

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 29

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIROSHI OHMI and HIROSHI SHIMIZU

Appeal No. 1998-1571
Application No. 08/022,199

ON BRIEF

Before GARRIS, LIEBERMAN, and JEFFREY T. SMITH, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 9, 12, 20 and 21 as amended subsequent to the final rejection. These are all of the claims pending in the application.

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The subject matter on appeal relates to a method for producing a cylindrical coil comprising the steps of imparting a catalyst to the surface of a cylindrical substrate having a particular range of heat conductivity, deactivating portions of the catalyst via irradiation with a laser beam whereby groove portions are formed by removing a part of the substrate corresponding to the groove portions, and applying a plating solution to the substrate which reacts with the catalyst remaining on the substrate. Further details of this appealed subject matter are set forth in representative independent claim 9, a copy of which taken from the appellants' brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Arima et al. (Arima) 1982	4,361,597	Nov. 30,
Halliwel et al. (Halliwel) 11, 1987	4,686,114	Aug.
Antoon 1989	4,870,751	Oct. 3,
Liu et al. (Liu) 1989	4,882,200	Nov. 21,
Morita et al. (Japanese) 25, 1987	62-218580	Sep.

All of the claims on appeal are rejected under 35 U.S.C.

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§ 103 as being unpatentable over Liu or Halliwell or Antoon in view of the Japanese reference or Arima.

We cannot sustain this rejection.

As correctly argued by the appellants, the applied prior art contains no teaching or suggestion of the groove formation feature required by the independent claim on appeal. The examiner urges that it would have been obvious to provide the method of Liu, Halliwell or Antoon with this feature in view of the Japanese reference. However, the method of the Japanese reference is completely different from the respective methods of the primary references (as well as the here claimed method). For this reason, we perceive no reason and the examiner proffers none for providing any of the primary reference methods with the groove formation feature of the Japanese reference method.¹

With further regard to the appellants' claimed groove formation feature, the examiner makes the following comments on page 5 of his answer:

¹In fact, we agree with the appellants that Antoon's teaching at lines 52 through 58 in column 1 militates against such a provision.

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It is the Examiner position that the formation of grooves in the substrate are not necessary for the invention to produce the desired results. In support of the Examiner position, the specification (pg. 16, lines 26-29), discloses that groove formation by the laser is not necessary for the invention to work, but merely to have the catalyst deactivated.

It is not immediately apparent to us what point the examiner is attempting to make with these comments. Regardless, we consider it appropriate to respond to these comments by clarifying that the appealed claims expressly require the formation of groove portions and that these groove portions are disclosed in the appellants' specification as serving a desirable purpose (e.g., see the last full paragraph on specification page 7).

The decision of the examiner is reversed.

REVERSED

Bradley R. Garris)
Administrative Patent Judge)
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Paul Lieberman) BOARD OF
PATENT Administrative Patent Judge) APPEALS AND
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Jeffrey T. Smith
Administrative Patent Judge

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BRG:tdl

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APPENDIX

9. A method for producing a cylindrical coil comprising the steps of:

(i) imparting an electroless plating reaction catalyst to at least an outside surface of an insulation cylindrical substrate having a heat conductivity of 4.5 to 8.4 W/mEC;

(ii) deactivating the electroless plating reaction catalyst in the form of a continuous winding on a side surface of the insulation cylindrical substrate by irradiating a predetermined portion of the electroless plating reaction catalyst by a laser beam, whereby groove portions are formed by removing a part of the substrate corresponding to the groove portions, from which the electroless plating reaction catalyst is removed, and the electroless plating reaction catalyst of sides of the groove portions are deactivated;

(iii) applying an electroless plating solution to the insulation cylindrical substrate; and

(iv) allowing the electroless plating reaction catalyst to react with an electroless plating solution.

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