

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 39

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JURGEN BACHMANN, LARS L. FINSEN,  
and POUL E. HANSEN

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Appeal No. 2000-0650  
Application 08/599,668

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ON BRIEF

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Before PAK, WALTZ, and JEFFREY T. SMITH, Administrative Patent Judges.

WALTZ, Administrative Patent Judge.

#### **DECISION ON APPEAL**

This is a decision on an appeal from the examiner's final rejection of claims 13 through 23, which are the only claims remaining in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to forming a wire which is used for forming the stator windings of an electrical refrigeration compressor (Brief, page 2). A

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lubricant coating is applied to the wire to produce a low coefficient of friction so that the wire is not damaged during winding and mounting, and this lubricant is not capable of releasing substances that can damage the refrigeration system or the compressor (Brief, page 3). Appellants state that "all of the claims can be considered as a single group" (Brief, page 4). We construe this statement as meaning that the claims stand or fall together with independent claim 22. See 37 CFR § 1.192(c)(7)(1997). A copy of illustrative independent claim 22 is attached as an Appendix to this decision.

In addition to the admitted prior art listed on pages 3-4 of the Answer and appellants' admission of prior art on page 1 of the specification, the examiner has relied upon the following references as evidence of obviousness:

Saunders et al. (Saunders)	4,420,536	Dec. 13, 1983
Watanabe et al. (Watanabe)	5,420,185	May 30, 1995

The claims on appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable over Saunders in view of Watanabe and appellants' admission (Answer, page 4).<sup>1</sup> We reverse this rejection for the reasons stated below.

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<sup>1</sup> The examiner has withdrawn the final rejections based on 35 U.S.C. § 112, first and second paragraphs (Answer, page 2).

**OPINION**

The examiner finds that Saunders discloses a process for coating magnet wire for use in hermetic motors with an electrically insulating layer (Answer, page 4). The examiner further finds that Saunders teaches a process step of applying, by any conventional means, an external lubricant to the insulated wire for purposes of power insertion (Answer, page 5). The examiner additionally finds that the external lubricant of Saunders "can be any conventionally used lubricant," citing col. 2, l. 50-col. 3, l. 30, of Saunders (*id.*). The examiner recognizes that Saunders fails to disclose or teach the amide lubricants disclosed and claimed by appellants (e.g., see claim 15), and the process steps of winding and mounting the lubricant coated insulated wire in a stator winding (*id.*).

The examiner applies appellants' admission of prior art, as disclosed in the specification, page 1, ll. 15-29, as evidence that it was well known in the electrical cable art to use amide compounds as conventional lubricants over insulating layers around cables (wires) to reduce friction (*id.*). The examiner applies Watanabe as further evidence that fatty acid amides or esters were well known as lubricants with electrical insulating layers around cables or wires (*id.*). The examiner also cites

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appellants' admitted prior art (especially Saunders '737) as evidence that it was well known in this art to use the winding and mounting steps in stator windings of the wire of Saunders (*id.*). From these findings, the examiner concludes that it would have been obvious to one of ordinary skill in the art to use the known amide external lubricants, as admitted by appellants' specification and shown by Watanabe, as the lubricant coating for the insulated wire of Saunders in the known process steps of forming a stator winding (Answer, pages 5-6). We disagree.

As correctly argued by appellants, Watanabe does not disclose an amide external lubricant but adds all the materials, including the lubricant, in one composition to form the electrical insulating composition (Brief, page 7). See Watanabe, col. 1, ll. 11-16; col. 3, ll. 46-52; and Examples 3-5.

The examiner has also misconstrued appellants' admission of prior art on page 1 of the specification. The specification discloses, at page 1, ll. 15-29, that

It is known from the DE Offenlegungsschrift 1947071 and the GB Patent Specifications 1175059 and 1175060 to provide electrical cables with lubricants for the purpose of reducing the mutual friction between the cables. When such a lubricant *is added to the insulating layer* around the conductor ....

The preferred lubricant *added to the insulating layer* of polyolefin according to the above-mentioned documents is an amide which is added in various amounts

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and using various additives *to the insulating layer*  
before this layer is applied around the conductor.  
[Italics added].

Therefore the examiner's use of appellants' admission is factually incorrect, since the admitted prior art as disclosed on page 1 of the specification adds an amide lubricant to the insulating layer composition and *not* as an external lubricant to the insulating layer as required by claim 22 on appeal. This factual error is also apparent from a review of appellants' "admitted prior art" (see the Answer, pages 3-4) where the examiner cites GB 1175059, GB 1175060, and the English equivalent to DE 1947071 (GB 1230189; Answer, page 4). Each of these documents discloses a sheath of polyolefin as an insulating layer surrounding an electrical cable, where the polyolefin is blended with various additives such as an amide lubricant (e.g., see GB 1175059, page 1, ll. 39-46; page 1, l. 86-page 2, l. 18; and the Example at page 2, ll. 88-108).

The examiner's reliance on Saunders 4,350,737 (hereafter Saunders '737), incorporated by reference in Saunders (col. 2, ll. 63-67), is also misplaced. The examiner finds that Saunders '737 teaches esters as a conventional external lubricant, citing col. 5, ll. 53-68 (Answer, page 5). However, Saunders '737 teaches esters as a class can be used as lubricants "according to

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the present invention, either admixed with paraffin as an external lubricant, or alone (or as admixtures themselves) as internal lubricants." Col. 5, ll. 57-66, underlining added. Accordingly, Saunders '737 merely teaches the external lubricant of paraffins and esters that has also been disclosed by Saunders (col. 3, ll. 15-22), and teaches esters alone only as an internal lubricant for the insulating layer.

We also note that the examiner has not addressed the last step required by claim 22 on appeal, namely that after winding and mounting the wire in the stator windings, the lubricant is exposed to a compatible refrigerant/refrigeration system without damage (i.e., the refrigerant will not cause precipitation of the lubricant; specification, page 2, ll. 5-15; page 3, ll. 5-17; page 6, ll. 21-29; see the Reply Brief, page 2).

For the foregoing reasons, we determine that the examiner has not presented a sufficient factual basis to support a *prima facie* case of obviousness in view of the reference evidence and appellants' admitted prior art. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Accordingly, we cannot sustain the examiner's rejection.

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The decision of the examiner is reversed.

**REVERSED**

Chung K. PAK	)	
Administrative Patent Judge)	)	BOARD OF PATENT
	)	
THOMAS A. WALTZ	)	APPEALS AND
Administrative Patent Judge)	)	INTERFERENCES
	)	
JEFFREY T. SMITH	)	
Administrative Patent Judge)	)	

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**APPENDIX**

22. A process for forming a wire in the stator windings of an electrical refrigerating compressor using a refrigerant comprising the steps of:

(1) coating said wire with an electrically insulating layer compatible with and resistant to said refrigerant;

(2) coating said electrically insulating layer with a lubricant to give it a low coefficient of friction so that said wire will not be mechanically damaged during winding and rewinding;

(3) winding and mounting said wire in said stator windings;  
and

(4) after winding and mounting said wire in said stator windings, preventing damage to the refrigerating system or the compressor by exposing said lubricant to a compatible refrigerant/refrigeration system.