

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 44

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLAND MOSER, DANIEL BAR and CARL W. MAYER

Appeal No. 2002-0755
Application No. 08/999,803

HEARD: January 07, 2003

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

KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 2-4, 8-11 and 14, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to a method for preparing

14. A process for preparing resin impregnated wire windings comprising

a) heating said wire windings in an oven to a temperature of about 110 to about 200°C;

b) subsequently trickling a one-component impregnating resin, which is storage-stable at room temperature, onto the heated, rotating wire winding or dripping the heated, rotating wire winding in a bath filled with said one-component impregnating resin,

wherein the impregnating resin consists essentially of:

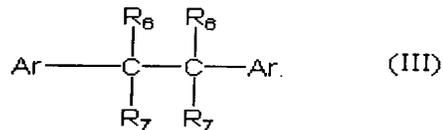
(A) an epoxy resin that is liquid at room temperature; and

(B) a heat-activatable initiator for the polymerisation of the epoxy resin, the initiator comprising

(a) at least one quaternary ammonium salt of an aromatic-heterocyclic compound which contains 1 or 2 nitrogen atoms, and of a complex halide anion selected from the group consisting of BF_4^- , PF_6^- , SbF_6^- [sic - SbF_6^-], $\text{SbF}_5(\text{OH})^-$ and AsF_6^- , and

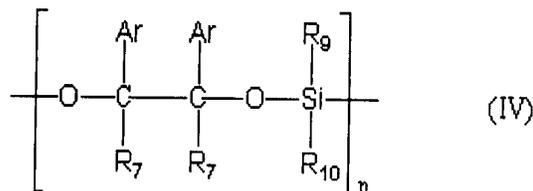
(b) at least one thermal radical former (b1), (b2), (b3) or (b4), wherein

(b1) is a diarylethane derivative of formula III



wherein Ar is phenyl, naphthyl, or C₁-C₄ alkyl- or chloro-substituted phenyl,

R₆ is hydroxy, C₁-C₄ alkoxy, $^- \text{OOC-R}_8$ or $-\text{OSiR}_9\text{R}_{10}\text{R}_{11}$, wherein R₈ is C₁-C₈ alkyl or phenyl, and R₉, R₁₀ and R₁₁ are each independently of one another C₁-C₄ alkyl or phenyl, and R₇ is C₁-C₄ alkyl or cyclohexyl or has the same meaning



wherein Ar, R₇, R₉ and R₁₀ have the same meaning as in formula II and n is 2-20,
(b3) is an organic peroxy compound, and
(b4) is a quinone.

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

Thigpen et al. (Thigpen)	5,474,799	Dec. 12, 1995 (filed Oct. 13, 1992)
Berner et al. (Berner)	4,393,185	Jul. 12, 1983

Claims 2-4, 8-11 and 14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Thigpen in view of Berner.

We refer to the brief and reply brief and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Upon careful consideration of appellants' specification and the claims on appeal, the evidence of obviousness relied upon by the examiner, and the opposing arguments presented by appellants and the examiner, we find that the aforementioned § 103 rejection

In rejecting the claim under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). In order to establish a prima facie case of obviousness, it is fundamental that all elements recited in each claim must be considered and given appropriate effect by the examiner in judging the patentability of that claim against the prior art. See In re Geerdes, 491 F.2d 1260, 1262-63, 180 USPQ 789, 791 (CCPA 1974). Here, the examiner's rejection set forth in the answer fails to meet that basic test for the presentation of a sustainable § 103 rejection.

In particular, the examiner (answer, pages 4 and 5) takes the position that it would have been obvious to modify the electromagnetic coil coating process of Thigpen by employing the one-component curable resin composition of Berner therein in place of the two-component resin of Thigpen. According to the examiner, that modification of the Thigpen process would have been suggested to one of ordinary skill in the art since any

The difficulty we have with the examiner's obviousness position stems from the fact that all of the claims on appeal are drawn to a two step process including a first step of "heating ... wire windings in an oven to a temperature of about 110 to about 200°C" followed by a trickling or dip coating method whereas Thigpen is concerned with a low temperature coating process wherein the coating of the coils begins at a temperature of 140°F and is followed by curing at 170°F. See column 2, line 59 through column 3, line 49 of Thigpen. Thus, the examiner's obviousness analysis does not address, much less explain, how the combination of the teachings of Thigpen and Berner would have led one of ordinary skill in the art to discard the low temperature coating method of Thigpen with a 170°F curing temperature and result in a method with an initial oven heating of the wire windings to a temperature of 110 to about 200°C (230 to about 424°F) as called for in all of appellants' claims.

The examiner simply has not furnished a convincing rationale explaining how the combined teachings of Thigpen and Berner would



our view that the examiner has not discharged the burden of establishing a prima facie case of obviousness with respect to the subject matter defined by the appealed claims.

CONCLUSION

The decision of the examiner to reject claims 2-4, 8-11 and 14 under 35 U.S.C. § 103 as being unpatentable over Thigpen in view of Berner is reversed.

REVERSED

CHUNG K. PAK)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
PETER F. KRATZ)	APPEALS
Administrative Patent Judge)	AND
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JEFFREY T. SMITH)	
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