

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte WINFRIED ARZ and STEFAN STOCKER

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Appeal No. 2003-1250  
Application No. 09/388,582

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HEARD: OCTOBER 9, 2003

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Before HAIRSTON, DIXON, and SAADAT, Administrative Patent Judges.  
HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, 11 and 13. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The disclosed invention relates to a magnetic coil directly cooled by a cooling tube that extends through an opening formed by at least two profiled electrical conductor segments of a coil winding.

Appeal No. 2003-1250  
Application No. 09/388,582

Claim 1 is the only independent claim on appeal, and it reads as follows:

1. A directly cooled magnetic coil comprising:  
  
a conductor forming a coil winding comprising at least two profiled electrical conductor segments which when fitted together, form an opening, and  
  
a cooling tube disposed permanently in said opening and surrounded by said profiled segment conductors, said coiling tube being comprised of a substantially electrically non-conductive, flexible material.

The references relied on by the examiner are:

Haldeman, III (Haldeman)	3,946,349	Mar. 23, 1976
Couffet et al. (Couffet)	5,430,274	Jul. 4, 1995

Claims 1, 2, 11 and 13 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Haldeman.

Claims 1, 2 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Couffet in view of Haldeman.

Reference is made to the supplemental brief (paper number 19) and the answer (paper number 20) for the respective positions of the appellants and the examiner.

#### OPINION

We have carefully considered the entire record before us, and we will sustain the anticipation rejection of claims 1, 2 and 11, and reverse the anticipation rejection of claim 13 and the obviousness rejection of claims 1, 2 and 11.

Appeal No. 2003-1250  
Application No. 09/388,582

Anticipation is only established when a single prior art reference discloses every limitation of the claimed invention, either explicitly or inherently. Glaxo Inc. v. Novopharm Ltd., 52 F.3d 1043, 1047, 34 USPQ2d 1565, 1567 (Fed. Cir.), cert. denied, 516 U.S. 3378 (1995). The examiner is of the opinion that Haldeman discloses all of the limitations of claim 1. We agree with the examiner's findings (answer, page 3) that Haldeman discloses (Figure 1) profiled conductor segments 5 fitted together to form an opening for a permanent plastic cooling tube 3.

Appellants argue (brief, pages 4 and 5) that the profiled conductor segments in Haldeman are akin to their nonelected species of Figure 9, and that "the Examiner either should not have relied on the Haldeman reference as a basis for allegedly anticipating the subject matter of claim 1, or should have withdrawn the election of species requirement (at least with regard to Fig. 9)." In response, the examiner indicates (answer, page 5) that:

[A]n election of species is based upon consideration of the independence of inventions disclosed in an application. Election of species practice is unrelated to rejection of claims over prior art where claims must be given their broadest reasonable interpretation.

Appeal No. 2003-1250  
Application No. 09/388,582

We agree with the examiner. When claim 1 is given its broadest reasonable interpretation, we find that it reads directly on Figure 1 of Haldeman.

Appellants argue (brief, page 6) that "[t]he interior core 3, however, is only temporarily present during assembly, and is subsequently removed, and in fact according to the teachings of the Haldeman reference, it is undesirable to keep the tube 3 in place." In response, the examiner states (answer, page 5) that "Haldeman's Fig. 1 is disclosed as an example of Haldeman's prior art (col. 1, lines 35-42) and as such constitutes a finished product." According to Haldeman (column 2, lines 44 and 45), "FIG. 1 illustrates the typical construction of Litz cable 1 with a nylon tube 3." The referenced portion of Haldeman (column 1, lines 35 through 42) states that water is pumped through the nylon tube 3. If water is pumped through the tube, then it is a finished product, and the tube is "permanently" disposed as set forth in claim 1.

Appellants arguments (brief, page 7) concerning high voltages, de-ionized water and non-processed water are not commensurate in scope with the invention set forth in claim 1.

In summary, the anticipation rejection of claim 1 is sustained based upon the conventional cooling tube and Litz cable

Appeal No. 2003-1250  
Application No. 09/388,582

teachings of Haldeman. The anticipation rejection of claims 2 and 11 is likewise sustained because appellants have chosen (brief, page 4) to let these claims stand or fall with claim 1.

The anticipation rejection of claim 13 is reversed because the examiner's conclusion (answer, page 5) that "[t]he term gradient does not confer any definite structural attribute to the coil" is in error, and because the appellants have correctly concluded (brief, page 8) that Haldeman is not directed to such a coil.

The obviousness rejection of claims 1, 2 and 11 is reversed because the examiner has not presented any evidence to buttress his opinion (answer, page 4) that the cooling tubes disclosed by the two applied references "were art-recognized equivalents at the time the invention was made . . . ." In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

#### DECISION

The decision of the examiner rejecting claims 1, 2, 11 and 13 under 35 U.S.C. § 102(b) is affirmed as to claims 1, 2 and 11, and is reversed as to claim 13. The decision of the examiner rejecting claims 1, 2 and 11 under 35 U.S.C. § 103(a) is reversed. Accordingly, the decision of the examiner is affirmed-in-part.

Appeal No. 2003-1250  
Application No. 09/388,582

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

AFFIRMED-IN-PART

KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	BOARD OF PATENT
JOSEPH L. DIXON	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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MAHSHID SAADAT	)	
Administrative Patent Judge	)	

KWH/hh

Appeal No. 2003-1250  
Application No. 09/388,582

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