

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DANIEL E. ACKERMANN and VERNON E. KIEFFER

Appeal No. 2000-2081
Application 08/656,082

ON BRIEF

Before FRANKFORT, McQUADE, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 34, all of the claims pending in this application.

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Appellants' invention relates to a method for constructing a salient pole motor. As noted on pages 2 and 3 of the specification, a salient pole motor differs from an induction motor having distributed windings (i.e., wherein the turns of a winding pole are distributed over a predetermined number of teeth of the stator core, e.g., over three, five or seven teeth) in that the salient pole motor windings have all the turns of the motor pole in one winding group spanning a single tooth of the stator core. Appellants indicate that salient pole motors find general application as stepper motors. Independent claims 1, 14, 27, 29 and 30 are representative of the subject matter on appeal and a copy of those claims may be found in Appendix I of appellants' brief (Paper No. 17).

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

Rakula	3,229,134	Jan. 11,
1966		
Kieffer et al. (Kieffer)	3,714,973	Feb. 6,
1973		
Anderson	4,750,258	Jun. 14,
1988		

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Barrera 4,901,433 Feb. 20,
1990

An additional reference cited by the examiner and relied upon as part of the 35 U.S.C. § 112, second paragraph, rejection is:

Balke 3,157,939 Nov. 24,
1964

Claims 1, 2, 6, 8, 9, 14, 19, 21, 22, 27 through 29 and 31 through 34 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention.

In addition to the foregoing rejection, the appealed claims stand rejected under 35 U.S.C. § 102 and § 103 as follows:

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a) claims 1 through 6, 12, 14, 16 through 19, 27 and 29 through 32 under § 102(b) as being anticipated by Anderson;

b) claim 15 under § 103(a) as being unpatentable over Anderson;

c) claims 7 and 20 under § 103(a) as being unpatentable over Anderson in view of Barrera;

d) claims 10, 11 and 23 through 25 under § 103(a) as being unpatentable over Anderson in view of Kieffer;

e) claim 13 under § 103(a) as being unpatentable over Anderson in view of Rakula; and

f) claim 26 under § 103(a) as being unpatentable over Anderson in view of Kieffer and Rakula.

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Rather than reiterate the examiner's full statement of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we make reference to the examiner's answer (Paper No. 19, mailed October 27, 1999) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 17, filed July 6, 1999) and reply brief (Paper No. 20, filed December 27, 1999) for the arguments thereagainst.

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 have made the determinations which follow.

We turn first to the examiner's rejection of appealed

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claims 1, 2, 6, 8, 9, 14, 19, 21, 22, 27 through 29 and 31 through 34 under 35 U.S.C. § 112, second paragraph. After reviewing appellants' specification and the above enumerated claims in light thereof, and also in light of appellants' arguments in their brief and reply brief, it is our opinion that the scope and content of the subject matter embraced by appellants' claims on appeal is reasonably clear and definite, and fulfills the requirements of 35 U.S.C. § 112, second paragraph. In our view, the examiner's criticism of the language used in appellants' claims on appeal, in each instance, goes to the breadth of the claims and not to indefiniteness. It is well settled that breadth alone is not to be equated with indefiniteness and that

in determining whether a claim sets out and circumscribes a particular area with a reasonable degree of precision and particularity, the definiteness of the language employed in the claim must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one

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possessing the ordinary level of skill in the pertinent art.
See In re Johnson, 558 F.2d 1008, 1016 n.17, 194 USPQ 187, 194 n.17 (CCPA 1977). When that standard of evaluation is applied to the language employed in the claims before us on appeal, we are of the opinion that those claims set out and circumscribe a particular area with a reasonable degree of precision and particularity.

As for the issue regarding the "top sticks" set forth in claims 8, 9, 21 and 22, we point the examiner to appellants' disclosure at pages 13-14 wherein both insulation "wedges" (63) and "top sticks" (64) are described and where it is noted that "[i]n addition to or in place of the wedge 63, a top stick 64 may be used to close the opening 63 [sic, 61]." Thus, since a top stick can be used in addition to a wedge to close the opening

(61), there would appear to be nothing wrong with appellants' claiming such a combination of elements as they have done in

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claims 8, 9, 21 and 22 on appeal.

Given the foregoing, we will not sustain the examiner's rejection of appellant's claims 1, 2, 6, 8, 9, 14, 19, 21, 22, 27 through 29 and 31 through 34 under 35 U.S.C. § 112, second paragraph.

We next look to the examiner's prior art rejections of the appealed claims, turning first to the rejection of claims 1 through 6, 12, 14, 16 through 19, 27 and 29 through 32 under § 102(b) as being anticipated by Anderson. After a careful assessment of appellants' independent claims 1, 14, 27, 29 and 30 and of the Anderson reference, we must agree with appellants' position as set forth in the brief (pages 6-8) and in the reply brief, that Anderson does not disclose the method of constructing a salient pole motor as defined in the claims on appeal. Indeed, Anderson does not once mention salient pole motors, and the examiner's reliance on the statement in Anderson that the apparatus and method therein can be used for axially inserting

windings of "a multiple pole, multiple phase electric motor or other dynamoelectric machine" (col. 1, lines 9-11) does nothing to fill this gap. While the disclosure of a species in a reference will anticipate a claim to a genus, the reverse is not true, and thus disclosure of the genus of dynamoelectric machines in Anderson does not anticipate the species of a salient pole motor as claimed by appellants.¹

In light of the foregoing, and the examiner's failure to address certain limitations in the claims on appeal as pointed out by appellants on pages 6-8 of their brief, we must refuse to sustain the examiner's rejection of claims 1 through 6, 12, 14, 16 through 19, 27 and 29 through 32 under § 102(b) as being anticipated by Anderson.

¹ While a rejection of independent claims 1, 14, 27, 29 and 30 based on obviousness has not been made by the examiner and is thus not before us, we note in passing that the mere fact that a claimed species or subgenus may be encompassed by a prior art genus is also not sufficient by itself to establish a prima facie case of obviousness. See In re Baird, 16 F.3d 380, 382, 29 USPQ2d 1550, 1552 (Fed. Cir. 1994), In re Jones, 958 F.2d 347, 350, 21 USPQ2d 1941, 1943 (Fed. Cir. 1992) and § 2144.08 of the Manual of Patent Examining Procedure (MPEP).

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As for the examiner's rejections of the remaining claims on appeal under § 103 as being unpatentable over Anderson and certain secondary references (i.e., Barrera, Kieffer and Rakula), we have reviewed the secondary references, but find nothing therein that provides for the deficiencies in Anderson as noted above. Accordingly, we will not sustain the examiner's rejections of dependent claims 7, 10, 11, 13, 15, 20 and 23 through 26 under 35 U.S.C. § 103(a).

To summarize our decision, we note that 1) the examiner's rejection of claims 1, 2, 6, 8, 9, 14, 19, 21, 22, 27 through 29 and 31 through 34 under 35 U.S.C. § 112, second paragraph, has not been sustained, 2) the examiner's rejection of claims 1 through 6, 12, 14, 16 through 19, 27 and 29 through 32 under § 102(b) as being anticipated by Anderson has not been sustained, and 3) that none of the examiner's rejections under 35 U.S.C. § 103 of the remaining claims on appeal have been sustained.

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As should be apparent from the foregoing, the decision of the examiner rejecting claims 1 through 34 of the present application is, accordingly, reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
)	
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)	BOARD OF PATENT
JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
JEFFREY V. NASE)	

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