

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KUNITAKE MATSUSHITA, TAKAYUKI YAMAWAKI,
HIROSHI SANO, and KAZUO MURAMATSU

Appeal No. 1998-3026
Application No. 08/531,613

HEARD: FEBRUARY 20, 2001

Before THOMAS, LALL, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-4, which are all the claims remaining in the application.

We reverse, and enter a new ground of rejection in accordance with 37 CFR § 1.196(b).

BACKGROUND

The disclosed invention is directed to a stator assembly of a rotary electric device and a method of assembling the same. Claim 1 is reproduced below.

1. A stator assembly of a rotary electric device having a yoke, a yoke plate and a stator coil which are integrated by a synthetic resin comprising:

a yoke having a plurality of stationary magnetic poles;

a yoke plate having a plurality of stationary magnetic poles;

a stator coil disposed between said yoke and said yoke plate;

alignment notches provided on a surface of said yoke for mating with alignment pins disposed in a mold;

a synthetic resin filled between said yoke and said yoke plate and covering an outer surface of said yoke, and fixing said yoke, said yoke plate and said stator coil together; and

small holes provided in a surface of said synthetic resin over said alignment notches so that the alignment pins inserted into said alignment notches exclude said injected synthetic resin from said small holes.

The examiner relies on the following references:

Chestnut et al. (Chestnut)	3,558,940	Jan. 26, 1971
Kato	4,926,540	May 22, 1990

Claims 1-4 stand rejected under 35 U.S.C. § 102 as being anticipated by either of Chestnut or Kato.

We refer to the Final Rejection (Paper No. 15) and the Examiner's Answer (Paper No. 21) for a statement of the examiner's position and to the Brief (Paper No. 20) and the

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Reply Brief (Paper No. 24) for appellants' position with respect to the claims which stand rejected.

OPINION

The 35 U.S.C. 102 Rejections

Claims 1-4 stand rejected under 35 U.S.C. § 102 as being anticipated by either of Chestnut or Kato. We must reverse, pro forma, the examiner's rejection of the claims, because we consider the scope of the claims to be indefinite. If certain claim language is not understood, then any attempt to apply art against that claim can only be based on speculation. Rejections of claims over prior art should not be based on speculation as to the meaning of terms employed and assumptions as to the scope of the claims. In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We enter a new ground of rejection against the claims under 37 CFR § 1.196(b), infra.

We note, however, that the Final Rejection deems the subject matter of claims 1-4 as being "clearly anticipated" by Chestnut or Kato. Neither the Final Rejection nor the Answer points out what the anticipatory structures in the references are believed to be, other than the "small holes." However, independent claim 1 recites at least a yoke, a yoke plate, a stator coil, alignment notches, and a synthetic resin, in addition to the "small holes." If not for the indefinite scope of the claims, which requires the new ground of rejection, the instant application likely would have been remanded to the examiner for the examiner to

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place the facts upon which the anticipation rejection is based into the record. Any future Examiner's Answer in the instant case, should it include a rejection over the prior art, must compare the rejected claims feature by feature with the prior art applied.

New Ground of Rejection -- 37 CFR 1.196(b)

We enter the following new ground of rejection against the claims in accordance with 37 CFR § 1.196(b): Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 1 recites "small holes provided in a surface of said synthetic resin over said alignment notches so that the alignment pins inserted into said alignment notches exclude said injected synthetic resin from said small holes." First, we note that the recitation "said injected synthetic resin" lacks proper antecedent in the claim. However, in view of appellants' disclosure, there is a more significant problem with the above-quoted final paragraph of claim 1.

Although claim 1 purports the apparatus of "a stator assembly," the final paragraph appears to make reference to manufacturing steps. In this regard, we also note a reference to manufacturing steps, and structures not comprising a portion of the "stator assembly," elsewhere in the claim: "alignment notches provided on a surface of said yoke for mating with alignment pins disposed in a mold..." (emphasis added). The mere fact

that an apparatus claim, or a product claim, may contain apparent process limitations does not render a claim indefinite. Assuming the subject matter of a claim is otherwise understandable, the inquiry would then turn to determining the patentable weight of the process limitations when comparing the claim to the prior art. Process steps per se cannot serve to limit product claims. See In re Stephens, 345 F.2d 1020, 1023, 145 USPQ 656, 658 (CCPA 1965) (“We think it well settled that the presence of process limitations in product claims, which product does not otherwise patentably distinguish over the prior art, cannot impart patentability to that product.”). The relevant inquiry is how the process recitations might define structure. See, e.g., In re Dike, 394 F.2d 584, 589, 157 USPQ 581, 585 (CCPA 1968) (no error in USPTO board holding that term “blow-molded” in claims drawn to integral plastic container and handle failed to distinguish over prior art, because term related to process of making the article, and was not definitive as to the structure of the article).

The principal defect of claim 1 is that it misdescribes the provision or the forming of the “small holes,” and thus misdescribes the structure of the “small holes” which are “in a surface” of the synthetic resin of the stator assembly. According to pages 6 through 8 of the instant specification, yoke 55 and yoke plate 55a are forcibly fitted together by means of a pressure plate 5 (Fig. 1). Alignment pins 4a, 4b mate with respective alignment notches 55f (Fig. 2) of yoke plate 55a, and alignment pins 7a, 7b mate with respective notches 55g (Fig. 3) of yoke 55.

The next steps in manufacture are described in the last paragraph of page 8 through the first paragraph of page 10. Upper stationary subassembly A and lower stationary subassembly B are placed in die 8a (Fig. 5) for injection molding using the claimed “synthetic resin.” Upper mold half 9 is lowered until it abuts lower mold half 8.

During this operation, the alignment pins 9c, 9d move into the respective notches 55g of the upper stationary subassembly A to accurately align the upper and lower stationary subassemblies.

Then, under this condition, molten synthetic resin is injected into the mold through the injection port 9a of the upper mold half 9 until all the space inside the mold is filled with resin flowing into the inside of the upper and lower stationary subassemblies A and B....Fig. 6 is a schematic perspective view of a stator assembly 51' taken out of the injection metal mold. As seen from Fig. 6, a pair of small holes 51a, 51a are formed by the alignment pins at the locations of the notches in the stator assembly 51'.

(Specification, page 9, final ¶ through page 10, first ¶.)

Claim 1 is thus at odds with the disclosed process and product thereof. The “small holes” are not “provided” in a surface of the synthetic resin so that alignment pins inserted into the alignment notches exclude synthetic resin from the holes. Rather, the “small holes” are in place over the alignment notches because the alignment pins displace liquid resin during the molding steps, and thus prevent resin from forming over the alignment notches which mate with the respective alignment pins.¹

The function of claims is (1) to point out what the invention is in such a way as to distinguish it from the prior art; and (2) to define the scope of protection afforded by the

¹ In this regard we note that original claim 1, which comprises a portion of the disclosure of the invention, recited that the small holes are “formed by alignment pins in a mold.”

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patent. In re Vamco Mach., Inc., 752 F.2d 1564, 1577 n.5, 224 USPQ 617, 635 n.5 (Fed. Cir. 1985). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. In re Warmerdam, 33 F.3d 1354, 1361, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). The inquiry is merely to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed must be analyzed -- not in a vacuum, but in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art. Id.

With these guidelines in mind, we conclude that claim 1, being in contradiction to the disclosed invention, fails to pass muster under 35 U.S.C. § 112, second paragraph. The claim fails to reasonably apprise those of skill in the art of its scope. Since dependent claims 2-4 contain at least the limitations of claim 1, we enter the new ground of rejection under section 112, second paragraph against claims 1-4.

CONCLUSION

The rejections of claims 1-4 under 35 U.S.C. § 102 are reversed.

Claims 1-4 are newly rejected by us under 35 U.S.C. § 112, second paragraph.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131,

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53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)).

37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings

(§ 1.197(c)) as to the rejected claim:

(1) Submit an appropriate amendment of the claim so rejected or a showing of facts relating to the claim so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner

. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED -- 37 CFR § 1.196(b)

JAMES D. THOMAS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PARSHOTAM S. LALL)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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HOWARD B. BLANKENSHIP)	
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