

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 50

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MATS LEIJON

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Appeal No. 2002-2050  
Application No. 08/973,019

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ON BRIEF

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Before STONER, *Chief Administrative Patent Judge* and  
THOMAS and GROSS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

**REQUEST FOR REHEARING**

In a decision dated April 16, 2003, the decision of the examiner rejecting claims 1 through 10, 12 through 21, 25, 27 through 32, 34, 36, 37, and 39 through 45 under 35 U.S.C. § 103 was affirmed. A request for rehearing was filed on June 16, 2003.

Appellant contends (Request, pages 1-3) that by relying on Elton '077 in our decision we improperly made a new ground of rejection. Specifically, appellant states (Request, pages 1-2) that since the examiner's rationale did not rely on Elton '077,

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our reliance on Elton '077 constitutes a new ground of rejection, which appellant asserts (Request, page 3) is "prejudicial to Appellants [sic] and a clear violation of due process requirements."

As pointed out at pages 4-5 of our April 16, 2003 decision, **appellant referenced Elton '077 first**. Appellant directed our attention to Mr. Aabo's January 21, 2002 declaration which in turn, starting at page 5, discussed Elton '077 at length regarding the characteristics of the materials of Elton '565. Appellant (January 27, 2003 Request for Rehearing, pages 4-7) asserted that we disregarded the declaration. Thus, appellant clearly considered and even relied upon Elton '077, and our dependence upon Elton '077 was in response to appellant's reliance thereon.

Further, as Elton '077 was incorporated by reference in Elton '565 for the method of making and characteristics of the material in question, the discussion of the method of making and characteristics of the material are a part of Elton '565, which was named in the statement of the rejection. Consequently, our reliance upon Elton '077 does not constitute a new ground of rejection, and there has been no violation of due process requirements.

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Appellant contends (Request, pages 2-3) that contrary to our statements at pages 8-9 of our April 16, 2003 decision, the teachings of Elton '077 relate "to matter that is not necessarily present as to the glass fiber that is chopped, mixed with resin and molded or blown as described at column 8, lines 3-9 of Elton '565." Appellant continues that Mr. Aabo's declaration establishes that the teachings of Elton '077 relied upon in our decision are not necessarily present as to the Figure 7 pyrolyzed glass fiber layers 104 and 110 described in Elton '565. However, Elton '565 explicitly states that the method of making and characteristics of the materials used therein are described in Elton '077 and incorporates those teachings by reference. Therefore, all of the discussion in Elton '077 relating to the methods of making and the characteristics of pyrolyzed glass are necessarily present in the disclosure of Elton '565.

Appellant argues (Request, page 3) that our reliance upon Elton '077 changes the thrust of the rejection presented by the examiner and, therefore, constitutes a new ground of rejection in accordance with *In re Kronig*, 190 USPQ 425, 427 (CCPA 1976). However, the thrust of the rejection is still the same: Shildneck teaches the basic structure, Elton '565 teaches adding layers to eliminate corona discharge. The only difference is that we have answered appellant's objections to Elton '565, as explained

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**supra.** A response to a request for rehearing **always requires** a response to the arguments and, therefore, would **always** necessitate a new ground of rejection if appellant's argument were followed.

Appellant argues (Request, pages 4-6) that we improperly considered the evidence presented by various declarations. Specifically, appellant accuses us of substituting "an interpretation of the teaching of column 2, lines 20-26 of Elton '565, as to a suggestion of semiconductive tape that 'possibly could be in close contact' (emphasis added), for the well reasoned position based upon technically sound principles expressed in the above-noted Aabo Declaration." We, however, did no such thing. We explained why our interpretation of Elton '565 differed from Mr. Aabo's, and our use of "possibly could be in contact" was a response to Mr. Aabo's statements that semiconductive tape could not be in close contact.

Appellant states (Request, page 4) that "[t]he Board also advances no authority as to why it may legally ignore the requirements for the consideration of evidence presented by those of ordinary skill in the art." We did consider Mr. Aabo's opinions, but simply disagreed with them. Although opinion testimony rendered by experts must be given consideration and is generally entitled to some weight, it is not controlling.

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**Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.**, 776 F.2d 281, 227 USPQ 657, 666 (Fed. Cir. 1985); **Orthopedic Equipment Co. v. United States**, 702 F.2d 1005, 1012, 217 USPQ 193, 199 (Fed. Cir. 1983).

Appellant contends (Request, page 4) that

the Board first fails to here make clear its above-noted reliance on the Elton '077 teachings as supplementing those of Elton '565 or the manner that it merges these teachings together, much less what the relied on combined teachings of Shildneck and Elton '565 translates to in terms of what parts of the references contain these teachings. This failure to be specific is a clear violation of precedent.

Appellant (Request, page 4-5) points to our statement on page 11 of the decision regarding "the combined disclosures of Elton and Shildneck" outweighing the evidence of the Fenton Declaration testimony to "suggest that a cable structure is a substitute for bar windings."

First, our "reliance on" Elton '077 at pages 6-9 of our decision is primarily a response to Mr. Aabo's discussion of and reliance upon Elton '077. Second, the examiner (Answer, pages 4-5) clearly indicates what parts of the references are relied upon for the rejection. We then further elaborate upon the examiner's explanation of the rejection with cites to specific portions of the references substantially at pages 6-9 and 15 of our decision.

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Thus, the teachings of the references and how they are relied upon have been made clear.

Appellant (Request, page 5) accuses us of oversimplifying "the multitude of the actual structural differences [between Elton and Schildneck]" and "clearly tak[ing] reference teachings completely out of context so as to improperly expand them." However, appellant fails to enumerate any of the "multitude of the actual structural differences."

Further, appellant questions "where is the 'substantial evidence' that the additional layers of FIG. 6 and FIG. 7 of Elton '565 'yield the same benefit' as simply concluded without explanation"? The evidence that the additional layers of Figure 6 (and Figure 1) of Elton '565 yield the same benefit as those of Figure 7 is implicit in the background section of Elton '565 and is explicitly stated in the descriptions of the drawings.

More specifically, the majority of the "Background of the Invention" discusses the problem of electrical charge buildup and corona discharge in windings of electromagnetic machines, and, at column 2, lines 14-18, indicates that the same problems occur in cables carrying high voltages. In addition, in the description of Figure 1, Elton states that pyrolyzed glass fiber layer 18 "bleeds off the electric charge on that [exterior] surface. This bleeding off of the electric charge prohibits the development of

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a corona discharge in the region immediately adjacent the exterior surface of the winding 10" (see column 4, lines 37-42). Likewise, Elton describes Figure 7 as "a cable utilizing a semi-conducting pyrolyzed glass fiber layer to equalize the electric charge on the exterior of the insulator of the cable" (see column 7, lines 12-15).

Similarly, the description of Figure 6 includes an internal grading layer 79 of semi-conducting pyrolyzed glass fiber that "provides an equal electrical potential about the end regions of electrical winding 70." Likewise, Elton describes Figure 7 as a cable with "a semi-conducting layer utilized as an internal grading layer surrounding the conductors within the cable" and explains that the internal grading layer "equalizes the electric charge about conductive strands 102" (see column 7, lines 12-17 and 19-22).

Appellant contends that the statement on page 16 of our decision that "the previous Board decision somehow explained 'why one of ordinary skill in the art would have been motivated to combine the references' is not well taken as this decision admits it departs from and modifies that decision to such a degree that it is, in effect, a new decision." We designated the decision of April 16, 2003 a new decision because the response to appellant's arguments was modified. However, we have consistently indicated

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the rationale or motivation for combining the references to be that stated by the examiner on page 5 of the Answer, "to prohibit development of corona discharge," as taught by Elton '565.

Appellant argues (Request, pages 7-8) that we did not "adequately treat the evidence submitted as to secondary considerations." Specifically, appellant takes issue with our assertion that the declarations of Mr. Hirt and Mr. Fenton fail to establish a nexus between commercial success and the claimed invention because they rely on a definition of "high voltage" that is of a different scope than the claimed subject matter. Appellant then contends that there is no lack of a nexus "because it is the claimed structure of a high-voltage rotating electric machine that has the claimed high-voltage stator winding . . . that produces the superior and unexpected results noted." Appellant compares claim 1 to claim 29 of *Piasecki* (223 USPQ 785, 786-87 (Fed. Cir. 1984) to show that "there is no reason not to consider the unexpected highly superior attributes of the machine of Claim 1 because it does not recite a particular level of 'high-voltage.'"

Upon review of *Piasecki*, we find nothing that suggests that the specification therein defined "heavy" to include lighter loads than those contemplated by the various declarations in the way that appellant's specification defines "high voltage" to

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include voltages specifically precluded by the testimony of Mr. Fenton and Mr. Hirt. Appellant's claim 1 recites "high voltage," which, in the absence of specific voltages in the claims, is interpreted in light of the specification. The disclosure indicates that "high voltage" refers to any voltage above 10 kV, which includes the voltages of Shildneck. Therefore, testimony of unexpected results at voltages of 136 kV or 177 kV, for example, as stated by Mr. Hirt on page 7 of the June 26, 2001 declaration, does not show unexpected results for all voltages covered by the claims and is thus not commensurate in scope with the claims. Accordingly, there is no nexus between the evidence of commercial success and unexpected results and the claimed invention. Further, the evidence does not speak to the obviousness *vel non* of combining Shildneck and Elton '565, which relate to the lower voltages covered by the claims.

In closing, we sufficiently modified our original decision (November 27, 2002) in this Appeal, as noted at pages 2 and 17 of our last opinion (April 16, 2003), that we designated that last opinion as a new decision. That designation afforded appellant the administrative due process right to seek its rehearing. Since this has been done, and since we have herein rendered a decision on appellant's request for rehearing, appellant's administrative due process interests have been preserved.

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Accordingly, appellant's request has been granted to the extent that our decision has been reconsidered, but such request is denied with respect to making any modifications to the decision.

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

**REHEARING  
DENIED**

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| Bruce H. Stoner, Jr.              | ) |                 |
| Chief Administrative Patent Judge | ) |                 |
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|                                   | ) | BOARD OF PATENT |
| JAMES D. THOMAS                   | ) | APPEALS         |
| Administrative Patent Judge       | ) | AND             |
|                                   | ) | INTERFERENCES   |
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| ANITA PELLMAN GROSS               | ) |                 |
| Administrative Patent Judge       | ) |                 |

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