification, page 30). On this record, the examiner has not established that any of the magnet compositions disclosed by Akioka '797 are both identical in composition and properties with the magnets encompassed by claim 24. Nor has the examiner furnished any convincing line of reasoning suggesting the obviousness to one of ordinary skill in the art of the product defined by claim 24 in light of the teachings of Akioka '797.

Similarly, the examiner's stated rejection of claim 24 as being unpatentable under § 103 over Kobayashi falls short of presenting a *prima facie* case of obviousness. This is so since Kobayashi, like Akioka '797 does not teach the claimed strain rate and the examiner has not established that the

claimed product herein with all of its attendant properties would have been obvious within the meaning of 35 U.S.C. § 103 from the disclosure of copper as one of several possible coercive force enhancing elements that may have been selected for use as a magnetic alloy additive therein. Accordingly, we will not sustain the examiner's stated rejections.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-23 under 35 U.S.C. § 103 as being unpatentable over Akioka '241; claim 24 under 35 U.S.C. § 102(b) as anticipated by,

or in the alternative, under 35 U.S.C. § 103 as obvious over
Akioka '797; and claim 24 under 35 U.S.C. § 103 as being
unpatentable over Kobayashi is reversed.

REVERSED

| | | |
|-----------------------------|---|-----------------|
| TERRY J. OWENS |) | |
| Administrative Patent Judge |) | |
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| |) | |
| |) | BOARD OF PATENT |
| PAUL LIEBERMAN |) | APPEALS |
| Administrative Patent Judge |) | AND |
| |) | INTERFERENCES |
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| PETER F. KRATZ |) | |
| Administrative Patent Judge |) | |

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APPEAL NO. - JUDGE KRATZ
APPLICATION NO.

APJ KRATZ

APJ OWENS

APJ LIEBERMAN

DECISION: **REVERSED**

Prepared By: TINA

DRAFT TYPED: 06 Dec 00

FINAL TYPED: